

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2537724 IN THE
NAME OF INTEGRATED FINANCIAL ARRANGEMENTS PLC**

**AND IN THE MATTER OF OPPOSITION NO. 102145 THERETO BY MOTU
LIMITED**

**OPPONENT'S APPEAL TO THE APPOINTED PERSON FROM THE
DECISION OF AL SKILTON DATED 21 SEPTEMBER 2012**

DECISION

Introduction

1. This case involves the relatively unusual situation in which an applicant for an opposed trade mark has persuaded the registrar to reject the opposition on the basis that the opponent has failed to establish use of the earlier trade mark relied on by the opponent to challenge the application.
2. The application concerned is for a series of two word marks, MONEYMAP and MoneyMap, in respect of “the provision of financial information, namely analysis of investments in portfolios” in Class 36 (UK trade mark application no. 2537724 – “the **Application**”). The opponent opposed this under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”), claiming that the marks were both similar to its own earlier UK trade mark registration no. 2325727 (“the **Earlier Mark**” – shown here)

Money Mapping

and covered identical or similar services (“insurance services, financial affairs, monetary affairs, real estate affairs, financial planning, collection of financial information”) such that there was a likelihood of confusion on the part of the public.

3. As a registered UK trade mark with an application date earlier than that of the Application, the opponent's mark qualifies as an “earlier trade mark” under section 6(1) of the Act. However, since it was granted on 27 February 2004 and the Application was published on 8 April 2011, it is subject to the use conditions set out

in section 6A of the Act, which were inserted by The Trade Marks (Proof of Use, etc.) Regulations 2004 (SI 2004/946), as follows:

6A Raising of relative grounds in opposition proceedings in case of non-use

- (1) This section applies where –
 - (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if –
 - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes –
 - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5)
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7)

4. The applicant put the opponent to proof that the Earlier Mark had been used during the five year period ending with the date of publication of the Application (or alternatively that there were proper reasons for non-use), the opponent thus bearing the burden of proof pursuant to section 100 of the Act, which provides:

100. Burden of proving use of trade mark

If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put it is for the proprietor to show what use has been made of it.

5. The opponent relied on a witness statement dated 21 November 2011 from its director, Austyn Smith, with two exhibits. The applicant did not file any evidence, but simply filed written submissions arguing that such evidence was insufficient to discharge the burden of proving use. The hearing officer, Al Skilton, agreed, issuing

a decision on the papers on 21 September 2012 (BL O-354-12 – “the **Decision**”), rejecting the opposition on the basis that the opponent had failed to prove use of the Earlier Mark in the relevant period and ordering the opponent to pay the sum of £500 as a contribution towards the applicant’s costs.

6. The opponent now appeals to the Appointed Person under section 76 of the Act, on the substantive and intertwined grounds that:
 - (1) the hearing officer failed to apply the correct legal principles relating to what constitutes genuine use, apparently imposing an incorrect requirement of significance or substantiality of use of the Earlier Mark; and
 - (2) she failed properly to understand and assess the opponent’s evidence and too readily accepted criticism of it, which she should not have done in the absence of conflicting evidence and without further investigation.

The opponent also raises two procedural grounds of appeal, as follows:

- (3) the hearing officer took account of written submissions filed by the applicant on 4 April 2012, which she should not have done given that these were filed out of time and the hearing officer did not mention that she would rely on them at a case management conference that took place on 3 July 2012; and
 - (4) Mr Huw Evans of Chapman Molony, the opponent’s representative, was told in a phone call to the Law Section of the Trade Marks Registry on 3 July 2012 that, “should the [opponent’s] evidence be deemed insufficient, ... the Registry would seek further clarification”, but no such clarification was sought before the Decision was issued.
7. Particularly in the light of the procedural complaints, the opponent also now requests permission to adduce further evidence, in the form of a second witness statement of Austyn Smith, dated 18 October 2012, with a further exhibit.
8. I heard the appeal and the opponent’s application on 24 March 2014. The opponent was represented by counsel, Thomas Moody-Stuart, instructed by Chapman Molony; the applicant was represented by Jeremy Pennant of D Young & Co LLP.

Approach

9. I consider the appeal first since, if I conclude that the hearing officer was wrong to hold that the opponent’s evidence was insufficient to prove genuine use in relation to relevant services, then it may not be necessary to consider the application to adduce additional evidence at all.

10. As both parties accept, my role as the appellate tribunal is to review the Decision, not to re-hear the case. I should show “a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle”: *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28].

The Appeal

11. The Decision is in a conventional form, setting out the key facts and dates (paragraphs 1-8) and then summarising the opponent’s evidence (paragraph 9), followed by a section going through the relevant legislative provisions (paragraphs 10-13). The hearing officer then cites a number of authorities in relation to the proof of genuine use (paragraphs 14-18), including my decision in *SANT AMBROEUS Trade Mark* [2010] RPC 28 summarising the guidance from the European Court of Justice in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and from the Court of Appeal in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5, and guidance given by the courts in relation to what constitutes a fair specification. She then refers to two points from the applicant’s written submissions (paragraphs 19-20) before spending two paragraphs (21-22) on her assessment of the opponent’s evidence of use and then setting out her conclusion (at paragraph 23) that the opposition fails for failure to prove use of the Earlier Mark, and her ruling and order as to costs (paragraphs 24-25).

12. The key parts of the Decision for the purpose of this appeal are the summary of the evidence, the guidance on what constitutes genuine use, and the hearing officer’s assessment of the evidence in the light of that guidance.

13. Starting with the evidence, the hearing officer summarised this as follows:

“9. The opponent’s evidence consists of a witness statement from Austyn Smith, dated 21 November 2011, accompanied by 2 exhibits. Mr Smith is the Director of Motu Limited, a position he has held for 12 years. The main facts emerging from Mr Smith’s statement are, in my view, as follows:

- Austyn James Consulting Limited (a licensee of Motu Limited) have offered MONEY MAPPING services from 2003.
- The service provides financial advice to individuals.
- The mark is Mr Smith’s own handwriting.
- During consultation with customers Mr Smith uses paper which has a copy of the mark on the top right hand corner. An example of this is provided at exhibit AJ1. It consists of one sheet of A4 paper. On the paper are some handwritten figures, a hand written date of 19 November 2010 and a handwritten version of the mark in the top right corner. It is not the exact version of the mark which has been registered. However, for reasons that will become clear, nothing rests on this difference.

- Mr Smith also provides financial forms and papers for customers, which have been used since 2004. An example is provided at exhibit AJ2. The form consists of one A4 sheet which is headed ‘360 REVIEW’, there is a space below for name and date. A blank spider diagram takes up the majority of the page, which has a copyright date of 2004 - 2011. The mark, as registered, can be seen in the top right hand corner and the address for Austyn James Consulting Limited is provided at the bottom.”

14. The opponent does not criticise this summary, which in my opinion is accurate, except to the extent that there may be a suggestion in the first sentence under the fourth bullet point that the paper used by Mr Smith during his consultations is pre-printed with a copy of the Earlier Mark, whereas it is clear from Mr Smith’s witness statement that this is not the case. In fact, he claims to write it on himself. What Mr Smith actually said was this:

“6) During the course of the [MONEY MAPPING] service, a unique kind of face-to-face consultation is provided by myself, whereby I collect financial information and provide advice, which is written down or mapped on paper, which the individual then takes away as a document for future reference.

7) When undertaking these special consultations I always apply a facsimile of the stylized mark (which is the subject of Trade Mark No. 2325727) to the top of the paper before the service is offered to the customer. This then acts as a badge of origin on the document to remind the customer that they have received our services under that mark. There is now produced and shown to me Exhibit AJ-1 which is a representation of a typical document that we would produce.”

15. For the sake of completeness, and because the appeal focuses on the precise words used by Mr Smith, he said the following about the “financial forms and papers for customers” referred to in the last bullet point of the summary:

“8) We have also produced some financial forms and papers for customers bearing the stylized mark (which is the subject of Trade Mark No 2325727). These forms have been provided from 2004 to-date. There is now produced and shown to me Exhibit AJ-2, which is one such form bearing the mark.”

16. These three paragraphs of the witness statement, together with the two one-page exhibits, were the sum total of the evidence put forward to substantiate the claimed licensed use of the Earlier Mark in the business of Austyn James Consulting Limited.

17. Turning to the legal principles, the hearing officer set out the six-paragraph summary from *SANT AMBROEUS* at [42] in full, which the parties both adopted. To further summarise the first four principles, in short, genuine use means:

- (1) actual use by the proprietor or a third party with authority;
- (2) which is more than merely token;

- (3) which is consistent with the essential function of the trade mark to guarantee trade origin;
- (4) and is by way of real commercial exploitation.

18. The fifth and sixth principles are particularly relevant to this appeal, which are that:

- (5) all the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide; and
- (6) use of the mark need not necessarily be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. ...

19. When she came to decide whether the opponent's evidence was sufficient to establish genuine use, the hearing officer set out her reasoning as follows:

21. The evidence provided by the opponent consists of two sheets of A4 paper. The first of these contains some handwritten figures, presumably for use as part of a financial consultation. In the top right hand corner there is a hand written representation of the mark. The form is dated 19 November 2010. The other is a blank form, headed '360 review', with a representation of the mark, as registered, in the top right hand corner. Copyright dates 2004 -2011 are provided at the bottom of the page.

22. The forms provided in evidence appear to be documents used for the collection of financial information for the purposes of financial planning. However, neither of these exhibits assists in any way to provide the information necessary for me to reach a conclusion on whether or not and to what extent the mark has been used. These forms may have been used on many occasions or only once. I have no turnover figures before me, no indication of marketing spend and no evidence to show the average consumer is exposed to the mark at all. The material provided by the opponent does not go to show evidence of use of the mark, in relation to the services for which it is registered, within the relevant period. Consequently, this opposition fails at the first hurdle.

Substantive grounds of appeal

20. The opponent does not raise any objection to the hearing officer's recitation of the law, except to say that the majority of the cited authorities relate to whether genuine use is established in relation to all or only a sub-set of the goods or services in a specification, which is irrelevant in this case. Its complaint under the substantive

grounds summarised at paragraphs 6(1) and (2) above is essentially that the hearing officer failed to apply the correct legal principles to the opponent's evidence, in particular by requiring fuller evidence than was necessary, and/or she misinterpreted that evidence.

21. In his oral submissions, Mr Moody-Stuart focused on the hearing officer's statements that the opponent's evidence "consists of two sheets of paper", that they "appear to be documents used for the collection of financial information", and that neither of them assisted by providing the information necessary for her to reach a conclusion on "whether or not and to what extent" the Earlier Mark has been used. He argued that the hearing officer appears to have forgotten her earlier summary of the evidence and the fact that the exhibits were put into context by Mr Smith's witness statement, the content of which makes it clear that the Earlier Mark was in fact used by way of real commercial exploitation, albeit without providing a great deal of detail. Mr Moody-Stuart conceded that the evidence was at the "slimmer" end of the spectrum of what was necessary to prove use, but argued that the hearing officer was wrong to say that the two exhibited documents did not provide evidence as to whether or not the Earlier Mark had been used at all, given that the witness statement says that they were given to customers, and does so in such terms that it is obvious that this was done on a number of occasions.
22. Mr Moody-Stuart argued further that the hearing officer's observation that there were no turnover figures was correct, but irrelevant given that there is no *de minimis* requirement for use; and that her remark that there was no indication of marketing spend was also correct, but irrelevant in circumstances where the evidence was that every customer was exposed to the mark during their consultation with Mr Smith and that forms bearing the mark were provided to customers since 2004.
23. Mr Pennant, arguing for the applicant, drew my attention to *Anheuser Busch Inc. v OHIM*, Case T-191/07, [2009] ECR II-00703, in which the General Court stated:

103. The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237, paragraph 71).

104. To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (*VITAFRUIT*, paragraph 99 above, paragraph 42; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 37; see also, by analogy, *Ansul*, paragraph 100 above, paragraph 39).

105. Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).

24. Building on the point in paragraph 105, Mr Pennant also relied on the decision of Daniel Alexander QC, sitting as the Appointed Person in *Awareness Limited v Plymouth City Council (PLYMOUTH LIFE CENTRE)* BL O-236-13, in which he referred to *Anheuser-Busch* (above) and stated as follows:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (to use the words of *Anheuser-Busch* – see above).

20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time review the material that it has to prove use of it. Courts and tribunals are not unduly harsh as to the evidence they are prepared to accept as establishing use....

and also:

22. The burden lies on the registered proprietor to prove use. However, that and other cases show that there is no particular way in which use must be established. At the initial stage of revocation proceedings, where all he has to show is an arguable case, the approach may be more relaxed but even when the matter comes to be finally determined there is also no hard and fast way in which use must be proved. Evidence which may be sufficient to establish an arguable case that there has been use for the purpose of rule 31 may be insufficient ultimately to prove that there has been such use on the balance of probabilities. However, it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more, so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

25. I note for the record that the reference to having to show an arguable case at the initial stage of revocation proceedings, for the purpose of rule 31, is a reference to rule 31 of the old Trade Marks Rules 2000, under which the proprietor had two bites of the cherry for proving use. This is not intended to be the case under rule 38 of the current Trade Marks Rules 2008, which provides that the proprietor must file evidence of use of the mark (or evidence supporting the reasons for non-use) either with its Form TM8(N) and counter-statement under rule 38(3), or within a further

period of not less than two months specified by the registrar under rule 38(4). While there is some flexibility in relation to further rounds of evidence, with the registrar having discretion under rule 38(8) to allow either side to file further evidence, the norm is that after the first round the proprietor would only be permitted to file evidence in reply to any evidence submitted by the applicant. Therefore, the proprietor has to put its best foot forward in the first round of evidence, subject to the possibility of seeking leave from the registrar to adduce additional evidence at a later date, which the registrar may or may not grant, depending on the circumstances of the case. The same is true in relation to the proof of use by an opponent under section 6A of the Act. Where the applicant puts the opponent to proof of use, the opponent must file its evidence of use along with any other evidence in chief on which it relies in support of its opposition. Again, while rule 20(4) of the Trade Marks Rules 2008 gives the registrar discretion to allow either party to file evidence on appropriate terms, the usual requirement is for the opponent to file the evidence in one go. (See sections 3.1.10 and 4.8.2.1 of Chapter 7 of the Registry's Manual of trade marks practice, published on its website at <http://www.ipo.gov.uk/tmmanual-chap7-law.pdf>.)

26. Based on this guidance, Mr Pennant submitted that the hearing officer was right to reach the decision that she did, even if she may not have expressed her reasoning very fully. I think he is right. As a long-time director of both the opponent and Austyn James Consulting Limited, which was claimed to be licensed to use the Earlier Mark, and the person who claims to be responsible for applying it to forms at meetings with customers, Mr Smith would be in the best possible position to explain the scope and extent of use of the Earlier Mark and to exhibit sample documents to which it has been applied during the relevant period. But his account of how the Earlier Mark has been used is in the vaguest of terms, and is by reference to one piece of paper on which Mr Smith has written the words "Money Mapping ®" by hand, which bears a date within the relevant period, and another undated piece of paper bearing the Earlier Mark. The handwritten representation on the first document is not identical to the Earlier Mark as registered, but probably falls within the scope of use that counts as being "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" within section 6A(4)(a). However, without seeing further examples, one could not be confident that its appearance is always so close to the Earlier Mark as registered; and, as far as the second document is concerned, there is no concrete information about how documents like it have been used.
27. As Mr Pennant submitted, even though he should have been in a position to provide such information, Mr Smith gave none relating to:

- (a) the alleged licence;

- (b) the extent of use in the form of financial or turnover figures;
- (c) the extent of or any examples of marketing materials or spend; or
- (d) the nature, identity or number of his customers.

28. While I agree with Mr Moody-Stuart that the hearing officer's discussion at paragraphs 21-22 of the Decision is not entirely accurate in that (a) it is not quite correct that "the evidence ... consists of two sheets of A4 paper", since the evidence consists of the witness statement as well as those two sheets (comprising Mr Smith's exhibits) and (b) she does not set out any discussion of what Mr Smith actually says about the exhibits and the use of the Earlier Mark generally, I do not agree that she misapplied the law or erred in her approach by imposing an incorrect requirement of significance or substantiality of use. The opponent took a significant risk by filing such scant evidence, and I believe that the hearing officer's assessment of it is well within the bounds of her discretion. She had clearly read the content of the witness statement itself, having summarised it earlier in the Decision, so I do not accept the suggestion that she only looked at the exhibits and not the covering evidence.

29. I would add that this is not a case of the hearing officer disbelieving Mr Smith's evidence without his having had the opportunity to respond to challenges under cross-examination. It is just that his evidence was not solid or cogent enough to meet the standard of proof required in the circumstances of the case, which include the fact that the deponent should have been in a good position to put together evidence of genuine use to the necessary standard if indeed there had been any.

30. This is also not a case where the opponent was unrepresented and therefore might not have fully understood the need to do more to prove his case on use. He was professionally represented throughout. Further, as Mr Pennant pointed out, it could not have been clearer that the applicant disputed the claim of genuine use. Not only did it put the opponent to proof of use in the Notice of defence and counter-statement (Form TM8), but it had also previously written to the applicant's representative on the same point.

Procedural grounds of appeal

31. Turning to the opponent's procedural grounds, I have concluded that the first one (set out at paragraph 6(3) above) is entirely without merit. The substance of the applicant's written submissions of 4 April 2012 which are objected to by the opponent was simply a contention that the opponent had failed to provide proof of use to the requisite standard and accordingly that the opposition should be dismissed. This document contained no detailed argument or submissions and accordingly nothing that the opponent was not aware of already, and nothing that the hearing officer did not already know that she had to deal with.

32. Although there appears to have been some confusion as to whether D Young & Co had received a letter from the registrar laying down an earlier date for the receipt of evidence and/or submissions, it does not seem to me that it makes any difference. The opponent would in any event have been able to submit final arguments to the registrar before the hearing officer took the decision on the papers, in the same way that parties can file skeleton arguments shortly prior to a hearing. Therefore I can see nothing wrong either procedurally or substantively with the hearing officer having taken the 4 April 2012 submissions into account.
33. I am also not persuaded by the fourth ground (at paragraph 6(4)) to the effect that the opponent was unfairly treated by virtue of its representative, Mr Huw Evans of Chapman Molony, having been told in a phone call to the Law Section of the Trade Marks Registry on 3 July 2012 that, “should the [opponent’s] evidence be deemed insufficient, ... the Registry would seek further clarification”, but the hearing officer went ahead with the decision without having sought any such clarification.
34. First of all, for this complaint to have any teeth, I would expect to see at least a witness statement from Mr Evans, setting out the detailed circumstances and substance of the phone call, rather than the opponent simply relying on a paragraph in the Notice of Appeal. Without such detail, I have nothing to go on to persuade me that Mr Evans, and thus his client, the opponent, had any reasonable basis for assuming that, contrary to the relevant provisions of the Act, the Rules and the Manual, the opponent would somehow be ‘warned’ if its evidence of use was not going to be good enough to substantiate the Earlier Mark as a basis for the opposition.
35. At the hearing, Mr Moody-Stuart did not really pursue this ground as a basis for concluding that the hearing officer had reached the wrong conclusion, but instead used it as a reason for inviting me to deal sympathetically with the application to adduce further evidence on appeal if I did not agree with him that the hearing officer wrongly assessed the evidence that was submitted in the first round. I deal with that separately below.
36. In conclusion, I am not persuaded that any of the grounds raised justify a re-assessment of the case on the evidence submitted by the opponent at first instance. I believe that the hearing officer was justified in concluding that the evidence was not sufficient to satisfy the use conditions of section 6A and therefore that she was right to reject the opposition on that basis.

The application to adduce additional evidence

37. My rejection of the appeal means that I must go on to consider the opponent’s application for permission to adduce further evidence of use. It is not possible to do

this without reviewing the content of the evidence itself, as well as the circumstances in which it is being submitted.

38. The evidence consists of a further witness statement from Mr Smith, dated 18 October 2012. He repeats the assertion that Austyn James Consulting Limited, as licensee of the opponent, has “offered a MONEY MAPPING service from early 2003 to-date, whereby financial advice is provided to individuals on life insurance, financial affairs, monetary affairs, real estate affairs, and financial planning”, and again refers to the face-to-face consultations in which he collects financial information and provides advice, “which is written down or “mapped” on paper, which the individual then takes away as a document for future reference”. He then makes a similar, though slightly different, statement to the one in paragraph 6 of his previous witness statement (reproduced at paragraph 14 above), in that he says, “Each time the MONEY MAPPING service is provided, I apply a facsimilie (sic.) of the stylized mark (which is the subject of Trade Mark No 2325727) to the top of the paper before the service is offered to the customer”, the reference to “each time” replacing the previous reference to “always” in the previous statement. As an illustration, he again refers to exhibit AJ-1 to his first witness statement, but does not exhibit any further examples. He goes on to refer again to exhibit AJ-2 to his first witness statement, but without giving any further information about it.
39. Mr Smith goes on to explain that an adviser training manual was developed on how to charge fees for value add services, and sold to IFAs in 2004/5, which was very well received; and that during 2005 several Money Mapping articles were published in Prospect magazine. However, none of these are produced in evidence and Mr Smith does not mention whether the Earlier Mark was appeared on or in them. In any event, these dates are before the relevant period for the purposes of this case.
40. Mr Smith then explains that “MONEY MAPPING success continued and in my own practice turnover increased a massive 38% between 2005 and 2006, attributed to MONEY MAPPING in the Directors Report” and that a similar increase followed in the next year as well. He then says that the success of Austyn James Consulting Ltd stems from the unique MONEY MAPPING service, and he lists practice turnover figures that increase year on year from £407,769 in 2005 up to £1,030,329 in 2010.
41. He states that MONEY MAPPING has developed into “a suite of financial service/planning tools which we are now offering to the professional adviser community, as the MONEY MAPPING Collection”, but there is no exhibit to show how these tools are presented.
42. Mr Smith goes on to state: “In addition to using the mark MONEY MAPPING in the stylised form, ... I have also widely used the mark MONEY MAPPING in an unstylised form”, and he exhibits a collection of publicity material and brochures

which he states were widely distributed in the United Kingdom. These include five different corporate brochures from the years 2009 to 2012, an article in Citywire Magazine from July 2010 in which Mr Smith is interviewed, a Client Agreement and a Retainer Agreement, two financial questionnaires, one headed “MONEYMAPPING CASHFLOW” and the other “THE MONEYMAPPING SNAPSHOT”, a client folder 2010, an advertisement in FS Magazine from February 2005 (which falls outside the relevant period), two ‘Client Welcome Books’ from 2009 and 2011, and two flyers for Wine and Cheese Evenings held by Austyn James Consulting Limited in 2008 and 2011. I have been through these exhibits and, while they are littered with references to the term “Money Mapping”, either in plain text like this or all in upper case, and often followed by the TM or ® symbol, none of them contains these words in the manuscript style of the Earlier Mark.

43. I am asked to admit the evidence either into the appeal, pursuant to the broad case management powers that I have pursuant to rules 62(2) and 73(4), or into the case to be re-considered at first instance, pursuant to rule 20(4).
44. The opponent relied on the phone call with the Registry as the primary basis for its application, and Mr Moody-Stuart argued that it would be just and appropriate for me to admit the evidence in the light of the “manifestly unfair procedural history of the opposition”. As will be clear from the previous discussion at paragraphs 33-34, I am not persuaded by the claim of unfairness and therefore this is not a sufficient ground for admitting the evidence. However, that is not the end of the story, since procedural irregularity is not the only basis on which additional evidence might be admitted at this stage.
45. This is not a case where the opponent sought to put in further evidence for consideration at first instance, but was refused, so I do not believe that it would be appropriate for me to deal with this as a request to put in additional evidence of use pursuant to rule 20(4) for the registrar to re-consider at first instance. Instead, I shall treat this as what it is: a request to put in additional evidence on appeal.
46. Pursuant to rule 52.11(2) of the Civil Procedure Rules, as an appellate tribunal my general approach should be not to receive evidence which was not before the registrar at first instance. However, I do have discretion to admit fresh evidence on application by the party seeking to adduce it. In exercising that discretion, I must have regard to the overriding objective of dealing with the case justly and at proportionate cost, as provided by rule 1.1 of the Civil Procedure Rules.
47. Further, in exercising my discretion, I must have regard to the factors set out in *Ladd v Marshall* [1954] 1 WLR 1489, albeit not as a strait-jacket of fixed rules; and I should also consider whether any of the factors set out in *Hunt-Wesson Inc’s Trade Mark Application (SWISS MISS)* [1996] RPC 233 are relevant: see in particular

Omega Engineering Incorporated v Omega S.A. (Omega AG) (Omega Ltd) [2010] EWHC 1211 (Ch), per Arnold J at paragraph 97.

48. The first *Ladd v Marshall* requirement is that the new evidence could not have been obtained with reasonable diligence for use at first instance. That is plainly not the case here. All of the evidence given and material referred to would have been available to Mr Smith when he gave his first witness statement. Mr Moody-Stuart did not suggest otherwise.
49. The second requirement is that the new evidence would probably have an important influence on the case. This is why one cannot avoid looking at the content of the evidence. Having done so, I do not believe that it would have an important influence. It would only do so if it added sufficiently cogent and solid evidence of use of the Earlier Mark to be sufficient to satisfy the use conditions of section 6A of the Act. Although on the one hand the witness statement does now give some details about the size of the business operated by Austyn James Consulting Limited, there is no further evidence at all of the use of the Earlier Mark in the form registered. Indeed, the scepticism of the hearing officer as to the value of the first round evidence is to some extent further supported by the fact that Mr Smith has managed to find plenty of examples in his company records of materials in which the sign “Money Mapping” is used in text form, but none in which it is used in the stylised handwritten form of the Earlier Mark as registered. Therefore, without needing to doubt the veracity of Mr Smith’s evidence, since he has not sought to put a scope or value on the business conducted under and by reference to the Earlier Mark, as opposed to his “Money Mapping business” generally, I am unpersuaded that the additional evidence would change the outcome of the ‘proof of use’ stage of the opposition.
50. I could stop there, as this conclusion arguably ‘kills’ the application. However, I can see that it is possible that another hearing officer or Appointed Person would have a more generous approach to the combination of the original and additional evidence, if the latter were admitted, and therefore I go on to consider other relevant factors.
51. The third *Ladd v Marshall* requirement is that the new evidence is credible. As I have indicated above, I have no reason to doubt Mr Smith’s credibility.
52. Turning to the additional factors identified by Laddie J in *SWISS MISS*, these are:
 - (1) whether the evidence could have been filed earlier and, if so, how much earlier: it obviously could have been filed at the same time as the original evidence, so this factor does not assist the opponent;
 - (2) if it could have been filed earlier, what explanation has been offered to explain the delay: see the discussion above about the phone call to the Registry, which

again does not assist without a full and detailed explanation of why this was relied on;

- (3) the nature of the mark and the nature of the objections to it: here I take into account the fact that the Mark is the subject of an application and the objections to it are raised in the context of an inter partes opposition. This means that the worst that can happen if I reject the additional evidence is that the opposition will fail and the Mark will be registered. It is not a case where the failure to prove genuine use will result in the opponent losing its mark for non-use. Further, since the Mark is by definition later in time than the Earlier Mark, there is no danger of the Mark being relied on to object to the Earlier Mark being on the register or in use on the market;
- (4) the potential significance of the new evidence: this does not help – see the discussion at paragraph 49 above;
- (5) whether the other side will be significantly prejudiced by the admission of the evidence in a way which cannot be compensated, for example by an order for costs: this could well be the case, given that my acceptance of the additional evidence would mean that the opposition would be remitted to the registrar for further consideration at first instance, which would further delay the grant of registration to the Mark, even if the opposition were ultimately to fail;
- (6) the desirability of avoiding a multiplicity of proceedings: this factor weighs against the opponent; and
- (7) the public interest in not admitting onto the Register invalid marks: while the opponent relied on this factor in its notice of appeal, in my judgment it does not weigh strongly in its favour. The Mark would not be invalid per se if it turned out that the opponent could have succeeded in the opposition if only it had pulled together better evidence of use. Section 5(2)(b) only comes into operation when the proprietor of an earlier trade mark successfully establishes its challenge. It is not there to protect the public at large, but to enable owners of certain earlier rights to prohibit registration of later conflicting marks.

53. Taking all of these matters into account, I refuse the opponent permission to adduce the further evidence.

Conclusion

54. Having considered all of the submissions made by each side, I am not persuaded that the hearing officer fell into error in concluding that the opponent had not satisfied the use conditions under section 6A of the Act.

55. I also refuse the opponent's application to adduce further evidence on appeal (or as additional evidence for the registrar to consider in re-assessing the case at first instance).
56. I therefore dismiss the appeal and direct that the Mark should be permitted to proceed to registration.
57. Since I have upheld the first instance decision, the applicant is entitled to receive the award of costs made by the hearing officer against the opponent in the sum of £500.
58. Bearing in mind the nature of the appeal, the application to adduce fresh evidence, and the representation at the hearing, I order the opponent to pay the applicant an additional sum of £1,150 as a contribution towards the costs of this appeal, which includes £400 in respect of dealing with the application to adduce fresh evidence.
59. The total sum of £1,650 is to be paid within 14 days of the date of notification of this decision.

ANNA CARBONI

The Appointed Person

28 July 2014

The appellant/opponent (Motu Limited) was represented by Jeremy Pennant of D Young & Co LLP.

The respondent/applicant (Integrated Financial Arrangements PLC) was represented by Counsel, Thomas Moody-Stuart, instructed by Chapman Molony.