

O-353-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2530191
BY ARCHIBALD DUNCAN OGILVIE MCINTYRE TO REGISTER THE SERIES
OF TWO TRADE MARKS:**



IN CLASSES 9, 16 AND 41

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 100311
BY MARIE MONGAN**

BACKGROUND

1) On 27 October 2009, Archibald Duncan Ogilvie McIntyre applied under the Trade Marks Act 1994 (“the Act”) for registration of the following series of two marks:



2) The application is in respect of the following goods and services:

Class 9

Sound and video recordings relating to hypnobirthing.

Class 16

Books, pamphlets and publications having as a subject, sole or part, hypnobirthing and hypnotherapy within the context of childbirth.

Class 41

Provision of training relating of hypnobirthing and related services; provision of antenatal courses and the application of hypnotherapy relaxation and visualisation techniques in the context of childbirth.

3) The application was subsequently published in the Trade Marks Journal and on 18 March 2010, Marie Mongan filed notice of opposition to the application. The opposition is based upon a single ground of opposition, namely, that the application offends under Section 5(4)(a) of the Act because Ms Mongan has been trading using the sign HYPNOBIRTHING word-only and the following composite mark (that corresponds to a UK mark that was applied for, and registered AFTER Mr McIntyre made his application – in December 2009 and not 2010 as erroneously stated in Mrs Mongan’s statement):



4) Reliance upon these two marks is set out in paragraphs 3 and 5 of Mrs Mongan's statement of case. In written submissions, filed on 4 April 2012, in support of Mrs Mongan's case, reference is made to a third mark, namely HYPNOBIRTHING – THE MONGAN METHOD. This mark is not relied upon in the statement of case and I will not comment further upon this mark in my decision. Further, in Mr McIntyre's written submissions, he appears to be under the misapprehension that Mrs Mongan is relying upon her later filed registered composite mark. This is not the case. Mrs Mongan relies on her unregistered rights in a sign that corresponds to the registered composite mark and the single word mark HYPNOBIRTHING.

5) Mrs Mongan claims she has been trading in the USA since 1989 and in the UK since the mid-1990s and claims to be the founder and creator of a specialist birthing method. She has written a book entitled "Hypnobirthing – A Celebration of Life", first published in the USA in 1989 and which has been available in the UK since the mid-1990s with an anglicised and updated version published in the UK in April 2007. Mrs Mongan has promoted her goods and services through her website www.hypnobirthing.co.uk since April 2004. Consequently, it is claimed that Mrs Mongan has built up a valuable goodwill as a writer and teacher on methods of birth, and that the public has come to recognise the goods and services by reference to Mrs Mongan. I understand Mrs Mongan to be claiming goodwill in respect of a list of goods and services that corresponds to those listed in her UK registrations 2534408 and 2535510. These are listed below:

Class 9

Apparatus and instruments, all for recording, reproducing and/or transmitting sound and/or video; radio and television apparatus and instruments both for reception and transmission; compact disc players, mini disc players, DVD players, audio and video tape players; radios; parts, fittings and accessories for all the aforesaid goods; sound and/or video recordings; sound and/or video recording media; audio and visual recorded media; sound and/or video recordings including cassettes, records, discs, tapes or wires; recording discs; magnetic data carriers including magnetic data carriers for bearing sound and/or video recordings and magnetic data carriers for recording computer programs or data; discs, video discs, compact discs, mini discs, DVDs, tapes, cassettes, video tapes and cartridges all blank or previously recorded; CD-ROMs; computer software; computer programs; electronically, magnetically and optically recorded data for computers; computer games, electronic publications; downloadable electronic publications; cinematographic, movie, television, photographic films and motion pictures.

Class 16

Printed matter; paper, cardboard and goods made from these materials, not included in other classes; reports; promotional material, publications, albums, almanacs, booklets, books, brochures, diaries, directories, guides, handbooks, journals, leaflets, notebooks, pamphlets, magazines, manuals and periodicals; training manuals in the form of printed matter; stationery and printed forms; computer print-outs; database listings; instructional and teaching materials; bookbinding material; photographs; adhesives for stationery or household purposes; plastic materials for packaging (not included in other classes); document files and holders; folders for papers and stationery; loose leaf binders; photographs; artwork, diagrams and illustrations; charts; graphic prints and posters; graphic reproductions; signboards of paper or cardboard; stamps (seals); stencils; wrapping and packing paper; writing pads; writing paper; parts and fittings for all the aforesaid goods.

Class 41

Coaching services; life coaching services; mentoring services; training services; education services; provision and organisation of correspondence courses; providing on-line electronic publications; publication of magazines, books, texts and printed matter; publication of electronic information, periodicals, books or journals on-line; publishing services; organising of sporting, cultural and entertainment events and competitions; organising and conducting exhibitions, fairs, conferences, conventions, seminars, displays and/or events; production and presentation of films, audio and video tapes and cassettes, slides and records; all the aforementioned services also provided on-line from a computer database or from the Internet; information, advisory and consultancy services in relation to all the aforesaid.

Class 44

Hypnotherapy; medical, clinical and health care services; medical counselling; psychological counselling; medical information services; rehabilitation; medical analysis in connection with the treatment of individuals; physiotherapy services; advice on medical information relating to alleviation, diagnosis, prevention and treatment of illnesses; provision of nursing care; medical nursing; nursing home services; community nursing services; medical advisory services; medical care services; medical diagnosis; medical treatment; medical and medical care information services; information consultancy for health care professionals; medical and hygiene care and services; information, advisory and consultancy services in relation to all the aforesaid.

6) Mr McIntyre subsequently filed a counterstatement denying Mrs Mongan's claims. He counterclaims that his mark consists of the generic word

HYPNOBIRTHING and unique artwork. The view that the word HYPNOBIRTHING has been commented upon both by the Registry (in a letter issued as part of a Search and Advisory report in 2003) where it expressed the view that the mark is descriptive in respect of goods/services relating to birthing techniques which involve the use of hypnosis, and also by a US Federal Judge in 2002 who commented that “it would seem ... that anyone who teaches birthing methods that employ hypnosis ...has a right to call the process ‘hypnobirthing’”.

7) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side requested to be heard. Therefore, I make this decision after a careful consideration of the papers.

Opponent’s Evidence

8) This is in the form of a witness statement by Mrs Mongan. She reiterates that she has used the word HYPNOBIRTHING in connection with her business since at least 1989 and has used the word alone and as part of various composite signs. Ms Mongan states that it is her belief that use of her signs in respect of her “Hypnobirthing practice in the USA” has meant that “the goodwill associated with it has influenced and added to the goodwill in the UK a great deal.”

9) Mrs Mongan states that “I am as sure as I can possibly be that I was the first person to use the word “Hypnobirthing” in the course of business to describe the type of activity provided under the name by me” and “[t]he word was invented by me and is a neologism which was unused before that time”.

10) At Exhibit MM1, Mrs Mongan provides a copy of the front cover of the first edition of her book entitled “HypnoBirthing, The Mongan Method” and where the device element of the mark relied upon, appears below the above words. The HYPNOBIRTHING programme was introduced to the UK with a home study package based upon the book.

11) Exhibits MM2, MM3 and MM4 are examples of certificates awarded in 2000, 2001 and 2002 respectively, to graduates of the above mentioned programme. It is unclear if these were awarded to graduates in the UK or elsewhere, but Mrs Mongan states that the term HYPNOBIRTHING did not exist in the UK at that time, other than in her programme materials. These exhibits refer to “HypnoBirthing® Institute” and “Certified HypnoBirthing PractitionerSM”. At Exhibit MM5, Mrs Mongan presents a copy of an article, entitled “Pain-free labor under hypnosis”, published by the BBC and includes the text “Kerry Woodstock used an advanced relaxation technique called ‘hypno-birthing’ during her 24-hour labour”.

12) Mrs Mongan states that an active HypnoBirthing practice was established in 2002 with the first live class, conducted by Mrs Mongan, held in Oldham. This

prompted a further BBC article entitled “Why I chose hypnobirthing” and includes the following text:

“...when she was about 22 weeks pregnant she decided to try a pioneering new technique called hypnobirthing. Hypnobirthing, which started in the States, uses self-hypnosis, relaxation, visualisation and breathing techniques to prepare the mother for birth”

“Hypnotherapist Sonya Wadsworth, of Oldham said that Ms Goodman’s experiences at her birth just five weeks ago were typical of the many positive responses she has had to the pioneering technique. Since she started the hypnobirthing in the UK last November she has had 26 very happy mothers complete her course”

“Mary Newburn, of the NCT, said natural birthing methods like hypnobirthing should be encouraged by the NHS...”

13) In 2003, Mrs Mongan travelled to the UK to train a further 14 UK practitioners and in 2004, to present a certification class to 24 new UK practitioners. At this time, Mrs Mongan also featured on the “Richard and Judy” television programme and discussed HypnoBirthing techniques.

14) Since that time, “almost a thousand practitioners” have been certified in all areas of the UK and in support of this provides a list of “many HypnoBirthing-Certified midwives” at Exhibit MM8 where over 200 names are listed.

15) An Internet extract, at Exhibit MM9, illustrates the WHOIS data for www.hypnobirthing.co.uk illustrating that it was registered on 26 April 2004 by a Mr Gordon Mullan, trading as HypnoBirthing UK. Mrs Mongan does not explain who Mr Mullan is. A copy of the website’s homepage is also provided at Exhibit MM10. The date is partially obscured but is sometime in September 2010.

16) At Exhibit MM10, Mrs Mongan provides a copy of the homepage of her website, the banner of which includes the following signs:

HypnoBirthing UK

The Mongan Method



HypnoBirthing UK

HypnoBirthing - The Mongan Method

Are you interested in using self hypnosis for labour and childbirth?
Do you want to be in control of your birth? Are you looking for an
easy, comfortable, and yet drug-free birth?

17) Mrs Mongan provides copies of numerous articles that appeared in the specialist and general press, all discussing HYPNOBIRTHING, examples of which include:

- Exhibit MM11: An article from an unspecified magazine, bearing a handwritten date of August 2004 and entitled “I hypnotised myself and had a pain-free birth”. It includes the text “The couple found a hypnobirthing coach who helped prepare Bev for a stress-free delivery. ‘It’s based on the principle that fear makes you tense then tension creates pain’ she explains [...] The classes teach you breathing and visualisation exercises to banish those thoughts from your mind and relax your muscles to help your baby out easily” and “For a positive outlook on childbirth, join a hypnobirthing group. See www.hypnobirthing.co.uk”;
- Exhibit MM12: An article promoted on the front cover of Midwives (The magazine of the Royal College of Midwives) where it proclaims “HypnoBirthing®: the art to a peaceful birth”;
- Exhibit MM13: An articles that appeared on the website MailOnline in November 2007, and recounts how one father-to-be was introduced to hypnobirthing and Mrs Mongan and how it had a positive effect upon the delivery of his daughter;

18) At Exhibit MM19 is a copy of an undated letter sent to various midwives. The word elements of Mrs Mongan’s composite sign appears below the device element (rather than alongside, as in the composite sign relied upon) at the top of the letter. It is written by an ex-midwife based in Sheffield promoting her private hypnobirthing classes. She states that she has “worked with hypnosis for childbirth in varying forms on and off since 1984...” The accompanying leaflet includes a sign similar to the composite sign relied upon by Mrs Mongan in these proceedings, but with the “man, women and child” device appearing below the word elements. The text “The Gold Standard of Birthing with Hypnosis” appears underneath. The picture of a baby’s face present in Mrs Mongan’s composite sign is also missing.

19) Exhibit MM20 is a copy of a small newspaper advertisement by one of Mrs Mongan's practitioners, a registered midwife (it appears that this is the same practitioner as referred to in the above paragraph). The advertisement features the "man, women and child" device of Mrs Mongan's composite sign and the word "HypnoBirthing®" appearing underneath. A copy of the practitioner's business card is also provided featuring the same device and the word "HypnoBirthing®".

20) At Exhibit MM21 is a copy of a document, dated January 2010, entitled "Code of Ethics and Standards for the Practice of Educators Affiliated with HypnoBirthing®". It is unclear if this document is/has been used in the UK. It describes HypnoBirthing As "a discrete and comprehensive childbirth method, focusing on pregnancy and preparation for labor and birthing" and "Practitioners currently affiliated with the HypnoBirthing Institute are the only persons authorized to use the name and logo..."

21) In a number of areas around the UK, HypnoBirthing is an approved method of childbirth care available through the NHS with Mrs Mongan identifying Stockport, London, Ayrshire and Arran and Glasgow as three areas where it is available.

22) Testimonials from those who have benefitted from HYPNOBIRTHING are provided at Exhibits MM26 and MM27. These appear to have been elicited for the purposes of these proceedings, but the first confirms that "HypnoBirthing – The Mongan Method" was introduced into the NHS' Ayrshire Maternity Unit in July 2009.

23) Mrs Mongan also provides numerous extracts from her book on HYPNOBIRTHING, the latest edition published in 2007 to illustrate how the idea was conceived by herself and also the extent of the "HypnoBirthing movement".

Applicant's Evidence

24) This is a witness statement by Mr McIntyre. At Annex B he provides the full text of an Order issued in 2001 by the US District Court, District of New Hampshire in respect of a dispute between Mrs Mongan and another user of the term HYPNOBIRTHING, Dr Michelle LeClaire O'Neill. The Court commented that "It would appear beyond dispute that the basic concept of pain reduction in childbirth through natural relaxation techniques may be traced at least as far back as the work of English obstetrician Grantley Dick-Read in the 1930s". It dismissed a claim for summary judgement because the issue of distinctiveness of Mrs Mongan's mark was at issue, noting that this issue was "not yet ripe for decision". It offered an opinion on the chances of success, but as this opinion was offered without the case (and evidence) being fully developed, it carries little or no persuasive weight in the current proceedings.

25) Dr LeClaire O'Neill makes a claim to inventing the word HYPNOBIRTHING in her e-mail to Mr McIntyre, dated 24 January 2011 and exhibited at Appendix X.

26) At Appendix N is a witness statement, dated 3 March 2011, by Paola Katia Bagnall who attests to using the term "Inner Power Hypnobirthing" since 2000 a hypnotherapist who, when attempting to register it as a mark, was advised by the Registry that the word HYPNOBIRTHING is a generic term meaning the use of hypnosis in birth. Ms Bagnall has also recently learned that the Royal Society of Medicine uses the term HYPNOBIRTHING for workshops.

27) Mr McIntyre also exhibits, at Appendix W, an email from Mrs Mongan dated 15 August 2009 where she stated "I never claim to have 'created', I developed a program and pulled many thoughts together. I will say, the chief ones are mine, not GDR, and not standard hypnotherapeutic techniques..." Mr McIntyre disputes the final part of this statement, claiming that she uses a number of "completely standard hypnotherapeutic techniques".

28) Mr McIntyre provides exhibits illustrating other parties using the term HYPNOBIRTHING and these can be summarised as follows:

- Ms Bagnall's witness statement, mentioned above;
- At Appendix Q1, ii is a witness statement by Kristin Hayward. Ms Hayward states that she trained as a HypnoBirthing practitioner with Mrs Mongan in 2002, when it was the only one available. She states there are now many more courses offering hypnosis for childbirth. She further claims that the term is used generically throughout the medical profession and that she is regularly asked to speak about hypnobirthing by London hospitals and midwifery groups, covering all aspects of hypnosis for childbirth under this title. Ms Hayward states that Mrs Mongan's American Institute of HypnoBirthing does not support UK HypnoBirthing practitioners who fund their own marketing campaigns. Many practitioners have moved away from the Institute in order to teach hypnobirthing in the generic sense;
- At Appendix Q2, is a witness statement by Helianthe Rusken, an Advanced Clinical Hypnotherapist. She states that she has "put together" her "own version of hypnosis for birth/hypnobirthing" and has had stands at baby shows manned by herself and also jointly with other independent hypnobirthing practitioners. Ms Rusken also had an application to register the mark Hypnobirthing turned down by the Registry because the word "was too generic";
- At Appendix R, a witness statement by Nicholas Morris, a Consultant Obstetrician. Mr Morris states that the word HYPNOBIRTHING has been used with increasing frequency and is used generally to describe the use of hypnosis in childbirth. He states that HYPNOBIRTHING was developed from the work of French obstetricians who include Drs Vellay and Lemaz. It was originally called "psycho prophylaxis when they

- carried out their work over 50 years ago. He is aware of numerous practitioners of hypnobirthing who have nothing to do with Mrs Mongan;
- At Appendix S, an article by Dr R William Davey, former Physician to Her Majesty the Queen, in a 2008 publication called “Health” details how he recommends HYPNOBIRTHING and refers to his colleague and friend, Katherine Graves who practices HYPNOBIRTHING and who can be contacted at www.thehypnobirthingcentre.co.uk;
 - At Appendix T is a copy of an agenda of a course provided at The Royal Society of Medicine (The RSM”) on 22 February 2011 and entitled “Hypno Birthing – bringing babies into the world calmly and gently. The presenters appear to be from a wide spectrum of medicine and include a visiting professor of midwifery, the RSM’s president of its Section of Hypnosis & Psychosomatic Medicine and a Medical Hypnotherapist. There is no mention of a link to Mrs Mongan. Mr McIntyre points out that the only specialist hypnobirthing teacher on the agenda is Katharine Graves, who has no connection with Mrs Mongan and has taught about 1,000 women in the UK and also teaches other hypnobirthing teachers. He also points out that she is sufficiently highly thought of by the RSM, to be the only hypnobirthing teacher invited to speak. He contends that this puts into perspective that Mrs Mongan’s method is just one of the methods available in the UK;
 - At Appendix U are nine further witness statements:
 - The first of these is by Josephine Patricia Teague who states that both she and members of the Clinical Register of Advanced Hypnotherapists have used the term HYPNOBIRTHING for twenty years or more. She recalls her initial training in 1991 and when she attended a CPD course organised by Lionheart Training in 2002. She is of the view that both the profession and the public consider the term HYPNOBIRTHING to be a generic term. As a Fellow of the RSM, she is aware of its training day on 22 February 2011 (detailed above);
 - The second is from an independent midwife named Jacqui Tomkins who attests that the term HYPNOBIRTHING is used and familiar within the medical profession and also the general population. She states that most of the women she works with at the London Birth Practice are aware of HYPNOBIRTHING when “we discuss tools and resources for dealing with labour”;
 - The third is by Reshma Sidhpura who states she has been teaching hypnobirthing and hypnosis for birth for “quite a few years now”. She was not trained by Mrs Mongan and states that the term HYPNOBIRTHING is a generic term used widely by everyone in the hypnotherapy or birthing professions;
 - The fourth from Jackie Fletcher, a hypnobirthing practitioner who states that “hypnobirthing in the UK, over the last many years, has become a general term to mean using hypnosis in childbirth” and that it “is used by many practitioners around the UK who have

- training in both hypnosis and childbirth, were not trained by Marie Mongan and have no connection with The Mongan Method”;
- The fifth from Anna Higgs, who is currently studying to be a hypnobirthing instructor states that she understands the term to cover The Leclaire Method, The Mongan Method, HypBirth, Hypnobabies and Gerald Kein’s Complete Painless Birth method;
 - The sixth by Carlos Caruncho of the Jericho Complementary Health Practice in Oxford states that “Being an Alchemical hypnotherapist ..., I find the usage of the term Hypnobirthing widely expressed and used not only by practitioners of Alternative medicine but also by the clients themselves;
 - The seventh is by Hari Vaudrey, a qualified hypnotherapist who states that the term HYPNOBIRTHING has “been in common usage amongst pregnant women and hypnotherapists long before Mrs Mongan learned of the term. Mrs Vaudrey has no connection with Mrs Mongan but does promote herself as a Hypnobirthing teacher;
 - Two further witness statements are from US based professionals who do not comment specifically upon the position in the UK.
- Mr McIntyre states that hypnobirthing methods other than the Mongan Method are practised in Chelsea & Westminster, St Thomas’, St James’ (Leeds) and Salisbury hospitals.
 - Mr McIntyre points out that the mirror image of the device element of his mark is already registered in the UK under number 2508155;
 - Exhibit P are copies of front covers of two books by Dr Leclaire O’Neill, the first entitled “HYPNOBIRTHING, The Original Method”, the second “CREATIVE CHILDBIRTH, How you can easily give birth in comfort and without fear through Hypnobirthing the Leclaire Method”. Mr McIntyre draws attention to Dr Leclaire O’Neill’s claim to be the originator of HYPNOBIRTHING.

Submissions

29) Both sides also filed a number of written submissions criticising the respective party’s evidence and providing arguments in support of their cases. I will not detail these here, but I will keep these in mind in my decision that follows.

DECISION

Section 5(4)(a)

30) I will consider the ground under Section 5(4) (a) first. That section reads as follows:

“5.-(4) 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”.

31) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponents’ 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 applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

The Relevant Date

32) The relevant date for determining the opponent’s claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115), that is to say 27 October 2009. The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). There is no counterclaim to earlier use by Mr McIntyre, therefore, the position at an earlier date is not relevant in these proceedings.

Goodwill

33) In order to make an assessment of whether or not Mrs Mongan has goodwill in a business conducted under the earlier signs, I must be possessed of sufficient information to reach an informed conclusion. In *South Cone Incorporated v Jack*

Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership) [2002] RPC 19 Pumfrey J said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

34) In *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J commented directly upon South Cone in the following terms:

“8 Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

35) I do not understand Mr McIntyre to be denying that Mrs Mongan has goodwill attached to the composite sign relied upon. Rather, he claims that in respect of the word HYPNOBIRTHING, Mrs Mongan is only one of many practitioners using the term, that he believes is a generic description in the field of hypnosis during child birth.

36) I will consider the issue of whether the word HYPNOBIRTHING is descriptive. Whilst Mrs Mongan claims to have invented the word, Mr McIntyre claims that it is used generically to describe the use of hypnosis during child

birth. It is important to understand what the consumer of the respective services would understand by the word HYPNOBIRTHING. In *Forex Trade Mark* BL O/100/09, paragraph 15, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, commented that it is open to the hearing officer to look at appropriate works of reference “for the purpose of supplementing his understanding of the meaning(s) that [a word] could properly be taken to possess in accordance with ordinary English language usage in this country”. Accordingly, I note the following dictionary definitions as relevant in the current proceedings:

Hypno-
Combining Form: relating to sleep: *hypnopaedia*
relating to hypnosis: *hypnotherapy*¹

and;

birthing
noun [mass noun]
the action or process of giving birth: *a midwife allows mothers to feel more comfortable and calm during birthing*²

37) The consumer of such services will be any expectant mothers and also the professionals involved in delivering hypnosis practices during childbirth. I am of the view that these consumers are likely to be familiar with both the dictionary meanings detailed above, and upon seeing the word HYPNOBIRTHING, the consumer is likely to perceive a meaning of hypnosis during child birth, in the absence of it acquiring any secondary meaning. It is likely to be the natural and only way the mark will be perceived when a consumer is exposed to the word. Mrs Mongan claims that the programme she developed entails techniques that are not standard hypnotherapeutic techniques. This may be so, but misses the point. Anybody using hypnosis techniques during childbirth, whether standard or developed in some way, may wish to describe the practices as “hypnobirthing”. It is a very natural, possibly the most natural way to describe such techniques.

38) Having concluded that Mrs Mongan’s sign is, indeed descriptive, I must consider what impact this has upon the claim that it identifies the goodwill in her business. A sign which is prima facie descriptive will only be protected if it can be shown to have acquired a secondary meaning: that is to say, if it has also

1 "hypno-". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 03 September 2012 <<http://oxforddictionaries.com/definition/english/hypno->>.
"hypno-". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. <http://oxforddictionaries.com/definition/english/hypno-> (accessed September 03, 2012).

2 "birthing". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 03 September 2012 <<http://oxforddictionaries.com/definition/english/birthing>>.

become distinctive of the claimant (*Wadlow: The Law of Passing Off*, 4th edition (2011) paragraph 8-073) and that its descriptive nature has been displaced.

39) Some words, although newly created, as Mrs Mongan claims here, are so obviously descriptive that they will be unlikely to identify goodwill (see for example *McCain International Ltd v Country Fair Foods Ltd* [1981] RPC 69 where it was noted that the newly-coined term “oven chips” would easily pass into everyday speech). Other descriptive words or phrases may identify goodwill and in *Phones 4u Ltd v Phone 4u.co.uk Internet Ltd* [2006] RPC 583, the Court of Appeal held that there was goodwill in the name “Phones 4U” notwithstanding its descriptive quality because it was not descriptive “in the sense that anyone would describe a business or shop selling mobile phones as a ‘Phones 4U’ business or shop”.

40) Mr McIntyre states, on page 2 of 10 October 2011, “It is not disputed that the claimants goods and services have acquired a goodwill in the market” but “that the same is true of many practitioners ... and methods ...” Further, he claims that “The Opponent’s distinguishing mark is not the word hypnobirthing because the word is in generic use and common parlance used by many both medical and lay people. The Opponent’s distinguishing mark is defined by [Mrs Mongon] in her Mark recently registered with the IPO is [the composite sign relied upon in these proceedings]”. From these comments, I understand Mr McIntyre to only be challenging the existence of goodwill as attached to the word HYPNOBIRTHING.

41) In this respect, Mrs Mongan provides numerous exhibits where the use of HYPNOBIRTHING appears with the ® symbol. I note Mr McIntyre’s view that this is not legitimate use of the symbol, but it is not an issue I need to decide in these proceedings. I must decide, as a matter of fact, whether or not the evidence demonstrates that Mrs Mongan has the necessary goodwill identified by the word HYPNOBIRTHING.

42) In considering whether HYPNOBIRTHING has acquired a secondary meaning and become distinctive of Mrs Mongan’s services, I need to consider where the evidence illustrates that the word alone serves to identify goodwill rather than where it is used in combination with the device of the man and women holding a baby, and/or the words “The Mongan Method”. This is because, when the word is used in combination with these other elements and because of the word’s descriptive nature, it may be the other elements that become important in identifying goodwill.

43) I am unable to identify any compelling evidence that the word HYPNOBIRTHING alone identifies Mrs Mongan’s goodwill. The majority of “word only” use appears in the numerous press and media articles exhibited. Here, it is unclear whether references to HYPNOBIRTHING are to techniques available from a variety of practitioners or whether it is available only through practitioners

affiliated to Mrs Mongan's method. Even where it is described as being "a pioneering new technique" (see the BBC article at referred to in paragraph 10 above), it is not clear if the use of the word HYPNOBIRTHING identifies a trader or whether it is perceived as merely describing a method of childbirth.

44) Mrs Mongan identifies three NHS Trusts that offer her method of HYPNOBIRTHING, but offers no evidence of what mark is used to identify this. Consequently, I am unable to conclude that that the word HYPNOBIRTHING alone, serves to identify Mrs Mongan's goodwill as built up as a result of the activity of her practitioners in these NHS Trusts.

45) Many of the other exhibits illustrate the word HYPNOBIRTHING used with the "man, women and child" device and/or the words "The Mongan Method" and fail to demonstrate the goodwill is associated with the word HYPNOBIRTHING alone. The only example where the word HYPNOBIRTHING could be said to clearly indicate that Mrs Mongan's goodwill attaches, is that shown in the Code of Practice exhibited by Mrs Mongan and refers to "...educators affiliated to HypnoBirthing". These use of the term "affiliated" suggests a link to a single trader. However, this single document is insufficient to demonstrate that goodwill attaches to the word, as Mrs Mongan claims.

46) Taking all of this into account, I find that the evidence fails to establish that goodwill attaches to the word HYPNOBIRTHING. Rather, it illustrates that it is the "man, women and child" device and the words "The Mongan Method" when used separately, together, or with the word HYPNOBIRTHING that identify Mrs Mongan's goodwill.

47) I have reached this conclusion based upon my understanding of the ordinary meaning that is likely to be readily perceived by the consumer as attaching to the word HYPNOBIRTHING. Consequently, it is not necessary for me to consider the implications of a counter claim by Dr Leclair O'Neill to being the first to coin the term, as referred to by Mr McIntyre. Neither is it necessary to consider the claim, by Mr McIntyre, that "aggregate usage [by HYPNOBIRTHING practitioners not affiliated to Mrs Mongan's business] is large and widespread" throughout the UK. It is sufficient that the term is perceived as being descriptive of hypnosis during child birth, and that the evidence fails to demonstrate that the word has acquired the secondary meaning of identifying Mrs Mongan's goodwill. However, in case I am wrong in my finding that Mrs Mongan has failed to demonstrate goodwill attached to the word HYPNOBIRTHING, I will go on to consider the issue of misrepresentation in respect of this mark later.

48) As I noted in paragraph 40, above, it is my understanding that Mr McIntyre accepts that Mrs Mongan's goodwill attached to the composite sign relied upon in these proceedings. Consequently, I need not consider this point further, and I will move on to consider the issue of misrepresentation.

Misrepresentation and damage

49) Having reached these conclusions, I must go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to Mrs Mongan.

50) I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent's customers or potential customers would be misled into purchasing the applicant's products in the belief that it was the opponent's. This test is rather different to that which Mr McIntyre applies in his written submissions, where he appears to be under the misapprehension that it is only necessary for the marks to exhibit detectable differences. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill".

51) Despite Mrs Mongan relying upon both the composite signs and the word sign shown in paragraph 3 above, much of her evidence addresses the status of the word HYPNOBIRTHING and arguing that use of Mr McIntyre's mark would result in misrepresentation because of Mrs Mongan's goodwill as identified by the word HYPNOBIRTHING alone. Mr McIntyre strenuously argued that goodwill cannot be identified by the word because it is used generically to describe the use of hypnosis during childbirth and consequently, it cannot differentiate one trader from another.

52) The issue of descriptive marks and misrepresentation has been commented upon by the courts, notably in the decision of the House of Lords in *Office Cleaning Services v Westminster Window and General Cleaners* [1946] 63 R.P.C. 39 where the speech of Lord Simonds (with whom all three of the other judges expressly agreed) includes the following comment:

"... in the case of trade names the Courts will not readily assume that the use by a trader as part of his trade name of descriptive words already used by another trader as part of his trade name is likely to cause confusion and will easily accept small differences as adequate to avoid it."
(p.42, ll.28–31)

53) John Randall Q.C. sitting as a deputy judge of the High Court also commented as follows in *Radio Taxicabs (London) Ltd v Owner Drivers Radio Taxi Services Ltd* High Court (Chancery Division) [2004] R.P.C. 19:

56 In *The Cellular Clothing Co Ltd v Maxton and Murray* [1899] A.C. 326 , Lord Shand pointed out that the consequence of a claimant establishing a

distinctive reputation in words which are in ordinary usage would be to give that claimant a right more valuable than a trade mark, being unlimited in point of time. He went on to say (at 340):

“That being so, it appears to me that the utmost difficulty should be put in the way of anyone who seeks to adopt and use exclusively as his own a merely descriptive term”.

57 There is also a helpful statement of principle in the judgment of Parker J. in *Burberrys v J.C. Cording & Co Ltd* (1909) 26 R.P.C. 693 at 700 (l.53)–701 (l.37) :

“... It is important for this purpose to consider whether the word or name is prima facie in the nature of a fancy word or name, or whether it is prima facie descriptive of the article in respect of which it is used. It is also important for the same purpose to consider its history, the nature of its use by the person who seeks the injunction, and the extent to which it is or has been used by others. If the word or name is prima facie descriptive or be in general use, the difficulty of establishing the probability of deception is greatly increased. Again, if the person who seeks the injunction has not used the word or name simply for the purpose of distinguishing his own goods from the goods of others, but primarily for the purpose of denoting or describing the particular kind of article to which he has applied it, and only secondarily, if at all, for the purposes of distinguishing his own goods, it will be more difficult for him to establish the probability of deception. ...”

54) Taking account of all this guidance, even if I had found that Mrs Mongan’s goodwill attached to the word HYPNOBIRTHING, it has a clear descriptive primary meaning. This, combined with the fact that, in Mr McIntyre’s mark, the word is combined with a device element, I am of the view that this creates a difference that would be sufficient to avoid misrepresentation. Due to the descriptive nature of the term HYPNOBIRTHING, it should rightly be more difficult for Mrs Mongan to demonstrate the probability of deception and the evidence falls far short of demonstrating this. Consequently, I conclude that Mrs Mongan has failed in her attempt to demonstrate that use of Mr McIntyre’s mark would result in misrepresentation and damage to her goodwill, insofar as it is claimed to attach to the mark HYPNOBIRTHING.

55) I have also found that Mrs Mongan’s goodwill attaches to her composite sign and she argues that the get-up of this sign and Mr McIntyre’s mark adds to the likelihood of misrepresentation. Both the sign and the mark share a number of similarities and differences. The similarities are that they both share the word HYPNOBIRTHING and that they both have device element that includes or comprises a line drawings of a silhouette reminiscent of a family unit comprising

of a man, woman and child. The differences are that Mrs Mongan's sign also contains the words "The Mongan Method". Further, the orientation of the different elements differs, with the word HYPNOBIRTHING being "wrapped" around the base of the device element of Mr McIntyre's mark. In Mrs Mongan's sign, the word HYPNOBIRTHING is presented in large letters, with the device placed after the word and being on slightly taller than the letters and forms only about 10-15% of the total mark. The words "The Mongan Method" appear in smaller letters and are placed underneath the word HYPNOBIRTHING. Mrs Mongan's sign also includes the picture of a baby's face on the left hand side of the mark. But my view is that such a non-distinctive element is unlikely to play any significant role in my consideration of misrepresentation and certainly does not increase the likelihood of it occurring. The respective "man, women and child" devices have a different impact with it being considerably more dominant in Mr McIntyre's mark, accounting for about 90% of the mark. These respective elements also differ in that Mr McIntyre's marks: the characters are facing right to cradle what is clearly identified as being a small baby. The man appears on the left, the woman in the middle and the child on the right. There is no boundary. Mrs Mongan's device illustrates the characters facing forward with the woman on the right, the element that is reminiscent of being a baby (but does not actually create such a form) in the middle and the man on the right. The whole scene is presented in a darker circle that is itself surrounded by a light coloured circle boundary.

56) In support of the claim that her goodwill attached to the word HYPNOBIRTHING, Mrs Mongan, makes much of her using the word with a capital H and a capital B appearing thus: HypnoBirthing. I do not consider that this presentation of the word, within her composite sign, has any significant bearing on the issue of misrepresentation, but of course, it is a further point of difference between the sign and mark. Both of the respective devices of a man, woman and child are low in distinctive character because they represent the family unit who will benefit from the respective services. In Mr McIntyre's mark, the combination of a device of low distinctive character with a descriptive word creates a totality that is of a low to very low level of distinctive character.

57) Taking all of the above into account, it is my view that the Mrs Mongan's sign and Mr McIntyre's mark exhibit sufficient differences so that it is not likely that misrepresentation will occur. The common element HYPNOBIRTHING has a descriptive meaning, and even if it has acquired a secondary meaning of identifying Mrs Mongan's goodwill, it is clearly used in the profession and recognised by such and by customers as being descriptive. The only other element of Mrs Mongan's (composite) sign that may be considered to create a possibility of misrepresentation is in the "man, woman and child" device. However, the relative lack of dominance of this in Mrs Mongan's sign, the differences identified above and the low level of distinctive character in both devices, when factored into a comparison of the whole marks, results in it being unlikely that misrepresentation will occur.

58) In light of my conclusions above, Mrs Mongan's opposition fails in its entirety.

COSTS

59) Mr McIntyre has been successful and is entitled to a contribution towards the cost of the time he has spent on these proceedings. In his written submissions of 10 October 2011, he requested that he is allowed an opportunity to make detailed submissions on costs at the end of the proceedings. I refer Mr McIntyre to Tribunal Practice Notice (TPN) 4/2007 where information is provided on the costs regime operated by the Registry. It is common practice to make an award of costs in the form of a contribution and not on a compensatory basis. The Hearing Officer is free to deviate from this practice if he feels it is appropriate. However, in these proceedings, there is nothing that strikes me as requiring consideration of costs other than in the normal way.

60) The Registrar usually operates on a published scale of costs as set out in the above TPN. However, since Mr McIntyre has not been professionally represented during the proceedings, an award made from the published scale might be larger than his actual expenditure. Consequently, Mr McIntyre should produce an estimate of his costs, including the number of hours that he has spent on these proceedings, broken down by category of activity, i.e. reviewing the notice of opposition and completing the counterstatement, preparing his evidence and reviewing Mrs Mongan's evidence and written submissions. This should be filed within 21 days of the date of this decision and should be copied to Mrs Mongan's representatives, who will have 10 days from receipt of the estimate to provide written submissions on costs (and only on costs). I will then issue a supplementary decision covering the costs of these proceedings."

61) The period for any appeal against this decision will run concurrently with the appeal period for the supplementary decision on costs and so will not commence until the supplementary decision is issued.

Dated this 19th day of September 2012

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