

**O-376-17**

**TRADE MARKS ACT 1994**

**TRADE MARK REGISTRATION No. 3097262**

**IN THE NAME OF NYQUEST TRAINING AND PLACEMENT INC.**

**AND**

**APPLICATION No. 501206 BY AMERICAMP LIMITED**

**FOR A DECLARATION OF INVALIDITY**

**AND**

**TRADE MARK APPLICATION No. 3154357**

**BY AMERICAMP LIMITED**

**AND**

**OPPOSITION No. 406945**

**BY NYQUEST TRAINING AND PLACEMENT INC.**

## Background and pleadings

1. This decision covers an application by AmeriCamp Limited (“AmeriCamp”) to invalidate trade mark 3097262 in the name of Nyquest Training and Placement Inc. (“Nyquest”) and an opposition by Nyquest to trade mark application 3154357 by AmeriCamp.

2. Trade mark 3097262 consists of the words CAMP CANADA. The mark was applied for on 3<sup>rd</sup> March 2015. It was registered on 29<sup>th</sup> May 2015. The registration covers:

Class 35: Recruitment services; employment agency services; temporary employment agency services; employment consulting and employment assistance services; information and advice regarding employment opportunities and interviewing techniques; human resources management and consultancy services; testing to determine employment skills; organising and conducting events relating to employment opportunities, including interviewing techniques and training services; information and advisory services relating to the afore-going services.

Class 41: Education and training services; information and advisory services relating to the afore-going services.

3. On 17<sup>th</sup> May 2016, AmeriCamp applied to cancel Nyquest’s trade mark. AmeriCamp claims that Nyquest’s trade mark is invalid under s.47 of the Trade Marks Act 1994 (“the Act”). This is because Nyquest has an earlier right to CAMP CANADA as a result of the use of that name since October 2010 in relation to a range of services, including “*finding work for students and pupils as advisors at summer camps*”, “*arranging for employment of students as counsellors and support staff in summer camps*” and associated services, such as “*organisation and arrangement of travel, trips, journeys*” and “*instruction relating to travel possibilities and cultural conditions at the travel destination*”.

4. AmeriCamp further claims that Nyquest's application to register CAMP CANADA was made in bad faith. This claim was pleaded like this:

*"Prior to the filing of the application for the contested mark [Nyquest] was operating a placement service in Canada for summer camps to obtain their staff. This service was promoted as 'Canadian camp Experience Program (CCEP)' having been created by [Nyquest] at least as early as 2006. It was only in the autumn of 2015 that [Nyquest] quietly changed the name to 'Camp Canada Experience Program (CCEP)' before blatantly using [AmeriCamp's] CAMP CANADA trade mark from the beginning of 2016 to promote its business.*

*[AmeriCamp] trading as Camp Canada first started using the trade mark CAMP CANADA as long ago as October 2010 and worked with [Nyquest] via [AmeriCamp's] US visa sponsor Camp Counsellors USA (CCUSA). Participants of [AmeriCamp's] Camp Canada program would apply via a database which [AmeriCamp] shares with CCUSA who then in turn passes on [AmeriCamp's] Camp Canada applicants to [Nyquest]. During the past two years at least [AmeriCamp] has become one of the biggest recruiters for [Nyquest] which it was privy to all of [AmeriCamp's] data. [Nyquest] has been caught out trying to poach [AmeriCamp's] participants by getting them to apply directly to it rather than [AmeriCamp] and using [AmeriCamp's] trade mark."*

5. Nyquest filed a counterstatement denying the grounds for invalidation. In particular, Nyquest denies that AmeriCamp has been using CAMP CANADA since 2010 and claims that it has been using that mark in the UK since 2011. Nyquest admits that:

*"[Nyquest's] partner, CCUSA, entered into a sub agency agreement with [AmeriCamp] in 2014, but such agreement did not entitle [AmeriCamp] to file trade mark applications in the United Kingdom for the mark CAMP CANADA, nor claim ownership of the CAMP CANADA brand in any way."*

6. On 11<sup>th</sup> March 2016, AmeriCamp applied to register a series of two marks. The first is shown below.



The second mark is the same mark, except shown in black on white. Nothing turns on the presence/absence of colour, so for convenience I will refer to AmeriCamp's marks in the singular. My findings will apply to both marks.

6. AmeriCamp's application covers the following services:

Class 35: Recruitment services; organisation for the placement of au pairs, internships and the provision of services and information relating thereto; finding work for students and pupils as advisers at summer camps; arranging for employment of students as counsellors and support staff in summer camps; employment agency services; arrangement of au pair positions and study places; information, advisory and consultancy services relating to all the aforesaid services.

Class 39: Transportation services; transport services; storage services; provision of transport; organisation and arrangement of transport and transport services; transport and travel reservation services; services of escorting of travellers; travel agency services; provision of information relating to travel; organisation and arrangement of trips, journeys, excursions and tours; information services concerning travel, tours and excursions; booking and reservation of seats in transportation means; arrangement for the transportation of goods; packaging and storage of goods; storage of goods in

a warehouse for the purposes of preserving or caretaking; garaging; hiring of refrigerators; hiring of garages; warehousing; distribution of electricity and water; household removals; use of ferries; tugging, unloading, refloating of ships; hiring of horses and vehicles; arrangement of au pair positions and study places; information, advisory and consultancy services relating to all the aforesaid services.

Class 41: Education and entertainment services, language teaching, instruction relating to travel possibilities and cultural conditions at the travel destination; social events at the travel destination; arranging of study courses, professional training, arranging of excursions and leisure activities; organisation of leisure and leisure activities; organisation of leisure activities; organisation of leisure and study arrangements; provision of tuition, vocational and educational training; organisation of study; organising study courses; organisation of classes and courses; guidance for students in schools and training colleges; organisation of competitions; arranging for the reception of students in schools and educational establishments; arranging for the attendance of students at schools; teaching institutions; book publishing, reviews; book-lending; animal training; shows; radio or television entertainment; film production; artists agencies; hiring of films, phonographic recordings, projectors and accessories, theatre scenery; arranging and supervising the attendance of pupils at schools and colleges; information, advisory and consultancy services relating to all the aforesaid services.

Class 43: Accommodation consultancy services; temporary property rental advisory services; arrangement of temporary accommodation for others; provision and rental of temporary accommodation; accommodation reservation services; boarding houses and boarding house booking services; reservation and provision of camping holidays; provision of camp accommodation; provision of campground facilities; temporary accommodation agency services; hotel and catering services; hostel, hotel, camp and private accommodation reservation and booking services; services to aid others find temporary board and lodgings; boarding services; provision of hostel, hotel, camp and private accommodation; rental of temporary

accommodation; management of restaurants, self-service restaurants, snack-bars, canteens, cafes and cafeterias; restaurant, cafe, bar, canteen and catering services; providing of food and drink; child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services.

7. Nyquest opposes this application under sections 3(6), 5(2)(b), 5(3) & 5(4)(a) of the Act. The grounds under s.5(2) and 5(3) are based on earlier trade mark 3097262. Nyquest claims that the use of AmeriCamp's mark would result in a likelihood of confusion. Further, or alternatively, such use would, without due cause, dilute the distinctiveness of Nyquest's mark and/or tarnish the reputation of the mark and/or take unfair advantage of the mark's reputation.

8. The ground under s.5(4)(a) is based on Nyquest's claim to have an earlier right to CAMP CANADA in the UK as a result of its use of that mark since 2011.

9. The ground under s.3(6) is based on AmeriCamp's knowledge of Nyquest use and registration of CAMP CANADA in the UK. In this connection, I note, in particular, that Nyquest claims that:

*".....from 31 October 2006, the Opponent entered into a partnership agreement with Camp Counsellors USA ("CCUSA") to assist it in seeking customers for its services in Canada, the United Kingdom and elsewhere. The Opponent began using CAMP CANADA in the UK in 2011, and secured the domain name <http://www.campcanada.co.uk/> on 12 September 2011."*

10. Nyquest's opposition is directed at all the services covered by AmeriCamp's application.

11. AmeriCamp filed a counterstatement denying the grounds of opposition. In response to the grounds of opposition based on sections 3(6) and 5(4)(a), AmeriCamp relied upon its earlier use of CAMP CANADA since 2010. It also denied that Nyquest had the necessary goodwill in the UK in order to found a passing off

action. AmeriCamp put Nyquest to proof of its claim that its earlier CAMP CANADA mark had a reputation in the UK. Further, AmeriCamp relied on its application to invalidate trade mark 3097262 as an answer to Nyquest's grounds based on that trade mark. Finally, AmeriCamp admitted that the services covered by classes 35 and of its application are identical or similar to the services covered by the corresponding class of Nyquest's earlier trade mark. It also admitted that the services in class 41 relating to education, training and tuition were identical or similar to the services covered by class 41 of Nyquest's earlier trade mark. However, it denied that the remaining services in class 41 of the application, or any of the services in classes 39 and 43, were similar to any of the services covered by Nyquest's earlier trade mark.

12. Both sides seek an award of costs.

13. The proceedings were consolidated.

## **Representation**

14. AmeriCamp is represented by Wilson Gunn, Trade Mark Attorneys. Nyquest is represented by Cleveland, Trade Mark Attorneys. A hearing took place on 4<sup>th</sup> July 2017 at which Mr Jonathan Moss appeared as counsel for AmeriCamp. Ms Amanda Michaels appeared as counsel for Nyquest.

## **The evidence**

15. AmeriCamp's evidence consists of two witness statements by Lee McAteer who is a Director. He founded the company in January 2010. Prior to that he had conducted a business under the name AmeriCamp since 2005. Broadly speaking, Mr McAteer gives evidence about AmeriCamp's business and its dealings with Nyquest.

16. AmeriCamp's evidence also includes witness statements by Catherine Tomlinson and Ross Alcock. Ms Tomlinson joined AmeriCamp in September 2011 as Head of Recruitment. She became Chief Executive Officer in 2015. Her evidence goes mainly to AmeriCamp's dealings with Nyquest. Mr Alcock says that he joined

AmeriCamp in 2012 and became Social Media Manager in 2013. His evidence also goes mainly to AmeriCamp's dealings with Nyquest.

17. Additionally, AmeriCamp relies on a witness statement by Marielle Den Hollander who is the President of CCUSA Inc. ("CCUSA"). Since 1985, her company has provided summer camp jobs, work, travel experience and 'volunteer adventures'. The company recruits people from 60 countries and has placed 250k young adults in the USA and around the world, including Canada. CCUSA has worked with both the parties to these proceedings. Ms Den Hollander's evidence goes to her company's dealings with AmeriCamp and Nyquest and the branding those parties have used for the Canada program.

18. Finally, AmeriCamp's evidence includes two witness statements by Terry Roy Rundle, who is a Trade Mark Attorney working for Wilson Gunn. Mr Rundle's evidence goes mainly to the Nyquest's claim to have used CAMP CANADA in the UK prior to December 2014.

19. Nyquest's evidence consists of three witness statements by Jonathan Nyquist, who is the founder and President of Nyquest. Mr Nyquist's evidence goes to the operation of his company's Canadian Camp Experience Program in the UK since 2006 and his company's relationship with CCUSA and AmeriCamp.

#### Background - the parties' businesses

20. Since 2006/7 Nyquest has run a program through which participants acted as 'camp counsellors' and other work roles in summer camps in Canada. Until 2015/16 the program was called Canadian Camp Experience Program ("CCEP"). Nyquest operated in the UK throughout this period through an agreement with CCUSA. Essentially, CCUSA recruited applicants for Nyquest's CCEP. Between 2014 and 2016, AmeriCamp worked with CCUSA to recruit UK participants to the program. Nyquest simultaneously undertook direct UK recruitment of participants in the CCEP. Where such participants were recruited directly by Nyquest, it received an application payment and (if successful) a program payment fee from the applicant. Where participants were recruited through CCUSA/AmeriCamp, they received these



payments. In either case, Nyquest received a placement fee for each participant in the CCEP from the camp in Canada, which acted as the participant's employer.

21. AmeriCamp recruits participants to work in summer camps in the USA and Canada. In November 2011 it signed a partnership agreement with AC Partnership and CampstaffUSA. AC Partnership, which is based in Florida, was to promote AmeriCamp. CampstaffUSA was to provide 250 placements in summer camps throughout North America on the basis of 350 applications from participants recruited by AmeriCamp.<sup>1</sup> However, the arrangement does not appear to have been a success and by 2013 AmeriCamp decided that CCUSA would be its visa sponsor. In 2014, AmeriCamp started to recruit UK participants in the CCEP. It used a database called 'footprint' which it shares with CCUSA. Successful recruits were passed on to Nyquest for placement in summer camps in North America.<sup>2</sup>

22. There is no evidence that either party to these proceedings actually operates camps in North America (or anywhere else). Nyquest is effectively a specialist employment agency. AmeriCamp and CCUSA have, in effect, operated as recruiters for that agency.<sup>3</sup>

### Irrelevant evidence

23. The nature of the relations between the parties is relevant, but AmeriCamp's evidence about this focuses on Nyquest's perceived improper behaviour, such as poaching AmeriCamp's prospective recruits. A significant part of Nyquest's evidence is devoted to responding to such allegations. However, none of this sheds much light on the ownership of any rights in the name CAMP CANADA. I will therefore focus on what I consider to be the relevant evidence. It is convenient to start by examining the evidence of use of CAMP CANADA by the parties before they started working together at the beginning of 2014.

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<sup>1</sup> See McAteer 2, exhibit LWMcA-23

<sup>2</sup> See McAteer 1, paragraphs 5 and 6

<sup>3</sup> See the agreement between the parties for 2016, but signed in 2015, at exhibit JN24 to Nyquist 1

## The use of CAMP CANADA prior to 2014

24. Mr McAteer claims that AmeriCamp began using CAMP CANADA in October 2010 when a Twitter account was created under that name. A copy of a webpage from the 2016 Twitter account is in evidence.<sup>4</sup> It bears the mark shown in paragraph 6 above and invites applications for CAMP CANADA 2017. The webpage references AmeriCamp's website at 'CampCanada.org.' 2016 is, of course, well after Nyquest applied to register CAMP CANADA as a trade mark in March 2015. However, Mr McAteer relies on the fact that the Twitter page states that the holder joined in October 2010. According to Mr Nyquist's first statement,<sup>5</sup> AmeriCamp registered the domain name 'CampCanada.org' on 13<sup>th</sup> January 2014. AmeriCamp does not deny this. It follows that what appeared on AmeriCamp's Twitter page in 2016 is not necessarily reflective of what it looked like in 2010.

25. AmeriCamp also relies on the partnership agreement it entered into in November 2011 with AC Partnership and CampstaffUSA as evidence of its use of CAMP CANADA as a trade mark in the UK. Schedule 1 to the agreement does indeed list a 'Camp Canada logo' as an AmeriCamp 'product'. The 'supplier territory' (i.e. where the recruits would come from) is defined in schedule 2 as the UK and Ireland. I accept that this shows that AmeriCamp regarded a 'Camp Canada logo' as one of its trade marks in 2011. However, it does not show that such a mark was used in the UK and became distinctive of AmeriCamp's services prior to 2014. Indeed, Mr McAteer's evidence is that AmeriCamp's "old visa sponsor" (which I take to have been Campstaff USA) "could not deliver on the placing of our participants across North America". This appears to be why AmeriCamp decided to look for a new visa sponsor and came to an agreement with CCUSA in 2013.

26. Mr McAteer says that AmeriCamp promotes and advertises its CAMP CANADA services "In various ways including at universities and camp fairs and on social media and T-shirts." Mr McAteer's evidence includes examples of such promotional material for the 2014 season.<sup>6</sup> However, none of it is dated earlier than June 2014

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<sup>4</sup> See McAteer 1, paragraph 4 and exhibit LWMcA-01

<sup>5</sup> See Nyquest 1, paragraph 3.7.1 and exhibit JN17

<sup>6</sup> See exhibit LWMcA-17

and much of it is from 2015. Mr McAteer provides figures for the amounts spent promoting AmeriCamp's services between 2012-13 and 2015-16, but these are said to be global figures which include the amounts spent promoting services under CAMP CANADA and AMERICAMP, the latter of which appears to be AmeriCamp's primary trade mark. Further, as Mr McAteer says that AmeriCamp "*sends people from around the world to work at summer camps around the world*" it seems likely that these expenditure figures also include promotion of the marks outside the UK. I cannot therefore establish how much AmeriCamp spent (if anything) promoting services in the UK under the name CAMP CANADA.

27. Against this background, I regard it as highly significant that AmeriCamp has not provided any figures for the number of people from the UK (or anywhere else) that it recruited prior to 2014 under the name CAMP CANADA. No explanation has been provided as to why this information is unavailable.

28. Mr Moss drew my attention to Mr McAteer's evidence that during 2011 he had a telephone call with Mr Nyquist during the course of which he canvassed the possibility of the parties working together. However, Mr McAteer does not say that he identified his business to Mr Nyquist as Camp Canada (as opposed to AmeriCamp). In any event, Mr Nyquist was a potential business partner, not a UK customer.

29. Ms Tomlinson's evidence also covers a conversation that she had with Mr Nyquist in 2012. She says:

*"4. By my email of 9 July 2012 I reached out to Jonathan Nyquist through AmeriCamp which is the parent company of Camp Canada to discuss the possibility of working with him under our Camp Canada brand. The camp Canada program was already in operation under our previous visa sponsor that that AmeriCamp was working with at the time. Unfortunately, this visa sponsor Camp Staff USA was unable to fulfil the placement quota for the amount of pax we had and we had and we had to look elsewhere for alternative providers.*

*5. During the week beginning 16 July 2012 I had a conference call with Jonathan Nyquist and I clearly recall pitching the opportunity for Nyquest to work With Camp Canada as a recruiting partner. We did not discuss AmeriCamp recruiting applicants for Nyquest as this would make no sense as we already had the Camp Canada branding, and social media in place for Camp Canada, and had already placed applicants through our Camp Canada program.”*

30. Ms Tomlinson has not provided a copy of the email of 9<sup>th</sup> July referred to in her witness statement. In his first witness statement, Mr Nyquest accepts that this conversation took place, but he says that Ms Tomlinson only mentioned an American program under the name AmeriCamp. Further, he provides a copy of the email chain which preceded and followed the telephone conversation.<sup>7</sup> It ended with Nyquest declining AmeriCamp’s offer to work with it as a recruiter. There is no express mention in the emails of AmeriCamp’s Canadian program. The emails were sent from an americamp.co.uk web address. They identify AmeriCamp by that name. There is no reference to CAMP CANADA. The emails clearly support Mr Nyquist’s recollection of the conversation rather than that of Ms Tomlinson. I therefore accept Mr Nyquist’s evidence on this point. As to Ms Tomlinson’s general assertions that AmeriCamp’s CAMP CANADA program was already in operation in the UK and AmeriCamp had placed applicants under it, it is just that; mere assertion. Ms Tomlinson provides no specific evidence, such as the number of applicants AmeriCamp placed under the CAMP CANADA program. In these circumstances, and particularly bearing in mind the apparent unreliability of Ms Tomlinson’s evidence about her conversation with Mr Nyquist, I will treat Ms Tomlinson’s assertions with a great deal of caution.

31. This brings me to the evidence of Marielle Den Hollander of CCUSA. Ms Den Hollander states that *“AmeriCamp started promoting the Canada program in the UK for [her company] under the agent agreement [her company] has with AmeriCamp.”* In this connection, I note Mr McAteer’s evidence that CCUSA became AmeriCamp’s sponsor in 2013. Ms Den Hollander goes on to give evidence that *“AmeriCamp used*

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<sup>7</sup> See exhibit JN13 to Nyquist 1

*“Camp Canada” to promote the Canada program which it was actively promoting in 2010.”*

32. Mr Moss invited me to attach considerable weight to this evidence. He rightly pointed out that it is the only independent evidence before me. However, Ms Den Hollander herself is based in California. CCUSA’s commercial relationship with AmeriCamp does not appear to have started until 2013. She does not explain how she knows which marks AmeriCamp was using in the UK in 2010. In these circumstances, I am cautious about attaching much weight to her evidence that AmeriCamp used Camp Canada in the UK since 2010. If that had indeed been the case I find it surprising that AmeriCamp itself has been unable to identify the number of people it recruited under CAMP CANADA prior to 2014, or to provide any concrete evidence of any earlier use by it, in trade, in the UK.

33. For the reasons given above, I find that AmeriCamp has not established any trade mark use of CAMP CANADA in trade, in the UK, prior to 2014. If I am wrong about that, I find that any such use was entirely trivial and insufficient to generate any protectable goodwill in the UK.

34. Turning to Nyquest’s use of CAMP CANADA prior to 2014, Mr Nyquist’s evidence is that since 2006 1230 participants in the CCEP came from the UK.<sup>8</sup> He claims that 500 of these were recruited by Nyquest directly. A further 560-590 were recruited by CCUSA. The rest were recruited through AmeriCamp.

35. Mr Nyquist claims that use of CAMP CANADA began when *“Participants, recruiters and my company began referring to the CCEP program as CAMP CANADA soon after the business was launched in January 2006.”* He further claims that *“In the trade, the name CAMP CANADA was utilised to describe the services provided by the staff at my company.”*

36. In my view, it is obvious that the words ‘Canadian Camp’ in Nyquest’s ‘Canadian Camp Experience Program’ were used descriptively to designate the location and

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<sup>8</sup> This appears to be the figure up to the date of Mr Nyquist’s first witness statement in November 2016.

nature of the 'experience' provided through the program. The fact that the descriptive elements of the name may sometimes have been shortened to, or alternatively expressed as, 'Camp Canada' does not necessarily change the nature of the use of those words in the program title, which *prima facie* remains descriptive.

37. So the fact that a Rebecca Harvey from the UK appears to have sent an email to Nyquest in March 2011 headed 'NYQUEST: Camp Canada' and an Emma Osborne from the UK appears to have sent NyQuest an email in December 2011 in which she said "*Here is my second reference for Camp Canada*", does not necessarily show that they regarded CAMP CANADA as distinctive of Nyquest (as opposed to a description of a program of camps in Canada).<sup>9</sup>

38. Mr Nyquist relies on evidence that Nyquest set up a Twitter account in 2011 and had a Facebook page in 2012.<sup>10</sup> The Twitter account was set up in January 2011, but the two pages in evidence are from later (unspecified) dates. The user appears to be NyquestCanada, but both pages show use of 'NYQUEST Camp Canada'. Mr Moss submitted that this evidence was unreliable because changes in user names on Twitter (and Facebook) are applied retrospectively to pre-existing posts. I do not know whether this is true or not, but it seems obvious to me that pages from date X which show that the user joined on date Y do not necessarily show what the page looked like on date Y. The Facebook page is effectively dated (by the date it was 'liked') as early 2012. However, there is no evidence it was seen by anyone in the UK. Mr Nyquist provides evidence of similar use of 'NYQUEST Camp Canada' on Twitter and Facebook during 2013.<sup>11</sup> The tweets on Twitter do appear to show use of this name in March 2013. However, it is not clear who would have seen these posts either.

39. There is similar evidence in relation to Nyquest's website [www.go-nyquest.com](http://www.go-nyquest.com), which Mr Nyquist says was used to promote Nyquest's business in the UK until December 2014 (when Nyquest first made use of [www.campcanada.co.uk](http://www.campcanada.co.uk)).<sup>12</sup> Mr

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<sup>9</sup> See pages 11 and 12 of exhibit JN9 to Nyquist 1

<sup>10</sup> See exhibits JN11(a) and (b) to Nyquist 1

<sup>11</sup> See exhibits JN14(b) and (c) to Nyquist 1

<sup>12</sup> See paragraph 3.1 Nyquist 3

Nyquist exhibits a historical page from the website dated 12<sup>th</sup> August 2012.<sup>13</sup> It shows prominent use of NYQUEST as the name of the business. The heading for the post which appears on the page is 'Camp Canada'. It is about summer camps in Canada. Again it is, at best, ambiguous whether this would have been regarded as a reference to the provider of the services or just a description of the nature and place of the services.

40. According to Mr Nyquist, Nyquest received £13k in application and program fees from directly recruited UK participants in CCEP in 2012, and £35k in 2013. He says that Nyquest spent £1k and £2k, respectfully advertising and promoting the CCEP during this time. Examples of promotional material are provided.<sup>14</sup> They consist of promotional posters and on-line advertisements, but these are from 2014 and 2015. I return to them below.

41. There are further examples of third parties in the UK using Camp Canada in a similarly ambiguous manner during 2012 and 2013. A Matthew Jones used a UK email address to email Nyquest during March 2012 to say that his best friend was "*very interested in coming to Camp Canada..*". Caity Williams of CCUSA's UK Leeds office emailed others within CCUSA in October 2012 to say that "*..Camp Canada applications are now officially open in the Apps Centre and you can track them through IPAX*". The meaning she attaches to CAMP CANADA appears from the following sentence in her mail: "*I hope everyone has a great season recruiting for Canada Camps.*" There are further examples of similar emails to Nyquest during 2013 by potential or actual participants in the CCEP.<sup>15</sup>

42. Ms Michaels submitted that, for the purposes of establishing the relevant date under the law of passing off, use of CAMP CANADA in the UK began at least as early as 12<sup>th</sup> September 2011. This is when Nyquest registered the domain name campcanada.co.uk. I return below to the matter of relevant dates for the purposes of the law of passing off. However, I note at this point that the registration of the .co.uk domain name cannot have contributed to the creation of any business goodwill in the

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<sup>13</sup> See exhibit JN(3)1a to Nyquist 3

<sup>14</sup> See exhibits JN10(a)(b) and (c) to Nyquist 1

<sup>15</sup> See exhibit JN 14(a) to Nyquist 1

UK before December 2014. This is because this is when Mr Nyquist says that Nyquest first used the campcanada.co.uk website. I conclude that there is some evidence of Nyquest and third parties based in the UK using CAMP CANADA prior to 2014, but it is not clear whether these words were used to identify Nyquest's business or its placement program, or just the nature and location of the placement services it provided.

The use of CAMP CANADA from 2014 until the date of Nyquest's application to register those words on 3<sup>rd</sup> March 2015

43. Mr McAteer says that AmeriCamp provides recruitment services to Nyquest through CCUSA. As part of the recruitment process, AmeriCamp reviews applications, conducts interviews, undertakes reference checks and police background checks *"before submitting an applicant for placement"* [to Nyquest].

44. According to Mr McAteer, AmeriCamp *"actively recruits from its internal student database as well as visiting universities across the UK to promote the AmeriCamp and Camp Canada programs."* It also attends recruitment fairs and graduate and international fairs. He claims that AmeriCamp also organises and runs annual 'camp fairs' each January where potential applicants can meet directors of camps in Canada. AmeriCamp is said to have promoted and advertised *"its CAMP CANADA placement services"* at camp fairs, on social media and on T-shirts. Examples of such promotional material are in evidence.<sup>16</sup> These are claimed to include AmeriCamp's CAMP CANADA brochure for the 2014 season. The front cover of the brochure features the mark shown at paragraph 6 above, including the domain name www.CampCanada.org, which was registered on 13<sup>th</sup> January 2014.<sup>17</sup> According to the evidence, the season for summer camps in Canada runs from June to August. Exhibit LWMcA-17 includes screenshots showing lists of computer graphic files and the dates that they were created. I assume that these were filed in order to corroborate the dates of the various images shown in the exhibit. The image shown on the front page of the 2014 brochure is shown as having been created on 22<sup>nd</sup> August 2014. This is too late for it to have been on the brochure seeking applicants

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<sup>16</sup> See exhibit LWMcA-17 to McAteer 1

<sup>17</sup> See exhibit JN17 to Nyquist 1



for the 2014 season. It therefore seems likely that the brochure in evidence is in fact the brochure for the 2015 season.<sup>18</sup> The same exhibit includes a one page flyer for a camp fair held on 17<sup>th</sup> January 2015 in Leeds. The principal branding on the flyer is AmeriCamp. It offers a 10% discount on AmeriCamp's "*programme Fees*". However, there is a box towards the bottom of the page in which the mark shown in paragraph 6 above appears above the words "*This discount also applies to the Camp Canada Programme*", i.e. CAMP CANADA was used as the title of the summer camp program.

45. The inside page of the CAMP CANADA brochure includes a 'welcome' signed by *The Camp Canada Team*. The 'What you get' section mentions, inter alia, placement at camps, free food, 2 nights accommodation in the host Canadian city, medical insurance, an emergency telephone number, a flight assistance option and a free T-shirt. Exhibit LWMcA-17 also includes a picture of a T-shirt bearing the mark shown in paragraph 6 above. This appears to have been posted on social media by Mr McAteer. It was 'liked' on 6 July 2014, indicating that it was posted sometime prior to that.

46. Mr McAteer's evidence is that AmeriCamp placed 18 applicants through the CCEP in 2014, 57 in 2015 and 42 in 2016. These figures are not in dispute.

47. Mr Nyquist's evidence is that the business relationship with AmeriCamp started at the end of December 2013 when he received an email from Marielle den Hollander of CCUSA confirming that AmeriCamp's participants would be attending the January 2014 Canadian Job fair. In fact there were three such fairs in Edinburgh, Leeds and London. There are a number of disputes about who paid for these job fairs and even what time one of them started. There is evidence that Nyquest paid for the Edinburgh event. It also covered the cost of attendance by directors of camps in Canada. Mr McAteer disputes that Nyquest paid all the job fair costs, claiming that CCUSA paid for some of them. However, it appears to be common ground that both Nyquest and AmeriCamp were represented at the Edinburgh job fair, and possibly

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<sup>18</sup> Although the application fees quoted in the brochure (£95 on application and £304 final payment) does not correspond with the information provided in Mr McAteer's statement (who says that there was a fixed fee of £299 in 2014 and 2015, which increased to £349 in 2016).

also at the one in Leeds. Thus the parties were in attendance at the same events, both seeking recruits to the same summer camp job placement program in Canada.

48. Nyquest accepts that AmeriCamp launched its campcanada.org website and also Twitter and other social media sites under the CAMP CANADA name in 2014.<sup>19</sup> Mr Alcock says that he represented AmeriCamp at the Edinburgh job fair in mid-January 2014, and that he wore a T-shirt bearing the logo shown in paragraph 6. Nyquest does not appear to dispute that AmeriCamp started using the mark shown in paragraph 6 above at this time, in trade, and in the UK. However, Mr Nyquist states that it was Nyquest's understanding that AmeriCamp were promoting Nyquest's Camp Canada program. Once AmeriCamp had recruited a potential applicant the files were passed to CCUSA and then on to Nyquest for final approval. Thus Nyquest regarded AmeriCamp as a sub-agent of its recruiting partner, CCUSA.<sup>20</sup>

49. Mr Nyquist notes that some of the benefits of the program listed on AmeriCamp's campcanada.org website were in fact provided by Nyquest. In particular, Nyquest provided visa assistance and advice, placement at a Canadian summer camp, health insurance, accommodation and food whilst at the camp, 2 nights hotel accommodation at the host Canadian city, flight assistance options, travel in Canada and an emergency helpline. In support of these points, Mr Nyquist points out that AmeriCamp had to ask Nyquest where the 18 participants it had recruited to the 2014 program had been placed in Canada.<sup>21</sup> This was so that AmeriCamp could send the participants the free Camp Canada T-shirts promised on its website. Mr McAteer does not appear to dispute Mr Nyquist's evidence on this matter. I therefore accept this evidence as to the division of roles between the parties. Further, it appears from the evidence that AmeriCamp's recruits knew that Nyquest was responsible for their camp placements, medical insurance, travel to camp and accommodation in Canada etc.<sup>22</sup>

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<sup>19</sup> The website was registered on 13<sup>th</sup> January 2014. See exhibit JN17 to Nyquist 1.

<sup>20</sup> Exhibit JN20 to Nyquist 1 consists of a copy of a Recruiter Agent Agreement dated September 2015 between Nyquest and CCUSA, in which AmeriCamp is named, but not as a party to the agreement. The agreement makes provision for sub-agents.

<sup>21</sup> See exhibit JN19 to Nyquist 1

<sup>22</sup> See, for example, the email correspondence between AmeriCamp recruits and Nyquest at exhibit JN(2)8 to Nyquist 2.

50. Turning to Nyquest's use of CAMP CANADA from 2014, Mr Nyquist's evidence includes a copy of the 'Goggle +' poster used for the January 2014 camp fairs.<sup>23</sup> However, the poster itself did not mention Camp Canada. Mr Nyquist also provides copies of email correspondence between Nyquest, its recruiters and potential participants in the CCEP.<sup>24</sup> The first such email, dated 3<sup>rd</sup> January 2014, is from Nyquest to someone in the UK called Alistair Rocke. The body of the email contains details of a UK "SUMMER CAMP CANADA JOB FAIR" which was to be held on 17<sup>th</sup> January 2014. At the hearing, Mr Michaels relied on this as use of CAMP CANADA in the UK by Nyquest. Mr Moss disputed it was any such thing. He submitted that the proper meaning of this phrase was instead 'SUMMER CAMP' 'CANADA JOB FAIR'. The heading of the incoming email is also in evidence. I note that the subject of the incoming email from Mr Rocke was "*Re: Camp Canada Job Fair*". I therefore think that Ms Michaels' interpretation of the title of Nyquest's 2014 job fair is more likely to be correct than Mr Moss's interpretation. However, Nyquest's email starts off by thanking Mr Rocke for his help before inviting him to "*come along too.*" So it is not clear whether Mr Rocke was really a potential recruit or someone helping to set up the job fair. Nevertheless, this is evidence that Nyquest was, at least informally, referring to its program as Camp Canada in the UK in January 2014. There are a significant number of further emails to and from UK recruits to the program referring to it as CAMP CANADA during 2014.<sup>25</sup> For example, a Sam Baldwin emailed Nyquest on 15<sup>th</sup> January 2014 about 'Camp Canada Job Fairs' saying that he would be unable to attend the Leeds or London job fairs and asking if he could speak to someone over the phone. There is also a copy of an email dated January 2014 from CCUSA's Leeds Office to potential UK participants in the CCEP which referred to the job fairs for 'Camp Canada'. By 1<sup>st</sup> December 2014, Mr J C Conway of Nyquest was describing his role as the Placement Officer for NYQUEST Camp Canada. On 10<sup>th</sup> December 2014, Nyquest emailed the University of Bradford asking it to share information with its students about 'NYQUEST Camp Canada' and its forthcoming job fairs for 2015. By 5<sup>th</sup> January 2015, Nyquest's email signature had changed from NYQUEST to NYQUEST Camp Canada.

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<sup>23</sup> See exhibit JN10(b) to Nyquist1

<sup>24</sup> See exhibit JN23 to Nyquist 1

<sup>25</sup> All the emails mentioned in the remainder of this paragraph are in exhibit JN23 to Nyquist 1

51. Mr Nyquist says that Nyquest started using its campcanada.co.uk website in December 2014. An example of an advertisement for summer camps in Canada that appeared on that website on 22<sup>nd</sup> December 2014 is in evidence.<sup>26</sup> It invited viewers to see “*what can NYQUEST Camp Canada do for you.*” There is therefore no doubt that Nyquest was trading under that name in the UK by December 2014.<sup>27</sup>

52. Mr Nyquist says that Nyquest received £37k in 2014 in application and program fees from direct recruits (i.e. not via CCUSA or AmeriCamp) to the CCEP. This equates to around 100 applicants. In 2015, Nyquest directly recruited 94 UK applicants to CCEP. This compares with 57 participants that were recruited through AmeriCamp and 44 that were recruited via CCUSA. The corresponding figures for 2016 are 113 (Nyquest), 42 (AmeriCamp) and 44 (CCUSA). This amounts to £35k in application and program fees in 2015 and £43k in 2016. In addition, Nyquest received £165-170k in camp placement and other services provided to UK recruits (irrespective of the recruiter) in each of the years 2015 and 2016. It spent around £5k per annum during these years promoting the CCEP in the UK, mostly through universities and online advertising.

53. Mr Rundle gives evidence that a Rusja Foster posted blogs on 11<sup>th</sup> January 2015 and 15<sup>th</sup> February 2015 on the website summercampsecrets.org.<sup>28</sup> The later one was about AmeriCamp’s Canadian summer camp offering. It was identified by the Camp Canada logo shown at paragraph 6 above. In the earlier blog, the author wrote “*In terms of agencies for summer camp in Canada, there are three main choices, NYQUEST, CCUSA (on their Camp Counsellors Canada Program) and Camp Canada (a branch of AmeriCamp).*” The blog finishes with a comparison table including the respective application costs in pounds sterling, indicating that this blog was directed at a UK audience. I note that although the three parties are presented in the table as offering competitive summer camp programs, the associated flight assistance offerings from CCUSA and AmeriCamp are recorded as being provided through Nyquest. This further confirms Mr Nyquist’s evidence on this point, and also

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<sup>26</sup> See exhibit JN11(d) to Nyquist 1

<sup>27</sup> Mr Rundle’s evidence is that he used the Wayback web archive machine, but could find any earlier use of CAMP CANADA on either of Nyquest’s websites.

<sup>28</sup> See exhibits TRR-02 and TRR-03 to Rundle 1

shows some recognition of a connection between Nyquest and the programs said to have been available through CCUSA and Camp Canada/AmeriCamp.

54. Mr Nyquist filed evidence in reply in which he claimed that the webpage from 11<sup>th</sup> January 2015 filed by Mr Rundle with the comparison table was incomplete. He provided what he says is a full copy of the webpage. Mr Nyquist points out that the NYQUEST Camp Canada logo appeared near the top of the webpage. The AmeriCamp's Camp Canada logo, as shown at paragraph 6 above, appeared below, both above the comparison table. Mr Nyquist says that this shows that both parties were known to be trading as CAMP CANADA in January 2015. Mr Nyquist points out that Ms Rusja posted another blog on the same website on 19<sup>th</sup> January 2015 about Nyquest's summer camp program.<sup>29</sup> This also showed the NYQUEST Camp Canada logo, which looks like this.



55. Mr Nyquist says that Nyquest, CCUSA and AmeriCamp entered into a 'Participant Program Agreement' for 2015/16. He filed a copy of the agreement.<sup>30</sup> Nyquest is identified as 'Nyquest Training Placement'. CCUSA is identified by a logo including those letters. AmeriCamp is identified by a logo including that name. I note that Mr McAteer signed the agreement on 12<sup>th</sup> July 2015. It is standard agreement between participants in the CCEP and the three parties named above. The program is described as "*Camp Canada – CCEP Program.*" The agreement states that "*CCUSA works solely as a staff provider for Nyquest. AmeriCamp/CCUSA is responsible to recruit, interview, and accept staff on behalf of Nyquest.*" However, final acceptance on the program was reserved to Nyquest "*depending on the needs*

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<sup>29</sup> See exhibits J(3)2 and J(3)(3) to Nyquist 3

<sup>30</sup> See exhibit JN24 to Nyquist 1

of the Canadian camps.” Under this agreement, it was Nyquest’s responsibility to place participants, arrange transportation, provide hotels, medical insurance, and generally support participants in Canada.

56. In his second witness statement, Mr McAteer explained the reference in this agreement to his company as AmeriCamp saying “CCUSA wanted the AmeriCamp logo and details rather than Camp Canada because only AmeriCamp was a limited company. With AmeriCamp being the parent company it of course only made sense to refer to it as AmeriCamp, and as we were trading as Camp Canada for the purposes of the agreement, I did not see it as an issue.”<sup>31</sup>

57. I find it slightly odd that the program was identified in this agreement as the “Camp Canada – CCEP Program.” In full (in 2015) this would have meant ‘Camp Canada – Camp Canada Experience Program Program’. However, it is clear from the context that ‘Camp Canada’ was here being used by all the parties as part of the title of the program. This is consistent with those words designating the program rather than it being the trading name of AmeriCamp.

58. There is no equivalent agreement in evidence covering 2014. It seems likely that there was no previous formal agreement between the parties to these proceedings. Rather, the arrangements for 2014 and 2015 seasons appear to have been covered by agreements between Nyquest and CCUSA, with AmeriCamp acting as a sub-agent of CCUSA. Pages from the Nyquest/CCUSA agreements for 2014/15 and 2015/16 are in evidence.<sup>32</sup> Not surprisingly, the agreement for 2015/16 is similar to the agreement signed around the same time by all three parties, except that it expressly states that “CCEP was created by NYQUEST.” Only the front page of the 2014/15 agreement has been filed. Consequently, this does not shed any further light on the relationship between Nyquest and its recruiters at earlier dates. In the absence of any evidence to the contrary, I regard the terms of the 2015/16 agreements as shedding light backwards on the relationship between, and roles of, the parties at earlier dates.

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<sup>31</sup> Mr McAteer also mentions a contract his company had with CCUSA, but he has not filed a copy of that contract.

<sup>32</sup> See exhibits LWNmA-3 and 4 to McAteer 1

59. It is clear that UK participants in the CCEP for the 2016 season would have been required to sign a copy of the standard agreement described in paragraph 55. It would have been clear to these people that AmeriCamp and CCUSA were recruiters for Nyquest's Canadian program and that following the initial recruitment, Nyquest was responsible for the qualitative aspects of that program. There is no direct evidence showing what CCEP participants would have seen when they completed the initial application. Mr McAteer says that AmeriCamp's recruits used a database called 'footprints' which it shared with CCUSA, and that participants recruited this way were then passed on to Nyquest. Again in the absence of evidence to the contrary, I infer that at least at the point when applicants were passed onto Nyquest, it would have been clear to them that AmeriCamp and CCUSA were recruiters for Nyquest's Canadian program.

### **AmeriCamp's application to invalidate Nyquest's CAMP CANADA trade mark**

#### AmeriCamp's claim to an earlier right to the name CAMP CANADA

60. The relevant parts of s.47 and 5(4) of the Act are set out below.

"47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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

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

Provided that this shall not affect transactions past and closed.”

“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.”

61. AmeriCamp claims to have an earlier right in CAMP CANADA in relation to:

“Recruitment services; organisation for the placement of au pairs, internships and the provision of services and information relating thereto; finding work for students and pupils as advisors at summer camps; arranging for employment of students as counsellors and support staff In summer camps; employment agency services: arrangement of au pair positions and study places: organisation and arrangement of travel, trips, journeys, excursions and tours; organisation of leisure activities organisation of leisure and study arrangements: social events at the travel destination; instruction relating to travel possibilities and cultural conditions at the travel destination; arrangement of temporary accommodation for others; provision and rental of temporary accommodation: accommodation reservation services; reservation and provision of camping holidays; provision of camp accommodation; provision of campground facilities; camp and private accommodation reservation and booking services: information, advisory and consultancy services relating to all the aforesaid services.”



62. There is no dispute as to the applicable law. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

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

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

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

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

63. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,<sup>33</sup> Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

"39. In *Last Minute*, the General Court....said:

'50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

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<sup>33</sup> BL O-410-11

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the

Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
  
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

This is fuller statement of the position than, but is consistent with, the judgment of Kitchen L.J. in *Roger Maier and Assos of Switzerland SA v ASOS plc*.<sup>34</sup>

64. As I noted above, Ms Michaels submitted that the relevant date for assessing AmeriCamp's passing off right is 12<sup>th</sup> September 2011 when Nyquest registered the domain name campcanada.co.uk. In support of this submission, she relied on the judgment of Aldous L.J. in *British Telecommunications Plc v One in a Million Ltd*<sup>35</sup> in which it was held that, in appropriate circumstances, the registration of a domain name can itself constitute an instrument of deception or fraud, leading to liability for passing off. However, as Mr Moss pointed out, the mere registration of a domain name cannot automatically be regarded as use of that name, still less use of it as a trading name. As the judgment in *One in a Million* makes clear, whether a domain name is an instrument of fraud depends on the facts and circumstances. Many domain names consist of purely descriptive words. It seems very doubtful that such names could ever be regarded as instruments of fraud. On the other hand, it is much easier to see why domain names equating to well known trade names, such as British Telecommunications or Marks and Spencer, could be regarded as instruments of fraud in the hands of someone offering to sell them to the companies concerned. Even then the registration of the domain name would have to be the subject of a *quia timet* type action, i.e. a sign that may be used to cause deception in the future. I therefore reject Ms Michaels' submission that the relevant date is the date that Nyquest registered the campcanada.co.uk domain name.

65. Despite Nyquest's claims to have used CAMP CANADA in trade, I have not found it possible to identify any use of CAMP CANADA that was (a) by Nyquest, (b) unequivocally in the UK, and (c) clearly use as a trade name, or as a part of such a name, prior to December 2014. The first such use I can identify is when Mr J C Conway of Nyquest publicly described his role as the Placement Officer for NYQUEST Camp Canada on 1<sup>st</sup> December 2014. In any event, Nyquest was clearly using NYQUEST Camp Canada as a trading name on its .co.uk website on 22<sup>nd</sup> December 2014. I therefore find that the first relevant date is 1<sup>st</sup> December 2014. The second is the date of Nyquest's trade mark application on 3<sup>rd</sup> March 2015. In

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<sup>34</sup> [2015] EWCA Civ 220 at paragraph 165

<sup>35</sup> [1999] FSR 1 CA

order to succeed, AmeriCamp has to show that it could have restrained Nyquest's use of CAMP CANADA at both dates.

66. As I noted earlier, Nyquest accepts that AmeriCamp launched its campcanada.org website and also Twitter and other social media sites under the CAMP CANADA name in 2014.<sup>36</sup> There is also some evidence of use of the mark shown in paragraph 6 above on T-shirts, the earliest such use in the UK started in mid-January 2014. However, Nyquest submits that such use was in relation to its summer camp program, for which AmeriCamp acted solely as a recruiter.

67. This gives rise to two questions. Firstly, whether AmeriCamp's use of CAMP CANADA prior to December 2014 was distinctive of its recruitment services.<sup>37</sup> Secondly, if it was distinctive of AmeriCamp's services, whether the length and scale of use was sufficient to establish a passing off right by that date.

68. On the first point, the nature of AmeriCamp's use of CAMP CANADA on its UK website, social media sites and on T-shirts is ambiguous. Used in relation to the recruitment of people for Canadian summer camps, the name is likely to have been understood by at least some of AmeriCamp's recruits, and potential recruits, as descriptive of the nature and location of the recruitment services. This is consistent with Nyquest's evidence showing that a number of UK recruits (or potential recruits) to the CCEP sent emails to Nyquest during 2012, 2013 and 2014 referring to the CCEP as 'Camp Canada'. This appears to have started even before the parties themselves started using that name publicly. It is true that AmeriCamp's mark, as shown in paragraph 6 above, includes a domain name ending in .org. This might suggest that what precedes it – campcanada - is an organisation rather than just a description. On the other hand, the domain name makes up only a small part of the logo, and is towards the bottom of it. I do not therefore consider that it would not be safe for me to assume that the people who saw the logo would have given much consideration to the precise meaning of the words in the domain name. I am not

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<sup>36</sup> The website was registered on 13<sup>th</sup> January 2014. See exhibit JN17 to Nyquist 1.

<sup>37</sup> See *T Oertli, AG v EJ Bowman (London) Ltd* (No.3) [1959] RPC 1 (HOL)

therefore persuaded that AmeriCamp's use of CAMP CANADA would have been regarded as distinctive of its recruitment services.

69. On the second point, the evidence of AmeriCamp's use of CAMP CANADA prior to December 2014 is very scant. Most of AmeriCamp's evidence focuses instead on Nyquest's use, or non-use, of Camp Canada. On AmeriCamp's own evidence, it recruited only 18 people under CAMP CANADA in 2014. And on the evidence I have seen it is not clear how many of them would have identified their recruiter as CAMP CANADA (as opposed to AmeriCamp recruiting them to the Camp Canada program). I remind myself that the question I am addressing is not who used CAMP CANADA first in the UK, but whether AmeriCamp has established that it had acquired a passing off right prior to December 2014 (and which was still exercisable in March 2015).

70. In *Hart v Relentless Records*,<sup>38</sup> Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

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<sup>38</sup> [2002] EWHC 1984 (Ch)

71. It is true that the law protects the goodwill or small businesses as much as that of larger businesses, and there are cases where the law of passing off has been successfully deployed to protect a business which was quite modest in both duration and scale.<sup>39</sup> However, it is easier to show that a name is distinctive of a business where the name is inherently distinctive than where it may have been regarded as descriptive of the goods/services.

72. In my view, the strongest evidence provided by AmeriCamp in this respect is the evidence of Rusja Foster's blogs on the website [summercampsecrets.org](http://summercampsecrets.org) in January and February 2015. This was after the first relevant date in December 2014, but not long after. Therefore, it may reflect how the author saw the parties' trading names at that date. The author recorded that the relevant part of AmeriCamp's business was called Camp Canada. On the other hand, she also appears to have identified Nyquest's business as NYQUEST Camp Canada. It is not therefore clear whether she thought that both parties were trading under CAMP CANADA, and/or whether she thought that AmeriCamp was Camp Canada and Nyquest also used that those words as the title of its summer camp program. Ultimately, Ms Foster's views on this matter are her own. They are not necessarily representative of the parties' customers and potential UK customers at the first relevant date in December 2014.

73. I acknowledge that publicity on websites etc. has the potential to shape consumers' perception of terms which may not be distinctive of the business of an undertaking, such as Camp Canada. However, there is no evidence as to the number of UK visitors to the [summercampsecrets.org](http://summercampsecrets.org) website. I cannot therefore safely infer that this publicity would have materially influenced the relevant part of the UK public to perceive CAMP CANADA as AmeriCamp's trading name by the date of Nyquest's trade mark application on 3<sup>rd</sup> March 2015.

74. I conclude that AmeriCamp has not established that CAMP CANADA was distinctive of its recruitment services (or any other services) by the first or second relevant dates. Further, even if I am wrong about this, the number of AmeriCamp's UK customers (or potential customers) who would have regarded CAMP CANADA

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<sup>39</sup> See, for example, *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Jian Tools for Sale v Roderick Manhattan Group Limited* [1995] FSR 924.

as distinctive of its services at those dates is likely to have been trivial. Consequently, Nyquest's use of CAMP CANADA would not have constituted a misrepresentation likely to deceive a substantial number of AmeriCamp's customers (or potential customers).<sup>40</sup> It follows that AmeriCamp's passing off right claim would have failed at the relevant dates.

75. AmeriCamp's claim to have established an earlier right to CAMP CANADA fails accordingly.

AmeriCamp's claim that Nyquest's trade mark 3097262 was filed in bad faith

76. Section 47 of the Act states:

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

Section 3(6) of the Act states:

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

77. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited*:<sup>41</sup>

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

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<sup>40</sup> See, for example, *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, per Morritt L.J.

<sup>41</sup> [2012] EWHC 1929 (Ch)



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

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

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

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

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

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

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

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

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

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

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the

relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

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

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

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

78. AmeriCamp's pleaded case is re-produced in paragraph 4 above. It consists of the following claims:

- *Prior to the filing of the application for the contested mark Nyquest was operating a placement service in Canada for summer camps to obtain their staff.*

This is not disputed.

- *This service was promoted as 'Canadian camp Experience Program (CCEP)' having been created by Nyquest at least as early as 2006.*

This is not disputed either.

- *It was only in the autumn of 2015 that Nyquest quietly changed the name to 'Camp Canada Experience Program (CCEP)' before using the CAMP CANADA trade mark from the beginning of 2016 to promote its business.*

There is no dispute that Nyquest changed the name of the CCEP to Camp Canada Experience Program in Autumn 2015. This was after it had applied to register the trade mark. On my findings, Nyquest was using CAMP CANADA in the UK from December 2014 as part of the trading name NYQUEST Camp Canada. This was prior to filing its trade mark application.

- *AmeriCamp trading as Camp Canada first started using the trade mark CAMP CANADA as long ago as October 2010.*

On my findings, AmeriCamp started using CAMP CANADA in the UK in January 2014.

- *AmeriCamp worked with Nyquest via AmeriCamp's US visa sponsor Camp Counsellors USA (CCUSA).*

This is not disputed.

- *Participants of AmeriCamp's Camp Canada program would apply via a database which AmeriCamp shares with CCUSA who then in turn passes on AmeriCamp's Camp Canada applicants to Nyquest.*

There is no dispute that AmeriCamp worked with CCUSA to recruit participants for the CCEP, which it passed on to Nyquest. There is an implicit dispute as to whether AmeriCamp's Camp Canada 'program' was anything more than an alternative route into Nyquest's CCEP.

- *During the past two years at least AmeriCamp has become one of the biggest recruiters for Nyquest which it was privy to all of AmeriCamp's data.*

On the evidence, there were only three recruiters to the CCEP, and AmeriCamp was not the biggest. In any event, it is hard to understand what relevance this has, except to the extent that it bears on the question of who the CCEP belonged to (and, by extension, who had rights to any names distinctive of that program).

- *Nyquest has been caught out trying to poach AmeriCamp's participants by getting them to apply directly to it rather than AmeriCamp and using AmeriCamp's trade mark.*

I do not understand the relevance of this to the claim that Nyquest filed its trade mark application in bad faith. It appears to be an attempt to bring Nyquest's general commercial morality into the trade mark dispute.

79. Where a party has used a trade mark as its trading name, or as a part of its trading name, prior to filing an application to register that mark, it is appropriate to exercise a good deal of caution before classifying the application as one made in bad faith. As Mr Daniel Alexander QC, as the Appointed Person, stated in *Roadrunners Gatwick Limited v Road Runners (East Grinstead) Limited*:<sup>42</sup>

“28. .... it is said the Hearing Officer ignored his own finding that the proprietor had goodwill dating back to 1991 and therefore had a legitimate business to protect. It is submitted that this means that the proprietor itself had a legitimate basis upon which to register its trading name as a trade mark. This, it is said, is therefore no more than an aspect of a normal, albeit aggressive, fight for control of one's own brand and does not constitute bad faith.

29. The proprietor is on stronger ground with this argument, as a matter of principle. It is this issue which has caused most reflection in considering this appeal, since the boundary between impermissible appropriation or denial of third party right amounting to bad faith and permissible assertion of a bona fide claim to a trade mark right of one's own is not always easy to draw. That

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<sup>42</sup> BL O/094/17

is partly because it is not bad faith as such to stake a claim to trade mark protection even if that claim may not ultimately be justified. Nor is it bad faith as such for an undertaking to seek registration of a trade mark with a view to preventing others from using that or a similar mark. Indeed, securing exclusivity is the very purpose of trade mark registration. The jurisdiction to refuse protection in cases of bad faith is also not to be invoked so as to make general adjudications as to commercial morality.

30. That said, the CJEU made it clear in *Lindt* that the intention to prevent a third party from marketing a product may, in certain circumstances, be an important element of bad faith on the part of the applicant. There is therefore no doubt that, in a given case, this can be a factor to which a tribunal can give considerable, indeed dominant, weight. There are, of course, cases in which an undertaking innocently registers a mark which it believes that it is itself entitled to use. That may have an incidental adverse effect on the business of other traders in the field. That is not bad faith as such: it is a normal approach to registration. While that is a sound proposition and is supported by the passages from the *Cipriani* case cited above, in my judgment, some care must be taken in applying it uncritically to the facts of any given case on bad faith.

31. On the one hand, there are doubtless cases where the intention of the party registering the mark is not very clear and, in those, a proprietor might reasonably be given the benefit of the doubt as to whether the mark was applied for in protection of its own business, bearing in mind the nature and seriousness of a bad faith attack. On the other hand, there are cases where it is sufficiently clear that the application for registration is not undertaken mainly to protect a proprietor's own business but is primarily to prevent a third party from using a mark which it is known that it is legitimately entitled to use. Exactly where the line is to be drawn between such cases may not always be easy but tribunals generally recognize sufficiently clear cases where they see them.

80. Having regard to this guidance, my decision that Nyquest was using NYQUEST Camp Canada in December 2014 and that AmeriCamp has not established that it had acquired a protectable goodwill in the UK under CAMP CANADA at either that date, or at the date of Nyquest's application for registration, does not provide fertile ground for AmeriCamp's claim that Nyquest's application was filed in bad faith.

81. AmeriCamp's claim, which is essentially that Nyquest stole its CAMP CANADA trading name, is further weakened by the relative descriptiveness of that name for a recruitment program for summer camps in Canada. The evidence that participants in Nyquest's program, and Nyquest itself on occasions, informally referred to the CCEP as Camp Canada, even before 2014 when AmeriCamp started using that name, is another reason to be cautious about classifying Nyquest's trade mark application as one filed in bad faith.

82. The evidence shows that, despite what Rusja Foster might have thought when on 11<sup>th</sup> January 2015 she posted her 'comparison' table for summer camps in Canada on the website [summercampsecrets.org](http://summercampsecrets.org), the reality is that AmeriCamp did not have its own program. It was a sub-agent and recruiter for Nyquest's CCEP. AmeriCamp's recruits would have known this. Therefore, if anything, the evidence points to CAMP CANADA having become distinctive of the CCEP at the date of Nyquest's application. This is consistent with the program being called 'Camp Canada CCEP Program' in the 'Participant Program Agreement' the parties signed later in 2015. This provides another reason why AmeriCamp was identified by that name, rather than CAMP CANADA, in that agreement. Otherwise AmeriCamp would have had the same trading name as the name of the program for which it was recruiting on behalf of Nyquest.

83. Whose program was it? In my view, the evidence is consistent with it being Nyquest's program. CCUSA and AmeriCamp recruited for that program "*...on behalf of Nyquest.*" Thus if there was any goodwill in the program name at the date of Nyquest's trade mark application, I find that it belonged to Nyquest. Consequently, although AmeriCamp's use of CAMP CANADA may have helped to promote Nyquest's CCEP in the UK, I do not accept that Nyquest's decision in 2015 to

change the formal name of the program to ‘Camp Canada Experience Program’ constituted a misappropriation of AmeriCamp’s rights or trading style.

84. For the reasons given above, AmeriCamp’s bad faith claim fails.

**Nyquest’s opposition to AmeriCamp’s trade mark application 3154357**

The opposition under section 5(2)(b) based on earlier trade mark 3097262

85. Section 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

86. AmeriCamp accepts that the marks are similar and that the services shown below are identical or similar to the services covered by earlier trade mark 3097262. It therefore accepts that a consequence of losing on the cancellation application is that Nyquest’s opposition will succeed in relation to:

Class 35: All services

Class 39: Arrangement of au pair positions

Class 41: Education, language teaching, instruction relating to travel possibilities and cultural conditions at the travel destination; social events at the travel destination; arranging of study courses, professional training, organisation of leisure and study arrangements; provision of tuition, vocational and educational training; organisation of study; organising study courses; organisation of classes and courses; guidance for students in schools and training colleges; organisation of competitions; arranging for



the reception of students in schools and educational establishments; arranging for the attendance of students at schools; teaching institutions; animal training; arranging and supervising the attendance of pupils at schools and colleges.

87. This leaves:

Class 39: Transportation services; transport services; storage services; provision of transport; organisation and arrangement of transport and transport services; transport and travel reservation services; services of escorting of travellers; travel agency services; provision of information relating to travel; organisation and arrangement of trips, journeys, excursions and tours; information services concerning travel, tours and excursions; booking and reservation of seats in transportation means; arrangement for the transportation of goods; packaging and storage of goods; storage of goods in a warehouse for the purposes of preserving or caretaking; garaging; hiring of refrigerators; hiring of garages; warehousing; distribution of electricity and water; household removals; use of ferries; tugging, unloading, refloating of ships; hiring of horses and vehicles; arrangement of study places; information, advisory and consultancy services relating to all the aforesaid services.

Class 41: Entertainment services; arranging of excursions and leisure activities; organisation of leisure and leisure activities; organisation of leisure activities; book publishing, reviews; book-lending; shows; radio or television entertainment; film production; artists agencies; hiring of films, phonographic recordings, projectors and accessories, theatre scenery; information, advisory and consultancy services relating to all the aforesaid services.

Class 43: Accommodation consultancy services; temporary property rental advisory services; arrangement of temporary accommodation for others; provision and rental of temporary accommodation; accommodation reservation services; boarding houses and boarding house booking services; reservation and provision of camping holidays; provision of camp accommodation; provision of campground facilities; temporary accommodation agency services; hotel and catering services; hostel, hotel, camp and private accommodation reservation and booking services; services

to aid others find temporary board and lodgings; boarding services; provision of hostel, hotel, camp and private accommodation; rental of temporary accommodation; management of restaurants, self-service restaurants, snack-bars, canteens, cafes and cafeterias; restaurant, cafe, bar, canteen and catering services; providing of food and drink; child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services.

88. With the exceptions of the services I have underlined in the above table, Nyquest accepts that these services are not similar to those for which trade mark 3097262 is registered. It follows that the only issue I have to resolve under s.5(2)(b) is whether the underlined services are similar to any of the services covered by the earlier mark.

Nyquest's trade mark	AmeriCamp's trade mark
<p>Class 35: Recruitment services; employment agency services; temporary employment agency services; employment consulting and employment assistance services; information and advice regarding employment opportunities and interviewing techniques; human resources management and consultancy services; testing to determine employment skills; organising and conducting events relating to employment opportunities, including interviewing techniques and training services; information and advisory services relating to the foregoing services.</p> <p>Class 41: Education and training services; information and advisory</p>	<p>Class 39: Arrangement of study places; information, advisory and consultancy services relating to all the aforesaid services.</p> <p>Class 41: arranging of excursions and leisure activities; information, advisory and consultancy services relating to all the aforesaid services.</p>

services relating to the afore-going services.	
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89. In assessing whether the respective services are similar, I will bear in mind the guidance provided by the Court of Justice of the European Union (“CJEU”) in *Canon*.<sup>43</sup> The court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

90. I find that AmeriCamp’s *arrangement of study places* has a similar purpose and is complementary to Nyquest’s *education and training services*. Consequently, I find that the services are similar at least to a medium degree. Given the accepted degree of similarity between the respective marks, this is sufficient to create a likelihood of confusion, including the likelihood of association. Nyquest’s opposition therefore succeeds in relation to these services too.

91. I cannot see any similarity between AmeriCamp’s *arranging of excursions and leisure activities* and any of the services covered by Nyquest’s earlier mark. Therefore the opposition under s.5(2)(b) fails in relation to these services.

92. The opposition to *advisory and consultancy services relating to all the aforesaid services* can only succeed to the extent that the identified *aforesaid services* are themselves similar to any of the services for which Nyquest’s mark is registered. With *arrangement of study places* in class 41 removed, none of the remaining services are similar. Therefore, this description of services is free from objection under s.5(2)(b) when applied to AmeriCamp’s remaining services in classes 39 and 41.

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<sup>43</sup> Case C-39/97

93. This means that Nyquest's opposition under s.5(2)(b) succeeds in relation to the services specified in paragraph 86 above, and *arrangement of study places* in class 39.

Nyquest's claim to an earlier right to the name CAMP CANADA

94. The claim is now directed at the following of the remaining services covered by AmeriCamp's application.<sup>44</sup>

Class 39: Transportation services; transport services; provision of transport; organisation and arrangement of transport and transport services; transport and travel reservation services; services of escorting of travellers; travel agency services; provision of information relating to travel; organisation and arrangement of trips, journeys, excursions and tours; information services concerning travel, tours and excursions; booking and reservation of seats in transportation means.

Class 41: Entertainment services; organisation of leisure and leisure activities: organisation of leisure activities; organisation of leisure arrangements.

Class 43: Accommodation consultancy services; temporary property rental advisory services; arrangement of temporary accommodation for others; provision and rental of temporary accommodation; accommodation reservation services; boarding house booking services; reservation and provision of camping holidays; provision of camp accommodation; temporary accommodation agency services; hostel, hotel, camp and private accommodation reservation and booking services; services to aid others find temporary board and lodgings; provision of hostel, camp and private accommodation; rental of temporary accommodation; child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services.

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<sup>44</sup> Per Ms Michaels' skeleton argument for the hearing

95. In accordance with my earlier findings, there is no evidence that AmeriCamp has acquired goodwill under CAMP CANADA in relation to the above services. To the extent that it has advertised such services, it has done so as a recruiter and agent acting on behalf of Nyquest in relation to the CCEP. Consequently, the relevant date for this purpose is the date of AmeriCamp's trade mark application on 11<sup>th</sup> March 2016.

96. By this date Nyquest had been trading as NYQUEST Camp Canada for at least 15 months. Further, I find that CAMP CANADA was, by this date, distinctive of the CCEP for which Nyquest was known to be responsible. It follows that CAMP CANADA was distinctive of Nyquest and its CCEP program.

97. That program included services to arrange transport and accommodation. Therefore, in my view, use of CAMP CANADA by AmeriCamp at the relevant date in relation to the following services would have amounted to a misrepresentation likely to deceive a substantial number of Nyquest's customers or potential customers in the UK.

Class 39: Provision of transport; organisation and arrangement of transport and transport services; transport and travel reservation services; services of escorting of travellers; travel agency services; provision of information relating to travel; organisation and arrangement of trips, journeys, excursions and tours; information services concerning travel, tours and excursions; booking and reservation of seats in transportation means.

Class 43: Accommodation consultancy services; temporary property rental advisory services; arrangement of temporary accommodation for others; provision and rental of temporary accommodation; accommodation reservation services; boarding house booking services; reservation and provision of camping holidays; provision of camp accommodation; temporary accommodation agency services; hostel, hotel, camp and private accommodation reservation and booking services; services to aid others find temporary board and lodgings; provision of hostel, camp and private accommodation; rental of temporary accommodation; information, advisory and

consultancy services relating to all the aforesaid services.

98. I find that AmeriCamp's use of CAMP CANADA in relation to the above services, other than as an agent of Nyquest, was liable to damage the goodwill in Nyquest's business. Most obviously, through diversion of business, but also through loss of control of the name CAMP CANADA and the services provided under that name in the UK.

99. I see no evidence that Nyquest's UK goodwill and reputation extended to the services shown below. For example, no one would have thought that Nyquest provided a transport service for which it was responsible (as opposed to providing or arranging the transportation services of a third party).

Class 39: Transportation services; transport services.

Class 41: Entertainment services; organisation of leisure and leisure activities: organisation of leisure activities; organisation of leisure arrangements.

Class 43: Child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services.

100. Accordingly, Nyquest's opposition under s.5(4)(a) succeeds in relation to the services specified in paragraph 97, but fails in relation to the services specified in paragraph 99.

Nyquest's claim that trade mark application 3154357 was filed in bad faith

101. In the light of my finding that Nyquest's goodwill and reputation did not extend to the services shown in paragraph 99 above, I cannot see that Nyquest has any stronger case for saying that the application was filed in bad faith in relation to these services.

Nyquest's claim that use of AmeriCamp's mark would, without due cause, dilute the distinctiveness of Nyquest's mark and/or tarnish and/or take unfair advantage of the mark's reputation

102. Section 5(3) of the Act states that:

“(3) A trade mark which-  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

103. There is no requirement under s.5(3) for the applicant's services to be similar to the services covered by the earlier mark. Therefore, Nyquest's case under s.5(3) could, in principle, improve its position over the outcome of its case based on sections 5(2) and 5(4)(a) of the Act.

104. Once again, the relevant date is 11<sup>th</sup> March 2016.

105. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.



(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

106. The test for 'reputation' was set out by the CJEU in *General Motors*. The earlier mark must be known by 'a significant part' of the relevant public. Some commentators have regarded this as setting a low threshold. In *Iron & Smith kft v Unilever NV*,<sup>45</sup> the CJEU was asked whether a CTM (now a EU TM) with a qualifying reputation 'in the Community' (now the European Union), but not in the member state where infringement was alleged, was capable of being infringed under a provision of the Community Trade Mark Regulation (now the European Union Trade Mark Regulation), which is broadly equivalent to s.5(3) of the Act. The court answered that:

"If the earlier Community trade mark has already acquired a reputation in a substantial part of the territory of the European Union, but not with the relevant public in the Member State in which registration of the later national mark concerned by the opposition has been applied for, the proprietor of the Community trade mark may benefit from the protection introduced by Article 4(3) of Directive 2008/95 where it is shown that a commercially significant part of that public is familiar with that mark, makes a connection between it and the later national mark, and that there is, taking account of all the relevant factors in the case, either actual and present injury to its mark, for the purposes of

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<sup>45</sup> Case C-125/14

that provision or, failing that, a serious risk that such injury may occur in the future.”

107. A European Union trade mark may therefore be known to “a significant part of the public concerned by the products or services covered by that trade mark” in the EU, without meeting that threshold in a particular Member State. Nevertheless, provided that the mark is known to “a commercially significant part of” the relevant public in the relevant Member State in question, it may be entitled to extended protection in that Member State on account of its reputation in the Union. This is confirmed by other language versions of the judgment. The French version says that a “commercially non-negligible” part of the relevant public in the Member State must be aware of the earlier CTM (now EU TM) and make a link with the later national trade mark. If a ‘commercially non-negligible’ part of the relevant public represents a lower threshold than the standard requirement for the earlier mark to be known amongst ‘a significant part of the [relevant] public’, it follows that the standard requirement must be for more than a non-negligible or minimal level of reputation. This makes sense because s.5(3) is based on an optional provision of the 1989 Trade Mark Directive and is intended to provide more extensive protection to marks with a certain level of reputation. This suggests that the level of reputation required under s.5(3) is higher than that which is required in order to support a passing off right under the common law of the UK.

108. The “public concerned by the products or services covered by that trade mark” are consumers and potential consumers of the services set out in paragraph 2 above. I see nothing in the evidence which persuades me that Nyquest’s CAMP CANADA mark was known to a ‘significant part’ of that public in the UK. Further, even if the question is narrowed down to focus on those interested in temporary summer jobs, or even temporary summer jobs abroad, I find it difficult to accept on the evidence before me that Nyquest’s mark would have been known at the relevant date to a ‘significant part’ of the relevant UK public.

109. Therefore, in my view, the s.5(3) ground falls at the first hurdle.

110. If I am wrong about this, then I would hold that the reputation of the earlier mark was modest at the relevant date and insufficient to cause those encountering AmeriCamp's mark used in relation to the [different] services specified in paragraph 99 above to make the required link or connection with the earlier mark.

111. In addition to which, as Mr Moss pointed out at the hearing, Nyquest has made little or no attempt to particularise its case under this heading so that AmeriCamp (and I) can clearly understand what the damaging or unfair consequences of any link made between the marks would be, other than a likelihood of confusion. I have already assessed that risk under other headings. Therefore, even if I am wrong about the non-existence of a qualifying reputation and/or link, I would still have rejected the s.5(3) opposition in relation to the services specified in paragraph 99 above.

112. I conclude that the s.5(3) case adds nothing to other grounds of opposition.

### **Overall result**

113. AmeriCamp's application to invalidate trade mark 3097262 fails.

114. Nyquest's opposition to application 3145357 succeeds, except in relation to:

Class 39: Transportation services; transport services.

Class 41: Entertainment services; organisation of leisure and leisure activities; organisation of leisure activities; organisation of leisure arrangements.

Class 43: Child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services.

115. The application may therefore proceed to registration for these services as well as those for which Nyquest no longer maintains that there are grounds for refusal. This means that the application may proceed for:

Class 39: Transportation services; transport services; storage services; arrangement for the transportation of goods; packaging and storage of goods; storage of goods in a warehouse for the purposes of preserving or caretaking; garaging; hiring of refrigerators; hiring of garages; warehousing; distribution of electricity and water; household removals; use of ferries; tugging, unloading, refloating of ships; hiring of horses and vehicles.

Class 41: Entertainment services; organisation of leisure and leisure activities; organisation of leisure activities; organisation of leisure arrangements; organisation of competitions; book publishing, reviews; book-lending; shows; radio or television entertainment; film production; artists agencies; hiring of films, phonographic recordings, projectors and accessories, theatre scenery.

Class 43: Child care services; provision and maintenance of crèche facilities and day nurseries, looking after children; information, advisory and consultancy services relating to all the aforesaid services; boarding houses; provision of campground facilities; hotel and catering services; boarding services; hotel and private accommodation; management of restaurants, self-service restaurants, snack bars, canteens, cafes and cafeterias; restaurant, café, bar, canteen and catering services; providing of food and drink.

## **Costs**

116. Nyquest has successfully defended its trade mark and its opposition to AmeriCamp's application has succeeded to a greater extent than it failed. Nyquest is therefore entitled to a contribution towards its costs. In the circumstances I assess the appropriate sum as follows:

- Considering AmeriCamp's application for invalidation and filing a counterstatement - £300
- Filing a notice of opposition to AmeriCamp's application and considering the counterstatement - £400 (including the official fee of £200)
- Filing evidence and considering AmeriCamp's evidence - £1700

- Attending a hearing and filing a skeleton argument - £1000

I therefore order AmeriCamp Ltd to pay Nyquest Training and Placement Inc. the sum of £3400. The above sum should be paid within 21 days of the expiry of the appeal period.

**Dated this 9<sup>th</sup> day of August 2017**

**Allan James  
For the Registrar**