

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2068227
BY SIDERGIE TO REGISTER A TRADE MARK
IN CLASSES 35 AND 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 49371 BY THE SYNERGY GROUP LIMITED**

TRADE MARKS ACT 1994

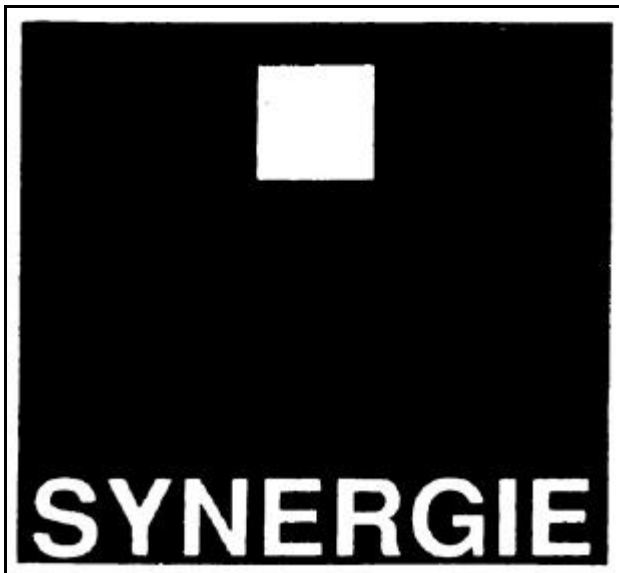
**IN THE MATTER OF Application No 2068227 by
Sidergie to register a trade mark in Classes 35
and 41**

AND

**IN THE MATTER OF Opposition thereto under
No 49371 by The Synergy Group Limited**

BACKGROUND

1. On 10 April 1996 Sidergie applied to register the following trade mark in Classes 35 and 41 of the register -



Mark claim / limit:

The mark is limited to the colours red and white.

for the following specifications of services:

Class 35

Advertising, distribution of handbills and of samples, renting of advertising material; business aid to industrial or commercial enterprises in the management of their affairs, business advice and information; book-keeping; reproduction of documents; employment offices; renting of typewriters and office material.

Class 41

Professional education and educational establishments relating to professional education and temporary work; publishing of books and magazines; book lending; training of animals; radio television entertainment, film production; agencies for artists; renting of films, of gramophone recordings, of apparatus for cinema projection and accessories, of theatre scenery; organisation of education or of entertainment contests.

2. The application was accepted by the Registrar and published in the Trade Marks Journal. On 18 January 1999 Chancery Trade Marks, on behalf of The Synergy Group Limited, filed a Notice of Opposition against the application on the grounds of Section 3(6) of the Act. The opponent alleged that the application was made in bad faith because the mark applied for "is not being used nor is there or has there been at any material time a bona fide intention that it should be used (or, more particularly used as a service mark) in relation to all or any of the specified services".

3. The applicant, through their agents Trade Mark Owners Association Limited, filed a Counterstatement denying the ground of opposition, stating that the mark had been used in France, Spain and the Czech Republic and confirming that they have a bona fide intention to use the mark. The applicant contended that the opposition had been entered into because their application stands as an obstacle to a later filed application of the opponent.

4. Both sides have filed evidence and have asked for an award of costs in their favour. Neither side requested a hearing and were content for a decision to be taken on the basis of the written evidence and submissions forwarded to the Registrar.

Opponent's Evidence

5. This consists of a statutory declaration by Anthony Moss dated 20 June 2000. Mr Moss is the Chairman of The Synergy Group Limited (the opponent). He has held his position since 1997 and has been associated with the recruitment industry for thirty five years.

6. Mr Moss explains that the reason behind the opposition is that his company wish to register their own mark, but the applicant's have refused consent. He adds that the application in suit is acting as an obstacle to the registration of his company's mark "because of the wide specification of services which shows in Classes 35 and 41".

7. Mr Moss draws attention to the applicant's Counterstatement which he says, clearly states that no use has taken place in the UK of the mark applied for and provides no proof that the applicant has a bona fide intention to use the mark subsequent to the filing of their application. He adds that "no use of the subject mark was made prior to the filing, nor has any use been made from the date of filing up to and including the present date which is now nearly four years". To confirm the position on use of the mark in suit, Mr Moss asked Chancery Trade Marks (the opponent's professional advisors in this case) to instigate an "in use" search with an investigation company specialising in trade mark research. Their report, dated 4 January 2000, is attached as Exhibit AM3 to Mr Moss' declaration and shows that no use of the mark applied for in the UK could be found. Mr Moss adds that the report contains website pages and their contents and the contents of subsequent website searches, make it clear that UK

customers are not being targeted under the mark as the site was initially in French and later, at 26 January 1999, the SIDERGIE pages had disappeared.

Applicant's Evidence

8. This consists of two witness statements, one each by Daniel Augereau and Jennifer Lebby, dated 14 December 2001 and 6 November 2001.

9. Mr Augereau is the Chairman of Synergie (the applicant company) and has occupied this position since 1969.

10. Mr Augereau states that his company has been using their SYNERGIE trade mark in France for more than thirty years and that his business is expanding throughout Europe. He adds that the SYNERGIE trade mark is currently also used in Spain, Italy, the Czech Republic and Slovakia, as well as Canada. He refers to Exhibit "DA1" to his statement which comprises a print out from his company's website (www.synergie.fr...) dated 21 August 2001, which provides addresses of his company's offices in the above mentioned countries. Next, Mr Augereau draws attention to Exhibit "DA1 2" which consists of copies of his company's Annual Reports for 1997 and 1998, as well as various commercial brochures relating to overseas activities.

11. Mr Augereau confirms that at the date of filing the application the applicant had the bona fide intention to use the trade mark and he anticipates that use of the mark SYNERGIE will commence in the UK in the near future. Exhibit "DA3" to Mr Augereau's statement comprises a 1999 leaflet and 2000 brochure, in English, which relate to the applicant's activities in Human Resources Management. The sections entitled "Strategy/Outlook" and "More Growth Ahead" state that Synergie intends to expand into the UK.

12. Mr Augereau goes on to state that his company has already taken steps to set up a company operating under the name SYNERGIE in the UK and has been in contact, since 1999, with FRES the Temporary Employment Trade Federation in the United Kingdom. He adds that his company has also corresponded with several UK companies with a view to purchasing them.

13. Finally, Mr Augereau draws attention at Exhibit "DA5" to his statement to a previous unsuccessful opposition (No 48841) brought by the opponent under Section 3(6) against the applicant's mark SYNERGIE TRAVAL TEMPORAIRE. However, that opposition was decided on its own merits and I must decide the opposition in suit on its own facts and in light of the evidence and submissions which directly relate to the current opposition.

14. Jennifer Lebby is a trainee trade mark attorney at Trade Mark Owners Association Limited, the applicant's professional advisors in this opposition.

15. Ms Lebby points out that under UK law it is not prerequisite to have used a trade mark prior to filing an application to register it, provided there is a bona fide intention to use it.

16. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

17. Section 3(6) reads:

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

18. In the current opposition Section 32 of the Act, which deals with basic application requirements is relevant. Sub section (3) reads:

"The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used."

19. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J considered the meaning of "bad faith" in Section 3(6) of the Act and stated (at page 379):

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes 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. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

20. In a recent unreported decision of the Appointed Person; in the matter of Application No 2031741 by Eicher Limited - Royal Enfield Motor Units to register a mark in Class 12 and in the matter of Opposition thereto under No 45356 by David Matthew Scott Holder T/A Velocette Motorcycle Company and in the matter of Application No 9188 by David Matthew Scott Holder T/A Velocette Motorcycle Company for a declaration of invalidity in respect of Trade Mark No 15614064 in the name of Eicher Limited - Royal Enfield Motor Units, paragraph 31, Simon Thorley QC in relation to Section 3(6) stated that:-

*"An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning M.R. in *Associated Leisure v Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch. D. 473 at 489). In my judgment precisely the same considerations apply to an allegation of lack of bad faith made under Section 3(6). It should not be made unless it is distinctly proved and this will rarely be possible by a process of inference."*

21. I have little doubt that applying for a trade mark without the intention to use the mark on all the goods specified amounts to bad faith, especially given that the application form for the

registration of a trade mark requires a signature by or on behalf of the applicant agreeing that:

"The trade mark is being used by the applicant or with his or her consent, in relation to the goods or services stated, or there is a bona fide intention that it will be so used."

22. I am fortified in this view by the following comment on Section 3(6) from the publication 'Notes on the Trade Marks Act 1994' (which was prepared for the use of Parliament during the passage of the Bill) that bad faith might be found "where the applicant has no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application." Furthermore, in the case of the Demon Ale Trade Mark Application [2000] RPC 345, the Appointed Person, Mr Geoffrey Hobbs QC, held that where the applicant was a person who could not truthfully claim to have a bona fide intention to use the mark applied for as a trade mark for beer, the fact that his application included a claim to that effect was sufficient to justify its rejection under Section 3(6).

23. While it is clear that bad faith can arise where there is no actual dishonesty, bad faith is nevertheless a serious allegation and there is a clear onus on the opponent to satisfy the Registrar that the ground of opposition is made out. Furthermore, an objection under Section 3(6) is a difficult one to substantiate. It is difficult for the opponent to prove a negative; that the applicant did not have an intention to use.

24. It is clear from the Act that there is no requirement for a mark to have been used prior to application and it is sufficient that an applicant has a bona fide intention to use the mark. The applicant for the mark in suit makes no claim to have used the mark in the UK prior to the date of application. However, the applicant rebuts the allegation that the mark was applied for in bad faith; states that there was and is an intention to use the mark in the UK; and has filed evidence to demonstrate that it is active outside the UK and intends to expand its operations into the UK. I would only add that it is not uncommon for an applicant to seek registration of a trade mark before finalising and implementing trading plans. The opponent's evidence does not demonstrate the claim that the applicant has no intention to trade in the UK.

25. While I acknowledge the difficulties faced by the opponent in attempting to prove a negative, the opponent's evidence cannot assist its claim in the face of the rebuttal and explanations of the applicant. As stated earlier, the onus rests with the opponent and on the evidence before me the opponent has not shown and I feel unable to infer that, the application was made in bad faith in respect of all or some of the services for which registration is sought. Certainly, on a prima facie basis and after taking into account the evidence filed, the specifications of services applied for do not appear to me to be unduly wide or unrealistic in their scope or potential application. The opposition fails.

26. The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay them the sum of £450. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31 day of July 2002

**J MacGILLIVRAY
For the Registrar
the Comptroller-General**