

O-038-19

TRADE MARKS ACT 1994

IN THE MATTER OF UK APPLICATION NO. 3233611
IN THE NAME OF TAG PROFESSIONAL LTD
FOR THE TRADE MARK



IN CLASSES 16, 35 AND 41

AND

OPPOSITION THERETO UNDER NO. 410574
BY TAG MANAGEMENT CONSULTANCY SERVICES LIMITED

Background and pleadings

1. On 26 May 2017, TAG Professional Ltd (“the applicant”) filed trade mark application number UK00003233611 for the mark detailed on the cover page of this decision, for the following goods and services:

Class 16: *Books for children*

Class 35: *Consultancy relating to business management and organisation*

Class 41: *Consultation services relating to the publication of books*

2. The application was accepted and published for opposition purposes on 21 July 2017. Tag Management Consultancy Services Limited (“the opponent”) opposes the application under section 5(4)(a) of the Trade Marks Act 1994 (“the Act”), relying upon the earlier unregistered mark ‘TAG PROFESSIONAL’, which the opponent states has been used throughout the UK since 25 June 2007 for the following services:

Class 35: *Business consultancy and advisory services relating to accountancy, bookkeeping and auditing; arranging business introductions; the bringing together, for the benefit of others, of a variety of business advisory services, enabling consumers to conveniently compare and purchase those services; the bringing together, for the benefit of others, of a variety of insurance and financial services, enabling consumers to conveniently compare and purchase those services; the bringing together, for the benefit of others, of a variety of legal services enabling consumers to conveniently compare and purchase those services.*

Class 36: *Insurance; financial affairs; monetary affairs; real estate affairs; mortgage broking; consultancy services relating to insurance; real estate consultancy services; estate trust planning; financial information, data, advice and consultancy services; administration of financial affairs; pensions consultancy; tax planning; consulting services in relation to corporate finance; providing information and assistance in the field of financial planning.*

3. The opponent claims that use of the applicant's mark would amount to passing off for Class 35: *Consultancy relating to business management and organisation* in the applicant's specification. The opponent's reasoning for this is as follows:

"The opponent has used the mark TAG PROFESSIONAL extensively and continuously since 2008 in relation to the aforementioned services. Over this time, it has developed significant goodwill and reputation under the brand. The opponent can submit proof of this use and reputation.

It is submitted that use of the same mark TAG PROFESSIONAL for related services in Class 35 will create the impression that the respective parties are commercially connected and may give rise to confusion. Use of the mark will allow the applicant to take advantage of the good name and reputation that the Opponent has spent time and resources developing.

The trade mark applied for is identical to the trade mark the opponents have used and in which they claim a reputation. Registration and use of the trade mark applied for in Class 35 would therefore be contrary to Section 5(4) of the Trade Marks Act 1994."

4. The applicant denies the grounds set out by the opponent and, in its counterstatement, submitted the following:

"I disagree with all statements and I require proof of any grounds set out by the other party."

5. Both the opponent and the applicant filed evidence. The applicant also filed written submissions with its evidence. Neither party requested a hearing. The opponent then filed written submissions in lieu of a hearing.

6. The applicant is represented by MW Trade Marks. The opponent is represented by Kelly-Ann Franz.

Evidence summary

The opponent's evidence

7. The opponent's evidence takes the form of a witness statement and two exhibits from Terry Field, Director of the opponent.

Witness statement

8. Mr Field's witness statement is dated 23 April 2018, in which he gives the following evidence:

- Tag Management Consultancy Services Limited ("the company") was incorporated on 25 June 2007. The company was incorporated as Attivo Partnership Limited but changed its name, first to Property Animal Limited and later to Tag Management Consultancy Services Limited;
- The company has traded as Tag Professional since 2006, but extensively and continuously since 2008;
- The company project manages the financial and property planning matters and other core objectives and goals of its clients;
- Areas of planning may include residential and commercial mortgages, estate planning, insurance matters, conveyancing, investments, pensions, tax planning, accounting services and legal matters;
- The company enlists specialist advice firms to carry out each individual area of planning separately;
- The company has gathered momentum and has developed significant goodwill and reputation in the name TAG PROFESSIONAL and TAG;
- The company has clients throughout the UK and has over 2000 individuals and firms who work with the company to provide the aforementioned advisory services;
- The company has incurred substantial expenditure in promoting its services under the TAG PROFESSIONAL brand;

- As a result of the company's extensive use of the marks TAG PROFESSIONAL and TAG, it has acquired a substantial reputation in the UK in its business, such that members of the public associate the brands TAG and TAG PROFESSIONAL with the company and its services.

Exhibits

9. Exhibit TF1 is described by Mr Field as evidence of the mark in use since 2009. The exhibit contains three separate pieces of evidence: a series of emails between employees of the company and a printing company (pages 4-7); an example of a 'TAG PROFESSIONAL' member agreement (pages 8-21); and an example of a 'TAG PROFESSIONAL' member application form (pages 22-25).

10. The email thread seemingly includes an email from a printing company attaching a 'Business card proof'. The email is forwarded from Jenny Hayward at the company to Mr Field requesting permission to proceed (I assume with the business cards). These emails are dated 20 March 2010. There is a further email from Mr Field to a David Milham dated 22 March 2010. The subject of the email reads:

“David, I need to have a chat with you, could we agree a time to talk on the phone ref the advertising email and the Client [REDACTED]”

11. It is not clear what this email relates to or who David Milham is, as there is no explanation in Mr Field's witness statement. The words TAG PROFESSIONAL are visible in the signature of these emails and on the business card proof.

12. The member agreement is dated 5 February 2009 and contains clauses relating to, inter alia, members' obligations, TAG Professional's obligations, termination of the agreement and contractual provisions. There is also a schedule (schedule 1) to the agreement containing an explanation of definitions and interpretation. All information relating to the member this agreement relates to has been redacted.

13. The member application form forms schedule 2 of the member agreement. The form is split into section A ('Firm and Personnel Detail'), section B

(‘Company/Personnel Background’) and section C (‘Declarations and Authorisation’). The form has been partially completed but all details of the member have been redacted, save for the title ‘Mr’, one address line of Buckinghamshire and a job title of ‘BDM’. The words TAG Professional are evident throughout the member agreement and the two schedules.

14. Exhibit TF2 is described by Mr Field, in his witness statement, as a collection of advertisements bearing the company’s name, TAG PROFESSIONAL. The exhibit consists of five pages containing undated marketing material (pages 1-2), an undated letter from a printing company to someone named Sabastian (page 3), and one invoice dated 27 September 2011 (pages 4-5).

15. The marketing material appears to me to be some sort of factsheet, leaflet or poster, advertising the services of Tag Professional, although its content does not fit fully on the page so there are sections I cannot read in full.

16. The letter at page 3 has no address or date contained within it but is addressed to ‘Sabastian’ and signed from Danny Clements, Director of Roff Media Ltd t/a printing.com. The letter refers to 5000 leaflets that were produced on 30 September 2011 and confirms that a corresponding invoice will be sent separately. The letter does not mention Tag Professional.

17. The invoice is addressed to Jenny Hayward at TAG Professional and delivered from Danny Clements at printing.com. It details the job description as 5000 silk folded A5 leaflets at a cost of £527.00. A full version of the leaflet is shown within the invoice at page 5 but the writing is far too small to be legible.

18. This concludes my summary of the opponent’s evidence insofar as I consider it relevant.

The applicant’s evidence

19. The applicant’s evidence consists of a witness statement and one exhibit from Anne Wong, Trade Mark Attorney of MW Trade Marks, representing the applicant. A

set of written submissions were also provided in response to the opponent's notice of opposition and evidence.

20. Ms Wong's witness statement is dated 24 July 2018 and simply confirms her position and describes the attached exhibit as confirmation of the opponent company's change of name.

21. Exhibit AW1 contains printouts from Companies House confirming that PROPERTY ANIMAL LTD changed its name to TAG MANAGEMENT CONSULTANCY SERVICES LTD on 19 October 2015.

22. This concludes my summary of the applicant's evidence, insofar as I consider it relevant. It is not necessary to separately summarise the written submissions, however, I take them into account (and those filed by the opponent in lieu of a hearing) and will refer to them, where necessary, throughout this decision.

Decision

Section 5(4)(a)

23. Section 5(4)(a) of the Act states:

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

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

(b) [...]

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

24. In *Discount Outlet v Feel Good UK*¹, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

25. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*², Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM* O-212-06 Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceeding 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,

¹ [2017] EWHC 1400 EPEC

² BL O-410-11

and then to assess whether the position would have been any different at the later date when the application was made.”

26. The opponent needs to show in its evidence that it had goodwill at the relevant date which, in this case, is 26 May 2017. There is no evidence that the contested mark was in use prior to the date of application, so there is no need to consider the position at any earlier date.

Goodwill

27. The sign that the opponent claims would be associated with its goodwill and therefore protected under the law of passing off is “TAG PROFESSIONAL”. First, I must consider whether there is protectable goodwill.

28. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*³ provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

29. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)*⁴, Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends

³ [1901] AC 217 (HOL)

⁴ [2002] RPC 19 (HC)

to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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

30. However, in *Minimax GmbH & Co KG v Chubb Fire Limited*⁵, Floyd J. (as he then was) stated that:

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

31. In *Hart v Relentless Records*⁶, Jacob J. (as he then was) states that:

⁵ [2008] EWHC 1960 (Pat)

⁶ [2002] EWHC 1984 (Ch)

“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 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 has 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”.

32. Goodwill arises as a result of trading activities. The opponent’s claim to goodwill is supported by evidence of: (i) preparations for business cards; (ii) marketing material; and (iii) one example of a member agreement. There is no evidence of any actual trade. Further, all the evidence is dated prior to 2011 (6 years prior to the relevant date).

33. The opponent’s written submissions in lieu of a hearing state:

“3. The Opponent’s clients and associate firms are situated throughout the UK and the business has developed to such an extent that they have acquired significant goodwill and reputation in relation to all of the services claimed in their trade mark registration.

4. They have not been able to provide extensive evidence showing this goodwill but they have shown that their use of the mark dates back to at least 2009.”

34. By their own admission, the opponent’s evidence is not extensive. I think this is quite clear. In fact, the opponent’s evidence is poor.

35. I note that Daniel Alexander QC in *Advanced Perimeter Systems Limited v Multisys Computers Limited*⁷ stated:

“19. *Pan World and NODOZ* were applications for revocation for non-use. The approach to use is not the same as in a s.5(4)(a) case. As Floyd J said in *Minimax*, it is possible for a party to have made no real use of a mark for a period of five years but to retain goodwill sufficient to support a passing off action. Conversely, use sufficient to prevent revocation for non-use may be insufficient to found a case of passing off.

20. However, the approach to evaluation of evidence of use is similar: the less extensive the evidence of use relied on, the more solid it must be. The Registrar is not obliged to accept – and in some circumstances may be obliged to reject – a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out.

21. That point was also made by Laddie J in *DIXY FRIED CHICKEN TM* [2003] EWHC 2902 (Ch) and, more recently, in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32, Geoffrey Hobbs QC, Appointed Person, said at [38]:

“...it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish.”

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield’s aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *CLUB SAIL*:

⁷ BL O-410-11

“...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”

36. Mr Field’s witness statement states that the opponent has clients throughout the UK and has over 2000 individuals and firms who work with them to provide their services. However, the opponent has not provided any copies of invoices of sales, evidence of its clients, or information relating to turnover figures. Despite the opponent’s acceptance that its evidence is not extensive, it has not explained why it could not have provided better evidence. One would imagine that it would be a relatively simple task to provide this type of documentary evidence. It is the responsibility of the parties before the Tribunal to provide the evidence upon which they wish to rely. The evidence relied upon by the opponent builds a picture that is too incomplete to find that it had protectable goodwill at the relevant date. The opposition under section 5(4)(a) fails at the first hurdle. In these circumstances, I am not required to consider misrepresentation or damage.

Conclusion

37. The opposition fails. The applicant’s mark may proceed to registration.

Costs

38. The opponent, in its written submissions, submitted the following:

“It is hoped that a decision issues in the Opponents favour but if it should not, we feel that the parties should bear their own costs in the proceedings. The Applicant benefited [from] extended time periods on several occasions yet when the Opponent requested further time to file evidence, this request was not granted. The Applicant also failed to copy the Opponent in to correspondence early on in the proceedings which, again, was prejudicial to the proceedings. These things cannot simply be disregarded.”

39. Requests for extensions of time are considered on their own merits. It is not appropriate to penalise the applicant for being granted extensions of time.

40. As the applicant has been successful, it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide, and bearing in mind my comments above, I award costs to the applicant on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Preparing evidence (and accompanying submissions) and considering and commenting on the other side’s evidence:	£500
Total:	£700

41. I order Tag Management Consultancy Services Limited to pay TAG Professional Ltd the sum of **£700**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of January 2019

Emily Venables
For the Registrar,
The Comptroller-General