

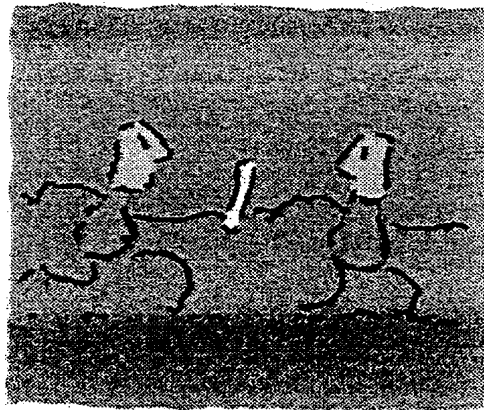
TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2212804
by Friends Provident Life and Pensions Limited to
register a series of two trade marks in classes 16, 35 & 36**

**AND IN THE MATTER OF Opposition thereto under
No 50664 by Co-operative Wholesale Society Limited,
Co-operative Insurance Society Limited and The Co-operative
Bank plc**

Decision

1. An application was made on 28 October 1999 to register in classes 16, 35 and 36 a series of two trade marks. The second mark in the series is shown below. The first mark is the same as this except that it is represented in colour and the applicant claims the colours mauve, blue and beige as an element of the mark.



CO-OPERATE – TO ACHIEVE

2. The application was originally filed in the name of Friends Provident Life Office, but now stands in the name of Friends Provident Life and Pensions Limited.
3. The application is the subject of an opposition filed jointly in the names of Co-operative Wholesale Society Limited, Co-operative Insurance Society Limited and The Co-operative Bank plc.
4. The matter came to be heard on 15 August 2002 when the applicant was represented by Mr M Bilewycz of Markforce Associates, and the opponents were represented by Mr B Marsh of Wilson Gunn M'Caw.
5. For the reasons I gave at the conclusion of the hearing, which are contained in the attached approved transcript, I rejected all the grounds of opposition and determined that the opponents should pay the applicant the sum of £1200 as a contribution towards its costs.

6. I order the opponents to pay the applicant this sum within 7 days of the end of the period allowed for appeal, or in the event of an unsuccessful appeal, within 7 days of the final determination of the matter.

Dated this 05 Day of September 2002

**Allan James
For the Registrar**

1 **The Hearing Officer:** On 28 October 1999, Friends Provident Life Office applied for the
2 registration of a series of two trade marks in Classes 16, 35 and 36. The goods for which
3 registration is sought in Class 16 are: printed matter, publications and periodicals;
4 newspapers; stationery and office requisites; writing instruments; instructional and teaching
5 material; graphic reproductions; signs of paper or cardboard.

6
7 The services for which registrations is sought are in Class 35: accounting; book keeping;
8 business management; business consultancy; provision of business statistical information;
9 advertising and marketing services; rental of office machines and apparatus; and Class 36:
10 insurance and assurance services; investment services; pension services; management of
11 mutual funds; banking; financial services relating to real estate; quotation of stock exchange
12 prices; actuarial services.

13
14 The series of two trade marks consist, in each case, of a device of two human characters
15 exchanging a baton beneath which appears the words “Co-operate to Achieve”. A
16 representation of the respective trade marks will appear in the written decision that follows.
17 One of the marks is limited to the colours in which it appears. The other mark is in black and
18 white. Noting turns on this.

19
20 The trade marks were accepted by the Registrar and published for opposition purposes and,
21 on 3 February 2000, an opposition was filed jointly in the names of Co-operative Wholesale
22 Society Limited, Co-operative Insurance Society Limited and The Co-operative Bank Plc.

23
24 The ground of opposition are, in summary, that the opponents are the proprietors of a number
25 of registered trade marks which are registered in classes, inter alia, 6 and 36 and include or
26 consist of the word ‘co-operative’ and/or ‘co-op’. The opponents contend that the applicant’s
27 marks are to be registered for goods and services which are either identical or similar and that
28 the respective marks are sufficiently similar to give rise to a likelihood of confusion, including
29 the likelihood of association. The opponents say that the registration should therefore be
30 refused under Section 5(2)(b) of the Trade Marks Act 1994.

1 The opponents also say that, where the respective goods or services are or may be found to be
2 dissimilar, the applicant's marks should be refused under Section 5(3) of the Act because use
3 of the applicant's marks would take unfair advantage or be detrimental to the distinctive
4 character or repute of the earlier trade marks. The opponents further say that, as a result of
5 their use of the registered trade marks, they have acquired a reputation and goodwill under
6 those signs and that, as a result, use of the applicant's marks at the date of the application
7 would amount to a passing-off and registration should therefore be refused under Section
8 5(4)(a) of the Act.

9
10 There is a further ground of opposition under Section 3(3)(b) of the Act. The opponents say
11 that, as a result of their use of the trade marks which they have registered, use of the
12 applicant's marks would be liable to cause deception amongst the public.

13
14 The final ground of opposition is under Section 3(4) of the Act. The opponents say that use
15 of the applicant's marks would be contrary to the Business Names Act 1985 which, the
16 opponents contend, states that 'co-operative' and similar words are not allowed without the
17 sanction of the Secretary of State for Trade and Industry.

18
19 The applicant filed a counter-statement accepting that the opponents, or at least two of them,
20 are the proprietors of the various trade marks listed in the grounds of opposition, but
21 otherwise denying or refusing to admit the grounds stated.

22
23 Both sides ask for an award of costs.

24
25 Both parties subsequently filed evidence. The opponents filed a witness statement by Jonathan
26 Peter Mounteney dated 20 October 2000. Mr Mounteney is the senior solicitor in the
27 Solicitors Department of the co-operative Insurance Society Limited. The opponents'
28 evidence also includes two Witness Statements by Bruce Marsh of Wilson Gunn M'Caw who
29 is their UK trade mark attorney. The applicant's evidence consists of a single Statutory
30 Declaration by Joanna Hands, who is a legal adviser with Friends Provident Group which
31 includes Friends Provident Life Office, the applicant.

1 I have had the benefit of oral submissions from Mr Marsh who appeared for the opponents
2 today. I have also had the benefit of a skeleton argument from Mr Bilewycz of Markforce
3 Associates who appeared for the applicant.

4
5 I turn, first, to the ground of opposition under Section 3(4) of the Act. Section 3(4) is as
6 follows:

7
8 “(4) A trade mark shall not be registered if or to the extent that its use is prohibited in
9 the United Kingdom by any enactment or rule of law or by any provision of
10 Community law.”

11
12 The opponents rely primarily upon the evidence of Jonathan Peter Mounteney to support this
13 ground of opposition. Mr Mounteney states:

14
15 “Section 2(1)(b) of the Business Names Act 1985 provides that a person to whom the
16 Act applies shall not, without the Approval of the Secretary of State (for Trade and
17 Industry), carry on business in Great Britain under a name which includes any word or
18 expression for the time being specified in regulations made under the Business Names
19 Act 1985. The relevant regulations made under the Business Names Act 1985 are the
20 Company and Business Name Regulations 1981 (SI 1981/1685) as variously amended,
21 which include the word ‘Co-operative’ as a specified word.”

22
23 Mr Mounteney continues:

24
25 “.... the Business Names Act 1985 applies to the concept of ‘the carrying on of
26 business in Great Britain under a name’, which is obviously much wider than simply
27 the using of words or expressions in company names. ‘Carrying on business under a
28 name’ has reminiscence to ‘offers or supplies under the sign’, the definition of ‘Use’
29 under Section 10(4)(b) of the Trade Marks Act 1994.

30
31 “Since Section 32(3) of the Trade Marks Act 1994 states that an application to register

1 a trade mark shall state that the trade mark is being used by the applicant or with his
2 consent or that there is a *bona fide* intention that it should be so used, then it is
3 reasonable to infer from this application to register the trade mark including the words
4 ‘Co-operate to Achieve’ an intention to carry on a business under that name/trade
5 mark.

6
7 “The word protected by the Business Names Act is ‘Co-operative’; the word
8 specifically objected to within the application is ‘co-operate’. ‘Co-operate’ is ‘Co-
9 operative’ without ‘iv’ ”.

10
11 Mr Mounteney then continues to give definitions for the two words from Chambers Student’s
12 Dictionary which show that ‘co-operative’ is an adjective meaning “working together towards
13 some common end”, whereas ‘co-operate’ is shown as an intransigent verb meaning “to work
14 together to some common end”.

15
16 Mr Mounteney concludes:

17
18 “Since the public seem unlikely to distinguish between the different words within the
19 semantic group, then even though it is only the adjectival form which is protected
20 under the Business Names Act, to hold that the verbal and noun forms are unprotected
21 would appear contrary to the purpose of the legislation.”

22
23 The applicant contends that the Business Names Act does not apply to trade marks unless
24 those marks are being used as a business name and, secondly, that it does not extend to the
25 use of the verb “co-operate”.

26
27 I have not been provided with a copy of the Business Names Act. I cannot, therefore, be sure
28 what is meant by the term “a person to whom the Act applies”, which apparently appears in
29 Section 2(1)(b) of that Act. Further, it seems to me that it would be surprising if the Business
30 Names Act had any wider scope than the use of words in business names.

1 I am not persuaded by the submissions I have heard that the Act extends to the use of a name
2 as a trade mark other than as the use of that trade mark as a business name. In any event, I do
3 not believe that the regulations in question extend the restriction that applies to ‘co-operative’
4 to the word ‘co-operate’. There is nothing in the regulations to suggest that similar names are
5 caught by the restriction. Furthermore, ‘co-operative’ in the sense relevant to the legislation is
6 defined in Collins English Dictionary (Second Edition) entry No. 4 as being “a co-operative
7 organisation”. It seems to me unlikely that consumers would take the verb ‘co-operate’ as it
8 appears in the slogan ‘Co-operate to Achieve’ as a relevant reference to the word ‘co-
9 operative’ in the sense in which it appears in the regulations.

10
11 The ground of opposition in Section 3(4) of the Act is therefore rejected.

12
13 I turn, next, to the ground of opposition under Section 3(3)(b) of the Act. The section states
14 that:

15
16 “A trade mark shall not be registered if it is:

17
18 (b) of such a nature as to deceive the public (for instance, as to the nature,
19 quality or geographical origin of the goods or services).”

20
21 It is evident from the wording of the statute that the objection must arise from the nature of
22 the mark itself. The opponents’ objections, by contrast, appear to arise as a result of their use
23 of what they regard as conflicting trade marks. As the objection has been pleaded, I consider
24 it covers the relative grounds of objection specified elsewhere in the grounds of opposition. It
25 does not add anything to those other grounds and I do not, therefore, need to consider it any
26 further.

27
28 I turn, therefore, to the ground of opposition under Section 5(2)(b) of the Act. Section
29 5(2)(b) is as follows:

30
31 “(2) A trade mark shall not be registered if because -

1 (b) it is similar to an earlier trade mark and is to be registered for goods or
2 services identical with or similar to those for which the earlier trade
3 mark is protected,
4

5 there exists a likelihood of confusion on the part of the public, which includes the
6 likelihood of association with the earlier trade mark.”
7

8 The opponents rely upon 21 earlier trade marks consisting of or containing the words ‘co-
9 operative’ or, a shortened form, ‘co-op’. I detected a hint in the submissions that I have heard
10 that the opponents were relying upon what is sometimes known as a family of marks.
11

12 This point has recently been considered by Mr Geoffrey Hobbs QC, as the Appointed Person
13 in the case of *Miguel Torres SA v. Vina Torreblanca SL* BL/0/207/02. Paragraphs 21 to 25 of
14 Mr Hobbs’ decision are as follows:
15

16 “21. When (as contemplated by Section 5(2)(b) of the Act) the marks in issue are not
17 identical, they need to be distinctively similar in order to be capable of inducing such a
18 belief in the mind of the average consumer of the goods concerned.
19

20 “22. At this point it is necessary to observe that marks which converge upon a
21 particular mode or element of expression may or may not be found upon due
22 consideration to be distinctively similar. The position varies according to the
23 propensity of the particular mode or element of expression to be perceived, in the
24 context of the marks as a whole, or origin specific (see, for example, *Wagamama Ltd*
25 *v. City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example,
26 *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283).
27

28 “23. The relevant propensity may, on established principles, be inherent or acquired
29 through use. This leaves room for evidence demonstrating that the mode or element of
30 expression in question has an established significance which the average consumer
31 would take to have been carried through to the marks in issue.

1 “24. The view that the established significance is origin specific may be supported by
2 evidence directed to the way in which the mode or element of expression has been
3 used as the basis for a ‘family’ of distinctively similar marks: *Duonebs Trade Mark 2*
4 January 2001 SRIS 0/048/01 (Mr Simon Thorley QC); *The Infamous Nut Company*
5 *Ltd’s* Application 17 September 2001 SRIS 0/411/01 (Professor Ruth Annand);
6 *Lifeforce International Inc’s* Application; *Opposition of Novartis Nutrition AG*
7 [2001] ETMR 106, P. 1227 (Opposition Division, OHIM).

8
9 The view that the established significance is origin neutral may be supported by
10 evidence directed to the way in which the mode or element of expression has been
11 used by traders and consumers more generally.

12
13 “25 In neither case can the proposition in contention be substantiated simply by
14 evidence of entries in the register of trade marks: entries in the register do not in
15 themselves affect the way in which marks are perceived and remembered.”

16
17 It appears to me, from what Mr Hobbs has said, that the opponents are no better off simply
18 having 21 registrations of marks including the word ‘co-operative’ than they would be with a
19 single such registration.

20
21 In assessing the distinctive character of the earlier trade marks, I note that the word ‘co-
22 operative’ is a word which has the meaning I have already described, ie. a type of
23 organisation. It does not, therefore, appear to be a word which has a high degree of
24 distinctive character as a trade mark. I therefore need to look at the evidence the opponents
25 have filed to see whether their use of the marks has been shown to be such that the word ‘co-
26 operative’ is now exclusively connected with the opponents in the mind of consumers of the
27 goods and services in question.

28
29 Mr Marsh’s second Witness Statement is a short statement covering copies of seven Statutory
30 Declarations completed by officers of the opponents’ companies in support of other earlier
31 trade mark applications. These declarations are attached to Mr Marsh’s statement by way of

1 annexes. The first four are unsworn and undated. Mr Marsh says in his statement that the
2 opponents have confirmed that the facts recited therein are correct. However, he does not
3 give any specific indication as to the source of this statement.

4
5 Evidence filed in other proceedings can, of course, be adopted in subsequent proceedings.
6 The correct procedure for doing this is for the party concerned to file a Witness Statement or
7 declaration adopting the earlier evidence into the later proceedings. It is evident, from what I
8 have already said, that this procedure was not followed on this occasion. The result of this,
9 particularly in relation to the four unsworn declarations exhibited to Mr Marsh's Witness
10 Statement, is that it is impossible to say who the witness is that is providing the evidence
11 stated. In these circumstances, I can give no weight to this evidence.

12
13 The remaining three declarations annexed to Mr Marsh's second Witness Statement are dated
14 in 1994 and 1995. As I have already indicated, they were completed in support of applications
15 by the Co-operative Wholesale Society Limited to register the Co-op logo in various classes.
16 Only one of these classes covers a class which is listed in the application under opposition and
17 even in respect of that class, which is Class 16, the respective goods are different.

18
19 Further, as these applications were to register the Co-op logo rather than a mark incorporating
20 or consisting of the word 'co-operative', I think that the weight that might have been attached
21 to this evidence would, in any case, have been very slight indeed.

22
23 I conclude that there is no evidence here that any of the opponents' marks, including the word
24 'co-operative', have acquired a highly distinctive character than might have justified an usually
25 extensive scope of protection.

26
27 Mr Marsh's first Witness Statement introduces a copy of the Annual Report and Accounts of
28 the Co-operative Wholesale Society for the year 1999.

29
30 I have been through these documents and they show that all three of the opponents are multi-
31 million pound businesses with the corporate names stated in the notice of opposition. I do not

1 believe that this evidence shows any more than that.

2
3 There is further evidence from Mr Mounteney which goes to the reputation which the
4 opponents claim to have in their earlier trade marks. It is particularly relevant to earlier trade
5 mark No. 1279142 which consists of the words 'Co-operative Insurance' and is registered in
6 Class 36.

7
8 Paragraph 8 of Mr Mounteney's declaration is as follows:

9
10 "Although the Society's principal trading style is the acronym of its name, 'CIS', that
11 acronym is generally used in combination with the word 'Co-operative', ie. in the
12 phrase "Co-operative Insurance".

13
14 This may suggest that the principal trading style of one of the opponents is, in fact, CIS rather
15 than "Co-operative Insurance". Even though Mr Mounteney asserts that this term is used
16 alongside the word 'Co-operative', he further states, in relation to the Section 3(4) ground of
17 opposition that:

18
19 "Due to the large amount of advertising of the Co-op trading style of the opponents
20 and other co-operatives which has occurred over many years, in fact, the public seem
21 to associate any word with the common root 'co-op' with those using that style."

22
23 This suggests that the word 'co-operative' is still associated with co-operatives generally
24 rather than specifically with the opponents.

25
26 I conclude that the opponents' evidence does not establish that any of their earlier trade marks
27 are entitled to a greater scope of protection under Section 5(2) than they would otherwise be
28 entitled to at face value assuming normal and fair use of the marks, in which case, in practice,
29 it is only necessary for me to consider the grounds of opposition based upon earlier trade
30 marks 1279142 and 1286604.

1 I have already mentioned that 1279142 consists of the words ‘Co-operative Insurance’ and
2 that it is registered in Class 36. It includes a range of financial services including insurance
3 services. The other registration, 1286604, consists of the words ‘The Co-operative Bank’. It
4 is also registered in Class 36 in relation to another wide range of financial services including,
5 inter alia, banking. These are identical or closely similar services to those for which the
6 applicant seeks registration.

7
8 In relation to these marks I note that ‘co-operative’ is the only part of the trade mark which
9 could possibly have any distinguishing effect. I also note that a lesser degree of similarity
10 between trade marks may be necessary to give rise to a likelihood of confusion where the
11 respective services are identical than would be the case where they are only similar.

12
13 I intend to consider these marks first. If the opponents cannot succeed on the basis of these
14 marks, they will be no better off with any of the other marks that they have relied upon. I take
15 note of the guidance from the European Court of Justice in the cases of *Sabel BV v. Puma AG*
16 [1998] RPC 199; *Lloyd Schufabrik Meyer & Co v. Klijsen Handel BV* [2000] FSR 77 and
17 *Marca Mode CV v. Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

18
19 It is common ground that I must consider the matter judged through the eyes of the average
20 consumer of the goods or services in question who is deemed to be reasonably well informed
21 and reasonably circumspect and observant. However, the average consumer rarely has the
22 chance to make direct comparisons between marks and must, instead, rely upon the imperfect
23 picture of them he has in his mind.

24
25 Furthermore, I must bear in mind that the average consumer normally perceives trade marks as
26 a whole and does not proceed to analyse their various details. I must, therefore, look at the
27 visual, aural and conceptual similarities of the marks and assess the likelihood of confusion by
28 reference to the overall impressions created by those marks, bearing in mind the distinctive and
29 dominant components. I must also bear in mind that mere association, in the sense that the
30 later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section
31 5(2)(b).

1 Looking, first, at the earlier trade mark ‘Co-operative Insurance’ and considering the visual
2 similarity of that mark to the applicant’s marks, I note that the applicant’s marks consist of a
3 significant device element comprising two highly stylised human characters passing a baton
4 underneath which appears the words ‘Co-operate to Achieve’. The two elements within the
5 trade mark combine to present a consistent message.

6
7 The opponents’ mark, by contrast, consists, simply, of the two words ‘Co-operative
8 Insurance’. There is no device element; the similarity is limited to the resemblance between
9 the word ‘Co-operative’ and the word ‘Co-operate’ which appears in the applicant’s marks.

10
11 Turning to aural similarity, I find that the degree of resemblance is somewhat similar to that
12 which I have already described, although it may be said that there is a lesser degree of
13 distinction because the device element within the applicant’s trade marks is not liable to find
14 aural expression.

15
16 Turning, then, to the conceptual similarities between the marks, the opponents’ case is that
17 there is a strong conceptual similarity. They contend that the device and words in the
18 applicant’s marks combine to create an impression of co-operation which is one of the
19 fundamental principles on which co-operatives are based. However, although the word ‘co-
20 operative’ is undoubtedly derived from the word ‘co-operate’, in my view, it has a different
21 meaning as it appears within these respective trade marks. The word ‘co-operate’ as it
22 appears within the phrase “Co-operate to Achieve” is a verb. “Co-operative Insurance”, by
23 contrast, is a reference to the type of undertaking responsible for providing insurance.

24
25 The case of *The European v. European Voice* [1999] FSR 283, provides an example of a case
26 where the same descriptive word in two marks, appearing in one case as a noun and in the
27 other as a verb, was insufficient to present a likelihood of confusion between the trade marks.
28 In this case the words ‘co-operative’ and ‘co-operate’ are not even the same word but merely
29 words with a common derivation.

30
31 I conclude that there is little similarity between the respective trade marks and I have come to

1 the clear view that there is no likelihood of confusion even in respect of identical services. At
2 the very most, there may be a semantic association made between the two respective marks,
3 although I regard even that as unlikely. If that is the case where the respective services are
4 identical, it follows that it must be equally so where the respective goods and services are
5 merely similar or even further apart.

6
7 The objection based upon the earlier trade mark 1279140 therefore fails.

8
9 Mr Marsh placed some weight on the registration for ‘The Co-operative Bank’. I do not
10 consider that this presents the opponents with any better case than the mark I have already
11 considered. The arguments are much the same and, for the same reasons, I find that that
12 objection also fails. It follows, from what I have already said, that the objections based upon
13 all the other earlier trade marks similarly fail.

14
15 Turning, next, to the Section 5(3) ground, I have not heard any specific submissions from Mr
16 Marsh in relation to this ground. He accepted that if his case under Section 5(2)(b) failed, this
17 ground would also fail. As that is the way it has transpired, I need say no more about this
18 ground of opposition.

19
20 That brings me to the Section 5(4)(a) ground. Again, I have heard no specific submissions
21 under Section 5(4)(a). Mr Marsh did, briefly, refer to the fact that the opponents have made
22 concurrent use of marks including of the words ‘co-operative’ and ‘co-op’ and he suggested
23 that the result of that concurrent use may be to increase the likelihood of confusion arising
24 from a third party using a trade mark including the word ‘co-operate’. That is an argument
25 that could have been run under Section 5(4)(a). However, I do not consider that the evidence
26 filed in this case goes anywhere near to supporting that argument. The Section 5(4)(a) ground
27 therefore fails because, inter alia, use of the applicant’s marks would not, in my view, to a
28 misrepresentation.

29
30 Those are my reasons for rejecting the opposition. Is there anything you wish to say to me on
31 the question of costs?

1 **Mr Bilewycz:** No, Sir, except I think there was an Interlocutory Hearing for which costs
2 need to be taken into account.

3
4 **The Hearing Officer:** Yes. I have looked at the record of that Hearing and it appears to
5 have been a score draw.

6
7 **Mr Bilewycz:** Yes. I suppose we cancel each other out in that respect.

8
9 **The Hearing Officer:** Yes. Is there anything else?

10
11 **Mr Bilewycz:** No, Sir.

12
13 **The Hearing Officer:** I believe this opposition started before the revised scale of costs came
14 into operation so the costs will be awarded on the previous scale. On the basis of that scale, I
15 propose to order the opponents to pay the applicant the sum of £1,200. Is there anything
16 else?

17
18 **Mr Bilewycz:** No, thank you, Sir.

19
20 **The Hearing Officer:** Thank you very much for your assistance.

21
22