

O-132-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2375932
BY
GRAHAM STUART MARSHALL AND AMANDA HOWELL**

TO REGISTER THE TRADE MARK:

SURETIME

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 93281
BY
TIMEGUARD LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF Application No 2375932
by Graham Stuart Marshall & Amanda Howell
to register the trade mark SURETIME
in Class 9**

**and of Opposition thereto
under no 93281 by
Timeguard Limited**

BACKGROUND

1. On 16 October 2004, Graham Stuart Marshall & Amanda Howell of Home Port, Riverside, Gunthorpe, Nottingham, NG14 7FB, whom I will refer to as Marshall, applied to register the trade mark SURETIME, ('the sign'). The application was published for opposition purposes in the Trade Marks Journal on 17 December 2004 with the following specification:

Electronic time switches; light switches and controls; apparatus for remotely controlling electrical appliances.

The above goods are in class 9 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. On 17 March 2005, Timeguard Limited of Victory Park, 400 Edgware Road, London, NW2 6ND, whom I will refer to as Timeguard, filed notice of opposition. In the attached statement of grounds, Timeguard stated that they have used the unregistered trade mark SURETIME (the trade mark) since October 1999 in relation to the following products and their related packaging and promotional literature:

Electrical switches, electrical power sockets, residual current detector circuit breakers, time switches, time controllers, electrical surge protectors, parts and fittings for all the aforesaid goods.

3. Timeguard is opposing the application from Marshall on the basis of Section 5(4)(a) of the Trade Marks Act 1994 as amended, hereafter referred to as the Act. They seek refusal of the application and an award of costs.

4. Marshall filed a counterstatement on 30 June 2005 which denied the grounds of opposition under 5(4)(a) and sought registration and an award of costs. Marshall put Timeguard to strict proof in relation to the goodwill they had acquired in the unregistered trade mark SURETIME. Marshall claimed that they had been using the unregistered trade mark SURETIME since 1995 in relation to electronic time switches. This use predated the use claimed by the opponent Timeguard.

5. Only one side, the opponent, Timeguard, filed evidence.

6. Both sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Mr Graham F Coles of Graham Cole & Co, Registered Trade Mark Attorneys, filed a written submission dated 5 October 2006 on behalf of Timeguard, the opponent. The following decision is made from the evidence and written submissions before me.

EVIDENCE

Evidence of the Opponent - Timeguard

7. This consists of a statutory declaration from Mr Andrew Gordon Douglas and associated Exhibits AGD1-AGD10. Mr Douglas is the Managing Director of Timeguard Limited and has held this position since January 2002. Prior to this, from May 1995 until January 2002, Mr Douglas was Sales Director of Timeguard.

8. Timeguard is a leading supplier of time controllers and time switches to the UK market. They manufacture and supply time controllers and time switches under the unregistered trade marks TIMEGUARD and SURETIME. They also manufacture and supply these products under the brand names of certain major customers. From his knowledge of the market, Mr Douglas estimates that Timeguard has about 12.5% of the UK market for time controllers and time switches. He does not state whether this is for goods sold under the trade mark SURETIME alone, TIMEGUARD alone, under both SURETIME and TIMEGUARD, or such goods sold under its own marks and under the brand names of other suppliers.

9. Timeguard adopted the trade name SURETIME in 1999 in relation to a range of products aimed at the lower priced end of the market. Mr Douglas provides figures for sales turnover and retail value of sales (i.e. sales at estimated end customer prices) under the SURETIME brand in the UK between 2000 and 2004.

Year (1/1-31/12)	Sales Turnover (£)	Value of Sales (£)
2000	8206	14770
2001	30295	54531
2002	54856	98740
2003	46889	84400
2004	55620	99468

10. According to Mr Douglas, Timeguard had no knowledge of any use by the Applicants of the mark SURETIME in relation to time switches. Timeguard only became aware of the existence of the Applicant when they received an order dated 7 October 2004 from Amanda Howell of Sure International Ltd for 100 time-switches. A copy of this order is shown as Exhibit AGD8. Mr Douglas explains that the client is identified as Amanda Howe (and not Howell) by mistake (see paragraph 10 of Mr Douglas's statement). Also included in Exhibit AGD8 is a copy of the Annual Return to Companies House, dated 18 December 2002, for Sure International Limited made

15. Mr Douglas states in paragraph 5 that Timeguard have used this trade mark extensively in the UK since 1999 in relation to:

electrical switches, electrical power sockets, residual current detector circuit breakers, time switches, time controllers, electrical surge protectors, parts and fittings for all the aforesaid goods.

and he provides a number of exhibits in support of this claim.

16. Exhibit AGD1 comprises a copy of the packaging artwork for a model ST620 SURETIME time-switch which comprises a copy of the front sheet (referred to as page 1), the back sheet (referred to as page 2), and the instruction sheet (referred to as page 5). This artwork is dated 7/2/00. The trade mark is visible once on the front sheet, once on the back sheet and twice on the instruction sheet. The name and address of the Opponent is also visible on the back sheet and instruction sheet.

17. Exhibit AGD2 comprises similar packaging artwork to that shown in Exhibit AGD1 but this time for a model STU27 SURETIME time-switch. The front sheet (referred to as page 1) is dated 7/2/00, the back sheet (referred to as page 2) is dated 14/2/00 and the instruction sheet is undated. The trade mark SURETIME and the name and address of the opponent are found in the same position in this exhibit as in Exhibit AGD1.

18. Exhibit AGD3 shows a digital photograph of an individually packaged Model ST620 SURETIME branded time-switch and Exhibit AGD4 shows a digital photograph of an individually packaged Model STU27 SURETIME branded time-switch. These photographs are undated. Although these images are a little blurred, the unregistered trade mark SURETIME is clearly visible on the bottom surface of the time-switch in each package as well as on the packaging and the instruction booklet visible in each photograph.

19. Different examples of promotional materials and activities are provided by Mr Douglas in Exhibits AGD5-7. Exhibit AGD5 is an example of an A4 sized 2 page promotional leaflet produced by Timeguard. Mr Douglas states, in paragraph 5 of his statement, that this leaflet has been distributed continuously to potential customers throughout the UK since January 2002. It illustrates 9 different products sold under the SURETIME brand on two pages. The first page, clearly headed with the SURETIME mark, describes 4 different time-switch models, one of these is the same STU27 model shown in Exhibits AGD2 and AGD4 and another is the same model ST620 shown in Exhibits AGD1 and AGD3. The second page shows the name and address of the opponent at the bottom and illustrates 4 further time switch models as well as a residual current detector safety adaptor.

20. Timeguard products are also advertised and promoted through wholesale and retail suppliers of electrical and security goods under the trade mark SURETIME. From 2000 to 2002, SURETIME branded products were sold through the Stearn Electric Company Limited, a distributor of electrical goods to the wholesale trade. Exhibit AGD6 shows 3 examples of requests sent to Mr Douglas at Timeguard for

updated entries for SURETIME products to be included in the Quarterly Price Guide produced and distributed to the electrical trade by Stearn. These requests are dated 28 December 2000, 30 March 2001 & 30 June 2001. The final page of this exhibit is an example of the entry Timeguard placed in the Stearn catalogue. Although this page is not dated, it is clear that it relates to the catalogues produced by Stearn in the seven month period December 2000 to June 2001. Although, Mr Douglas states that SURETIME branded goods were sold through other wholesale and retail suppliers of electrical and security products such as City Electrical Factors Ltd. Edmundsun Electrical Ltd, Gardiner Security Ltd and John Lewis Plc, he does not provide any evidence to support this statement, e.g, invoices or evidence from catalogues.

21. Exhibit AGD7 shows one page photocopied from the Maplin Electronics catalogue. Mr Douglas states at paragraph 7(ii) of his statement that Maplin are a major retailer and wholesaler of electrical goods in the UK with a network of 104 stores and that they have been selling SURETIME branded products since 2001. The page shown, Mr Douglas states, is from the September 2003 to August 2004 catalogue. Although no date is visible of the photocopied page itself, the phone number and internet address for Maplin are visible on the bottom of the page. Three timers and two time-switch models are shown on this page and two of them can be identified as being Timeguard products. The first is the '24 Hour Tappet Plug-in Timeswitch' identified by order code PM44X at £9.99 inc. VAT and the other is the '24 Hour/7 day Electronic Timeswitch' identified by product code L56AG also priced at £9.99 inc. VAT. The trade mark SURETIME is visible in the picture showing the latter product in its packaging.

22. No evidence was supplied by the Applicant, Marshall.

23. This concludes my review of the evidence

DECISION

Passing Off – section 5(4)(a) of the Act

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

“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.”

25. In determining whether the sign in question offends against this section of the Act, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC

in the *Wild Child case* [1998] RPC 455. In that decision (at page 460, line 5), Mr Hobbs stated that:

“A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd v Borden Inc* [1990] RPC 341 and *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] AC 731 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 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.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

And he continued (at page 460, line 36):

“Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.”

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact. In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The Material Date

26. The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark...”

It is well established that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. The relevant date may therefore be either the date of the application for the mark in question (although not later), or the date at which the acts first complained of commenced (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9. The applicant Marshall has not substantiated its claim to have used the mark and so the material date is the date of application for the sign, i.e., 16 October 2004.

Goodwill and Reputation

Pumfrey J in *REEF Trade Mark* [2002] RPC 19 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 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 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

27. Professor Annand, sitting as the appointed person, in the *Loaded* decision BL O/191/02, accepted that proof of goodwill could be accomplished by other means. The judgment of the Court of Appeal in *Phones4U Ltd and another v Phone4u.co.uk Internet Ltd and others* [2006] EWCA Civ 244, reported as [2007] RPC 5, is a warning against basing a decision on a formula and ignoring the actual evidence.

Comparison of the Trade Marks

28. The trade mark SURETIME and the sign SURETIME (application no 2375932) are identical.

Comparison of the Goods

29. Timeguard have established that at the material date, 16 October 2004, the date of application for registration 2375932, it had established a goodwill in the unregistered trade mark SURETIME for various types of electrical time switches. Sales of goods bearing the SURETIME trade mark were significant and grew year on year from an approximate value of £15,000 in 2000 to one of £100,000 in 2004. Timeguard have clearly shown that they were selling electrical switches, electrical power sockets, time switches, and time controllers in this period. These goods all have an electrical socket and are used to switch on and off electrical apparatus plugged into them at specified times.

30. The STU27 time-switch model shown in Exhibits AGD2, AGD4 and AGD5 shows a digital timer setting mechanism in contrast to the simpler tappet type timer setting mechanism used in the model ST620 time-switch shown in Exhibits AGD1, AGD3 and AGD5. This, in my opinion, shows that this type of time-switch can also be identified as an electronic time-switch. In this instance I consider that the terms electrical and electronic are interchangeable when referring to time-switches. Thus I am satisfied that the goods sold by Timeguard in this period under the SURETIME mark are, for all intents and purposes, identical to the goods specified in Marshalls trade mark application 2375932. Mr Coles makes this point on behalf of Timeguard in his written submission dated 5 October 2006 at paragraphs 3 and 4 and I accept it.

31. I consider that the goods sold by Timeguard would be sold through the same or similar trade channels to those likely to be used by Marshall for the goods of the application. These include sales through electrical wholesale and retail stores and

sales through printed and on-line catalogues such as those provided by Stearn and Maplin (see Mr Douglas's witness statement at paragraphs 6 and 7 and Exhibits AGD6 and AGD7). The goods covered by the sign are also likely to be found in the same place in a store, or in a catalogue, as the goods covered by the trade mark. Thus I consider that there is a real likelihood that a member of the public seeing a time-switch from the applicant that is identified using the sign SUREtime would believe it to be a time-switch from Timeguard under its trade mark SURETIME. This clearly would result in a misrepresentation of the Opponents goods by the Applicant and is likely to lead to damage of the Opponents business through loss of sales and income. Given the similarity of the goods and the identical nature of the marks, this potential loss of sales and income is likely to be significant. As Lord Fraser stated in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31, it is for the plaintiff (i.e., the opponent in this case) to establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendant selling goods which are falsely described by the trade name to which the goodwill is attached.”

I am satisfied that, on balance, Timeguard is likely to suffer substantial damage to its goodwill.

32. The applicant Marshall did not provide any evidence in response to that provided by the opponent and did not seek to challenge the evidence of Mr Douglas through cross examination. Marshall also did not provide any evidence to support the statements in their counterstatement and notice of defence that they were selling electronic time-switches since 1995 and thus had a prior established goodwill and/or reputation to that of the opponents. In the copy of the letter from Mr Marshall to Mr Douglas, exhibited at AGD9, further claims are made as to the Applicants prior established goodwill and/or reputation in the sign SURETIME. However, no evidence is provided by the Applicant to support these claims. Mr Coles refers to this lack of evidence from the Applicant in his written submission on behalf of Timeguard (see paragraphs 13-16 of Mr Coles written submission).

33. The counterstatement from Marshall (see paragraph 3) also appears to accept that the sign and the trade mark are identical and that the goods of the specification are identical or very similar to the goods sold by Timeguard under the SURETIME trade mark. That being the case, Marshall imply that any use by Timeguard of the unregistered trade mark SURETIME “commencing after 1995 constituted a misrepresentation that was liable to cause damage to the Applicant's goodwill”. However, Marshall provided no evidence to support this claim of use since 1995. In the absence of any evidence to support the Applicants claims, I cannot accept them.

Conclusion

34. Taking into account all of the above, I find that Timeguard has established that it has a goodwill in the trade mark SURETIME for electrical time switches and time controllers; that a misrepresentation is likely to occur that would lead the public to believe that the goods for which Marshall seeks registration are the goods of the Opponent; and that this misrepresentation is likely to cause damage to goodwill in the business established by Timeguard.

35. The ground of opposition by Timeguard under section 5(4)(a) of the Act is successful.

COSTS

36. Timeguard having been successful is entitled to a contribution towards their costs. I order Marshall to pay Timeguard the sum of £750. 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 17th day of May 2007

**Dr Lawrence Cullen
For the Registrar,
the Comptroller-General**