

O-222-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 2604699
BY ADRIAN LEWIS
TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 9, 38 & 41:**

defibfinder

AND

**OPPOSITION THERETO (NO 103253)
BY THOMAS O'HALLERAN**

The background and the pleadings

1) The trade mark the subject of this dispute was filed on 15 December 2011 by Mr Adrian Lewis. It was published in the Trade Marks Journal, for opposition purposes, on 27 January 2012. The mark and the goods and services for which registration is sought are:

defibfinder

Class 9: Life saving apparatus and equipment.

Class 38: Internet portal services.

Class 41: Health education.

2) The opponent is Mr Thomas O'Halleran. He relies on a single ground under section 5(4)(a) of the Trade Marks Act 1994 ("the Act")¹. Mr O'Halleran claims that he first used the mark in the UK in January 2011. The claimed use relates to the provision (via a website, web application and smart devices) of a national public access defibrillator database to allow NHS ambulance trusts and the general public to direct individuals to defibrillators in case of heart attack. It is claimed that the use of the applied for mark by Mr Lewis would constitute an act of passing-off.

3) Mr Lewis denies the claim. Both sides filed evidence. Neither side requested a hearing or filed written submissions in lieu of attending a hearing. I will, though, bear in mind all of the arguments that have been made in the papers before me.

Legislation and the leading case-law

4) Section 5(4)(a) of the Act constitutes a ground of opposition in circumstances where the use of the applied for mark 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.."

5) The elements of passing-off (often referred to as the classic trinity) can be summarised as: 1) goodwill, 2) misrepresentation and 3) damage. In *Reckitt & Colman Products Ltd v Borden Inc* [1990] R.P.C.341, Lord Oliver summarised the position thus:

"The law of passing off can be summarised in one short general proposition - no man may pass off his goods as those of another. More

¹ A claim was initially raised also under section 5(4)(b) but this was struck out.

specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff...Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

6) The concept of goodwill was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

"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 custom."

7) To qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature². However, being a small player does not prevent the law of passing-off from being relied upon³.

The relevant date

8) The matter must be judged at a particular point(s) in time. In *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Joined Cases T-114/07 and T-115/07 the General Court stated:

"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).

² *Hart v Relentless Records* [2002] EWHC 1984

³ See, for instance, *Stannard v Reay* [1967] FSR 140, *Teleworks v Telework Group* [2002] RPC 27 and *Stacey v 2020 Communications* [1991] FSR 49

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.”

9) The relevant date at which Mr O’Halleran must establish his goodwill and that the use of Mr Lewis’ mark is liable to be prevented is, consequently, 15 December 2011. However, if Mr Lewis has used his make before this date then this could alter the position, if, for example, it is established that he is the senior or a concurrent user of the sign.

The evidence

10) Both parties claim to have created the defibfinder name to be used in connection with a system for the location of defibrillators. There does not appear to have been any relationship between Mr Lewis and Mr O’Halleran. There is nothing in the evidence that goes to any form of inappropriate conduct by which either party has intentionally “stolen” the idea/mark from the other. It appears to be a case of the independent creation of the idea/name. Nothing can be read into the fact that both parties have come up with the same name; there is nothing particularly striking in the name defibfinder (for obvious reasons). I have referred to the word “idea” intentionally. This is to highlight that having an idea, and even working on it, is not something which is protected under the law of passing-off. Passing-off is concerned with active businesses and their protection against unfair competition; in other words, one business passing themselves off as the other (although it is not necessary for this to be intentional). The claimant in these proceedings (Mr O’Halleran) must establish that he had goodwill in a business as of 15 December 2011. I now turn to consider what facts can be taken from the evidence.

Mr O’Halleran’s evidence

Witness statement of Thomas O’Halleran

11) Mr O’Halleran describes himself as the designer and creator of www.defibfinder.co.uk and the defibfinder automatic external defibrillators (“AED”) mapping tool/service. He states that the name was first used in 2011 (no specific date is given at this stage) by himself in the production of the above website using data provided by the West Midlands Ambulance Trust (“WMAT”). He states that the mark has been used regularly since then in respect of this website and the service which is provided to the general public, NHS Ambulance Trusts and manufacturers. He claims that the mark has been used in respect of various goods/services, all in the year 2011 (the exact date is unspecified): data processing equipment, computers, computer software (used in the production of

the website to allow the mapping of AEDs), portal services, email services providing user access to the Internet (in the production of the website to allow the mapping of locations of AEDs).

12) Mr O'Halleran then refers to a number of exhibits as follows:

- i) Exhibit TO1: This contains a print from Mr O'Halleran's website. It prominently features the name DEFIBFINDER. The website's domain name (defibfinder.co.uk) was registered in January 2011. A "test website" was shown to Duncan Parsonage (later evidence shows him to be the community response manager of WMAT) and "other members of the team" in April 2011. The final logo was designed on 29 May 2011. Mr O'Halleran states that the actual website then went live on 23 July 2011.

The exhibit also contains a promotional leaflet that was used at the ESS (Emergency Services Show) by Community Heartbeat Trust. The material was handed out at the show between 23 and 24 November 2011 to "multiple 3rd parties in the emergency services community". The leaflet depicts a logo containing the defibfinder name, but it is not the most prominent name/logo on the leaflet. The leaflet states "working closely with West Midlands Ambulance Trust and Safeheart we have constructed a national database built to NHS IT standards".

- ii) Exhibit TO2a: This contains various emails between Mr O'Halleran and members of the team involved in the creation of the website. The emails are difficult to follow. Those involved appear to be Thomas O'Halleran, Martin Fagin, Ian Shepherd and Jim O'Halleran. It is clear that these people were working together on the project; the name defibfinder is mentioned early on and ties in with the domain name registration.
- iii) Exhibit TO2b: An email from Martin Fagin of Community Heartbeat Trust (who appear to be the organisation marketing the website for Mr O'Halleran) to Thomas O'Halleran (and others in the team) in which he reports on a discussion he had with East Midlands Ambulance Trust regarding the project. A presentation was due to be made by Mr Fagin but there was no time to do so. The meeting appears to have taken place towards the end of July 2011. It is clear that at this stage East Midlands Ambulance Trust were not yet on board in term of providing data for the defibfinder website.
- iv) Exhibit TO2c: Emails relating to a meeting to be set up with the Resus Council UK. The email is dated 8 August 2011. The meeting did not take place until January 2012.

- v) Exhibit TO3: This consists of the slides of a presentation which was created by Thomas O'Halleran (in August 2011) and delivered by Jim O'Halleran and Nicola O'Halleran on 17 August 2011. The presentation was made to Shaun Ingram and Andy Relf who work for Cardiac Science UK. It is stated that the presentation was passed to others within Cardiac Science UK. Mr O'Halleran explains that the presentation was delivered to explain to manufacturers the benefits that the defibfinder service could bring to them. The name defibfinder is used prominently in the slides, often accompanied by a heart device.
- vi) Exhibit TO4: This consists of another presentation created by Thomas O'Halleran (in July 2011) that was presented by Martin Fagin to the Community Heartbeat Trust board and to "other experts in the field of heart care and research" to gauge opinion of the service and how it could be improved. No date that the actual presentation took place is given. The presentation features the defibfinder name.
- vii) Exhibit TO5: Two website extracts that refer to the launch of the defibfinder website. They are dated March 2012 (after the relevant date). One (from the BBC News website) states that "West Midlands Ambulance Service, Safeheart UK and the Community Heartbeat charity have spent three years developing the website" and "the website is the first to be developed with the co-operation of an ambulance service". The website covers Birmingham, the Black Country, Warwickshire, Staffordshire, Shropshire, Herefordshire and Worcestershire. I note from the other print (from the EHI ehealth Insider website) that the defibfinder website was the "...brainchild of Duncan Parsonage, community response manager for WMAS". Both prints focus on the website being for the public to use to find defibrillators. Although these prints emanate from after the relevant date, Mr O'Halleran states that the "relevant approvals and interviews go back further in time", although, as he does not say when, it cannot be inferred that the interviews took place before the relevant date.
- viii) Exhibit TO6: A WHOIS report demonstrating that Mr O'Halleran registered the domain name defibfinder.co.uk in January 2011. He states that any other party would have been able to check who owned the domain name from this point on. He repeats that the website went live on 23 July 2011, so at this point it was already in use and easily viewable.
- ix) Exhibit TO7: An undated letter (although Mr Thomas O'Halleran states that it was sent on 23 January 2012) from James [I assume this to be Jim] O'Halleran of Safeheart UK Ltd to Mr Parsonage of the WMAT; Thomas O'Halleran states that the letter was on behalf of the team involved in the creation and administration of the defibfinder website, including himself. It refers to WMAT data being loaded on to the

defibfinder website, and that future updating and amending can be carried out by WMAT's own administrative team. It is added that the agreement is to host data at no cost to WMAT and that the agreement is in place for an initial 5 year period and that during this time WMAT will be licensed for the use of defibfinder within its own business services. A basic suite of monthly usage reports will be provided free of charge; if more detailed reports are required then Safeheart is prepared to quote reasonable terms to commission and supply.

13) Mr O'Halleran concludes by stating his belief that through the use made by him and also as a result of the use by WMAT, the mark defibfinder is well-known to the general public and to users of AEDs, Ambulance Trusts, manufacturers, charities and experts in the heart research field and is uniquely associated with him.

Witness statement of Jim O'Halleran

14) Mr O'Halleran merely repeats most of what Thomas O'Halleran has said, including the contents of his exhibits. No further evidence of fact emanates from this witness statement. Mr O'Halleran states that he is the chairman of Safeheart UK, but he does not explain the exact nature of the relationship between Thomas O'Halleran and Safeheart UK or any of the other organisations referred to in the evidence.

Witness statement of Duncan Parsonage

15) Mr Parsonage is the community response manager of WMAT. Again, much of what Mr Parsonage states repeats the evidence of Thomas O'Halleran. He makes reference to Exhibits TO1, TO2 and TO7. In relation to the material in TO2 he states: "these emails comprised discussion of the use of the mark DEFIBFINDER on the website and providing services to [WMAT]. This was when I was promoting the service to other Ambulance Services across the UK at regular ambulance trust meetings".

Witness statement of Martin Fagan

16) Mr Fagin is the secretary of the Community Heartbeat Trust Charity. Again, he simply repeats much of what Thomas O'Halleran states including confirming the accuracy of the exhibits. He also states (in relation to the material in TO2) that he was also promoting the service to other ambulance services across the UK at regular ambulance trust meetings.

Mr Lewis' evidence

Witness statement of Adrian Lewis

17) Mr Lewis states that he has been a director of Defibfinder Limited since 15 December 2011. He refers to an email dated 4 July 2010 (Exhibit AL1) from Mr Rob Mannion (of Rural Net Futures) who Mr Lewis describes as his “app developer”. The email does not mention the defibfinder name. The email is requesting further information about the “idea”. Mr Lewis states in his witness statement that in the summer of 2010 they had a number of meetings to discuss the defibfinder project which would use GPS to find a defibrillator in case of emergency.

18) Mr Lewis states that on 8 July 2010 he had meetings with a former work colleague, Ms Tamar Grovenveld, and also Professor Jeremy Wyatt of Warwick University where the project was discussed. Professor Wyatt agreed to sit on and chair “our” scientific advisory committee.

19) The domain name defibfinder.org was registered on 2 August 2011. Mr Lewis knew that the .com and .co.uk versions of the domain name were already registered. However, “we” wanted the .org version to reflect the “not for profit” nature of the business. He says that a Google search at the time indicated that the defibfinder.co.uk website had not been launched and could not be found. A search at Companies House indicated that the name Defibfinder Limited had not been registered so “we” duly formed the company on 15 December 2011 (Exhibit AL2 contains the certificate of incorporation). On the same date, Mr Lewis made the application for the trade mark.

20) Mr Lewis states that in early 2012 the defibfinder.co.uk website appeared when defibfinder was searched. A meeting, by mutual consent, then took place between Mr Lewis (and his wife, a co-director) and Mr Jim O’Halloran. Apparently, Mr O’Halloran explained that defibfinder.co.uk was owned by Safeheart Limited and that he was a director of this not for profit company and that shares were equally divided between himself, his wife Nicola O’Halloran and Mr Duncan Parsonage. Mr Lewis states that a search of the records of Companies House revealed that Safeheart Limited did not exist. Mr Lewis refers to Mr O’Halloran’s Exhibit TO7, the letter from January 2012, noting that this was “conveniently” sent to Mr Parsonage, a future director of Safeheart Limited. He notes that the footer does not conform to the rules of Companies House and is signed by James O’Halloran as Chairman of Safeheart (UK) Ltd. Mr Lewis provides Companies House information (Exhibit AL3) showing that Safeheart Limited was incorporated in May 2012. It shows that Nicola O’Halloran had the controlling share of 52 shares, with Thomas O’Halloran and Duncan Parsonage having 24 each. He states that at the meeting with him on 30 March 2012, and in the letter to Mr Parsonage in January 2012, they must have been aware that Safeheart Limited had not been legally formed. He says that Jim O’Halloran

passing himself off as a chairman of a non-existent company is a breach of commercial and company law.

21) Mr Lewis completes his evidence by referring to what he considers the goods and services his mark has been used on and in what way. However, as none of the evidence he gives demonstrates that such activity has taken place before the relevant date, I do not consider it necessary to summarise this further.

Findings

22) As alluded to earlier, it is clear that both parties have independently come up with a similar idea (and name) at roughly the same time and that both have undertaken activities to develop the idea into a workable and practical tool to assist people and organisations to find the locations of defibrillators. However, in the context of the dispute before the tribunal, it does not matter who came up with the idea/name first. What matters is whether the opponent had a protectable goodwill at the relevant date.

23) I stated earlier that if Mr Lewis had used his mark before the date of application then this may impact upon the relevant date. However, what I refer to as use in this context should not be confused with Mr Lewis' use in terms of the development of his idea. Whilst Mr Lewis may have had meetings about his idea (with his application developer and with Professor Wyatt) none of this counts as a form of use that makes him a senior (or concurrent) user in trade. There is no evidence that Mr Lewis' idea had reached the stage where he was operating any form of trade or business in that his application was publically available for use. **In view of this, Mr Lewis' evidence, in so far as his use is concerned, has no significance on the matters before the tribunal.**

24) Some of these observations apply equally to the evidence provided by Mr O'Halleran. Goodwill is the attractive force that brings in custom. Thus, the registering of domain names and discussions with members of the team developing the project do not generate goodwill. What matters is whether any form of trade or business has occurred. There are also questions as to the owner of any goodwill (if it existed) which I will come back to later if necessary. Breaking Mr O'Halleran's activities down, and looking at events which clearly took place before the relevant date, the following occurred:

- i) A test website was shown to Mr Parsonage and "other members of the team" in April 2011;
- ii) Mr Fagin had a discussion with East Midlands Ambulance Trust at the end of July 2011;
- iii) The website went live on 23 July 2011 (although Mr Lewis says that he could not find it in August 2011 when he conducted a Google search);

iv) A presentation was made to Cardiac Science UK in August 2011;

v) Promotional leaflets were handed out at the ESS Show on 23-24 November 2011.

25) Other activities are referred to, but these are either unclear in terms of date, or took place after the relevant date:

vi) The meeting with Resus UK (although the meeting may have been arranged before the relevant date).

vii) The presentation by Mr Fagin to the Community HeartBeat Trust (and other experts in the field) – no date is given as to when the presentation took place, although the presentation itself was created before the relevant date.

viii) The WMAT data was added to the website and confirmed in the letter from James [Jim] O'Halleran to Mr Parsonage in January 2012.

26) There are also further references to discussions with other ambulance trusts, but without knowing the nature of the meeting, what was presented etc, this takes matters no further forward.

27) The sense I get from the evidence is that the defibfinder project which Thomas O'Halleran says he should benefit from (in terms of goodwill) was a collaborative one involving: Thomas O'Halleran, Jim O'Halleran & Natalie O'Halleran (who later incorporated a company called Safeheart Limited, but who appear to have referred to themselves with reference to this company name before incorporation), WMAT (with specific input from Mr Parsonage) and Community Heart Beat Trust (with specific input from Mr Fagin). The exact nature of the relationship is not clear, but Thomas O'Halleran refers on more than one occasion to the "team" which developed the website. There is further evidence of the collaborative relationship given the press articles (which Thomas O'Halleran states received the "relevant approvals"), one of which actually states that the website was the brainchild of Mr Parsonage. The other article refers to SafeHeart, WMAT & HeartBeat as co-operating in the project for three years (there is no mention of Thomas O'Halleran in any of this). I consider that the interactions between any of these individuals and/or the organisations which they represent are, in my view, to be regarded as internal development initiatives and are not considered as any form of outward facing use capable of generating goodwill.

28) In relation to the other activities that took place before the relevant date, the discussion Mr Fagin had with the East Midlands Ambulance Trust is not particularly telling. By his own admission he did not conduct a presentation as he had planned due to time constraints. Therefore, the discussion may have been

brief and lacking significance. It is not known the extent to which the name defibfinder was used; if it was so used it is difficult to tell what cognisance those who attended the meeting will have taken. The meeting was, anyway, directed more at obtaining the data for AED sites rather than the offer of any service.

29) In relation to the existence of a website, this tells me nothing. There is no information as to how many people accessed the website. It is not even clear if the website was even operative at this point in time as the data from WMAT does not appear to have been ready by this stage. The simple existence of a website does not generate goodwill. In any event, Mr Lewis provided evidence that he could not even find the website.

30) That then leaves the meeting with Cardiac Sciences UK in August 2011 and the handing out of leaflets at the ESS Show some three weeks before the relevant date. None of this is evidence of trading or obtaining business. It is more like the advertising of the availability of a service, or possibly in this case, the availability of a future service. Whilst pre-launch activity can generate goodwill⁴, this is the exception rather than the rule and would be based upon an existing business. Furthermore, a meeting with one company is not significant. As to the leaflets, the name defibfinder was not the most prominent, there is no evidence as to the numbers given out, or of the significance that attendees at the event gave them. The timing of the event is only shortly before the relevant date so it is difficult to see that goodwill will have been generated in such a short period of time. Of course, the leaflets could have kick-started people accessing the website, but no evidence to this effect has been provided, evidence which was within the power of Mr O'Halleran to provide. I come to the view that at the relevant date it is not established that Mr O'Halleran had the requisite goodwill. **For this reason alone the opposition must fail.** I confirm that whilst I may not have referred to every single activity claimed to have taken place, they have all been borne in mind, but they take matters no further forward than the primary activities listed above. The nub of my finding is that whilst a business was clearly being developed, at the relevant date it was simply not operative in a way that is protected under the law of passing-off. Rights in passing-off do not arise from a name without a business as per, Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per

⁴ See *BBC v Talbot* [1981] FSR 228

Lord Parker; H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils (the Bollinger case) [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

The opposition is hereby dismissed.

31) I mentioned the ownership of goodwill earlier. I also stated earlier that the relationships between the “team” developing the website is not clear which could have had an impact upon the question as to whether Mr O’Halleran was, if any goodwill existed, the owner of it. If it was necessary to do so I would have sought clarification of this and possibly joined the other “team” members to the proceedings, but, given my primary finding, it is disproportionate do so now. One final point concerns the comments made by Mr Lewis that the incorporation of SafeHeart did not take place until after the meeting with him in which Mr O’Halleran (Jim) said he was the chairman of SafeHeart; I simply need to say that this is not a matter for the tribunal, so has no impact on my decision.

Costs

32) Mr Lewis, having succeeded, is entitled to an award of costs. When considering this I have borne in mind that he was not legally represented and, so, would not have incurred any legal fees. I make the award on the following basis:

Preparing a statement and considering the applicant’s statement: £150

Preparing and considering evidence: £250

Total: **£400**

33) I order Mr Thomas O’Halleran to pay Mr Adrian Lewis the sum of £400. 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 28th day of May 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**