

**O-567-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**TRADE MARK REGISTRATION NO 3129678**

**IN THE NAME OF PETNAP LIMITED & SIMON GOODWIN**

**FOR**

**THE TRADE MARK**

**UK Whelping Supplies Limited**

**IN CLASSES 20 & 21**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY THEREOF (UNDER  
NO. 501151)**

**BY**

**STEPHEN MEEK**

## **BACKGROUND**

1) Petnap Limited and Simon Goodwin ('the proprietors') are the proprietors of the registered trade mark 'UK Whelping Supplies Limited' in respect of the following goods:

**Class 20:** Beds for pets; Nesting boxes for household pets; Kennels for household pets; Beds for household pets.

**Class 21:** Blankets for household pets.

2) The trade mark was applied for on 02 October 2015. It was subsequently published in the Trade Marks Journal for opposition purposes on 16 October 2015. No opposition having been filed, it was entered on the register on 25 December 2015.

3) Stephen Meek ('Mr Meek'), who is representing himself in these proceedings, claims that the trade mark registration offends under Section 5(4)(a) of the Trade Marks Act 1994 ('the Act') and for that reason should be declared invalid. In support of that ground Mr Meek claims to be the proprietor of the unregistered mark 'UK WHELPING SUPPLIES' which he states has been used throughout the UK since February 2015 in relation to various whelping supplies and pet products including beds, blankets, mats and nesting boxes for household pets, whelping kits, animal feeding equipment and animal health and hygiene products. Mr Meek states that the proprietors' mark is identical to his company name and "would create confusion within the marketplace" presumably because consumers will believe that the proprietors' goods are his goods thereby amounting to passing off.

4) The proprietors filed a counterstatement denying Mr Meek's claims and putting him to proof that he had the necessary goodwill to support a passing off action at the date of filing of the registration.

5) Only Mr Meek filed evidence; the proprietors filed written submissions. Neither party requested to be heard nor did they file written submissions in lieu of a hearing. Accordingly, this decision is made on the basis of the papers before me.

## **EVIDENCE**

6) Mr Meek's evidence consists of a witness statement by him dated 10 July 2016 and four exhibits thereto. It can be summarised as follows:

- Mr Meek is the owner and Chief Executive of UK Whelping Supplies; a position which he has held since 22 April 2015. There is nothing to suggest that this is a body corporate.
- He states that the trade mark 'UK Whelping Supplies' was first used in the UK in 2015 and the goods on which the mark has been used are beds for pets, nesting boxes for household pets, Kennels for household pets, beds for household pets and blankets for household pets and that the date of first use for all of the aforementioned goods was 2015.
- Exhibit 1 is a copy of an invoice, dated 22 April 2015, for the cost of registration of the domain names 'UK Whelping Supplies.com' and 'UK Whelping Supplies.co.uk'.
- Exhibit 2 is a copy of an invoice, dated 31 July 2015, from eBay Europe S.a.r.l., addressed to 'UK Whelping Supplies', for the sales account of UK Whelping Supplies.
- Exhibit 3 is a copy of an invoice, dated 20 October 2015, addressed to 'UK Whelping Supplies' listing goods described as 'pet heated pads' and a 'Fleece cover'.
- Exhibit 4 is a copy of an invoice, dated January 2016, from an undertaking called 'beaphar', addressed to 'UK Whelping Supplies', listing various goods such as 'Feeding sets' and 'In Season Tablets'.
- Mr Meek states that, in 2015, sales of beds for pets, nesting boxes for household pets, Kennels for household pets, beds for household pets amounted to £27,461 and sales of blankets for household pets totalled £11,753.

- £600 was spent on promoting goods in 2015 by way of an eBay shop front design and Facebook campaigns.
- Mr Meek states that the mark has been used in Scotland, England, Ireland and Wales.

## DECISION

7) Section 47(2)(b) of the Act states:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) ...

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

And Section 5(4)(a) 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.”

8) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townsend & Sons (Hull) Ltd* [1979] AC 731. It 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 the 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."

9) 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 relevant date**

10) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘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).

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.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither

party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent



passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings 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, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

11) In the case before me, the filing date of the proprietors’ trade mark is 02 October 2015. As there is no evidence of any use by the proprietors before the filing date that is the only date I need to consider.

## **Goodwill**

12) In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) the Court stated:

“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. It is the one thing which distinguishes an old-established business from a new business at its first start.”

13) In terms of the evidence that is required to establish the existence of goodwill, in *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of 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 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.”

14) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) 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.”

15) The first hurdle that Mr Meek must overcome is to show that he had goodwill in a business at the relevant date of 02 October 2015 and that the sign he relies upon, 'UK Whelping Supplies', is associated with, or distinctive of, that business.

16) Mr Meek has provided the briefest of witness statements with very little narrative and four exhibits. Although he lists a number of goods which he states have been sold under the sign 'UK Whelping Supplies' in 2015 amounting to total sales of £39,214, there is not a single piece of corroborative evidence in support of these statements such as photographs of the said goods, invoices listing those goods issued to customers or even an explanation as to when in 2015 those sales took place or to whom. The lack of any such evidence makes it impossible to ascertain i) whether any of the sales Mr Meek refers to took place before the relevant date of 02 October 2015; ii) the extent of use for any of the goods referred to; and iii) how the sign 'UK Whelping Supplies' was used in relation to those goods (if it was indeed used at all). Mr Meek further states that he has spent £600 on promoting and advertising his goods through a shop front on eBay and facebook campaigns. Not only is this advertising expenditure very small but, again, there is no evidence provided to show examples of that advertising or the time in 2015 at which it took place.

17) As regards the four exhibits which have been provided, these do not shed any light on matters. The mere purchase of domain names<sup>1</sup> and possession of a sellers account on ebay<sup>2</sup> does not show me what goods were sold (if any) or what signs were used on, or in relation to, those goods. Further, even if the invoices<sup>3</sup> which have been provided had emanated from prior to the relevant date (which they do not and are, therefore, irrelevant for that reason alone), they merely show that goods were sold to UK Whelping Supplies by two suppliers. There is nothing before me to show that any of the goods of the sort listed in those invoices were sold on by Mr Meek to any customers prior to the relevant date, let alone that the sign 'UK Whelping Supplies' was used in relation to any such goods.

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<sup>1</sup> Exhibit 1

<sup>2</sup> Exhibit 2

<sup>3</sup> Exhibits 3 & 4

18) The evidence before me falls a long way short of establishing that Mr Meek had the required goodwill at the relevant date. Without goodwill, there can be no misrepresentation or damage. The application for invalidation is therefore dismissed.

## **COSTS**

19) As the proprietors have been successful, they are entitled to a contribution towards the costs they will have incurred in defending their trade mark registration. Using the guidance in Tribunal Practice Notice 4/2007 (which was in force at the time of commencement of these proceedings), I award the proprietors costs on the following basis:

Considering the application for invalidation and preparing the counterstatement	£200
Written Submissions	£300
<b>Total:</b>	<b>£500</b>

20) I order Stephen Meek to pay Petnap Limited and Simon Goodwin the sum of **£500**. 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 29<sup>th</sup> day of November 2016**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**