

O/851/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF REGISTRATION NOS

3465150 & 3434191

IN THE NAME OF DISTRICT VETERINARY PROFESSIONALS LTD

FOR THE TRADE MARKS:



IN CLASSES 35, 41 & 44

AND IN THE MATTER OF THE CANCELLATION THEREOF

UNDER NOS: 503802, 503806, 503812 & 503824

BY THE ROYAL COLLEGE OF VETERINARY SURGEONS

BACKGROUND AND PLEADINGS

1. District Veterinary Professionals Ltd (“the proprietor”) is the registered proprietor of UK registrations **3465150** and **3434191**.
2. Registration 3465150 was filed on 7 February 2020 and registered on 14 August 2020, for the mark:



for the following services:

Class 35: Veterinary practice business management.

Class 41: Education services relating to the veterinary profession; Academic examination services; Academy education services; Academy services (Education -); Accreditation [certifying] of educational achievement; Accreditation of educational services; Accreditation of professional competency; Adult education services; Adult education services relating to medicine; Adult training; Adult tuition; Advanced training; Advice relating to medical training; Advisory services relating to education; Arrangement of conferences for educational purposes; Arrangement of conferences for recreational purposes; Arrangement of conventions for educational purposes; Arrangement of training courses in teaching institutes; Arranging and conducting of conferences, congresses and symposiums; Arranging and conducting of in-person educational forums; Arranging and conducting of lectures; Arranging and conducting of lectures for educational purposes; Arranging and conducting of lectures for training purposes.

Class 44: Veterinary advisory services; Veterinary assistance; Veterinary information services provided via the Internet; Veterinary services; Veterinary

services (Professional consultancy relating to -); Veterinary surgeons' services; Veterinary surgery; Veterinary surgical services; Advice relating to dentistry; Advice relating to nutrition; Advice relating to the breeding of animals; Advice relating to the feeding of animals; Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals; Advisory services relating to weight control; Advisory services relating to weight loss; Animal clipping; Animal feed rationing service; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Veterinary advisory services; Veterinary and agricultural services; Veterinary assistance; Veterinary dentistry; Veterinary information services provided via the Internet; Veterinary services; Veterinary services (Professional consultancy relating to -); Veterinary surgeons' services; Veterinary surgery; Veterinary surgical services; Diabetes screening services; Diet planning and supervision; Dietary advice; Dietary and nutritional guidance; Dietary guidance; Dietetic advisory services; Blood pressure screening services; Care of birds; Care of fish; Care of pet animals; Charitable services, namely providing medical services; Charitable services, namely, providing medical services to needy persons; Compilation of information relating to birds; Compilation of medical reports; Conducting of medical examinations; Conducting of psychological assessments and examination; Conducting screenings for cardiovascular disease risk factors; Consultancy relating to health care; Consultancy relating to nutrition; Consultancy services in the field of nutrition; Consultancy services related to nutrition; Consultancy services relating to nutrition; Consultation services in the field of weight management; Consultation services relating to skin care; Consulting services relating to health care; Pet hospital services; Phlebotomy services; Physical examination; Physical rehabilitation; Physical therapy; Physical therapy services; Physiotherapy; Preparation and dispensing of medications; Providing health care information by telephone; Providing health information; Providing information relating to dentistry; Providing information relating to dietary and nutritional guidance; Providing information relating to dietary and nutritional supplements; Providing information relating to medical services; Providing information relating to nursing care services; Providing information relating to physical examinations; Providing information relating to the preparation and dispensing of medications; Providing information relating to

veterinary services; Providing information to patients in the field of administering medications; Providing information via the Internet in the field of diabetes; Providing laser therapy for treating medical conditions; Providing medical information; Providing medical information from a web site; Providing veterinary information; Provision of dietetic advice; Provision of information relating to birds; Provision of medical assistance; Provision of medical information; Provision of medical services; Provision of medical treatment; Provision of pharmaceutical information; Advice relating to the breeding of animals; Advice relating to the feeding of animals; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health]; Advisory services relating to degenerative diseases; Advisory services relating to health; Advisory services relating to medical apparatus and instruments; Advisory services relating to medical problems; Advisory services relating to medical services; Advisory services relating to nutrition; Advisory services relating to the care of animals; Advisory services relating to the care of birds; Advisory services relating to the care of fish; Advisory services relating to the care of pet animals; Advisory services relating to weight control; Advisory services relating to weight loss; Alternative medicine services; Animal breeding; Animal clipping; Animal feed rationing service; Animal grooming; Animal grooming services; Animal healthcare services; Animal hospitals; Animal husbandry; Animal performance testing services; Arranging of medical treatment.

3. UK registration 3434191 was filed on 6 October 2019 and registered on 24 January 2020, for the mark:



for the following services:

Class 41: Vocational guidance; Vocational guidance [education or training advice]; Vocational retraining; Vocational skills training; Vocational skills training (Provision

of -); Vocational testing; Vocational training; Vocational training courses (Provision of -); Vocational training services.

Class 44: Advice relating to the feeding of animals; Veterinary advisory services; Veterinary and agricultural services; Veterinary assistance; Veterinary services; Veterinary services (Professional consultancy relating to -); Veterinary surgeons' services; Veterinary surgical services; Diabetes screening services; Diet planning and supervision; Dietary and nutritional guidance; Blood pressure screening services; Care of birds; Care of fish; Care of pet animals; Compilation of medical reports; Conducting of medical examinations; Pet hospital services; Pharmaceutical advice; Pharmacy advice; Physical examination; Physical examination services; Physical rehabilitation; Physical therapy; Physical therapy services; Physiotherapy; Preparation and dispensing of medications; Providing information relating to medical services; Providing information relating to nursing care services; Providing information relating to physical examinations; Providing information relating to the preparation and dispensing of medications; Providing information relating to veterinary services; Providing laser therapy for treating medical conditions; Provision of medical assistance; Provision of medical information; Provision of medical services; Provision of medical treatment; Advice relating to the feeding of animals; Advice relating to the medical needs of elderly people; Advice relating to the personal welfare of elderly people [health].

4. The Royal College of Veterinary Surgeons (“the applicant”) applied to revoke and invalidate both of the proprietor’s registrations and filed two TM26(I) forms and two TM26(O) forms, on 29 April 2021, in order to do so. Both registrations face attack under several grounds of the 1994 Trade Marks Act (“the Act”).

5. For the purposes of the invalidation actions (503802 against 3465150 and 503824 against 3434191), the applicant relies on sections 3(1)(a), (b) and (c); section 3(3)(b); section 3(6) and sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

6. In respect of the invalidation actions brought under section 5(2)(b) and section 5(3), the applicant relies on earlier UK certification mark 2181252 for the mark below:



7. This earlier UK mark was registered as a certification mark on 27 October 2000 for the following services:

Class 44: The provision of veterinary assistance and animal nursing services.

8. The applicant relies on all of the services of the earlier mark and attacks all of the services of both contested registrations.

9. In respect of cancellation action 503802 under Section 5(4)(a), the applicant relies on the figurative mark above and claims that it has used that mark throughout the UK since 1984 in respect of 'provision of veterinary assistance and animal nursing services'. It also states that it has used the mark '**VETERINARY NURSE**' throughout the UK since 1984 in respect of 'provision of veterinary assistance and animal nursing services'. It attacks all of the services of the registered proprietor's 3465150 mark.

10. In respect of cancellation action 503824 under section 5(4)(a), the applicant again relies on the figurative certification mark above and claims that it has used that mark throughout the UK since 1984 in respect of 'provision of veterinary assistance and animal nursing services'. It also states that it has used the mark '**Veterinary Nurse**' since 1984 throughout the UK on 'Veterinary nursing services including the provision of veterinary assistance and animal nursing services'. This ground is raised against all of the services of the registered proprietor's 3434191 mark.

11. Use is claimed in respect of the services under the earlier certification mark, and the applicant claims a reputation in those services, for the purposes of section 5(3).

12. In its statement of grounds, the applicant claims that under section 5(2)(b) the contested registrations should be invalidated entirely as there exists a likelihood of

confusion, including a likelihood of association, between the marks, as they are highly similar visually, aurally and conceptually. It also submits that the services in issue are highly similar, if not identical.

13. Under section 5(3) the applicant claims that the contested registrations should be invalidated entirely, as they are highly similar to the earlier certification mark and use of the contested registrations will take unfair advantage of, and will be detrimental to, the distinctive character and reputation of the earlier mark. It asserts that use of the contested marks would allow the proprietor to freeride on the applicant's well-consolidated reputation in the certification mark, and this would therefore dilute the distinctive character of that earlier mark. It submits that use of the proprietor's marks would also cause damage to the strong reputation in the registered certification mark.

14. Under the section 5(4)(a) ground of opposition, the applicant states that it has goodwill in the marks set out above, such that use of the contested registrations in respect of the services covered by them would constitute a misrepresentation likely to deceive the relevant public as to the origin of the services in question, resulting in damage to the applicant.

15. Given its filing date, the applicant's certification mark is an earlier mark in accordance with section 6 of the Act. As it had completed the respective registration process more than five years before the filing date of the contested registrations, it is subject to the proof of use provisions contained in section 6A of the Act, however the proprietor did not put the applicant to proof of use and therefore the applicant may rely on all of the services covered under that mark.

16. For the purposes of invalidity under 503802 and 503824, the applicant also relies on sections 3(1)(a), (b) and (c) of the Act; section 3(3)(b) and section 3(6), in respect of all of the proprietor's services.

17. In that regard, the applicant states that the contested registrations are incapable of distinguishing the goods or services of one undertaking from those of another; are devoid of distinctive character; and are descriptive of the kind of services and the location of performance of the services being provided under the offending marks. It submits that the offending marks consist of non-distinctive, descriptive words and figurative elements. It asserts that the words 'Veterinary District Professionals

Association' and 'Veterinary District Nurse' are generic and denote a professional job carried out by veterinary nurses and surgeons across the UK. It states that the services for which the offending marks are registered are services that any qualified veterinarian may carry out in accordance with the Veterinary Surgeons Act 1966 (the "VSA").

18. It adds that the letters VDN contained within contested registration 3434191 are merely an acronym denoting the non-distinctive, descriptive word element 'Veterinary District Nurse' and will be perceived as such by the relevant public, and the figurative element of a paw print contained in both marks is not sufficient to take the marks, as a whole, beyond the minimum degree of distinctive character required for registration, as a paw print element has a direct link to the kind of services for which the offending marks are registered, i.e. veterinary services. It adds that the middle of the paw print element represents a home, which is where the services on offer will be performed.

19. The applicant states therefore that the proprietor's registrations should be declared invalid under section 47(1) of the Act as they both contravene sections 3(1)(a), 3(1)(b) and 3(1)(c).

20. The applicant also states that the contested registrations have been registered contrary to Section 3(3)(b) of the Act because they are of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the services).

21. The applicant states that it is the statutory regulator and governing body of the veterinary profession in the UK, safeguarding the interests of the public and animals by ensuring that only those registered with the applicant can carry out acts of veterinary surgery. It adds that it maintains a Register of Veterinary Nurses (the "Register") qualified to provide supporting nursing care to animals and, under veterinary direction, to undertake certain treatments and procedures that are controlled by law under the Veterinary Surgeons Act 1966 ("Restricted Activities"). The applicant states that it controls entry to the Register and therefore controls who can practice as a qualified veterinary nurse in the UK and accredits qualifications that provide a "licence to practice" as a veterinary nurse. It submits that such qualifications are regulated awards made by either a recognised university or UK awarding organisation. The standards for accreditation of such qualifications and awarding

institutions are stipulated by the Veterinary Nurses Council. In addition, the applicant approves certain training practices. Upon qualification as a veterinary nurse, the applicant awards the nurse with a badge that depicts the certification mark relied upon by the applicant. This mark/badge acts as notification to the public that the veterinary nurse is a qualified veterinary nurse regulated by the Royal College of Veterinary Surgeons.

22. The applicant states that the proprietor is not a regulatory body and does not have the power to control entry to the Register or who may practice as a district veterinary nurse in the UK. It adds that the services provided by the proprietor under the contested registrations are not accredited by the applicant and the proprietor has not been approved by the applicant to provide training under the contested registrations.

23. The applicant submits that it is highly likely that the average consumer would believe that the services provided by the proprietor are endorsed and/or regulated by the applicant and will therefore be performed to a certain standard; that the proprietor offers accredited qualifications under the contested registrations; that the proprietor is providing training practices such as clinical training and professional development, that have been approved by the applicant; and that in order to provide veterinary nursing services in the local community, a veterinary nurse must be employed by or registered with the proprietor, and that the proprietor has the power to prevent a veterinary nurse from providing veterinary nursing services in the local community, as would be the case if the proprietor was a regulatory body.

24. Turning to the claim made under section 3(6), the applicant states that the proprietor made the applications at issue in bad faith. It submits that it is the statutory regulator and governing body of the UK veterinary profession and the owner of UK certification mark 2181252 for the figurative 'Veterinary Nurse' mark displayed above, which covers 'the provision of veterinary assistance and animal nursing services'.

25. The applicant provides the following information relating to a new initiative in support of the claim of bad faith, which it states the proprietor Ms Finzel, as a registered veterinary nurse, would have been fully aware of:

"The applicant and the British Veterinary Nursing Association launched a joint project called 'VN Futures' in October 2015. In July 2016 the 'VN Futures Report

and Action Plan' was published and one of the aims listed was to 'research and develop the district nurse role'. It states that "District RVNs will work within the guidelines of Schedule 3 and continue to work under the direction of a veterinary surgeon".¹

26. The applicant asserts that in that report, "RVN" means Registered Veterinary Nurse and "Schedule 3" is a reference to Schedule 3 of the Veterinary Surgeons Act 1966.

27. The applicant claims that the contested marks and the earlier certification mark all convey a job role that is highly similar and cover identical or highly similar services. It states that Charlotte Finzel (also known as Carla Finzel) is the sole Director and Shareholder of the proprietor company District Veterinary Professionals Ltd and is a registered veterinary nurse. As such, the applicant asserts that Ms Finzel must be aware of the applicant and its function as the statutory regulator for and the governing body of the UK veterinary profession. Ms Finzel would have received the badge depicting the earlier certification mark from the applicant upon qualifying as a veterinary nurse and would have been aware of the VN Futures project and the plans to develop the district nursing role.

28. This being the case, the applicant submits that at the time of filing the applications for registration, Ms Finzel's conduct fell below the standard of acceptable commercial behaviour observed by reasonable and experienced persons in the veterinary profession.

29. The applicant adds that the proprietor is not a statutory regulator and is not entitled to a monopoly right over the words 'Veterinary District Nurse' or 'Veterinary District Professionals Association' in relation to the contested services. It states that it is clear from the conduct of Ms Finzel at the time of filing and since then, that the proprietor is using the offending marks in a similar way to the manner in which the applicant, as a statutory regulator, uses its earlier certification mark. The applicant believes this behaviour falls below the standard of acceptable behaviour expected. As such the applicant claims that the contested registrations are contrary to section 3(6) of the Act,

¹ Paragraph 32 of the Statement of Grounds

having been filed in bad faith and that they should therefore be declared invalid pursuant to section 47(1) of the Act.

30. In respect of cancellation actions 503806 (against 3465150) and 503812 (against 3434191), the applicant applies to revoke both registrations. The applicant relies on section 46(1)(d) and claims that use of the proprietor's marks are liable to mislead the public, particularly as to the nature, quality or geographical origin of the registered goods or services. The revocation actions are directed against all of the registered services of the contested marks.

31. In its statement of grounds under the 503806 and 503812 revocation proceedings, the applicant states that the proprietor of the contested registrations, District Veterinary Professionals Limited, whose sole Director and shareholder is Charlotte (Carla) Finzel, will, as a consequence of the use of UK registrations 3465150 and 3434191, be liable to mislead the public as to the nature, characteristics and/or quality of the services provided under those marks. As such, the applicant states that the contested registrations should be revoked entirely under section 46(1)(d) of the Act.

32. The applicant claims that it is clear from the conduct of Ms Finzel and the proprietor company, that the contested marks are being used in a similar manner to a statutory regulator and/or a governing body, including to introduce a regulatory body; establish a Code of Conduct for Veterinary District Nurses (VDNs); set the standards by which VDNs must operate; establish training standards for VDNs; and provide a Register of qualified VDNs.

33. It bases this claim in part on information set out in Annex 1 to the TM26(O) which provides screenshots from the proprietor/Ms Finzel's Facebook pages including the following:

- The Proprietors/Charlotte Finzel have set up a Facebook page at [https://www.facebook.com/carlafinzeldistrictveterinarynurse/posts/?ref=page internal](https://www.facebook.com/carlafinzeldistrictveterinarynurse/posts/?ref=page_internal) (screenshots of which are attached at Annex 1) which states:

"After a long time planning and preparing, I am pleased to inform you all that we are now ready to move into phase one of creating a register for district veterinary nurses (DVNs).

Our first step is to create a database for all interested parties who wish to part of this exciting development. This includes DVNs already working in the community together with RVNs wishing to progress their career as well as those who may wish to connect with DVN services.

As the register develops, interested RVNs will be issued with an application form requesting further information to enable us to define category 1 registrations and to develop training programmes for category 2 registrants.

It is our intention in due course to connect category 3 registrants with DVNs.

Accordingly we are inviting interested parties to write to us in the first instance to register as one of the following 3 categories:

Category 1: Anyone who is currently working as a Registered Veterinary Nurse in the community.

Category 2: Anyone who is a Registered Veterinary Nurse and is interested in becoming a District Veterinary Nurse.

Category 3: Anyone who is interested in accessing District Veterinary Nursing services (e.g. pet owners, industry, vets, GPs, "Human nurses", social workers, dementia carers etc)."

34. The applicant asserts that Ms Finzel is thereby misrepresenting to the public that the proprietor is a statutory regulator or governing body for VDNs, authorised by and/or associated with the UK government, which is not the case.

35. In addition, the applicant submits that Ms Finzel is misrepresenting to the public that VDNs must register with the proprietor in order to practise as a VDN, which is not the case. The proprietor does not have the power to control entry to the Register or decide who may practice as a VDN in the UK. Further, the applicant claims that Ms Finzel is misrepresenting to the public that any Code of Conduct/standards/training standards or other materials produced by the proprietor under the contested registrations are authorised by the statutory regulator and/or governing body for VDNs, which is not the case. The applicant states that the services covered by the contested registrations include Restricted Activities (as established under Schedule 3 of the VSA) as well as other veterinary nursing services, but these services are accredited by the applicant not the proprietor.

36. The applicant states that as a result, there is a real likelihood that the public and VDNs will be deceived into believing any and all of the following:

- that the services covered by the Registration and offered by the Proprietors are endorsed and regulated by the Revocation Applicant and therefore will be performed to a certain standard defined by the Revocation Applicant;
- that the Proprietors are offering accredited qualifications under the Registration;
- that the Proprietors are providing a training practice under the Registration approved by the Revocation Applicant, such as clinical training, work experience and professional development;
- that the training/subscription/registration fees paid to Charlotte Finzel/the Proprietors for the services provided under the Registration are being paid to the statutory regulator and/or governing body (authorised by and/or associated with the UK government) for VDNs (which is not the case); and
- that in order to provide veterinary nursing services in the local community, i.e. to perform the role of a district veterinary nurse, a veterinary nurse must be employed by or registered with the Proprietors under the Registration and that the Proprietors have the power to prevent a veterinary nurse from providing veterinary nursing services in the local community and using the title veterinary district nurse (as would be the case if the Proprietors were a regulatory body).

37. The applicant states that the deceptive nature of the proprietor's use of the contested marks give rise to a clear and real expectation by VDNs that once registered by the proprietor, they will be regulated by an authorised government agency/public authority, which is not the case.

38. In response the proprietor submitted counterstatements in which it explicitly denied all of the claims made by the applicant in respect of all of the grounds of invalidity and revocation.

39. The proprietor has been represented by Francis McEntergart of MC Legal throughout these proceedings. The applicant has been represented by Penningtons Manches Cooper LLP.

40. A hearing was requested, at which the applicant was represented by Jacqueline Reid of Counsel, instructed by Penningtons Manches Cooper LLP. The proprietor was not represented at the hearing and no submissions in lieu were provided.

41. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Preliminary Issue

42. The applicant has claimed that contested mark 3465150 is not a valid registration and should be declared a nullity. In her submissions to me during the hearing Ms Reid told me that the original name of the applicant in that case was an entity called VDP Ltd. The name of the proprietor of that registration is now District Veterinary Professionals Ltd, matching the name of the proprietor in the other contested registration, 3434191.

43. Ms Reid stated that after VDP Limited applied for and registered 3465150, a form TM21A was filed which initially changed the name of the owner to District Veterinary Professionals Ltd, with Ms Finzel as a joint owner. She told me that a TM21A was not the appropriate way to try and change an owner.

44. Having researched the matter including reference to Companies House records, Ms Reid suggested that, as VDP Ltd did not appear to be a legal entity at the time of filing, the application for 3465150 resulted in a nullity. She also asserted that, as the registration was still in the name of VDP Ltd when District Veterinary Professionals Ltd filed the TM8 defence in this matter, no legitimate defence had been raised to the actions of her client.

45. I have considered this issue carefully and discussed the matter with the IPO Recordals department to establish all of the facts in what is clearly an important point made by the applicant.

46. It is the case that the other contested registration, 3434191, was filed on 6 October 2019 in the name of the current proprietor. This establishes, along with Companies House records, that District Veterinary Professionals Ltd was a legal entity prior to the filing of contested registration 3465150.

47. I note from the TM3 application form for 3465150, filed on 7 February 2020, that the 'Declarant Name' listed on page 4 of that form shows 'Carla Finzel'. This establishes that Ms Finzel was involved in that application at the time of filing, as is the case when looking at the TM3 application form for registration 3434191.

48. It appears to be the case that Ms Finzel, when realising the discrepancies in the names listed on the IPO records for these two registrations, contacted the IPO Recordals department to resolve the matter and align the registrations under a single, correct name. Initially a form TM21A was relied upon, erroneously, as Ms Reid correctly points out. Following further engagement with IPO colleagues, Ms Finzel submitted a form TM26(R) on 4 October 2021, and stated that at the time of filing 3465150, VDP Ltd were incorrectly filed as owners, an error which she wished to have rectified. The Recordals department accepted Ms Finzel's statement and rectified the records accordingly.

49. The form TM26(R) is used to correct the name or address of a registered owner because of a clerical error - 'Application to rectify the register'.

50. Section 64 of the Act reads:

(1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) ...

(3) Except where the registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

51. I am satisfied that, as District Veterinary Professionals Ltd was a legal entity prior to the filing of 3465150, and was the name provided in the application for 3434191,

with Ms Carla Finzel instrumental in both applications (and being a person having a sufficient interest in these matters), the provision of 'VDP Ltd' as the applicant name in 3465150 was an error which can and has been rectified. As the effect of rectification is that the error will be treated as if it had never been made, the filing of the TM8 by District Veterinary Professionals Ltd is not an issue.

52. Ms Reid pointed out to me that there were anomalies between the addresses used by the various parties. This is true however I note that all three addresses involved (Ms Finzel's, VDP Ltd's and District Veterinary Professionals Ltd's) are all geographically within 5 miles of each other in West Sussex and within the BN post code. This does not strike me as particularly unusual and does not alter my conclusion that the rectification that has taken place under 3465150 is reasonable.

53. That being the case, I find that contested registration 3465150 remains valid for the purposes of these proceedings.

The Proprietor's submissions

54. The proprietor filed written submissions on 10 March 2022, comprising a witness statement of Mr McEntegart, dated 1 March 2022. The proprietor also submitted evidence, however this evidence was rejected in the official letter of 11 March 2022 and was not re-submitted later in an appropriate format. With no additional written submissions or attendance at the main hearing, I have only the witness statement of Mr McEntegart to consider, over and above the counterstatements provided by the proprietor in each defence.

55. In his witness statement, Mr McEntegart set out the following arguments against the claims made by the cancellation applicant:

- Regarding cancellation actions 503812 and 503806 intended to revoke the contested registrations on the basis of section 46(1)(d), Mr McEntegart asserts that his client's marks do not mislead the relevant general public and that the registered proprietor, as a registered veterinary nurse, provides services in accordance with the requirements of The Veterinary Surgeons Act, under a registered veterinary surgeon. He adds that the registered proprietor has

provided these services since 2015 and has consulted with the cancellation applicant during that time.

- Mr McEntergart states that his client does not claim to be a statutory body but states that the cancellation applicant has known of his client's services for many years and there have been no issues. He adds that his client does not consider that veterinary nurses providing services under the contested marks would operate outside of the requirements of the VSA and therefore none of the activities fall under the Restrictive Activities as set out in the VSA.
- Mr McEntergart asserts that there can be no deception with respect to the services of his client as the consumers of these services are delighted to be able to access these services in their own homes and the veterinary nurses carrying out these services are working with the registered proprietor and under their relevant veterinary surgeon and are well aware of their obligations under the VSA.
- Regarding cancellation actions 503802 and 503824, Mr McEntergart states that under section 3(3)(b) the proprietor's services do not deceive the relevant public as those professionals working with his client are aware of the compliance requirements of the VSA and the regulations of the cancellation applicant. He adds that the trade marks in dispute contain words but also distinctive figurative elements that create distinctive marks and that the proprietor does not claim monopoly rights to the words alone but only to the trade marks as a whole.
- Mr McEntergart submits that the services provided by his client are operated in accordance with the VSA and always under a registered veterinary surgeon, and as such under the regulations of the cancellation applicant.
- Regarding the section 3(6) ground of invalidation, Mr McEntergart states that his client's trade marks were made in good faith. He adds that the cancellation applicant's claims that his client's marks are identical or highly similar to its earlier certification mark is incorrect as the marks are conceptually and visually very different and the registered proprietor makes no claim to a monopoly in the word elements of the contested marks.

- Regarding the section 5(3) ground of invalidation, Mr McEntergart submits that the marks at issue are not similar and as such there could be no confusion by the relevant public.
- In respect of the section 5(4)(a) ground of invalidation, Mr McEntergart asserts that the applicant has not provided any evidence of confusion by the relevant public or any loss suffered by the applicant (actual or likely). He states that use of his client's marks would not cause any confusion to the relevant public.
- Regarding the section 5(2)(b) ground of invalidation, Mr McEntergart states that the marks at issue are not similar. He states that the applicant's mark is an oval shape containing a sketched drawing of St Francis of Assisi accompanied by three animals, whilst his client's marks include an image of a cartoon kennel which is also the central part of an animal paw.
- Turning to the grounds of invalidation under sections 3(1)(a), (b) and (c) of the Act, Mr McEntergart claims that both of his client's marks are distinctive and therefore do not contravene section 3(1) of the Act.

Evidence of the applicant

56. The applicant ("RCVS") is not required to prove use of the mark relied upon for the purposes of section 5(2)(b) of the Act, however it must prove that the earlier mark is reputed and that it holds goodwill, for the purposes of section 5(3) and section 5(4)(a).

57. The evidence of the applicant comprises a witness statement of Eleanor Ferguson dated 21 December 2021, with accompanying exhibits EF1 – EF34. Ms Ferguson is the Registrar and Director of Legal Services at the Royal College of Veterinary Surgeons ("RCVS").

58. The applicant refers to evidence within Exhibits EF26-EF33 and Annex 1 of the TM7, where it states that the registered proprietor Charlotte Finzel (also known as Carla Finzel) is the sole director and shareholder of District Veterinary Professionals Ltd, the proprietor. This information also shows Ms Finzels' use of the marks at issue

on a Facebook group and an article dated 26 February 2020 (provided within exhibit EF28) in which Ms Finzel states her intention to:

Introduce a regulatory body; establish a Code of Conduct for veterinary District Nurses (VDNs); set the standards by which VDNs must operate; establish training standards for VDNs and provide a Register of qualified VDNs.

59. This evidence also includes minutes from a British Veterinary Association meeting dated 11 December 2020, raising concerns about Ms Finzel's actions amongst the Veterinary Nurse community.

60. The applicant submits that the proprietor is using the contested registrations in a similar manner to a statutory regulator and/or governing body. It states that the proprietor misrepresents to the public that it is a statutory regulator or governing body and that VDNs must register with it in order to practice, which is not the case. The applicant states that the proprietor does not have the power or authority to control who may practice as a VDN in the UK. It adds that the services covered by the contested registrations include Restricted Activities.

61. As a result, the applicant submits that the public and VDNs will be deceived into believing that the services offered by the proprietor are endorsed and regulated by the applicant and will therefore be performed to a certain standard defined by the applicant; that the proprietor offers accredited qualifications under the contested registrations; that the training provided by the proprietor under the contested marks has been approved by the applicant; that fees being paid to the proprietor are being paid to the statutory regulator and/or governing body for VDNs; and that in order to provide veterinary nursing services in the local community, a veterinary nurse must be employed by or registered with the proprietor and that the proprietor has the power to prevent a veterinary nurse from providing veterinary nursing services in the community and/or from using the title of Veterinary District Nurse (which might be the case if the proprietor were a regulatory body).

62. The applicant goes on to state that the deceptive nature of the proprietor's use of the contested registrations gives rise to a clear and real expectation by VDNs that once registered by the proprietor, they will be regulated by an authorised government agency/public authority. The applicant re-asserts therefore that under section 46(1)(d)

of the Act the contested registrations should be revoked entirely, as they are liable to mislead the relevant public as to the nature, characteristics and/or quality of the services provided.

63. In her witness statement Ms Ferguson provides information relating to a supplementary Royal Charter of 2015, which introduced the requirement for veterinary nurses to be regulated professionals and made registration a necessity for veterinary nurses wishing to work in the UK, in the following manner:

The RCVS's supplemental Royal Charter provides that:

"12. The College shall continue to keep a list of veterinary nurses, and the list is to be known as the register of veterinary nurses. A veterinary nurse who is registered in the register of veterinary nurses shall be an associate of the College.

13. There shall continue to be a committee of the Council whose functions shall encompass the regulation of the profession of veterinary nurse and that committee shall be known as the Veterinary Nurses' Council.

14. The Veterinary Nurses' Council shall set standards for the training and education of persons wishing to be entered in the register of veterinary nurses.

15. The Veterinary Nurses' Council shall set requirements in relation to the registration of veterinary nurses. Persons who satisfy the standards set by the committee in relation to education and training shall be entitled to be entered in the register of veterinary nurses, subject to compliance with such other requirements as may be set in Bye-laws of the College including, but not limited to, the payment of a registration fee and a requirement that they be of good character.

16. The Veterinary Nurses' Council shall set standards for the conduct of veterinary nurses. Breaches of standards set by the committee may render a person entered in the register of veterinary nurses liable to disciplinary proceedings in accordance with any relevant Bye-laws or rules."

In this paragraph, "the College" means the RCVS.

64. An article from the applicant explaining the supplemental Royal Charter is provided under Exhibit EF2.

65. Ms Ferguson sets out in paragraph 45 of her witness statement, the following DEFRA comment regarding regulation of the term Veterinary Nurse:

On 8 January 2016, the Department for Environment, Farming and Rural Affairs (DEFRA), responded to a petition organised in part by the RCVS calling for the title "veterinary nurse" to be protected in statute. Their response states:

[W]hat sets professional veterinary nurses apart from other animal care workers is that they can perform certain tasks which ordinarily by law would be restricted to a veterinary surgeon; namely the provision of medical treatment and the carrying out of minor surgery. No person may undertake this full range of activity that we

consider to be "veterinary nursing" unless they are appropriately trained and qualified, regardless of any title they might use.

This safeguarding of animal welfare is provided for through provisions in both the Veterinary Surgeons Act 1966 and the Supplemental Charter 2015 of the Royal College of Veterinary Surgeons (RCVS). Together these ensure that a veterinary nurse (VN) can treat animals only when: the animal is under the care of a registered veterinary surgeon; the treatment is carried out under the direction of that veterinary surgeon who is the employer (or acting on behalf of the employer) of the VN; the veterinary surgeon is satisfied that the VN is qualified to carry out the treatment; the VN is registered with the RCVS. Registration brings with it professional responsibilities such as compliance with a code of conduct and an obligation to keep skills up-to-date.

*The RCVS register of veterinary nurses is publicly available to any animal owner who wishes to be sure that their veterinary nurse is properly qualified to treat their animal. We would encourage them to do so. The register can be searched via the RCVS website at the following link
<https://www.rcvs.org.uk/registration/check-the-register/>*

Given the legal protection already in place to make sure that animals in veterinary care are treated only by individuals who are trained and qualified to do so, we believe that criminalising the use of the term "veterinary nurse" by other animal carers in a veterinary setting to be an unduly harsh solution

66. In respect of the section 5(3) and section 5(4)(a) grounds of invalidation, the applicant has provided a large number of exhibits which set out the history of the use of the term Veterinary Nurse, and a substantial amount of information relating to some wider issues such as the drive for statutory regulation of veterinary nursing; background information relating to the RCVS and regulation of veterinary surgeons and nurses; the activities of the Veterinary Nurses Council, which was established in 2002 and has overall responsibility for all matters concerning veterinary nurse training, post-qualification awards and the registration of qualified nurses; and use of the earlier certification mark on badge, indicating that the wearer is a qualified registered veterinary nurse 'RVN'.

67. I do not intend to summarise this evidence to any great degree as it is significant in volume. I will however set out my conclusions as to the pertinent aspects of that evidence:

68. It is clear that the term Veterinary Nurse has been used by the applicant for some time. It claims use from 1984, however evidence for this is not entirely clear. The evidence of the applicant provides some limited examples of the earlier certification mark relied upon, however much of this is simply comprised photographs of badges upon which the mark is placed, and these photographs are largely undated (Exhibit EF10 for example). Exhibit EF11 comprises a single page document titled 'Your RCVS veterinary nursing badge' which shows the earlier certification mark, albeit a variant version, with the word 'REGISTERED' added to the base of the mark. This document outlines what the badge signifies, when it should be worn, how it should be worn etc. EF11 is not dated, however.

69. Ms Ferguson states that the non-statutory Register of veterinary nurses was opened by the RCVS in 2007 and a Guide to Professional Conduct of veterinary nurses was developed.

70. The applicant provides statistical information as to the numbers of registered veterinary nurses on a yearly basis from 2002 to 2021. In 2020 there were 18,480 registered veterinary nurses in the UK, up from 17,169 in 2019.

71. The applicant claims that the applicant's communications team, which comprises 15 staff members, spends around 40-50% of its time annually raising awareness of the applicant's activities in relation to veterinary nursing. Exhibits EF13 and EF14 provide screenshots of the applicant's website between 1999 and 2011 and screenshots of the applicant's social media presence on Twitter, Facebook, LinkedIn and Instagram. The figurative certification mark relied upon does not appear to be present on any of this information, however the unregistered terms relied upon for the purposes of section 5(4)(a), namely: 'Veterinary Nurse' and 'VETERINARY NURSE' are used extensively throughout the applicant's evidence, albeit in what largely appears to be a descriptive nature.

72. The applicant states that it attends events and conferences to promote the Veterinary Nurse name and its services. It submits that it has attended the London Vet Show since it started in 2012 and also attended BBC Countryfile Live at Blenheim and

York, Devon County show, Royal Welsh Show and the Royal Highland Show between 2016 and 2019, as further examples of the promotion of the role of veterinary nurses.

73. At paragraph 22 of Ms Ferguson's witness statement, she refers to the VN Futures project which was launched in October 2015 as a joint project between the applicant and the British Veterinary Nursing Association ("BVNA"), from which one action point raised in the "VN Futures Report and Action Plan" of July 2016, was to "research and develop the district nurse role". The full Report is provided under Exhibit EF8.

74. The applicant's evidence also focuses, to a significant extent, on the use that the proprietor, generally under the name of Ms Finzel, makes of the contested registrations, in order to support its claims of deceptiveness and bad faith under section 3(3)(b) and section 3(6), and the claim under section 46(1)(d) that the contested marks will mislead the public.

75. At the hearing before me, Ms Reid made submissions that largely reflected the statements made in the applicant's statements of grounds in the TM7 forms, and I note that the majority of Ms Reid's submissions focussed on the grounds brought under section 46(1)(d), section 3(3)(b) and section 3(6).

76. I will reference Ms Reid's submissions where necessary throughout my decision.

Decision

77. For the sake of procedural economy, I will begin by considering the invalidation actions brought by the applicant under sections 3(1)(a), 3(1)(b) and 3(1)(c) of the Act, as I believe that these issues may be dealt with relatively briefly.

78. In respect of invalidation proceedings, grounds based on section 3 of the Act are relevant because of the provisions set out in section 47 of the Act, the relevant parts are set out as follows:

79. Section 47 of the Act states:

"(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

80. Section 3(1) states that:

“3(1) The following shall not be registered –

(a) signs which do not satisfy the requirements of section 1(1)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

[...]”

81. Section 1(1) states that:

“1(1) In this Act “trade mark” means any sign which is capable-

(a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and

(b) of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”

82. The marks at issue are:



83. Having considered the relevant case law, I dismiss the grounds of invalidation brought under all three subsections of section 3(1) of the Act. It is clear that both contested registrations are graphically represented, enabling the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor in both marks. It is also clear, in my opinion, that the marks at issue are not, when considered as a whole, devoid of any distinctive character, and do not consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services.

84. The applicant has claimed that elements within the contested marks, such as the figurative paw print and ‘house’ device, or the letters VDN, are entirely lacking in distinctive character and/or would be merely perceived by the relevant public as

indicative of what services are provided (the paw print indicating animal services) and the location of those services (the house device at the centre of the paw print).

85. I disagree with the applicant. Whilst consideration of individual elements within a complex mark can be important during a global, or multi-factorial, assessment of a mark, ultimately, when considering an application for registration under section 3(1) of the Act, it is the whole that must be taken into account. The inclusion of non-distinctive or descriptive words and figurative elements, as is the case here, with e.g. the use of the words 'veterinary', 'district' or 'association' and the device of a paw print, does not overwhelm or detract from the overall impression provided under each mark, which is that of a distinctive mark that does not comprise exclusively of descriptive matter.

86. Therefore the invalidation actions brought under section 3(1)(a), section 3(1)(b) and section 3(1)(c) of the Act against both registrations have failed.

87. I now move on to consider the invalidation actions brought against both marks under section 5(2)(b), section 5(3) and section 5(4)(a).

Section 5(2)(b)

88. Section 5(2)(b) of the Act states:

“5. (2) A trade mark shall not be registered if because –

(a) ...

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

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

The principles

89. The following principles for determining whether there is a likelihood of confusion under section 5(2)(b) of the Act are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon*

Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;



(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

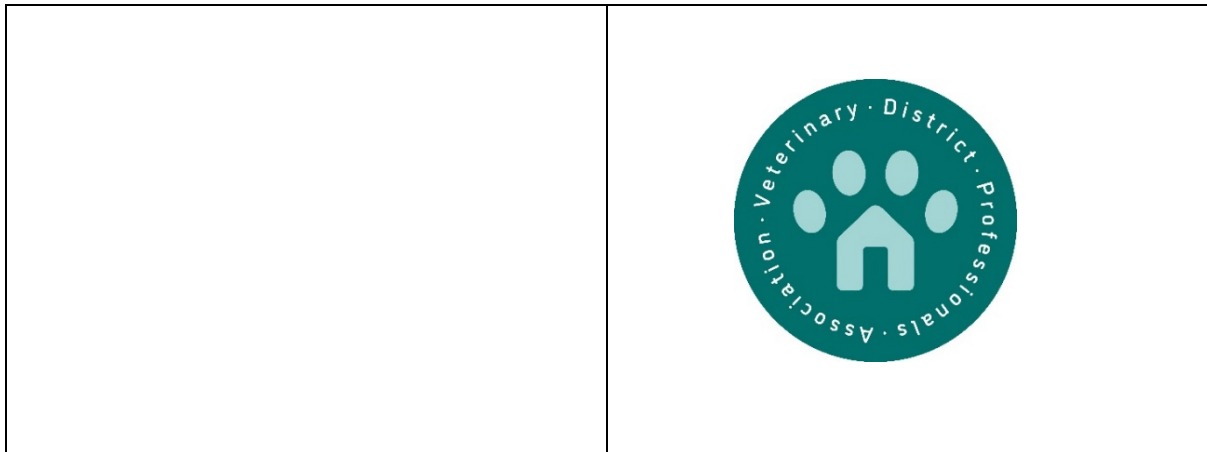
(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the services

90. For the sake of procedural economy I will proceed on the basis that all of the contested services under both of the proprietor's marks are identical to the services of the applicant's earlier mark.

Comparison of the marks

Earlier Mark	Contested Marks
	<p data-bbox="1027 1379 1171 1413"><u>First mark</u></p>  <p data-bbox="991 1834 1179 1868"><u>Second mark</u></p>



Overall impression

91. The earlier mark is a complex figurative mark combining the words VETERINARY NURSE and an oval shaped device element that contains a human figure and several small animals in an open environment. The figurative aspects of the mark are larger and can be said to dominate, although the verbal elements, even when placed at the base of the mark, forming the smaller element, will not be overlooked or go unnoticed and do play a significant role in the mark. The figurative element of a human figure with animals can be said to be the more distinctive aspect in the earlier mark as the words VETERINARY NURSE can be said to be entirely descriptive given the context of the services offered under that mark.

92. The first contested mark is also a complex figurative mark combining the letters VDN with a device element that can be described as a paw print with a house element set in the middle of the pad, with the words Veterinary District Nurse presented to the right-hand side of that figurative element. Neither aspect can be said to be dominant however, the words can be said to be the less distinctive part of that mark given the nature of the services provided by the proprietor.

93. The second contested mark is also a complex figurative mark that comprises a dark green circle, within which is the same paw print device found in the first contested mark presented in a lighter green colour, and the words 'Veterinary District Professionals Association' that run around the inside of the circle device and are presented in the same light green colour as the paw/house device. Due to the size of the paw device and the non-distinctive, descriptive nature of the verbal elements, the

paw device dominates this mark and can be said to be the most distinctive aspect of it.

Visual Comparison

94. Visually the marks all share the word 'veterinary', and the earlier mark and first contested mark also share the word 'nurse'. Aside from these shared verbal elements, which are presented in different styles and colours, the marks have no other visual similarities. They differ in all of their figurative and device elements, aside from an oval and a circular border, and I conclude that they can be said to be visually similar, to no more than a very low degree.

Aural Comparison

95. All three marks share the word 'veterinary', and the earlier mark also shares the word 'nurse' with the first contested mark. The marks differ in that the word 'district' and the acronym 'VDN' of the first earlier mark, and the words 'district professionals association' do not have a counterpart in the applicant's earlier mark. I find the earlier mark and the first contested mark to be aurally similar to a medium degree where the acronym VDN is not articulated but similar aurally to only a low degree where VDN is spoken. I find the earlier mark and the second contested mark to be aurally similar to no more than a low degree.

Conceptual Comparison

96. The marks share the concept of 'veterinary' which will be commonly understood amongst the relevant public as relating to animal care. The earlier mark and the first contested mark also share the concept of 'nurse' which will also be commonly understood. The concept of 'district' in both contested marks, and a 'professionals association' in the second contested mark have no counterpart in the earlier mark. The concept that may be conveyed by the figurative device of a human and animals in the earlier mark is not shared in the contested marks, and the pawprint device and the 'house' device contained in the contested marks are not shared by the earlier mark. Given the shared concept in 'veterinary' and 'nurse' I find that the earlier mark and the first contested mark are conceptually similar to a medium degree. As they only share

the concept conveyed by the term 'veterinary', I find the earlier mark and the second contested mark to be conceptually similar to a low degree.

Distinctive character of the earlier mark

97. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion². The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

98. “In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings” - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

99. Trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it.

100. Whilst the applicant has provided evidence in support of the use of the earlier mark relied upon, I have found that this evidence is quite limited in a number of areas and as a result I do not accept that the earlier mark can be said to enjoy an enhanced degree of distinctive character by virtue of the use made of it prior to the filing of the contested registrations. As a result, the applicant may only rely upon the inherent distinctive character in its mark.

101. I find that the earlier mark has an obvious link to the services at issue due to the inclusion of the words VETERINARY NURSE, however the incorporation of the

² *Sabel BV v Puma AG*, Case C-251/95, § 24

figurative elements with the verbal elements combines to create a distinctive whole. I therefore conclude that the applicant's mark is inherently distinctive to a medium degree.

Average consumer and the purchasing act

102. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

103. The services at issue are all related to veterinary and health care services, including the provision of care, education and training in those areas, predominantly being provided to animals and pets. The average consumer of these services will be a veterinary professional and/or a member of the public looking for medical advice and care services for their pets and animals. These services will be selected from high street establishments and retail outlets, and via advertisements provided in traditional media such as newspapers, or online in specialist websites.

104. I consider the purchasing process to be predominantly visual. However, I do not discount that there may be an aural component to the process, given that word-of-mouth recommendations may be made, or discussions may take place over the telephone. Due to the nature of the services being provided, although the price and frequency of purchase of the services may vary, the level of attention involved will be

at least medium for both types of consumer, with the more specialist and sophisticated services attracting a higher degree of attention, albeit not the highest level.

Likelihood of confusion

105. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

106. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

107. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises that the marks are different but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

108. These examples are not exhaustive but provide helpful focus.

109. I have concluded that the services at issue are identical. The competing marks have been found to be visually similar to no more than a low degree and aurally/conceptually similar to between a medium and a low degree. The average consumer of the services in issue will be members of the general public and professionals, who will select the services primarily through visual means, though I have considered an aural component in the selection process as well. I have concluded that the level of attention exercised during the purchasing process will range from at least average to slightly higher than average, depending on the consumer group and the precise nature of the services required. I have found the applicant’s mark to have a medium degree of distinctive character.

110. Having considered all of the findings and case law set out above, I come to the view that direct confusion will not occur. Although the marks share certain aspects, namely the words ‘veterinary’ and ‘nurse’, they are elements which have been found

to be non-distinctive and descriptive in each mark and are not considered to be dominant elements within the respective marks. I find that the additional verbal elements and figurative elements in the marks (notwithstanding the interdependency principal and a finding of identical services; or the notion of imperfect recollection), are more than sufficient to ensure that the average consumer will not mistake one mark for the other.

111. Having concluded that direct confusion will not occur, I go on to consider the possibility of indirect confusion.

112. I remind myself of the comments set out above of Mr Purvis QC in *LA Sugar Limited*, where he identified categories that might support a claim of indirect confusion.

113. In this instance the common element between the marks can be said to be the words 'veterinary' and/or 'nurse'. These words are considered to be entirely descriptive and non-distinctive within the context of the services at issue. The differences found in the contested registrations, e.g. the acronym 'VDN', the figurative pawprint devices or the overall 'get-up' found in both contested marks, cannot be said to be logical brand extensions of the applicant's earlier mark, nor can they be said to be non-distinctive additions to the earlier mark relied upon. The shared elements 'veterinary' and 'veterinary nurse' cannot be said to be particularly striking, to the degree that one might expect only a single undertaking to be using that element. In the alternative, I have found those shared elements to be entirely descriptive and non-distinctive. That being the case, I find that indirect confusion will not occur.

114. Having found that no direct or indirect confusion will occur in respect of either of the contested registrations, the invalidation actions, insofar as they are based on section 5(2)(b), have failed.

115. I now move on to consider the section 5(3) ground of invalidation.

Section 5(3)

116. Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

117. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and *the court's answer to question 1 in L'Oreal v Bellure*).

118. An invalidation based on section 5(3) of the Act can only be successful via the establishment of several individual elements, the cumulation of which must satisfy all elements of the claim. To be successful on this ground, the applicant must prove that

it holds a reputation in the earlier figurative certification mark that it relies upon, amongst a significant portion of the public.

Reputation

119. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

120. The applicant claimed to have a reputation for the services on which it relied for the purposes of the section 5(2)(b) ground of invalidation. This was denied by the proprietor and, following my assessment of the applicant’s evidence, I find that the applicant has not proven that it enjoys a reputation for the services claimed.

121. In its evidence, the applicant has provided no indication of market share and very little information relating to promotional or marketing activities undertaken to raise brand profile. No financial figures have been provided to show the level of marketing and promotional activities undertaken in respect of the figurative certification mark. No financial figures have been provided to indicate any sales of services, or turnover

generated under the earlier mark. With no third-party evidence or testimony to support a claim of reputation, I conclude that the applicant has not shown that its earlier figurative mark is known by a significant part of the public concerned by the services covered by that mark. That being the case, the invalidation actions, insofar as they are based on section 5(3), must fail.

122. I now move on to consider the section 5(4)(a) grounds of invalidation.

Section 5(4)(a)

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

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

(a) by virtue of any rule or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection 4(A) is met ...”

124. Subsection 4(A) is as follows:

“The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

125. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341, HL, Lord Oliver of Aylmerton described the ‘classical trinity’ that must be proved if a claim of passing off is to succeed:

“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 a 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 the 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."³

Relevant Date

126. In *Advanced Perimeter Systems v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*, BL O/212/06:

"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."⁴

127. The proprietor has not claimed to have used the contested marks before the dates of application and so the relevant dates are 6 October 2019 in respect of contested registration 3434191, and 7 February 2020 in respect of contested registration 3465150.

Goodwill

128. The applicant must show that it had goodwill in a business at the relevant dates and that the marks relied upon are associated with, or distinctive of, that business.

129. The applicant claims to have used the figurative mark:

³ Page 406.

⁴ Quoted in paragraph 43 of BL O-410-11.



throughout the UK since at least 1984 on the following services: 'provision of veterinary assistance and animal nursing services'.

130. The applicant also states that it has used the mark '**VETERINARY NURSE**' throughout the UK since 1984 in respect of 'provision of veterinary assistance and animal nursing services', and that it has used the mark '**Veterinary Nurse**' since 1984 throughout the UK on 'Veterinary nursing services including the provision of veterinary assistance and animal nursing services'.

131. The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantages 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has the power of attraction sufficient to bring customers home to the source from which it emanates."

132. 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 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 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.”

133. 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.”

134. In *Smart Planet Technologies, Inc. v Rajinda Sharm* [BL O/304/20], Mr Thomas Mitcheson QC, as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31,

paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

135. I have already summarised the applicant’s evidence and having considered it carefully, I conclude that there is little evidence of the figurative mark being used other than on badges, which the applicant issues to veterinary nurses. It appears on some power point slides that the applicant has provided with background material, however this is extremely limited evidence. There is no indication at all of any sales of services either by the applicant or authorised users of the figurative mark, and very little evidence of promotion and marketing under the figurative mark. The applicant has provided no evidence from the trade or the public to support its claims.

136. The use of the plain word marks relied upon, which I conclude are essentially the same mark: ‘VETERINARY NURSE/Veterinary Nurse’, is, in my opinion, entirely descriptive in nature and I do not find that this use supports the applicant’s case. Within the context of the services at issue, the term ‘Veterinary Nurse’ will not be perceived by the relevant public, whether that be a qualified veterinary professional or a member of the public seeking veterinary services, as a distinctive expression but simply as a description of a person who can administer veterinary assistance. The applicant’s evidence does not persuade me that the relevant public will view the plain words ‘Veterinary Nurse’ as a sign which is distinctive of the applicant’s business.

137. Taking the evidence as a whole, I conclude that it does not support a finding of goodwill. I come to this finding based on the evidence before me and application of the relevant case law set out above. It seems clear to me that at the relevant date none of the marks relied upon will have been known to a

significant part of the relevant public as anything other than a non-distinctive and descriptive expression and as such, they cannot be said to be distinctive of the applicant's business.

138. As goodwill has not been established, the invalidation actions, insofar as they are based on section 5(4)(a), have failed.

139. I now move on to consider jointly, the invalidation actions brought under section 3(3)(b), and revocation actions 503806 & 503812, which have been brought under section 46(1)(d).

140. Section 3(3)(b) of the Act states:

“3(3)(b) A trade mark shall not be registered if it is—

(a) ...

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

141. Section 46(1)(d) reads as follows:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) ...

(b) ...

(c) ...

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.”

142. In *Cormeton Fire Protection Ltd v Cormeton Electronics Ltd & Anor* [2021] EWHC 11 (IPEC), it was alleged that the use of the mark was deceptive because there had been at least a partial separation of the goodwill, meaning that the mark was no longer

distinctive of a single undertaking and had therefore become misleading. Dismissing the argument, David Stone, sitting as a Deputy High Court Judge, said:

“85. First, in relation to the law, as I have already noted, section 3(3)(b) is in the part of the TMA which deals with absolute grounds of refusal. Absolute grounds are those that pertain to the mark itself – for example, marks devoid of distinctive character, marks which denote kind or quality, certain types of shape marks, and marks contrary to public policy. That is already a clear guide to the interpretation of section 3(3)(b) – it is clearly not aimed at preventing registration of marks in which a third party may own rights.

86. Next, the section itself lists, albeit non-exclusively, examples of types of mark which may deceive the public – “for instance as to the nature, quality or geographical origin of the goods or services”. Counsel for the Defendants submitted that this list is not closed, and I accept that submission. But the examples given are all absolute grounds examples, concerned with deception about the nature of the goods or services on offer. None of the examples given relates to the message that may be conveyed about the business origins of the goods or services provided under the mark.

87. Third, this position is entirely consistent with the limited case law on section 3(3)(b) and its equivalents in the EU instruments I have referred to above [...]”.

143. He summarised the findings in *Case C-259/04 Elizabeth Florence Emanuel v Continental Shelf 128 Ltd* [2006] ETMR 56, *Melly's Trade Mark Application* [2008] ETMR 41, *Sworders Trade Mark* (BL O/212/06 and *Case C-689/15 WF Gözze Frottierweberei v Verein Bremer Baumwollbörse* [2017] Bus LR 1795 and said:

“87. [...] These four decisions speak with one voice – section 3(3)(b) of the TMA refers to per se or absolute grounds.

88. Fourth, if the Defendants are right, their interpretation would drive a coach and horses through the relative grounds provisions in section 5 of the TMA. All an earlier right owner would need to do would be to allege public deception, without first having to comply with the requirements for identical or similar marks,

identical or similar goods/services, or ownership of a mark with reputation. This cannot be what the legislature intended.

89. Therefore, in my judgment, section 3(3)(b) of the TMA is not engaged where the only "deception" is as to who is using the mark to provide goods or services. That sort of deception is remediable under the relative grounds for refusal of registration to be found in section 5 of the TMA. The Defendants' application for invalidity under section 3(3)(b) fails.”.

144. Noting the CJEU’s finding at paragraph 53 of *Elizabeth Emanuel* that the conditions for revocation under s. 46(1)(d) are the same as those for refusal of registration under s. 3(3)(b), he also dismissed the allegation of deceptiveness based upon s. 46(1)(d):

“98. In my judgment, for the same reasons as I have set out above in relation to section 3(3)(b) of the TMA, section 46(1)(d) of the TMA is not engaged where the only "deception" is as to who is using the mark to provide goods or services. That sort of deception is remediable under the relative grounds for revocation of a registration. The Defendants' application for revocation under section 46(1)(d) also fails”.

145. I believe that the findings of Justice Stone apply equally to the matter at hand. The applicant has set out in detail its concerns regarding the possibility of deception and a misleading of the relevant public, under section 3(3)(b) and section 46(1)(d), due to the proprietor’s use of the contested registrations. I do not intend to set out the applicant’s arguments again here, as they have been summarised in some detail above.⁵ I note however, that predominantly the focus of the applicant’s concerns appears to be that the relevant public will be misled or deceived into believing that the services of the proprietor have been endorsed or approved by the applicant, who is the appropriate regulatory body for veterinary nursing in the UK. The applicant does not appear to suggest that the services provided by the proprietor will be of a poor or low quality. I note that the applicant also asserts that consumers may be deceived into thinking they are achieving an accredited qualification when taking up the proprietor’s services, however I find that this argument is based on the claimed behaviour of the

⁵ Paragraphs 20-23 and 30-37 of this decision

proprietor, rather than on the marks or the content presented within the marks themselves. I find that the marks themselves do not deceive the public as nothing in them suggests that the services offered will result in accredited qualifications.

146. Therefore, in line with Justice Stone's conclusions in the *Cormeton* case, and for the reasons he has given in that decision, I find that the relevant public will not be deceived or misled by the proprietor's use of the contested marks.

147. The invalidation actions brought under section 3(3)(b), and the revocation actions brought under section 46(1)(d) have therefore failed.

148. I now move on to consider the invalidation actions brought under section 3(6).

149. Section 3(6) of the Act states:

"3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

150. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli*, CJEU, Case C 529/07, *Malaysia Dairy Industries*, CJEU, Case C-320/12, *Koton*, CJEU, Case C-104/18P, *Sky v Skykick*, CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO*, General Court of the EU, Case T-82/14, *Daawat Trade Mark*, The Appointed Person, [2003] RPC 11, *Saxon Trade Mark*, [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark*, The Appointed Person, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

151. The law appears to be:

(a) While in everyday language the concept of 'bad faith' involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky CJEU*.

(b) Applying to register a trade mark without an intention to use it is not bad faith per se. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU*.

(c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU*.

(d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU*.

(e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky EWHC and Copernicus-Trademarks v EUIPO*.

(f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky CJEU*.

(g) This may be the case where the applicant has included a specific term in the specification, such as 'computer games', with no intention of using the mark in relation to any such goods, simply to obstruct third parties from using or registering the same mark, or similar marks. It may also be the case where the applicant has included a broad term, such as 'computer software', with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using the mark in relation to all the other (sometimes very different) sub-categories of goods/services covered by the

broad term, with the objective of obstructing third parties from using or registering the mark in relation to such goods/services: *Sky EWHC*.

(h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future (even if there were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky EWHC*. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

152. The following points are apparent from the pre-Sky case-law about registering trade marks in bad faith:

(a) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(b) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(c) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat*, or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited*.

(d) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another

party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro*; or where a legal agreement prohibits such a filing.

153. The correct approach to the assessment of bad faith claims was set out in *Alexander Trade Mark*, the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested application could not be properly filed? and

(c) Was it established that the contested application was filed in pursuit of that objective?

154. The applicant's intention (i.e. objective) is a subjective factor which must be determined objectively by the competent authority. An overall assessment is required, which must take account of all the factual circumstances relevant to the particular case: *Lindt*.

155. The matter must be judged at the relevant date, which is the date of the application for registration: *Lindt*.

156. It is necessary to ascertain what the applicant knew at the relevant date: *Red Bull*. Evidence about subsequent events may be relevant, if it casts light backwards on the position at the relevant date: *Hotel Cipriani*.

157. An allegation of bad faith is a serious allegation which must be distinctly proved, but in deciding whether it has been proved, the usual civil evidence standard applies (i.e. balance of probability). This means that it is not enough to establish facts which are as consistent with good faith as bad faith: *Red Bull*.

158. Bad faith has been defined as dishonest behaviour and dealings falling short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area (*Gromax Plasticulture Ltd v Don & Low*

Nonwovens Ltd [1999] RPC 367 at 379). In *Red Bull v Sun Mark*, it was emphasised that convincing evidence of bad faith is required due to the seriousness of the allegation ((*Red Bull GmbH v Sun Mark Ltd and Sea Air & Land Forwarding Ltd*) [2012] EWHC 1929 (Ch) at 133).

159. As it is the date on which the applications were filed that is relevant for a case of bad faith, the relevant dates for the purposes of these proceedings are 6 October 2019 and 7 February 2020.

Assessment

160. When coming to a decision in this matter I have considered carefully all of the submissions and evidence that the applicant has provided, and the detailed submissions of Ms Reid during the hearing before me.

161. I do not intend to set out the applicant's statements in respect of the bad faith claim in great detail here, as they have been summarised earlier in my decision.⁶ However, I do reflect on the comments of Ms Reid, and in particular the following submissions:

"It is clear that Ms. Finzel is fully aware of the applicant. She is on the Royal College of Veterinary Surgeons Register. She is fully aware that there is already a statutory basis for control and provision of these regulated services. She was fully aware that she is not a regulator for veterinary nurses or accredited to train or authorised to provide regulated services. She would have been aware that she is not entitled to seek to exclude people from using the term "veterinary nurse" or "district veterinary nurse".

"...there is an indication in Exhibit EF8, this is an expert from the VN Futures report, which came out in July 2016. ... The bullet point which is highlighted: "District veterinary nursing is commonplace across the UK, providing veterinary nursing care advice and guidance directly in the community". So, it is not something that Ms Finzel created. The term has been used since 2016. She would have been aware of this. She is on the register. Obviously, she gets sent

⁶ Paragraphs 24-29 of this decision

all the information by the applicant, so she gets the RCVS News, which includes all the references to this.”

“...in 2015, after they got the charter, there was a formal requirement for registration on the Register, so none of this could have been something that Ms. Finzel did not know. The name and role is not exclusive to her but she was seeking to make the role and the name exclusively within her control. ... She was prepared to assert publicly that the applicant had no role in the regulation of district veterinary nurses in order that she could win a prize. She publicly admitted she was seeking to overcome the statutory requirements of schedule 3 rather than comply with them. It was never in her gift to be the regulator or to lawfully seek to authorise the use of the term or to register individuals as such, but that was her intention. She applied for the mark in full knowledge that the applicant was exclusively entitled to admit persons to the register and without right to use that name”

162. The applicant submits that the proprietor is not a statutory regulator and is not entitled to a monopoly right over the words ‘Veterinary District Nurse’ or ‘Veterinary District Professionals Association’ in relation to the contested services. It states that it is clear from the conduct of Ms Finzel at the time of filing and since then, that the proprietor is using the offending marks in a similar way to the manner in which the applicant, as a statutory regulator, uses its earlier certification mark. The applicant believes this behaviour falls below the standard of acceptable commercial behaviour observed by reasonable and experienced persons in the veterinary profession.

163. Having assessed the evidence and submissions before me and, taking account of the relevant authorities, I conclude that the applicant has established a prima facie case.

164. I remind myself of the questions raised in the *Alexander Trade Mark* case: (a) What, in concrete terms, was the objective that the applicant has been accused of pursuing, (b) Was that an objective for the purposes of which the contested application could not be properly filed, and (c) Was it established that the contested application was filed in pursuit of that objective.

165. The answer to these questions would appear to me to be:

a) Establishing a regulatory body, which would provide a register of qualified veterinary district nurses; provide training and accreditation, establish a code of conduct for veterinary district nurses; all of which whilst not being an official or authorised regulatory body, and without any authorisation from the appropriate authority (the applicant).

b) Ms Finzel is a registered veterinary nurse and as such will be conscious of the applicant and its role as a regulatory body for veterinary surgeons and nurses in the UK. As Ms Reid has submitted, Ms Finzel would also have been aware of the VN Futures project, which set out plans to develop veterinary nursing in the community since at least 2015. Mr McEntergart stated in his submissions that his client had worked with the applicant since 2015, and that the applicant was aware of Ms Finzel's work and did not have a problem. Whilst that may have been the case in 2015, things have clearly changed since Ms Finzel filed the trade mark applications in October 2019 and February 2020 for the two contested marks.

c) It is clear from the evidence provided by the applicant, and from information provided under Annex 1 of the TM26 forms, that the registration of the contested marks plays an important role in Ms Finzel's plans to establish a national association and introduce a new regulatory body. To support this argument, I refer to an extract from an article provided under Annex 1 of the TM26 form, in which Ms Finzel explains how she intends to use her trade marks in business. That extract is set out below:

**3. Your solution: How are you planning to solve this problem?
Share your specific approach.**

By replicating the human Nursing model (with its extensive suite of specialisms that Nurses can develop into) & using it as a paradigm to implement a community based service, Veterinary District Nursing (VDN). I am setting up an Association to: *Establish a Code of Conduct for VDNs *Set the standards by which VDNs must operate *Establish training standards for VDNs *Provide a template for the development of other specialisms *Provide a Register of qualified VDNs *To lobby and represent the interests of VDNs This will enable a Registered Veterinary Nurse (RVN) to work as a VDN and opens the door to get VN specialities recognised in their own right. Currently in the UK, anyone can call themselves a VN undermining the status of those that have studied to qualify as (RVN). As a consequence, to protect the status of a VDN I have Trademarked "Veterinary District Nurse" so that only those who meet the standards set by the Association will be eligible to call themselves VDN. My VDN model protects the human-animal bond for the benefit of patients, carers and their families, supports RVNs to grow new VN skills, forms new career pathways & improves RVN retention

4. Innovation: How are you innovating or using unique approaches to solve the problem?

I have founded a National Association, The Veterinary District Professionals' Association (VDPA) to introduce a regulatory body. This will: *Establish a Code of Conduct *Set the standards by which VDNs must operate *Establish training standards *Provide a template for the development of other specialisms *Provide a Register of qualified VDNs *To lobby & represent the interests of VDNs I've also established a Company with a Veterinary Surgeon, Veterinary District Professionals Ltd to overcome the requirements of the Veterinary Surgeons Act, that demands RVNs be directly employed. The broader purpose of this company is to enable other RVNs to operate under our umbrella, in order to facilitate the establishment of VDNs nationally

166. I conclude, based on the evidence before me, and with no rebuttal whatsoever from the proprietor, that the objective of the proprietor in filing the contested marks was to establish a new regulatory body, separate and distinct from the applicant; provide training and accreditation, and establish a new Register of qualified veterinary district nurses, which Ms Finzel's organisation would control and regulate.

167. I recognise that much of the applicant's evidence in this regard relates to information directly attributable to Ms Finzel, rather than District Veterinary Professionals Ltd, who are the proprietor in this matter. However, it is the case that Ms Finzel has been shown to be the sole Shareholder and Director of the proprietor and therefore controls the company. In this regard I recall the comments of Professor Annand, sitting as the Appointed Person in the *WALKERLAND* decision, where she stated that: "A claim of bad faith is not avoided by making an application in the name

of an entity that is owned or otherwise controlled by the person behind the application.”⁷

168. I also remind myself of the relevant case law and in particular the *Saxon* decision: “An application may have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party...”

169. At the relevant dates, being the application dates of the contested marks, it has been shown that the proprietor was aware of the applicant and its role as the statutory regulator of veterinary nurses and surgeons in the UK. The proprietor was also aware of the VN Futures project which was established in 2015 and set out in detail, in its report of July 2016, plans to develop the district veterinary nurse role in the community. Ms Finzel is aware that she and the proprietor company are not authorized to act as a regulatory body for veterinary nurse, veterinary district nurses or district veterinary nurses in the UK. She is also aware that she is not authorized to provide ‘accredited’ training for nurses or establish a Register of veterinary district nurses. I believe that the proprietor has acted in breach of a general duty of trust towards the applicant, who it knows is the statutory body responsible for the regulation of the services that it proposes to offer, and for which it has stated it intends to regulate, control, register and accredit, without the necessary authorization to do so.

170. Geoffrey Hobbs K.C., sitting as the Appointed Person, made the following comments recently in respect of a bad faith claim, which I feel resonate with the matter at hand:⁸

“As too often happens in Registry proceedings involving allegations of bad faith filing, neither side attempted to test the reliability of the other side’s account of events by way of cross-examination or by means of any application for disclosure. Their written and oral submissions required the Hearing Officer to assess the correctness of their respective positions in the light of the witness statements and exhibits they had provided. That involved an acceptance on their part that the Hearing Officer was entitled to consider whether or how far the evidence presented on one side of the case had in significant respects

⁷ BL O/013/05, Paragraph 22

⁸ Trade Mark Inter Partes Decision O/327/22

been disproved or displaced or outweighed by evidence presented on the other side of the case: *Williams v Canaries Seaschool SLU (CLUB SAIL Trade Marks)* [2010] RPC 32; BL O/074/10; at paragraphs [37] to [41].

...

The required determination is, on any view of the matter, fact sensitive and case specific. It falls to be made with due regard for the fact that the trade mark applicant is best placed to provide the decision taker with information as to his or her intention at the time of the application for registration: Case T-663/19 *Hasbro Inc v EUIPO* EU:T:2021:211, paragraph [44]; *Univers Agro EOOO v EUIPO* EU:T:2021:633, paragraph [33] citing Joined Cases T-3/18 and T-4/18 *Holzer y Cia, SA de CV v EUIPO (ANN TAYLOR and AT ANN TAYLOR)* EU:T:2019:317, paragraph [37]. 97.

....

The fact (if it is the fact) that the trade mark applicant saw nothing wrong in his or her behaviour is not sufficient, in and of itself, to defeat a bad faith filing objection: *Red Bull GmbH v Sun Mark Ltd* [2013] ETMR 53; [2012] EWHC 1929 (Ch); at paragraph [137]; *Paper Stacked Ltd v CK Holdings NV (ALEXANDER Trade Mark)* BL O/036/18 (18 December 2017) at paragraph [24].”

171. Having found that the applicant has put forward a sufficient prima facie case in support of the claim of bad faith, it is incumbent on the proprietor to rebut that claim by way of submissions and evidence to the contrary. The proprietor has not adequately answered the applicant’s prima facie case at all. The proprietor has not provided an explanation, supported by evidence, as to the reasons that it filed the contested marks. The proprietor has simply stated that it has not acted in bad faith, that it is well known to the applicant, and that it has been very clear and honest about the valuable work it does under the contested marks.

172. With no rebuttal to the applicant’s bad faith prima facie case, the application for invalidation based on section 3(6) is successful.

Conclusion

173. The invalidation actions brought under sections 3(1)(a), 3(1)(b), 3(1)(c), 3(3)(b), 5(2)(b), 5(3) and 5(4)(a) have failed.

174. The revocation actions brought under section 46(1)(d) have failed.

175. The invalidation actions brought under section 3(6) have been successful.

176. Subject to an appeal to this decision, the contested UK registrations will be declared invalid, and both registrations will be deemed never to have been made.

COSTS

177. As the applicant has been successful in respect of the invalidation actions brought under section 3(6), it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying said TPN as a guide, I award costs to the applicant on the following basis:

Official fees for invalidation actions:	£400
Preparing statements of grounds and considering the counterstatements:	£600
Preparing and submitting evidence:	£800
Preparing for and attending a Hearing:	£800
Total:	£2600

178. I hereby order District Veterinary Professionals Ltd to pay to The Royal College of Veterinary Surgeons the sum of £2600. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 3rd day of October 2022

**Andrew Feldon
For the Registrar**