

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NOS 2148060 and 2156025
IN THE NAME OF CATAPULT LONDON LIMITED**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITION THERETO
UNDER NOS 48630 and 48631 IN THE NAME OF
CATAPULT PUBLIC RELATIONS LTD**

TRADE MARKS ACT 1994

**IN THE MATTER OF application Nos 2148060 and 2156025
in the name of Catapult London Limited**

and

**IN THE MATTER OF consolidated opposition thereto
under Nos 48630 and 48631
in the name of Catapult Public Relations Ltd**

Background

On 15 October 1997 and 22 January 1998, Robinson Mac London Limited applied to register the trade mark CATAPULT in respect of the following services:

Date	Application Number	Class	Specification
15 October 1997	2148060	35	Advertising, market research.
		42	Artwork design; graphic art services; illustrating services; copy writing; design services for company's products, services and retail concepts; but not including design of clothing and footwear.
22 January 1998	2156025	35	Business services relating to brand creation, brand development and marketing of products and services.

On 4 June 1998, Catapult Public Relations Ltd filed notice of opposition to these applications, in which they say that they are the proprietor of the unregistered mark CATAPULT and the applicants for the following trade mark:

Number	Mark	Class	Specification
2166632	CATAPULT	35	Public relations services; sponsorship maximisation services.

The grounds of opposition are in summary:

- 1. Under Section 3(3)(b)** because use of the trade mark by the applicants in respect of services for which registration is sought would deceive the public.

2. **Under Section 5(2)** because the services of the subject application are the same or similar to those encompassed by the opponent's trade mark, and the respective marks are identical such that there exists a likelihood of confusion.
3. **Under Section 5(3)** because the opponent's trade mark has a reputation and use of the subject trade mark would take unfair advantage or be detrimental to its distinctive character or repute.
4. **Under Section 5(4)** by virtue of the opponent's extensive use and reputation.
5. **Under Section 3(6)** because the applicant does not intend to use the trade mark on all of the services encompassed by the application, and the applicant is not entitled to claim to be the proprietor.

The opponent makes several vague statements including a request that the registrar exercise her discretion in its favour. The Registrar has no discretion to refuse an application which meets the requirements for registration set out in the Act and I therefore do not propose to give this request any consideration.

The applicants filed a Counterstatement in which they deny all of the grounds on which the opposition is based.

Both sides request that costs be awarded in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 15 May 2001, when the applicants were represented by Mr Matthew O'Connor of Catapult London Limited, and the opponents by Ms Anne Roome of Laurence Shaw & Associates, their trade mark attorneys.

Opponent's evidence

This consists of a Statutory Declaration dated 22 January 1999, and comes from Jane Kathryn Hunt, Managing Director of Catapult Public Relations Limited, a position she has held since 19 December 1997, the date on which her company was incorporated.

Ms Hunt says that her company specialises in public relations and sponsorship maximisation services. She states that she is a full member of the Institute of Public Relations (confirmed by exhibit JKH1) a status which she says is only conferred on those who can demonstrate 10 years experience at the highest level within the profession. Ms Hunt says that she has worked in public relations for the last 13 years, and goes on to set out her employment experience and to detail awards that she has won for her work.

Ms Hunt states that in November 1997 she decided to create a public relations company under the name CATAPULT PUBLIC RELATIONS, the name CATAPULT being chosen as this

was thought apt to “catapult clients into the minds of the public”. Ms Hunt says that at that time she began negotiations with an insurance company with the aim of providing them with public relations services under the name. She continues saying that the company was subsequently incorporated in December 1997 and that she arranged for a logo to be designed, which is the logo mark referred to in the statement of grounds. Ms Hunt describes the letter “P” in the logo as being represented as a catapult projecting the words public relations and sponsorship maximisation. She next refers to exhibit JKH02 which she describes as illustrative examples of the mark as used since November 1997, and information about the formation of the company. The exhibit consists of:

- “Dempster” cards for promotional mailings, business card, and letter headed paper, all bearing the CATAPULT logo earlier referred to. (Dempster being a cartoon character depicted on the front of the card).
- brochure headed with the CATAPULT logo detailing Ms Hunt’s PR experience “in recent years”. The brochure is undated, refers to events dating from before the setting up of her company although it is not possible to say which, if any were provided under the CATAPULT name.
- fact sheet giving details of Ms Hunt’s PR credentials, confirming the setting up of the company in December 1997.
- VAT and company registration details dating from April 1998 and November 1997 respectively.
- list of discussion points for a meeting to be held on 6 January 1998, no mention of CATAPULT.
- letter dated 19 January 1998 which appears to refer to the development of the CATAPULT logo.
- correspondence addressed to CATAPULT PR relating to work underway in January 1998. There is no mention of the logo.

Ms Hunt goes on to give a list of her clients to date, which she says illustrates that the services have been provided on a national scale. She goes on to say that she conducts national campaigns in the national media for many of her clients. She refers to exhibit JKH03 which consists of items of printed matter, all undated or dated after the relevant date, the only mention of CATAPULT being in the company name.

Ms Hunt says that over 2,500 companies have received mailings from her company, and that an independent telesales survey to assess the effect of the mailing found that almost all of the recipients of the “Dempster” cards remembered and had retained them, and that awareness of her company is high. No information on the survey is given.

Ms Hunt explains that her company promotes its services in the Hollis Press and PR Annual which she describes as the only reference source that acts as a comprehensive shop window to

the PR and marketing communications consultancy world, and in Adline which she says is one of the main trade journals for advertising PR. She mentions that her company is listed in Yellow Pages and the Thomson Directory, and is noted as the media contact for various named insurance companies.

Ms Hunt goes on to refer to exhibit JKH04 which includes the following items of promotional material:

- further examples of “Dempster” cards and brochure referred to in exhibit JKH02.
- media/press releases noted as having been issued by CATAPULT PUBLIC RELATIONS, all either undated or dated after the relevant date.
- letters sent to CATAPULT PUBLIC RELATIONS apparently in response to a mail shot. All are dated after the relevant date.
- advertisements and information relating to advertisement of CATAPULT (shown in the logo form) placed in Hollis UK Press & PR annual and Adline, all dated after the relevant date.
- brochure (undated) giving a profile of the CATAPULT agency and Jane Hunt’s experience.
- extracts from phone books showing a listing for CATAPULT PR/ CATAPULT Public Relations Limited, and correspondence relating to their inclusion in Yellow Pages. All are either undated or dated after the relevant date.
- letter dated July 1998 promoting the CATAPULT agency.

Ms Hunt refers to the investigations carried out prior to adopting the name CATAPULT PUBLIC RELATIONS AND SPONSORSHIP MAXIMISATION, and to the filing of her company’s application to register the name as a trade mark which revealed the existence of the two applications the subject of these proceedings. Ms Hunt says that she had never heard of the applicants, who she says, changed their name to CATAPULT (London Limited in January 1998, exhibit JKH05 being copies of the official records relating to the change of name. Ms Hunt says that to her knowledge the applicants do not operate in the field of public relations. She goes on to give her views on the level of awareness of her company which she says is illustrated by an open letter dated 14 September 1998 from Ian Miller, a reporter with a national daily newspaper (exhibit JKH06) which attests to the reputation and goodwill of CATAPULT/Catapult Public Relations Limited dating from “late 1997”.

Ms Hunt goes on to refer to exhibits JKH07 which consists of a brochure profiling the applicant’s company, which although not dated makes reference to activities undertaken in 1997 and contains a quotation “It is rare to find radical, innovative agencies like CATAPULT” attributed to a Senior Brand Manager in September 1997. The brochure contains numerous references to CATAPULT, particularly in conjunction with the words “Firepower for Brands

and seems to position the applicants more in brand development. Ms Hunt refers to exhibit JKH08 which consists of extracts from a publication PR Week dated 1996 and 1998 listing the top 100 PR companies, noting that the applicants (whether Robinson Mac/Catapult London Ltd) do not appear. She concludes her Declaration by giving her view that if the applicants were to enter the field of public relations or sponsorship maximisation under the name CATAPULT, the likelihood of confusion would be great.

Applicant's evidence

This consists of a Statutory Declaration dated 5 November 1999, executed by Matthew Glyn O'Connor, Managing Director of Catapult (London) Limited, a position he has held since 1996 when he and his partner acquired Robinson Mac (London) Limited.

Mr O'Connor says that the change of name to Catapult (London) Limited took place on 21 January 1998, the rationale being to signify the establishment of a new team of personnel and present a more dynamic profile to clients. He refers to exhibit MO1 which consists of a business card and an item of letter headed stationery. Both bear a letter "C" logo preceding the words CATAPULT FIREPOWER FOR BRANDS.

Exhibit MO2 consists of the text for a letter to be sent to clients to tell them about the change of name. The letter is headed "READY AIM FIRE ROBINSON MAC BECOMES CATAPULT" and describes the establishment of a new team of personnel and a shift of emphasis from brand positioning to include brand innovation and identity. Some examples of campaigns are listed, although no dates or whether this was as CATAPULT.

Mr O'Connor refers to and details part of Exhibit MO3 which he describes as a "current brochure" for the applicant's company. The brochure is entitled CATAPULT FIREPOWER FOR BRANDS and describes their services as brand naming, brand identity, econometric modeling, trade & consumer positioning and qualitative research. The brochure is undated and refers to case histories, one from 1999.

Mr O'Conner next refers to exhibits MO4 and MO5 saying that exhibit MO4 appeared in The Grocer on 6 March 1999 and MO5 in the same publication on 18 July 1998. However, the exhibits consist of two versions of the article that appeared in 18 July 1998 edition of The Grocer magazine relating to the launch of an ice cream product. Exhibit MO6 consists of a copy of an article that appeared in April 1999 edition of The Grocery Trader announcing the launch of new products. There is no mention of CATAPULT in any of these articles although they do provide information on the date of some of the services provided by the applicants. Mr O'Conner says that these exhibits show his company is active in public relations and that the products mentioned are typical of the area of commerce in which his company operates; Fast Moving Consumer Goods (FMCG) in the grocery and drinks sectors.

Mr O'Conner next introduces exhibits MO7 and MO8, which consist of articles that he has written, and that were published in 4 July 1998 and 10 July 1999 editions of The Grocer. The articles announce the launch of new products and mention Mr O'Connor as the Managing Director of brand development agency CATAPULT.

Mr O’Conner goes to the Declaration by Jane Hunt, accepting her as a professional providing public relations and sponsorship maximisation services. He comments on the reasons given for her having adopted the name CATAPULT, noting that she does not say whether any searches were done to establish whether the name was available for use as a trade mark. He mentions Ms Hunt’s claim to having used the name CATAPULT in November 1997 in the course of negotiations to provide public relations services to an insurance company, noting that this is verified by exhibit JKH02. Mr O’Connor says that at that time, had Ms Hunt checked to see if CATAPULT was available for use she would have known about the applications by his company.

Mr O’Connor says that he believes the reason that Ms Hunt’s media colleagues have not mentioned the existence of another company using CATAPULT is because the public relations industry is disparate, and that those involved in one type of goods or services would not know of others operating in respect of different or unconnected goods or services. He says that the reason his company does not appear in the PR Week listings for the top 150 companies is because it is not a specialist PR consultancy, but provides public relations support in the form of trade positioning and presentation.

Mr O’Connor next refers to Ms Hunt’s claim that if his company were to use CATAPULT in the field of public relations and sponsorship maximisation services that there would be confusion. He goes on to refer to exhibit MO9, which consists of a copy of the opponent’s “Dempster” card which he says was sent to one of his clients on 8 May 1998. The postmark confirms this date, the addressee is the company referred to in the article shown as exhibit MO5. Mr O’Conner says that it was only when his client passed the card on to him that he became aware of Ms Hunt’s company.

Mr O’Connor notes and explains why he considers the opponent’s claims and objections based on rights in an earlier trade marks is at odds with Section 6 of the Trade Marks Act 1994, and denies the assertions that the public would be deceived (Section 3(3)(b)) by his company’s use of CATAPULT in relation to the services set out in Class 35 of the application. He concludes his Declaration saying that the evidence does not show that Ms Hunt’s company had established a reputation at the relevant date and that no grounds exist under Section 5(4)(a).

Opponent’s evidence in reply

This consists of two Witness Statements. The first comes from Jane Kathryn Hunt who confirms that she is the same Jane Hunt who filed the Statutory Declaration dated 22 January 1999, and which I have summarised above.

Ms Hunt details the various promotional and advertising activities undertaken by her company since the date of her Declaration, which includes mail shots, newsletter, and advertisements and editorials in trade and local press. All originate from after the relevant date and although referring to earlier events (launch of Dexter in Spring 1998) these have already been mentioned, and as such the exhibit adds little to this case.

Ms Hunt goes to the Declaration by Matthew O’Connor, noting the following:

- Exhibit MO2 is undated and there gives no indication of to whom or how many it was sent.
- Exhibit MO3 is undated, refers to case histories which must have been undertaken prior to adopting the name CATAPULT.
- Exhibits MO4, MO5 and MO6 do not mention CATAPULT or establish the applicants provide public relations services.

Ms Hunt refers to the promotional material that she says she obtained from the applicants, and which is shown as exhibit JKF07 to her Declaration, noting that the letter refers to the applicants as being a marketing, NPD and packaging design company, which, she says, does not encompass public relations. Ms Hunt makes several observations on the brochure noting that it does not mention public relations services, and that many of the case histories and the quote from Mattieu Lambeaux appear to pre-date the change of name to CATAPULT. Ms Hunt alleges that the reference to Simon Coker in the brochure is incorrect because Mr Coker has never worked for the applicants.

Ms Hunt refers to the “Dempster” card sent by her company to Fredericks Dairies Limited which Mr O’Conner states to be a client of his company, saying that this had been the second in a series of four mailings and that no complaints had been made to her company. She refers to exhibit JKH02, which consists of a copy of the applicant’s accounts for the year ending December 1998 noting that they refer to the completion of the change of name to CATAPULT Limited on 21 January 1998. Ms Hunt also highlights that the accounts refer to the applicant’s business up to 30 June 1996 as being that of a retailer of printing and stationery products, and that from that date they have not traded which, she says, conflicts with Mr O’Connor’s statement that his company’s name has become well established in the grocery industry since its inception in 1998.

Ms Hunt restates her view that the evidence shows the applicant’s company to be involved in brand positioning, but does not establish that CATAPULT is well known in this field or has been used in public relations. She concludes her Declaration by restating her view on the likelihood of confusion should the applicants use the mark in relation to public relations and sponsorship maximisation services.

The next Witness Statement comes from Simon Coker, who has worked in design and as a graphic designer for about 13 years, and is currently trading as Coker Brand Design.

Mr Coker says that he works on a consultancy basis but has never been employed or had any formal working agreement with the applicants. He says that he was concerned to find out that his details appeared in the applicant’s brochure, and that in an undertaking dated 1 March 1999 the applicants undertook to destroy all of this material. A copy of the undertaking is shown as exhibit SC01 and confirms the undertaking but also mentions Mr Coker as having had some involvement with the applicant’s business and that he had seen the brochure prior to its use.

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

In the skeleton argument submitted prior to the hearing the opponents reduced the grounds on which the opposition is based to Section 3(6) and Section 5(4)(a). I will deal first with Section 3(6). That section reads as follows:

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

The opponent's case under this section has two strands. The first assertion is that the applicant's are not entitled to claim to be the proprietor of the mark. There is no evidence that at the time of filing the applicant's were aware of any other claim to rights in the mark for which they seek registration, and I do not, therefore see how I can find them to have acted in bad faith in doing so. Nor do I see the fact that the applicants subsequently changed their name to Catapult London Limited provides any basis on which to conclude that they were acting in a commercially unacceptable manner. Companies change their names all the time. Whether the opponents can justifiably claim to be the true owner of the rights in the mark therefore properly falls to be considered under Section 5 to which I will come to later in this decision.

The second argument rests upon the assertion that the specifications of the applications are, at least in part, very general and somewhat vague, and that based on the applicant's previous trading activities as shown in their evidence, they do not, and never have had a bona fide intention of using the mark in relation to all of the services applied for. Reference is made to Section 32(3) of the Act.

Section 32(3) of the Act sets out, as a basic requirement of making an application, that an applicant confirm in a statement that the trade mark is being used, either by the applicant or with his consent, in relation to the goods or services for which they seek registration of their mark, or they have a bona fide intention that it shall be so used. The section does not require that an applicant be using the trade mark in relation to all, or indeed any of the goods or services for which they seek registration at the time of application for registration, only that where the mark is not in use that there is a bona fide intention that it will be so used. Section 32(3) clearly allows for some futurity in putting the trade mark into use, and although the section does not set a timescale, from the provisions of Section 46 it would appear that the Act envisages that an applicant should have a real intention of doing so within the five years following registration.

Ms Roome argued that the applicant does not provide public relations or sponsorship maximisation services, and by their own admission, they do not specialise in public relations services, but so what? Distinct from an application for revocation (based on the non-use of the registered trade marks) where it can be established through evidence that the mark has either been used or not used in respect of all or some of the goods/services for which it is registered, the past actions of the trade mark applicant can at best only give an indication of the extent to which they may use a mark not yet registered in the future. Trading conditions are fluid and companies develop or identify new products and market opportunities making history an unreliable basis on which to say that they will not develop use the mark in the future. If through evidence it can be established that an application covers goods/services

which the applicant knows the trade mark cannot or will never be used in connection with there is every likelihood that they would be found to have acted in bad faith in making the application. There is no such evidence in this case.

To my mind the services set out in the applications may well be expressed in broad terms, but are not so wide in their scope; they either encompass those services that the applicant appears to have been providing, or are sufficiently closely allied so that it is within the realms of possibility that they may provide them in the future. Consequently the ground founded under Section 3(6) fails.

This leaves the ground founded under Section 5(4)(a). That section reads as follows:

5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

Mr Geoffrey Hobbs QC sitting as the Appointed Person in the *Wild Child* (1998 RPC 455) set out a summary of the elements of an action for passing off. The necessary elements are said to be as follows:

- (a) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (b) that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and
- (c) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The opponents make much of Jane Hunt's reputation in public relations built over a period of some thirteen years in the industry. In my view the evidence shows Ms Hunt to have achieved a degree of success in the provision of such services, and no doubt the trappings of reputation and goodwill that go along with this. But by their own admission the opponents did not adopt or start using the trade mark CATAPULT until November 1997 at the earliest, which given that the application was made in October 1997 is after the relevant date. Even allowing for the possibility that in an industry built on information and personal contacts the trade were immediately aware of Ms Hunt's new venture under the name CATAPULT or that a reputation in CATAPULT was immediately established, I do not see how the opponents could have an earlier reputation or goodwill in the mark. Any goodwill or reputation can only have accrued to Ms Hunt personally, or the name or business of her employer. Consequently I do

not see how there can be a finding of misrepresentation or that the opponent is likely to suffer damage and the ground under Section 5(4)(a) is dismissed accordingly.

The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore order that the opponents pay to the applicants the sum of £770 as a contribution towards their costs, this to be paid within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

Dated this 13 day of September 2001

**Mike Foley
for the Registrar
The Comptroller General**