

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2051132B  
BY RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL UNIVERSITY IN  
LONDON INC.  
TO REGISTER A SERIES OF FIVE TRADE MARK IN CLASSES 16, 25 & 41

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 49211  
BY THE AMERICAN COLLEGE IN LONDON LIMITED

## BACKGROUND

1) On 13 January 1996, Richmond College, The American International University in London Inc. of Queens Road, Richmond, Surrey, TW10 6JP applied under the Trade Marks Act 1994 for registration of a series of four marks (reproduced below):

RICHMOND  
THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON

RICHMOND COLLEGE  
THE AMERICAN INTERNATIONAL UNIVERSITY IN LONDON

RICHMOND, THE AMERICAN INTERNATIONAL  
UNIVERSITY IN LONDON

RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL  
UNIVERSITY IN LONDON

RICHMOND COLLEGE, THE AMERICAN INTERNATIONAL  
UNIVERSITY IN LONDON, INC.

The application proceeded by consent of number: 2011234 (6138,444)

2) In respect of the following goods:

Class 16: "Printed publications; instructional and teaching materials (except apparatus); stationery, pens and pencils."

Class 25: "T-shirts, sweatshirts, baseball caps."

Class 41: "University educational services; adult teaching services; library services; provision of sports and recreational services; publishing services."

3) On the 19 November 1998 The American College in London Limited filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of Trade Mark number 2171459 AMERICAN COLLEGE IN LONDON registered "in respect of University education services and the like in Class 41".

b) The mark in suit offends against Section 5(2)(b), 5(3) and 5(4) of the Trade Marks

Act 1994.

4) The opponent further requested that the Registrar refuse application number 2051132B in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

5) The applicant subsequently filed a counterstatement denying the opponent's claims.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 16 July 2001 when the applicant was represented by Mrs Cookson of Messrs Field Fisher Waterhouse, and the opponent by Mr Edenborough of Counsel instructed by Messrs D Young & Co.

#### OPPONENT'S EVIDENCE

7) The opponent filed two declarations. The first, dated 14 June 1999, by Barbara Demosthenous, the Vice President and Director of Finance of the American College in London (the opponent). Ms Demosthenous states that the opponent has used and done business under the trade mark AMERICAN COLLEGE IN LONDON in the UK since at least the year 1978. The opponent has a trade mark application pending for this mark in relation to services in Class 41.

8) Ms Demosthenous provides annual gross turnover figures from 1986 to 1998. Also provided are the numbers of students attending the college for the same period. Below are figures for the five years prior to the relevant date.

| Year ending | Turnover £ | Total number of students |
|-------------|------------|--------------------------|
| Sept 1991   | 3,481,446  | 3,510                    |
| Sept 1992   | 3,603,951  | 3,422                    |
| Sept 1993   | 3,904,996  | 3,373                    |
| Sept 1994   | 4,012,078  | 3,259                    |
| Sept 1995   | 4,302,666  | 3,418                    |

9) Ms Demosthenous states that approximately £175,000 per annum is spent on marketing by way of advertising, prospectuses and direct mailing. The opponent has also used the mark on merchandising "sold in particular to students" including mugs, T-shirts, sweatshirts, jackets and pens.

10) Ms Demosthenous refutes the applicant's claim that the opponent has abandoned its mark. She states that since 15 October 1998 the opponent has used the trading name "American Intercontinental University London" in relation to its services. However, the registered name

of the company remains “The American College in London Limited”. Reference is made to a decision in 1998 by the Registry involving the opponent. At that time the Hearing Officer found that the opponent had a substantial reputation in the field of educational services under their mark and that the mark THE AMERICAN UNIVERSITY, LONDON (AUL) was confusingly similar to the mark AMERICAN COLLEGE IN LONDON. A copy of this decision is provided at exhibit ACLL-6.

11) Ms Demosthenous also claims that there have been two instances of confusion between the marks of the two parties (see below).

12) In addition to the above mentioned exhibits Ms Demosthenous also provides the following:

- Exhibit ACLL-1: copies of a newsletter issued by the opponent *The American College Collegian* dated Winter 1995 and summer 1996. Also provided are copies of the college prospectuses for 1982, 1988-1990, 1995-1997 and Admissions catalogue 1983-1985.
- Exhibit ACLL-2: copies of examples of 1998 brochures.
- Exhibit ACLL-3: Copies of advertisements in publications such as The Sunday Times, The Economist, Harpers and Queen, Elle, Vogue, Tatler, Marie Claire and USA Today. All of which, it is claimed, are well known in the UK. These advertisements all date from 1996.
- Exhibit ACLL-7: It is claimed that this shows two instances of actual confusion. One letter from a prospective student in Bangladesh is addressed to American University of London and appears to have been sent mistakenly to the applicant rather than the opponent. The other letter is from the applicant to a prospective student pointing out their error in sending an application form to the applicant when it was meant for the opponent. It is not clear how the original letter from the student was addressed.

13) The second declaration, dated 14 June 1999, is by Karen Louise James the Admissions Officer for the opponent, a position she has held since January 1995. . She states that approximately once a month they receive a phone call from a prospective student who has mistakenly contacted them rather than the applicant. She states that typically these enquiries take the form of the student asking whether the American College in London has a college in Richmond or asking for information about courses they do not run. Exact numbers cannot be provided as this information is not recorded. She also refers to an instance she was informed of by a colleague where a referee had also confused the two parties.

#### APPLICANT’S EVIDENCE

14) The applicant filed a declaration, dated 13 December 1999, by Walter McCann the President of the applicant company, a position he has held since 1993. At exhibit WM1 he provides a copy of the declaration filed in support of the application. This was a declaration by Mr McCann dated 2 November 1999.

15) Mr McCann states that the mark Richmond College The American International

University in London (The Richmond mark) was first used in 1992. At exhibit WM1 & 2 he provides pages from catalogues for prospective students showing use of the mark dated 1992 /94, 1994 / 95 , & 1995 /96. He states that the name Richmond College has been used since 1975 and this is confirmed by prospectuses for the years 1975 - 1980 at exhibit WM3. In 1981 the name changes to Richmond College The American International College of London. This is reflected in the prospectuses filed at exhibit WM4 for the years 1981-88. In approximately 1988 the name reverted to Richmond College. Then in 1996 / 97 the name used was Richmond, The American International University in London. Use of this name is shown at exhibit WM7 where copies of prospectuses for 1996- 2000 are provided. However, he states that the incorporated name did not change until August 1998.

16) Mr McCann claims that the Richmond mark is very well known, and that Richmond has always been a significant and distinctive element of the applicant's mark.

#### OPPONENT'S EVIDENCE IN REPLY

17) The opponent filed a declaration, dated 11 April 2000, by Raphael Lago the President of the opponent company. He claims that the applicant's claims of use are contradictory in asserting that the mark (Richmond College The American International University in London) was first been used in 1992 yet later claiming that the mark has been in use since 1975. He also points out that no turnover figures have been provided and that some references to the Richmond mark do not relate to the mark in suit as they omit the word International and so refer to another trade mark entirely.

18) That concludes my review of the evidence. I now turn to the decision.

#### DECISION

19) At the hearing the opponent withdrew the grounds of opposition under Sections 5(2) & 5(3) . The only the ground of opposition left is under Section 5(4) of the Act which states:-

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

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

*(b) .....*

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

*(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the*

*registration.*

20) I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

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

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

21) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed....”. The relevant date is therefore 13 January 1996, the date of the application.

22) The applicant asserted that, at the relevant date, the opponent possessed no goodwill in the UK as it sought its students from overseas, and in particular the USA. Whilst I accept that the services of both parties are primarily targeted at overseas students, the services are actually provided in the UK and there is evidence of advertising in the UK through various magazines. In my view it is clear from the opponent’s evidence that they do have goodwill in the UK under their mark “THE AMERICAN COLLEGE IN LONDON” for the provision of education services.

23) I therefore move onto consider whether there is misrepresentation leading or likely to lead the public to believe that the services offered by the applicant are services of the opponent. The opponent contends that it has shown two instances of actual confusion recorded at exhibit ACLL-7.

24) In the first letter from the student in Bangladesh it is clear that the writer is seeking information regarding courses. The writer refers to joining AUL which is I understand an abbreviation used in relation to the applicant. So it would appear that whilst he is ill-informed as to the courses run by the applicant he knew who he was writing to.

25) As to the letter from the applicant to a Mr Malik from Pakistan the facts are somewhat more difficult to define. The letter states that the applicant company does not provide courses in the subject sought. The writer assumes that the letter was intended for the opponent. Without further details it is not clear why the gentleman in Pakistan sent the forms to the applicant nor why the applicant assumed that the opponent should have been the intended recipient.

26) At the hearing Mr Edenborough also placed great emphasis on the evidence of Ms James. This evidence referred to telephone calls being received by the opponent asking either if the opponent had a college in Richmond or enquiring about courses which the opponent does not provide. This evidence was described by Mr Edenborough as “the lynch pin upon which the opponent hangs its hat”. To my mind this evidence is flawed. I have no doubt that Ms James believes there to have been misrepresentation leading to confusion in the minds of potential students, but this does not seem to be borne out by the facts as she sets them out. Prospective students phoning and enquiring about courses which the opponent does not offer does not, in my view, indicate that there has been misrepresentation. It seems to me quite logical if one has heard of a good college to enquire if they are offering the course which one wishes to partake. Educational institutions are constantly improving and expanding the courses they offer and prospective students, whether from overseas or the UK, might well phone to ascertain details of courses, and if of interest a prospectus. There is no evidence that these callers were led to believe that the services offered by the applicant were those of the opponent or that they had ever heard of the applicant.

27) As to the question of callers asking if the opponent has a college in Richmond, this is not evidence of misrepresentation. They are clearly aware of the existence of the university in Richmond, they are not mistaking it for the opponent’s own college. There is a question as to whether they believe there is an association between the two institutions but this is not enough to find misrepresentation. In my view a prospective student, particularly one who is travelling from outside the UK will be highly circumspect in their choice of educational establishment. They are about to invest considerable amounts of money and time. The quality of the service provided will potentially determine their future or at the least exert considerable influence.

28) I am fortified in these views by the recent case of *South Cone Inc. V Jack Bessant, Dominic Greensmith, Kenny Gary Stringer (a Partnership) 16 May 2001*. Pumfrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“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 prime 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 Section 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97, as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

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."

29) The opponent's mark is descriptive of the service provided and has a small amount of distinctiveness from the combination of descriptive words. Consequently the penumbra of protection to which they are entitled is relatively small. [See *Office Cleaning Services Ltd v Westminster Window & General Cleaners Ltd* [1946] 63 RPC 39. To my mind the applicant's mark has at its start the most distinctive part of its mark namely the word "Richmond". The prominence and positioning of "Richmond" in the applicant's mark suggests itself as the name of the college of which "The American International University in London" is a description. In the absence of any misrepresentation the opposition under Section 5(4) must fail.

30) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1235. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 02 day of October 2001

George W Salthouse  
For the Registrar  
The Comptroller General