

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Application No 2167049  
by The Money Shop Limited**

**and**

**IN THE MATTER OF Opposition thereto under No 50790  
by Instant Cash Loans Limited**

### **Background**

1. On 19 May 1998, The Money Shop Limited, applied under the Trade Marks Act 1994 to register the trade mark THE MONEY SHOP for a specification of goods and services which reads:

#### Class 9

Computer hardware, software and firmware; computer software, firmware and hardware for use with computer networks; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds and images; audio and video recordings; audio recordings, video recordings, music, sounds, images, text, publications, signals, software, information, data and code provided by telecommunications networks, by on-line delivery and by way of the Internet and the worldwide web; multi-media apparatus and instruments; non-printed publications including those provided by telecommunications networks, by on-line delivery and by way of the Internet and the worldwide web; educational and teaching apparatus and instruments; parts and fittings for all the aforesaid goods.

#### Class 35

Advertising, promotional and publicity services; personnel and recruitment services; market research services; collation of information; business and management advice, consultancy, information and research.

#### Class 36

Provision of information concerning insurance and investment services including that provided by telecommunications networks, by online delivery and by way of the Internet and the world wide web.

2. The application was accepted and published and given the number 2167049. On 13 March 2000, Instant Cash Loans Limited filed notice of opposition to the application. Following amendment, the statement of grounds accompanying the notice of opposition sets out one

ground of opposition. This can be summarised as follows:

under section 5(4)(a), having regard to the opponents' use of the trade mark THE MONEY SHOP in the United Kingdom since 1992 in relation to money lending, cheque verification services, debt collection services, deposit of valuables, exchanging money and related financial services, the opponents have established a goodwill and reputation such that registration of the trade mark the subject of the application should be prevented by the law of passing off.

3. The applicants filed a counterstatement denying the ground of opposition and putting the opponents to proof of the claims made in their statement of grounds. Both sides filed evidence in the proceedings and both sides seek an award of costs in their favour.

4. The matter came to be heard before me on 12 December 2001. The opponents were represented by Mr James Abrahams of counsel instructed by Eric Potter Clarkson, the applicants were represented by Mr Ian Bartlett of W.H. Beck Greener & Co.

#### Evidence

5. As noted above, both parties filed evidence in the proceedings. The opponents' evidence consists of a witness statement dated 13 November 2000 by Richard Withers, Financial Controller of Instant Cash Loans Limited. The applicants' evidence consists of a statutory declaration dated 26 February 2001 by Peter Curtis-Allen, a Director of The Money Shop Limited. Finally, the opponents filed a witness statement by Cameron Hetherington dated 29 May 2001. Mr Hetherington is the Managing Director of Instant Cash Loans Limited.

#### The Opponents' Evidence

6. Mr Withers states that the trade mark THE MONEY SHOP was first used by the opponents in the United Kingdom in July 1992 in relation to, "cheque cashing services; provision of loans; pawn brokerage services", and now extends to money lending, cheque verification, debt collection, depositing of valuables, exchanging money. He states that the trade mark has been used throughout the United Kingdom and the opponents now have over 100,000 customers who use their services and by the end of December 1998 the number of customers using the opponents' services under the trade mark THE MONEY SHOP was increasing at a rate of approximately 4,500 customers per month.

7. Mr Withers gives approximate annual turnover in the United Kingdom of services offered under the trade mark THE MONEY SHOP in value and volume since 1992 as follows:

Year	Total Turnover	Volume of transactions
1992/93	£ 232,650	2,217
1993/94	£ 2,649,809	20,013
1994/95	£8,066,814	60,074

1995/96	£15,382,550	111,028
1996/97	£24,138,485	329,483
1997/98	£46,776,811	334,964

8. The number of customers in the UK who use the opponents' services offered under the trade mark since 1992 are:

1992/93	3,000
1993/4	8,000
1994/95	18,000
1995/96	35,000
1996/97	60,000
1997/98	107,000

9. He states that these customers will have been exposed to circulars, promotional material and correspondence which are branded with THE MONEY SHOP.

10. Mr Withers states that the approximate annual amount spent by the opponents in advertising and promoting its services under the trade mark since 1992 are:

Year	Advertising expenditure
1992/93	£20,982
1993/94	£21,371
1994/95	£30,892
1995/96	£62,106
1996/97	£155,402
1997/98	£468,255

11. He states that this advertising and promotional activity has been by way of local and national press, radio advertisements, Yellow Pages, circulars and direct mail activities. He provides the following exhibits

- At RW1 he exhibits copies and originals of advertising and promotional campaigns. These include what appears to be an information sheet or flyer for "THE MONEY SHOP specialist PAWNBROKERS" in Nottingham. It indicates that the company will cash personal cheques and then not present them for payment for up to one month. A "nominal" fee is levied for this facility. Included in the exhibit are photographs of the front of the opponents' premises in Coventry, Nottingham, Bristol, Newcastle and Cardiff. All show the sign THE MONEY SHOP above the door or within the premises. The displays in the windows indicated that they "cash cheques". An undated press cutting which shows an advert for a competition run by THE

MONEY SHOP explains the conventional way to cash cheques via your bank and then states, "Now there is a much faster way. The Money Shop - a new form of financial services company have appeared. They can advance cash against a cheque within minutes. Naturally there is a charge to cover the risk involved." Another advertisement gives a list of cheques that can be cashed. These include: wages, building society, insurance settlements, income tax rebate, giros, contractors payments, student grants, solicitors, housing benefit..." The majority of these advertisements indicate that the company cashes cheques but there are some which state, "The Money Shop Pawnbrokers - we lend cash - we buy quality items - we cash cheques". Another states, "Quick and easy loans on quality items." However, these all seem to refer to the Nottingham branch.

- At RW2 he exhibits originals and copies of some press articles. He gives circulation figures for these where known. They include the Daily Mirror with a circulation of 2,500,000, and the Newcastle Chronicle 122,914, down to the more modest Sheffield Trader 42,657. He states that some of the examples are one off advertisements but that others would be part of a campaign and would run for 13 weeks. They cover various dates during the relevant period. Some of the exhibits appear to be copies of those in RW1.
- At RW3 he exhibits copies of scripts from local radio advertisements. Mr Withers states that their local radio advertisements included BRMB Radio (Birmingham), GWR Mercia (Coventry), KIX 96 (Coventry) and Red Dragon (Cardiff). He states that the potential listening audience for these radio stations is in excess of 5,000,000 people. The text of the commercial starts with the chant, "What do we want, we want money, when do we want it, Now!" This is repeated before it continues, "When you want money you need The Money Shop. The Money Shop will cash your personal cheques supported by a guarantee card and keep it for up to a month before banking it, all for just £3.50 commission for each £50 cheque." This advert refers to the Coventry branch.

12. Mr Withers states that the opponents offer and promoted their services under THE MONEY SHOP trade mark throughout the United Kingdom and as such, he states his view that they have acquired a reputation and goodwill in the use of this trade mark.

#### Applicants' Evidence

13. Mr Curtis-Allen states that he is a director of The Money Shop Limited a position he has held since the company was incorporated on 8 July 1996. He states that his company owns the domain name moneyshop.co.uk. He states that he is the web master of Net Services International Limited who host and operate the moneyshop.co.uk web site. The web site was registered on 8 July 1996 and at PCA1 he exhibits a copy of the registration details of the domain name.

14. Mr Curtis-Allen states that the applicant uses the trade mark THE MONEY SHOP as the name of a web site operational since October 1996. He states that the web site is a directory containing information for those interested in purchasing financial products such as pensions

and life insurance policies. He explains that visitors to the web site can click on links to the web sites of others that supply such products. Mr Curtis-Allen gives an example of a person who is interested in purchasing a personal pension plan. He can click on a link on THE MONEY SHOP web site to the relevant web site of Norwich Union. It is an internet directory of services provided by others. At PCA2 he exhibits pages which he states are sample pages from the web site [www.moneyshop.co.uk](http://www.moneyshop.co.uk).

15. Mr Curtis-Allen explains that listings are provided free of charge to the suppliers of financial products but that in time, suppliers of financial products will be charged for the privilege of being listed on THE MONEY SHOP website. However, he states that in common with many internet businesses, there is a significant period of time between the web site being established and its ability to generate revenue.

16. Mr Curtis-Allen states that nevertheless, the web site is achieving a high level of recognition amongst the public. By its very nature the web site can be visited by anyone in the world with access to a computer and internet browser. This includes visitors throughout the UK. At PCA3 he exhibits a print out which he prepared showing a sample of the visitors to the web site in 1999. He notes that they come from a number of areas of the UK and he provides a list. He states that this is a random sample only and that visitors come from all over the UK.

17. Mr Curtis-Allen states that one way of assessing the degree of recognition of a site is by looking at the position it gets when listed on a web search engine. He states that it takes a significant amount of effort in maintaining THE MONEY SHOP web site at the top of the search engine. He states that he spends approximately five hours per week in making the relevant submissions to the search engines. At PCA4 he exhibits pages from various search engines which he downloaded on 27 September 1999. He states that he entered the words “money” and “shop” in the search request. He states that he uses these as examples and that the results would be similar if he conducted the search on any date since January 1997. He gives the following positions as at 27 September 1999:

<b>Engine</b>	<b>Position</b>	<b>No of matches</b>
MSN	2	7434
LYCOS	6	21,009
INFOSEEK(GO)	7	4,556,051
ALTA VISTA	12	12,702,963
HOTBOT	22	232,890

18. Mr Curtis-Allen states that most people search the word wide web using a search engine and that the higher the web site is on the list of hits, the more likely an individual is to click on the link and look at it. He says that the relative position in the search engine is a significant factor in assessing the popularity of a website.

19. He goes on to say that another way of assessing how many people visit the web site at [www.moneyshop.co.uk](http://www.moneyshop.co.uk) is to examine “page impressions”. He states that these show the number of times a page on a web site has been viewed. At PCA5, he exhibits a print out compiled of the page impressions from his site for the week 16 September - 22 September

1999. In this sample week, he states that twenty-one pages from the web site were called a total of 657 times. He states that the records do not show pages that are visited less than 10 times but he estimates that these account for another 300 impressions. Therefore he estimates that there are 1000 page impressions per week. Mr Curtis-Allen states that in theory a single visitor could have visited the site one thousand times so he looked at the number of new visitors to the site. To do this, he looked at the number of “new hosts served”. He explains that a host is another computer system requesting information for one of its users. He states that page 3 of exhibit PCA5 shows the number of new hosts served in the week commencing 16 September 1999 was 392. Therefore, he estimates that at least 392 different people visited the site during that week.

20. Mr Curtis-Allen was also able to track the number of people who “click through” their web site to get to the web sites of those listed on their directory. At PCA 6 he exhibits a print he downloaded showing, by way of example, the number of people who clicked through from their motor insurance directory page to the web sites of motor insurance providers. For the period 1 - 26 September 1999 he states that those visiting the moneyshop.co.uk web site visited the 36 motor insurers listed there a total of 1520 times. He states that the most popular site was Eagle Star which received 188 visits. He states that he would expect this to be representative of any given four week period. Mr Curtis-Allen states that the applicant has used the trade mark THE MONEY SHOP consistently and continuously in relation to an informational directory and guide to financial services provided by others. He states that it has used the mark for over four years and has generated a significant reputation and recognition in the mark THE MONEY SHOP.

21. At PCA7, Mr Curtis-Allen exhibits a copy of the Trade Mark Registry file relating to application 2169110, THE MONEY SHOP device, in class 36 filed in the name of the opponents. He states that this application proceeded partly on the basis of evidence of distinctiveness acquired by use. Mr Curtis-Allen submits that the mark has only been used on, “cheque cashing services; provision of loans; pawnbrokerage services.” He states that these are an entirely separate business from the business of the application and there is no commercial conflict between the parties.

22. Mr Curtis-Allen comments on the fact that the opponents’ application was filed after the application in suit and he notes that the application was cited against the opponents’ application. At PCA8 he exhibits a copy of a statutory declaration of Henry Hallam dated 3 December 1998 filed in support of the opponents’ application to support a claim to honest concurrent use. At paragraph 5 of that declaration, Mr Curtis-Allen notes that Mr Hallam states:

“The trade mark has been used extensively in the market place with other trade marks which comprises the word MONEY for over six years with no incidences of confusion with any third party.” [Mr Curtis-Allen’s emphasis].

23. Mr Curtis-Allen takes this statement to mean that the opponents’ mark has co-existed with all other marks which include the element MONEY, including the applicant’s mark without confusion. He states that he agrees with Mr Hallam and has seen no evidence of confusion. He states that he can only conclude that this is because they operate in separate

business fields. He goes on to note that the opponents have not adduced any evidence of confusion in these proceedings.

24. Mr Curtis-Allen speculates as to the true reason for the opposition proceedings and refers to various documents at PCA 9- 15 which he states show that the opponents' main interest is in the domain name and not in the trade mark in suit here.

#### Opponents' Evidence in reply

25. Mr Hetherington makes various comments concerning the applicants' evidence, I need not summarise these. He states that given the reputation and goodwill enjoyed by the opponents, and their large customer base, it would seem natural for their customers to assume that they owned the trade mark for the MONEY SHOP for inter alia financial related services and corresponding domain names. He states that they believe that confusion and deception would be caused in the event that such trade marks and domain names were not owned by the opponents.

26. Mr Hetherington notes that the applicants' area of interest appears to be a directory containing information for those interested in purchasing financial products such as pension and life insurance policies. He suggests that a person wishing to obtain information regarding such matters would type "pensions" and "life insurance" into the search engine and not the words MONEY and SHOP.

27. That concludes my review of the evidence.

#### **Decision**

28. The ground of opposition refers to section 5(4)(a) of the Trade Marks Act 1994. The relevant provision reads as follows:

"5.- (1) .....  
(2) .....  
(3).....

(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
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.

29. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents’ 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 applicants (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicants are goods or services of the opponents; and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicants’ misrepresentation.

30. Assuming notional and fair use, I must assess whether use of the applicants’ mark, THE MONEY SHOP, was as at the date of application, liable to be prevented by the law of passing off. In making that assessment, Mr Bartlett reminded me that the onus is on the opponents to show that their ground of opposition is made out. He also suggested that although the relevant date was the date of application, in making an assessment of the opponents’ case I should take into account the fact that as at that date, the applicants had been using their mark for eighteen months. In Mr Bartlett’s skeleton argument, he suggest that for those services on which the applicants had used the mark it was this earlier date that was of importance. In relation to those goods and services which had not as yet been used then the date of application was relevant. I will deal with this submission below. I should note also that both parties referred to a number of cases in support of their position. It has been stated that this area of law is bedevilled by the citation of cases which are merely examples of the application of well-established principles to particular facts; Pumfrey J. in *South Cone Incorporated v. Jack Bessant and others* (9 October 2001 *The Times*). With that in mind, I will mention the cases referred to me where necessary.

31. Mr Bartlett also pointed out that the opponents’ statement of grounds seeks refusal of the application in its entirety. At the hearing, and in his skeleton, Mr Abrahams’ position did not go that far. Taken from his skeleton, the opponents’ case in a “nutshell” can be summarised as:

“The opponent has a very substantial reputation and goodwill in the name THE MONEY SHOP used in relation to its business providing finance - particularly but not limited to personal finance. If the applicant or anyone else were to use the name THE MONEY SHOP in relation to a business related to finance, people would think that that business was connected to the opponent or that the opponent had moved into that area.”

32. On that premise:

“Some (but not all) of the goods and services applied for are the sort of goods and services that people might think that the opponent could move into.”

33. So:

“...use of the mark applied for, in relation to those goods and services would amount to passing off. To that extent, the application should be refused pursuant to s. 5(4).”

34. In his skeleton, Mr Abrahams analysed the applicants’ specification of goods and services and suggested possible limitations to the goods in classes 9 and the services in class 35. He sought refusal of the application in so far as it covered services falling within class 36. I will deal with his suggested limitations to classes 9 and 35 later in my decision. The position only arises if I find that opponents have made out the requirements for passing off.

35. Before considering that point I should note that both parties in their evidence referred to the use of the domain name moneyshop.co.uk. The opponents indicated that use of that domain name would amount to passing off, the applicants referred to attempts by the opponents to have the domain name transferred from the applicants to the opponents. In their view, the opponents’ main interest is to obtain the domain name and that they are not interested in the trade mark. These proceedings before me are concerned with the Trade Marks Act 1994 and the question I must answer is whether use of the mark shown on the application form, in relation to the goods and services set out therein, would be prevented by the law of passing off. It seems to me that in seeking an answer to that question, the history of the dispute concerning the domain name is not relevant.

#### Goodwill and Reputation

36. It was Mr Abrahams’ position that the opponents had shown the necessary goodwill and reputation in the trade mark THE MONEY SHOP as at the date of application. In his view the evidence showed a very large business being conducted under that name involving the provision of loans, cashing of cheques and pawn broking. This business was conducted through retail units located on high streets up and down the country. The level of turnover prior to the relevant date together with the examples of advertising in the national and local press and the local radio advertisements should enable me to find that the necessary goodwill and reputation subsists.

37. Whilst Mr Bartlett did not dispute the fact that the opponents had used the trade mark THE MONEY SHOP, he took issue with several of the opponents’ contentions. In his view the evidence was not sufficient for me to infer that the trade mark had established a goodwill and reputation. Firstly, the evidence did not give sufficient detail to enable me to find that the trade mark had been exposed to a sufficient number of the relevant public to enable them to view it as a badge of origin. Secondly, he suggested that the trade mark in issue was in his view descriptive of the services provided by the opponents, a shop at which you can get money. The case law indicates that in such circumstances it is harder for the opponents to show that their ‘descriptive’ sign has acquired a goodwill and reputation amongst the public.

38. In support of his contention, Mr Bartlett referred me to the judgment of Mr Robert Englehart Q.C., sitting as a Deputy Judge of the High Court in *Radio Taxicabs (London) Limited v. Owner Drivers Radio Taxi Services Limited* (12 October 2001). The case concerned a passing off claim on the basis of goodwill in the name RADIO CABS. Mr Bartlett drew attention to various comments made in this case. In particular, he pointed out that the judge noted that the court was faced with “*the total absence of evidence from members of the wider public*”; paragraph 87. The judge went on to find that the burden of proving reputation with the general public lay on the claimant and that this was all the more so as the name was a descriptive one. At paragraph 89 the judge stated:

*“I consider it possible that the claimant may have built up a sufficient reputation in the ways relied on but I cannot conscientiously put it any higher in the claimant’s favour than that..... Thus one is left to speculate. Speculation is not enough. At the end of the day the burden of proving on the balance of probabilities, the requisite reputation with the general public in the name “Radio Taxis” lies on the claimant and I find that the claimant has not discharged it.”*

39. Mr Bartlett argued that this could be applied to the opponents’ evidence. There was no independent evidence as to what the public or even the trade or anyone outside the opponents’ organisation understood by the name THE MONEY SHOP. He asked whether these words were in fact taken by the public at the relevant date to indicated the services supplied by the opponents? Or was it the logo element of the mark or a special get up or look or feel which customers recognised and brought business in? Whilst the opponents had submitted evidence of turnover, this in Mr Bartlett’s submission was insufficient of itself to show distinctiveness in the trade mark THE MONEY SHOP. Independent evidence was required and in this case there was none.

40. The question of evidence before the registrar in proceedings under section 5(4)(a) has recently been the subject of comment in an appeal to the High Court. Mr Justice Pumfrey in *South Cone Incorporated* stated:

*“12.....As Mr Hobbs QC said in Wild Child TM [1998] R.P.C. 455, the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?”*

13. 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 (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.

14. 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.....”

41. If goodwill was shown, there was a dispute as to the services on which the trade mark had been used. As noted above, Mr Abrahams cast his net fairly wide, whilst Mr Bartlett would confine the opponents to cheque cashing and pawnbroking.

42. Having regard to Mr Bartlett’s comments, I reach the view that it is nevertheless fair to infer from the evidence that as at the relevant date, the opponents did enjoy a reputation in the trade mark THE MONEY SHOP amongst the relevant public. Given the services involved this will be ordinary members of the public. In reaching that finding I have taken account of the length of user, the fact that the trade mark is displayed prominently above and within the opponents’ premises. The trade mark will have been exposed, not only those who use the opponents’ services but also ordinary members of the public as they go about their business. Whilst the evidence indicates that at the relevant date, the premises upon which the mark was displayed, were not located throughout the UK they were in my view sufficient in number to have established a reputation across a significant area of the United Kingdom.

43. I agree with Mr Bartlett that the use of the trade mark THE MONEY SHOP in respect of a cheque cashing service is somewhat descriptive but it is not in my view the most obvious term. One does not usually go to a shop to get money, although one can often have the offer of “cash-back” services in various shops. It seems to me that the term is not entirely descriptive and as such the evidence filed is sufficient for me to find that the mark has become known to the public as a badge of origin of the opponents.

44. Further, the evidence shows that throughout the relevant period, the opponents were advertising consistently in both national and local press. Whilst Mr Bartlett pointed out that the evidence did not state that the radio commercials put in evidence were ever transmitted, it seems to me that Mr Withers states that the trade mark “has been promoted via a number of advertisements on local radio...”; paragraph 10. The scripts exhibited to his declaration are said to be “copy scripts in connection with these radio advertisements”; paragraph 11. No date is given in the evidence for their transmission but in any event, I do not think that anything turns on this point.

45. Having found that the opponents enjoy a reputation, I must identify the services to which that goodwill and reputation extend. Mr Abrahams’ position was that the mark had been used in relation to the opponents’ business of providing finance, loans, and providing the service of cashing of cheques and pawnbroking. It seems to me that Mr Bartlett’s position here is to be preferred. The evidence shows that the opponents’ primary service is the cashing of personal and other cheques offered through high street outlets. Although the evidence does show some use on pawnbroking services, it seems to me that this is very much a secondary services. Indeed, the advertisements for pawnbroking all appear to refer to the Nottingham branch. The bulk of their advertisements do not refer to it at all. Whilst a cheque cashing service might be deemed to be giving the customer an “advance” on their cheque, I would not categorise this as a loan. On the evidence before me therefore, I am not satisfied that the opponents’ reputation extends to financial transactions generally, such as the provisions or loans or

financial advice. Of course, that does not mean that they would not succeed in passing off action against those services but that is something to consider when I address the question of misrepresentation.

46. To summarise therefore, I find that as at the date of application, the opponents enjoyed a reputation and goodwill in their trade mark THE MONEY SHOP in respect of the service of cashing cheques offered through high street outlets.

### Misrepresentation

47. Mr Hobbs, in the *Wild Child* case mentioned above, referred to *Halsbury's Laws Of England*. Mr Abrahams kindly supplied me with a copy of the relevant passages taken from the 4<sup>th</sup> Edition 2000 reissue at paragraphs 316-320 . It states:

“To establish a likelihood of deception or confusion in an action for passing-off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the claimant has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

The question whether deception or confusion is likely is one for the court which will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to

the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

48. The passage notes that whilst the first two elements appear to be two separate hurdles they are in fact inter-related. It seems to me that the question that I must answer is as follows:

Having regard to the goodwill and reputation found in the trade mark THE MONEY SHOP for cheque cashing services amongst ordinary members of the public, will those persons mistakenly infer from the applicants’ use of the mark THE MONEY SHOP on the goods and services for which registration is sought, that they are provided by the opponents or are connected.

49. I must assume notional and fair use across the specification for which registration is sought; this, as noted by Pumfrey in *South Cone*, is capable of raising a number of factual difficulties. In answering that question I take into account the factors listed above.

50. I have already decided that the opponents have a reputation in the mark but that it is for a fairly specialised area within what might be termed the provision of finance. Although it seems to me that the opponents’ customers would tend to be those either without bank accounts or those that need cash quickly, I accept that some small businesses may also make use of this service. Thus their direct customer base would it seems to me be quite limited. That said, as I found above, they are very visible on the high street of those towns and cities where they are based and as such, the trade mark would be exposed to a much large section of the public. Their marketing seems fairly forthright both in their shop fronts and their press advertisements and I do not doubt that those encountering their premises or advertisements would be in little doubt as to the service they provided.

51. Mr Abrahams was of the view that I should readily infer misrepresentation if the application covered an area which although not an area of business in which the opponents were currently engaged, members of the public might assume to be a natural extension of the opponents’ business; *Halsbury’s Laws of England* at paragraph 318. Although there is no longer a requirement of a common field of activity before an application for passing off can succeed it remains one of the factors to consider when addressing the question of misrepresentation. The further apart the relevant areas of trade, the less likely the relevant public will believe that those goods or services are provided by or linked to the opponents. Mr Abrahams was right in my view to narrow his attack in his skeleton to specific aspects of the goods and services covered by the application. The specification is very broad and it seems to me that in respect of some of the goods and services, the opponents held no prospect of success.

52. Naturally, Mr Bartlett expressed his view that the opponents’ reputation did not extend to the goods or services covered by the application and that they were so removed from one another that there was no danger of misrepresentation. There was in his view, clear blue water between the parties. I will therefore consider the areas of conflict identified by Mr Abrahams.

## Class 9

53. Mr Abrahams objected to goods related to finance and financial advice. He gave the example of “non-printed publications...by on-line delivery” which in his view could include publications that gave financial advice and information. He argued that one could easily imagine the opponents providing such a service and that the use of the trade mark THE MONEY SHOP on such goods would suggest to those who knew of the opponents that such products were part of the opponents’ range of services or that the opponents had slightly expanded its business to provide such services. As such, he suggested the following limitation on the applicants’ specification:

*“but not including any such goods designed or adapted for use in relation to finances or the provision of finance, or which concern financial matters.”*

## Class 35

54. Mr Abrahams objected to the services in this class in so far as they included information and advice relating to financial assistance. He again argued that such use would be assumed by the consumer to be from or linked to the opponents. There was he suggested an obvious connection between the provision of finance and providing information and advice. He suggested the following limitation:

*“collation of information (except financial information)” and “business and management advice, information and research (but not including advice, information or research relating to financial matters)”.*

## Class 36

55. Mr Abrahams argued that this class should be refused in its entirety. His position was that the provision of information concerning insurance and investment services was, in other words, the provision of information concerning personal finance. In his view it was quite plain that a person who knew of the opponents’ trade mark and personal finance service on seeing the applicants’ trade mark used on such services would think that the two organisations are the same or linked.

56. Another factor to consider is the similarity of the marks in question. Even the applicants admit that the marks in question are very similar if not identical. Where the marks are identical or very similar, then it seems to me reasonable to infer that where the goods or services offered under the same mark are similar or associated, the average consumer is more likely to make that connection. Of course, the average consumer is accustomed to seeing identical marks on dissimilar goods or services and not making such a connection, for example, TOTAL for yogurt and TOTAL for petroleum.

57. I must also take into account the manner in which the applicants’ have used the mark. However, in this case, there is little or no evidence as to how the mark has been used before the date of application. There is some evidence after that date which is said to reflect the use that has been made prior to the relevant date. The use is on a website which customers visit in

order to find links to providers of finance, pensions, loans and insurance.

58. The relevant public here are ordinary members of the public, given that the relevant goods and services are concerned with the provision of finance and financial information one might expect them to be more observant than if they were selecting an everyday item. However, as noted by Mr Abrahams, the marks here are identical.

#### The Effect of the Applicants' Use

59. The applicants have shown some use of the mark in relation to a website. This commenced in 1996. Although it is a factor to take into account, it is not in my view one that will affect the outcome of these proceedings. Whilst I do not find that this alters the material date for assessing the question of misrepresentation which remains in my view the date of application, it seems to me that where a party seeks to prevent another from registering their trade mark using the law of passing off, then where the applicant has been using that mark in the market place, the manner and length of use should be factors that I take into account. That said, as noted above, it seems to me that the use has been on a relatively small scale. The absence of confusion in these proceedings is again in my view not surprising. There would seem little mechanism for either the opponents or the applicants becoming aware of customer confusion. If a customer accessed the applicants' site looking for information on investments or insurance and believes that the service is provided by the opponents, how are the opponents to become aware of this. Even if he is dissatisfied with the results he finds on the applicants' site, he is unlikely to complain.

#### Effect of the opponents' mark proceeding on honest concurrent use

60. Mr Bartlett pointed out that the opponents in the evidence presented in support of their own application, had indicated that there was no confusion in the market place despite a number of marks containing the element MONEY. He suggested that this should be held against the opponents in these opposition proceedings. It seems to me that the provisions relating to honest concurrent use in examination proceedings are to some extent artificial. All the applicant has to show is that they have been using the mark for a period of time. The examiner has no knowledge as to the use, if any, of the marks which are earlier rights and reported as citations. As noted, the applicants' use is in my view on a low scale. Therefore, I do not believe that the opponents' statement can be held against them here. That said, it does no more than confirm the obvious, ie that the use of the word MONEY in relation to financial matters is either descriptive or lacking in distinctive character.

#### Conclusions on the question of misrepresentation

61. Taking account of all these factors, and in particular, the identity of the marks it seems to me that the average consumer, aware of the name THE MONEY SHOP when used in relation to cheque cashing services, on seeing the mark THE MONEY SHOP used in relation to the same or closely similar goods or services would in my view believe that those goods or services came from the opponents or were linked to the opponents. Thus, it seems to me, given their reputation for cheque cashing, use of the mark on goods and services associated with the provision of finance would result in a misrepresentation.

62. However, it seems to me that Mr Abrahams has cast his net too wide. Despite the fact that the marks in suit are identical, in my view given the narrow scope of the opponents' use, use of the applicants' mark on goods or services which are not directly linked to the provision of finance would not lead the average consumer to believe that the goods or services were provided or linked to the opponents. It seems to me that the users of cheque cashing services and those seeking financial, insurance or investment advice would not necessarily be the same. Nor, in my view, is there a link between the cheque cashing services and the provision of information concerning finance, insurance or investment. In my view, to suggest otherwise would be a leap too far for the opponents; use on such goods and services would not result in a misrepresentation. I will deal with the consequences of my decision below.

### Damage

63. Lastly I must consider the question of damage. Having regard to my findings in respect of misrepresentation, then in my view damage will follow. Where there is goodwill in a sign and another uses an identical sign such that there is a misrepresentation then damage can be inferred. Use of the trade mark on those goods or services would not be under the control of the opponents, any such use could damage their goodwill and reputation.

### Conclusions under section 5(4)(a)

64. Therefore, I reach the following findings in respect of each of the classes covered by the application.

#### Class 9

I find that the ground is made out in so far as the specification covers goods designed or adapted for use in relation to the provision of finance.

#### Class 35

I find that the ground is made out in so far as the specification covers services concerned with the provision of finance.

#### Class 36

I find that the ground is not made out in so far as it relates to services in class 36

### Consequences of Decision

65. The opponents have succeeded in part. The applicants must file a Form TM21 restricting the specification of the application as shown below within one month of the date of the expiry of the appeal period. Failure to file the Form TM21 will result in the application being refused in its entirety. The application should be amended to read:

## Class 9

Computer hardware, software and firmware; computer software, firmware and hardware for use with computer networks; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting and retrieving publications, text, signals, software, information, data, code, sounds and images; audio and video recordings; audio recordings, video recordings, music, sounds, images, text, publications, signals, software, information, data and code provided by telecommunications networks, by on-line delivery and by way of the Internet and the worldwide web; multi-media apparatus and instruments; non-printed publications including those provided by telecommunications networks, by on-line delivery and by way of the Internet and the worldwide web; educational and teaching apparatus and instruments; parts and fittings for all the aforesaid goods; but not including any such goods designed or adapted for use in relation to the provision of finance.

## Class 35

Advertising, promotional and publicity services; personnel and recruitment services; market research services; collation of information, but not including information concerning the provision of finance; business and management advice, consultancy, information and research; none being in relation to the provision of finance.

## Class 36

Provision of information concerning insurance and investment services including that provided by telecommunications networks, by online delivery and by way of the Internet and the world wide web.

## Costs

66. The opponents have been successful albeit in part. I heard submissions on costs at the conclusion of the hearing. If he succeeded in his application to restrict the applicants' specification, Mr Abrahams sought his costs from the scale. Mr Bartlett resisted that submission. In his view, the fact that the opponents had not identified their area of dispute should go against them. He pointed out that their statement of grounds sought refusal of the application in its entirety. If the opponents were successful in narrowing the specification then in respect of the other aspects of the mark the applicants had succeeded and should have a contribution towards their costs.

67. I can see logic in Mr Bartlett's submissions. As noted above, it seemed to me sensible that the opponents had, even if it was late in the day, identified the aspects of the applicants' specification to which they objected. It may be that if they had identified this in the statement of grounds, a suitable limitation could have been agreed. Given the history between the parties that may not be the case here but nevertheless it is good practice in my view to identify clearly those areas to which the ground is directed.

68. Taking all these factors into account, I reach the view that although the opponents have succeeded in part, the most appropriate course of action is to make no order as to costs. Each party shall bear their own costs of these proceedings.

**Dated this 08 day of April 2002**

**S P Rowan  
For the Registrar  
the Comptroller General**