

O-166-07

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2356921
IN THE NAME OF GERARD DUGDILL
TO REGISTER THE TRADE MARK EVERYMAN IN CLASS 16**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 93313 IN THE NAME OF
THE INSTITUTE OF CANCER RESEARCH:
ROYAL CANCER HOSPITAL & EVERYMAN ACTION AGAINST MALE CANCER**

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**IN THE MATTER OF Trade Mark Application No. 2356921
in the name of Gerard Dugdill
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**IN THE MATTER OF opposition thereto
under No. 93313 in the name of The Institute of Cancer Research: Royal Cancer
Hospital & Everyman Action Against Male Cancer**

BACKGROUND

1. On 27 February 2004, Blue Moon Publishing made an application to register the trade mark EVERYMAN in Class 16 in relation to the following specification of goods:

Paper; printed matter; magazines, journals, periodicals, medical and scientific publications; literature relating to lifestyle and women's health; all included in Class 16; but not including books or encyclopaedias.

2. On 30 March 2005, The Institute of Cancer Research: Royal Cancer Hospital & Everyman Action Against Male Cancer filed notice of opposition to the application, the grounds of opposition in summary being as follows:

1. Under Section 5(4)(a) by virtue of the law of passing off.

2. Under Section 3(6) because the application was made in bad faith.

3. The applicant filed a counterstatement in which he says that the application was filed as a defensive measure and is not an act of passing off or bad faith.

4. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither side took up the offer of an oral hearing, instead electing to file written submissions in lieu of a hearing. After a careful study of the evidence and submissions, I now go on to give my decision.

Opponents' evidence

5. This consists of a Witness Statement dated 6 April 2006, from Anthony Laurence Misquitta, a solicitor with Farrer & Co, the opponents' solicitors. Mr Misquitta exhibits a copy of the Statement of Grounds as Exhibit ALM1. Much of the Witness Statement consists of submissions on the law and the relative merits of these proceedings. Being submissions it is not appropriate that I summarise them, but I will, of course take them fully into account in my determination of the case. Where evidence of relevance or fact is provided, I have summarised this. Exhibits ALM2 and ALM3 consist of legal extracts supporting these submissions.

6. Mr Misquitta says that the Institute of Cancer Research (ICR) was established in 1909 to

investigate the causes of cancer and develop new strategies for its prevention, diagnosis, treatment and cure. ICR was incorporated into a limited company on 4 June 1954, and designated an exempt charity under the Exempt Charities Order 1962 made pursuant to the Charities Act 1960. Everyman Action Against Male Cancer (EAAMC) was incorporated on 29 February 1996, and is a wholly owned subsidiary of ICR. Related documentation from Companies House is shown as Exhibit ALM5. Mr Misquitta says that EAAMC was set up to raise the awareness of cancer, and raise funds for research into the prevention of prostate and testicular cancer in the UK. He says that the name EVERYMAN is a central part of the opponents' campaigns, and is the largest male cancer charity campaign in Europe.

7. Mr Misquitta says that ICR and EAAMC have extensively used EVERYMAN and associated stylised marks since January 1996, in a wide range of high profile campaigns that inevitably involved extensive publicity across all forms of media, including printed publications and literature. He says that this generated a significant amount of goodwill. A list shown as Exhibit ALM5 gives details of EVERYMAN related events dating from April 1999, mailings, press and PR coverage starting with a Christmas appeal in 1997, campaigns from 2000, marketing materials dating from 1999 and corporate relationships beginning in 2004. Some mention EVERYMAN in the title, but there is nothing that shows whether and how the mark may have been exposed to the public.

8. Mr Misquitta says that as part of its overall strategy to raise awareness for the EVERYMAN campaigns, in 2003 the opponents entered into an informal relationship with Blue Moon Publishing (BMP), the publisher of magazines, including one published annually entitled "Aware" targeted at young men with the specific aim of raising awareness of all male cancers. Mr Misquitta says that with the consent of the opponents, the 2003 edition of Aware featured the EVERYMAN awareness campaign. A copy of the magazine is shown as Exhibit ALM6. The cover page bears the date June 2003 and at the foot the word EVERYMAN with a cross placed above the letter "n", and the words "Funding research to cross out male cancer". The second page contains the word EVERYMAN in large letters, beneath stating "EVERYMAN IS PART OF THE INSTITUTE OF CANCER RESEARCH AND WAS ESTABLISHED FIVE YEARS AGO TO RAISE AWARENESS AND FUNDS FOR MALE SPECIFIC CANCERS". The next page, inter alia, states "DURING JUNE THE FOLLOWING ACTIVITIES ARE TAKING PLACE TO SUPPORT EVERYMAN", "The Institute of Cancer Research launched the Everyman Campaign in 1987...", and "Everyman would like to thank the following for their support during June, male cancer awareness month", going on to refer to the participation by the businesses shown beneath the entry "Aware magazine sold in W H Smith" in Exhibit ALM5. The page also contains the EVERYMAN cross logo. Other references to EVERYMAN, ICR, or The Institute can be found in later pages, along with reference to other awareness raising initiatives. The final part of the exhibit includes a leaflet referring to the EVERYMAN campaign and ICR, inviting donations to aid research.

9. Turning his attention to the bad faith allegation, Mr Misquitta refers to Exhibit ALM7, which consist of a copy of the Micky Dees (Nightclub) trade mark case. He goes on to set out details of the relationship between ICR/EVERYMAN and the Mr Dugdill, which the opponents brought to an end in late 2003 – early 2004. Mr Misquitta says that the applicant has since made repeated requests to be allowed to formally associate itself with the opponents' EVERYMAN campaign, including use of the trade mark. Mr Misquitta asserts

that the applicant was aware of ICR's continued use of EVERYMAN in its campaigns and their investigations into the possibility of publishing a magazine to be entitled Everyman. Mr Misquitta says that ICR had explored this possibility with the publishers Xcess Media Limited for 2004. He refers to Exhibit ALM8, which consists of e-mails exchanged between ICR and the publishers of Aware magazine, stating that this "highlights the opponents' intent...and shows that even the Applicant referred to the Opponent by its campaign name "Everyman"". The e-mail dated 10 March 2004 from Philip Black to Kamala Panday of Aware magazine does suggest that the opponents would consider working with other publishing companies, and in several places in the e-mails Ms Panday refers to the opponents as Everyman.

Applicants' evidence

10. This consists of a Witness Statement dated 7 July 2006, from Gerard Dugdill, formerly Blue Moon Publishing. Much of what is contained in this Witness Statement consists of submissions on the relative merits of the case, and denial of the allegations made, and as such it is not appropriate that I summarise them. I will, of course, take them fully into account in my determination of the case. Where evidence of relevance or fact is provided, I have summarised this.

11. Mr Dugdill says that Blue Moon Publishing did not go into liquidation, but does have a liquidator who was appointed in May 2006. Exhibits GD1 and GD2 consist of letters and documentation related to this issue. Referring to the applicant's claims in the Counterstatement, a copy of which is shown as Exhibit GD3, Mr Dugdill asserts that the opponents' use has not been in relation to goods covered by the application, and where there has been use this accrues to the applicants. He recounts how staff who had been involved in Aware magazine had left to set up a rival publication under the name of Xcess Media, and had contacted advertisers telling them that that magazine had set up under the name EVERYMAN. Exhibit GD4 consists of a letter dated 19 January 2004, from Victor Chandler Worldwide to Xcess Media, referring to a telephone call they had received from Xcess in which Xcess claimed that Aware magazine was to be published under the new name of EVERYMAN, and to having discovered that Aware was still being published.

12. Mr Dugdill refers to Exhibit GD5 which consists of a circular stating that the EVERYMAN male cancer campaign was to associate itself with a new magazine entitled Every Man to be launched in 2004 by Xcess media. Exhibit GD6 consists of details for registrations of EVERYMAN effected by third parties, Mr Dugdill asserting that this shows that no significance should be drawn from the fact the opponents' and the applicant's marks are identical. Exhibit GD 7 consists of a copy of the cover of the Aware 2004 magazine, Mr Dugdill referring to the fact that this shows the magazine to be associated with the charity called Orchid 2004. Exhibit GD8 consists of an Affidavit sworn by Mr Dugdill in which Mr Dugdill states that EAAMC had stated that working with a magazine was not commercially viable. Mr Dugdill denies that the applicants were aware of the possibility of the opponents publishing a magazine entitled EVERYMAN prior to the application date.

Opponents' evidence in reply

13. This consists of a Witness Statement dated 6 October 2006, from Alastair Charles Cotton.

This Witness Statement consists of submissions on the Witness Statement of Gerard Dugdill, on the law and relative merits of the respective cases, and a denial of the allegations made. As I have already said, it is not appropriate for submissions to be summarised as evidence. I will, however, take them fully into account in my determination of the case.

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

DECISION

15. I turn first to the ground under Section 5(4)(a) of the Act, which 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.”

16. In their Counterstatement, the applicant has the following to say in relation to the allegation of passing off:

“*The use of the Everyman mark on those goods by the applicant*”

It was not our intention at the time of application to use the Everyman mark in relation to a publication. Rather, the application was made as a defensive measure against what we saw as unlawful practices in trying to produce a “rival magazine” – a passing off of our own unique product being “created” through malicious falsehoods, and through breach of employment contract of our former employees (this relates to legal proceedings referred to para B5 of the opponent’s response, the “third party” including a group of ex-employees of Blue Moon Publishing (BMP), which produced the magazine *Aware*.) This “rival” would be using the name applied for in the trademark, it seemed. We believed this gave valid reason for us to apply for the trademark to help stop such illegalities used to create another magazine.

“*may result in misrepresentation...causing damage*”

Re any misrepresentation, we believe that the converse is true, that any goods created by the opponent would actually be thought of as those of the applicant, particularly in the way the magazines are sold to potential advertisers (using the same charity and ex-employees in an illegal manner to produce a very similar magazine, with statements referred to when selling this “rival” to the effect that “our magazine [*Aware*] was no longer being produced, but this new *Everyman* magazine was merely the same magazine with a new name”).

We believe we were further justified in taking such preventative measures given what we saw was a campaign of lying, and misinformation presented to us by the charity,

including statements to the effect that they were no longer interested in working on a magazine for male cancers because “it was not worthwhile for them commercially”. They then afterwards appeared to link or already linked with ex-employees of our company, certainly from press material being circulated to our advertisers by a third party, in breach of employment contract. Currently the opponent is a witness against BMP in these legal proceedings.

In sum, no such passing off is intended on the part of the applicant, rather the application was part of a defensive measure partly to prevent passing off of its own products.”

17. 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 *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 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 goods or services offered by the defendant are goods or services of the plaintiff;

and

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

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal, definition of 'passing off', and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

18. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

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

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

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

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

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

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

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

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

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

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

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

In *Reckitt & Colman Products Ltd v Borden Inc and others* [1990] RPC 341, (also known as the "*Jif Lemon*" case) Lord Oliver (page 880) summarised the law this way:

"It has been observed more than once that the questions which arise are, in general, questions of fact... The law of passing off can be summarised in one short general proposition – no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or

packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Second, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. Whether the public is aware of the plaintiff's identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the plaintiff. For example, if the public is accustomed to rely on a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Third, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff".

19. To the above I add the comments of Pumfrey J in *South Cone Incorporated v Jack Bessant, and others*, [2002] RPC 19, in which he said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under S.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 RPC 97 as qualified by *BALI Trade Mark* [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.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur.”

20. 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. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced, as per the comments in *Cadbury Schweppes Pty Ltd v The Pub Squash Co Pty Ltd* [1981] RPC 429.

21. The starting point is to ascertain whether the opponents have goodwill in the name EVERYMAN. In *IRC v Muller and Co's Margarine* [1901] AC 217 at 223, Lord Macnaughton explained what is meant by “goodwill” in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

22. It is clear from this and other authorities that goodwill in a sign is acquired by using it in some form of commercial activity. In *Kean v McGivan* [1982] FSR 119, Ackner LJ stated:

“It is well-settled--and I do not need to refer to the text books; it is amply set out in the text books and in particular in Halsbury and in Clarke and Lindsell--that apart from statute there is no property in a name as such; and, in the absence of misrepresentation or some malicious motive, a man or woman has the right to use not only his own name but to adopt the name of another for himself or his property. This is so despite the fact that this can give annoyance and inconvenience, and there are decided cases dealing with the consequences which can occur when a house is given a particular name which is also the name of another house of a telegraphic address. However, if the particular name is used in connection with a business or a profession, it may achieve a right to prevent another person from using that name in a manner likely to cause confusion in the minds of members of the public. But the basis of a right of action in passing off is that the conduct of the defendant is such that the public may be led to believe that the goods which the defendant is offering or the services which he is offering are in fact the goods or services of the plaintiff. The property which is said to be injured in that situation is not the name or the description of the goods but the right to the goodwill of the business which results from the particular commercial activity. Therefore the courts do not in general interfere to protect a non-trader. I hasten to add that of course the word "trade" is widely interpreted and includes persons engaged in a professional, artistic or literary occupation. Thus the action lies where there is a real possibility of damage to some business or trading activity.

Therefore the plaintiff must establish that in some sense he is carrying on a business with which the trade or public will be led to associate the defendant's activities.”

23. The opponents are not a commercial organisation in the normal sense of the word. They do not trade in goods or provide services in return for payment. Consequently, they offer no tangible benefits from which they could be said to create an attractive force that brings them custom. The courts have nevertheless been prepared to protect the goodwill of a charity: See *British Legion v British Legion Club (Street) Limited* [1931] 48 RPC 555 at 562.

24. There are two differences between the *British Legion* case and the position here. In the *British Legion* case the goodwill relied upon subsisted in the name of the charitable organisation itself, whereas in these proceedings it is attached to a secondary name created for a specific campaign. There was also conclusive evidence that the plaintiffs in the *British Legion* case had made extensive use of the name, and that it was widely known as a charitable organisation of some standing. Whilst there is evidence that clearly shows the

opponents to have used EVERYMAN as part of a campaign related to raising the awareness of male cancer, there is nothing that explicitly tells me the extent of this use. It is therefore a matter of piecing together what there is, and assessing whether this use is likely to have established a goodwill or reputation.

25. The one piece of evidence that actually shows EVERYMAN, (as a word alone and in a composite mark with a cross and the words “Funding research to cross out male cancer”) in use as part of a campaign can be found as Exhibit ALM6. This consists of a copy of the publication entitled AWARE that had participated in a campaign in 2003. The magazine was published by Blue Moon Publishing, a company with whom Mr Dugdill, the applicant, had been involved. Mr Dugdill asserts that this use would gravitate to him rather than the opponents. I do not agree. The fact that the publication may be associated with the applicant does not necessarily mean that the contents will also. There are references to EVERYMAN being connected with, or part of the campaign run by the Institute of Cancer Research throughout the magazine, and I do not see how there could have been any doubt or confusion over who was using the name and for what purpose. The problem is that whilst I know how the mark has been used, and have no doubts that anyone reading the magazine would connect the name with ICR, I know nothing about how, where and to whom the magazine was distributed, or even how many copies were sold. Even so, I do not consider it to be unreasonable to infer that copies did reach the public.

26. Where the magazine does help is in the information that it gives in relation to the organisations that are noted as supporting the EVERYMAN campaign in various ways, for example, TOP SHOP produced an exclusively designed T-shirt, the peanut brand Big D had one of their models participate in “cheeky initiatives” in pubs across the UK, the fashion brand Base London were to launch a T-shirt design competition from which the shirt would be manufactured and sold throughout the UK, the shaving product company King of Shaves offered free shave kits for people to organise sponsored shaves in aid of the campaign, the Professional Footballers Association ran a “keep your eye on the ball” campaign. Other high profile businesses such as Hayes and Curtis are noted as providing donations from sales. To my mind, that such well known businesses and organisations took part is a clear indication that the EVERYMAN campaign was widely known, and through their involvement reached a significant part of the public who buy goods of the sort covered by the application. The opponents describe EVERYMAN as the largest campaign of its type in Europe, a claim not challenged by the applicant. There is also the list of events, press and PR coverage, and campaigns listed in Exhibit ALM5. Whilst some of these specifically mention that this was part of the EVERYMAN campaign, and others can be seen to have done so from their mention in Aware magazine, many do not actually say this. However, the opponents’ claim that these events were promoted as part of the campaign has gone unchallenged. I see no reason to doubt the veracity of Mr Misquitta’s statement that they were.

27. Even without support from Exhibit AJM5 I consider there to be sufficient information upon which to be able to infer that at the relevant date, the opponents had a reputation in respect of EVERYMAN, and as the name that drew donations to the campaign, also possessed goodwill.

Misrepresentation

28. The trade mark applied for is identical to the name used by the opponents, and in which they have an established goodwill. There can be no dispute that charities use printed publications as a vehicle to get in touch with potential contributors, to provide information, or convey the messages and aims of their organisation. This is exactly what the evidence shows the applicant's involvement through the vehicle of their *Aware* magazine had been. This "involvement" is also illustrative of the fact that there is a natural relationship between charities and the goods covered by the application, but even without this evidence, it could hardly come as any surprise if I were to say that charities use printed means to interface with the public. The qualification of the goods of the application to being related to "lifestyle and women's health" seems a little at odds with the name **EVERYMAN**, and it would be easy to draw the inference that this was an attempt to put a little distance between the use by ICR. However, as the name **EVERYMAN** is already known in the market as a male cancer awareness campaign, I do not consider that the gender distinction would make any difference. The public is likely to see it as a connected campaign relating to women. Use by the applicant in relation to the goods sought to be registered would amount to a misrepresentation.

Damage

29. There is no evidence that the applicant has used **EVERYMAN**, and statements such as "...the application was in part made as a defensive measure partly to prevent passing off of its own products." leaves considerable doubt as to whether he intends to do so. In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 [1939] RPC 429 Goddard L.J. stated:

"But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man's business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage."

30. There is, of course the matter that there is no evidence that the opponents produce or trade in goods of the kind covered by the application. There is some suggestion in the evidence, and I put it no stronger than that, that the opponents may have gone on to produce a publication under the name **EVERYMAN**, be it alone or in conjunction with another. There is some doubt because of Mr Black's comments regarding the commercial viability of taking such action. The difficulty of establishing confusion where there is a distance between the fields of activities was considered by Millet L.J. in *Harrods v Harrodian School* [1996] RPC 697 at page 713, Millet LJ stated:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

at page 714

“The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

31. In *Stringfellow v McCain Foods (GB) Ltd* [1984] RPC 501 Slade LJ considered the difficulty of establishing damage where the parties are in different lines of business:

“even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs, as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than a minimal loss is in my opinion a heavy one.”

32. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31, Lord Fraser emphasised the substantial nature of the damage that a plaintiff must establish:

“That he has suffered, or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

33. As I have already said, the trade mark applied for is identical to the name in which the opponents have established goodwill. There is a connection between the goods of the application and charities; they have a natural relationship. The qualification of the goods of the application to being related to “lifestyle and women’s health” indicates an intention to use the EVERYMAN name in connection with health matters, and potentially cancer. The difference in gender to that for which the name EVERYMAN is already known would not, to my mind change the perception of the public, who will see it as a connected campaign or another phase. **To my mind, notwithstanding the “defensive” justification that the applicants seek to pray in aid, this is a clear case of passing off and the ground under section 5(4)(a) succeeds.**

34. My decision under Section 5(4)(a) effectively decides the matter, but for completeness I will go on to look at the allegation of bad faith founded under 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.”

35. In *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J.

considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

36. In *Harrison v. Teton Valley Trading Co* [2005] FSR 10, the Court of Appeal confirmed that bad faith is to be judged according to the combined test set out by the House of Lords in *Twinsectra v Yardley* [2002] 2 AC 164. Paragraphs 25 and 26 of the Court of Appeal decision are of particular assistance and read as follows:

“25. Lord Hutton went on to conclude that the true test for dishonesty was the combined test. He said:

““36. Therefore I consider that your Lordships should state that dishonesty requires knowledge by the defendant that what he was doing would be regarded as dishonest by honest people, although he should not escape a finding of dishonesty because he sets his own standards of honesty and does not regard as dishonest what he knows would offend the normally accepted standards of honest conduct.””

26. For my part, I would accept the reasoning of Lord Hutton as applying to considerations of bad faith. The words “bad faith” suggest a mental state. Clearly when considering the question of whether an application to register is made in bad faith all the circumstances will be relevant. However the court must decide whether the knowledge of the applicant was such that his decision to apply for registration would be regarded as in bad faith by persons adopting proper standards.”

37. Thus, in considering the actions of the registered proprietor, the test is a combination of the subjective and objective. Furthermore, it is clear that bad faith in addition to dishonesty, may include business dealings which fall short of the standards of acceptable commercial behaviour i.e. unacceptable or reckless behaviour in a particular business context and on a particular set of facts.

38. I am reminded of the comments of Nicholls LJ in the Privy Council judgment *Royal Brunei Airlines Sdn Bhd v. Tan* [1995] 2 AC 378, when he described dishonesty as “...to be equated with conscious impropriety”. This was in the context of accessory liability in the misapplication of trust assets to the detriment of a beneficiary. However, I think the same general principles would apply in trade mark law in the context of the current proceedings. He added:

“In most situations there is little difficulty in identifying how an honest person would behave. Honest people do not intentionally deceive others to their detriment. Honest people do not knowingly take others’ property The individual is expected to attain the standard which would be observed by an honest person in those circumstances. It is impossible to be more specific. Knox J captured the flavour of this, in a case with a commercial setting, when he referred to a person who is “guilty of commercially unacceptable conduct in the particular context involved”: see *Cowan de Groot Properties Ltd v. Eagle Trust Plc* [1992] 4 All ER 700 at 761. Acting in reckless disregard of others’ rights or possible rights can be a tell-tale sign of dishonesty. An honest person would have regard to the circumstances known to him, including the nature and importance of the proposed transaction, the nature and importance of his role, the ordinary course of business, the degree of doubt Ultimately, in most cases, an honest person should have little difficulty in knowing whether a proposed transaction, or his participation in it, would offend the normally accepted standards of honest conduct.”

39. In the Privy Council judgment in *Barlow Clowes International Ltd v. Eurotrust International Ltd* [2005] UKPC 37, their Lordships took the opportunity to clarify the speculation that *Twinspectra* had changed the law. The judgment confirmed the House of Lords’ test for dishonesty that had been applied in *Twinspectra*, i.e. the combined test, and clarified their Lordships’ statement of that test by making it clear that an enquiry into a defendant’s views as regards normal standards of honesty is not part of the test.

40. In my determination of the ground under Section 5(4)(a) I drew attention to the connection and natural relationship between the goods of the application and charities, and the fact that such a relationship had existed between the respective parties. I also took the limitation of the goods of the application to being related to “lifestyle and women's health” as an indication of an intention to use the EVERYMAN name in connection with health matters, and potentially cancer. The applicant cannot have been in any doubt that the opponents had used and intended to continue using EVERYMAN in connection with their male cancer awareness campaign. The use that they had been connected with did not derive them any rights to the name which the evidence shows that they accepted as being in the ownership of ICR. The evidence also shows that having been told that the opponents would not be continuing their association with *Aware* magazine, Ms Panday sent a number of e-mails to Phillip Black attempting to bring ICR back on board. The applicant was clearly concerned by the actions of his ex-employees but that has nothing to do with the opponents, or give the applicant the right to appropriate their mark as a defensive measure or whatever. It may, or may not be the case that the opponents were considering associating themselves with Xcess Media, the company formed by these ex-employees, but that was a matter for them and did not give the applicant the right to take what is not theirs.

41. In making the application the applicant seeks to deprive the opponents control of their asset and the rights vested in it, and taking all of the circumstances into account, I find this action to be an act of bad faith. **Accordingly, the ground under Section 3(6) also succeeds.**

42. The opposition having been successful, the opponents are entitled to a contribution towards their costs. I therefore order that the applicant pays the opponents the sum of £2,100

towards their costs. This is 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 12th day of June 2007

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