

O-227-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 2371424 IN THE NAME OF ENERGY SERVICES ONLINE LIMITED  
TO REGISTER A TRADE MARK IN CLASSES 1, 4, 35, 36, 38 AND 39**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 93112 IN THE NAME OF  
M3 & W INC.**

## **Trade Marks Act 1994**

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No. 2371424 in the name of Energy Services Online Limited  
to register a trade mark in Classes 1, 4, 35, 36, 38 and 39**

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**IN THE MATTER OF opposition thereto  
under No. 93112 in the name of M3 & W Inc.**

### **BACKGROUND**

1. On 24 August 2004, Energy Services Online Limited made an application to register the trade mark ENERGY SHOP in Classes 1, 4, 35, 36, 38 and 39 in relation to the following specifications of goods and services:

- |          |  |
|----------|--|
| Class 1  | Electricity.   |
| Class 4  | Fuels, gas, gaseous fuels, oil.  |
| Class 35 | Advertising; auditing; business appraisals; business consultancy; business information services, business promotion, business management consultancy, business administration; provision of price information relating to the supply of consumer and business goods and services including telecommunications, telephony, broadband, ADSL, DSL, ISP, WI-FI, electricity, gas, and financial services generally; taking applications and contracts for the supply of various goods and services to consumers and businesses, including telecommunications, telephony, broadband, ADSL, DSL, ISP, WI-FI, electricity, gas, and financial services generally; statistical information; administration services relating to the connection of utilities; administration services relating to searching for and providing information on competitive prices of goods and services to consumers and businesses; accountancy services relating to the consumption of gas, electricity, and other energy sources; provision of information and advice relating to all the aforementioned services. |
| Class 36 | Brokerage services, financial consultancy, financial evaluation, financial information, financial management, the provision of financial advice relating to the supply of consumer and business goods and services including telecommunications, telephony, broadband, ADSL, DSL, ISP, WI-FI, electricity, gas, insurance and financial services generally; brokerage services relating to the taking of applications and contracts for the supply of various goods and services to consumers and businesses from suppliers of telecommunications, telephony,  |

broadband, ADSL, DSL, ISP, WI-FI, electricity, gas, insurance, and financial services generally.

Class 38 Telecommunication services, including electronic mail services, providing user access to the Internet; Internet communication services; electronic communication services, including the provision of video on demand; Internet service provider facilities, broadband, cable, digital, ADSL, DSL, WI-FI, satellite television, wireless applications protocol and personal communication broadcasting services; provision of telephony services, including over the Internet; broadcasting services; message sending services; data transmission services; rental of telecommunications, broadcasting, broadcast receiving, message sending, and message receiving apparatus and instruments; the provision of information and advice services relating to all of the aforementioned services.

Class 39 Storage, distribution, transportation, supply and delivery of fuel, oil, and gas; storage, distribution, supply and delivery of electricity; the provision of information and advice services relating to all of the aforementioned services.

2. On 13 January 2005, M3 & W Inc. filed notice of opposition to the application, the ground of opposition being as follows:

**Under Section 5(2)(b)** because the mark applied for is similar to the opponents' earlier trade marks, and is sought to be registered in respect of goods or services that are identical and/or similar to the services for which these earlier trade marks are registered, such that, there exists a likelihood of confusion on the part of the public.

The objection is founded on the basis that the opponents have the mark ENERGYSHOP and ENERGYSHOP.COM registered in Canada, which is a member of the WTO, and on the basis that it is well known and qualifies for protection under Section 6(1)(c).

3. The opponents rely on two earlier marks, details of which are shown as an annex to this decision.

4. The applicants filed a counterstatement in which they deny the ground on which the opposition is based. Both sides ask that an award of costs be made in their favour.

5. 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, the opponents instead electing to rely on 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

6. This consists of a Witness Statement dated 1 December 2005, from Greg Scott, President of M3 & W Inc.

7. As evidence that Energyshop.com is a division of M3 & W, Mr Scott refers to Exhibit 1a, which consists of a copy of a Master Business Licence issued by the province of Ontario on 1 December 1998. Exhibit 1b consists of extracts from an archive website Wayback Service, Mr Scott referring to the two alterations shown for the Energyshop.com website. As Exhibit 1c, Mr Scott provides copies of the trade mark registration documents for Energyshop and Energyshop.com, showing that these were filed in October 2001 and registered in 2004. As Exhibit 1d, Mr Scott provides copies of the web domain name registration for Energyshop.com, that shows M3 & W Inc to have owned this since 13 November 1997.

8. Mr Scott goes on to refer to Exhibit 4a to 4d, which consist of:

- 4a Business Number Summary of Accounts for M3 & W Inc, showing an effective date of 1 October 2001. This shows Energyshop.com to provide 80% of the company's revenue. There are no figures showing what this is 80% of.
- 4b Account Summary from December 1999 to September 2003, that appears to relate to charges for telephone calls made by ENERGYSHOP.COM.
- 4c copies of certificates of registration for the trade marks Energyshop.com and Energyshop showing registration dates of April 2004 and June 2003, respectively.
- 4d a print from the website of waybackmachine that includes a view of the EnergyShop.com web pages on 28 April 1999, 12 April 2000, 2 March 2001, 24 January 2002 and 4 February 2003. These give the domestic fuel user the option of comparing gas tariff rates, the business user to obtain information on obtaining gas and electricity, and energy companies access to customers or to advertise their products/services.

9. Mr Scott goes on to refer to a page from the Google search engine obtained on 3 October 2005, by inputting the search criteria, "electricity prices", Mr Scott highlighting that Google ranked EnergyShop.com as the most relevant result. He goes on to make the same point in relation to a search using the criteria "dual fuel prices". Mr Scott goes on to say why he considers these results to be the best proof that if a UK based domestic customer was to search for electricity or "dual fuel" prices, his business would be severely compromised should the application be allowed to proceed. Mr Scott goes on to refer to further searches on Google, noting that there are over 80 "third party web pages linked to his company's site". Mr Scott goes on to refer to another Google search using the criteria "energyshop", noting that the M3 & W site is the top ranked result. Mr Scott gives an explanation of how Google ranks results. These searches were all conducted on the world wide web at large, and not limited to pages from the UK.

10. Mr Scott states that for the year ending September 2004, his company's sales under EnergyShop.com amounted to \$4.18 million Canadian Dollars

### **Applicants' evidence**

11. This consists of four Witness Statements. The first is dated 7 June 2006, and is from Joe Malinowski, founder and Chief Executive of Energy Services Online Limited, having occupied these positions since the start of the company on 1 January 2003. Mr Malinowski says that his company trades as Energy Shop, The Energy Shop and TheEnergyShop.com.

12. Mr Malinowski says that his company has made continuous use of ENERGY SHOP and THE ENERGY SHOP since the start of the company, in respect of independent energy price comparison and switching services to domestic and business users in the UK. His company also acts as an agent for energy suppliers in obtaining new customers. Mr Malinowski gives details of his company's turnover for the years 2003 to 2006, which stands as £232,000, £656,000, £400,000 and a figure of in excess of £1 million, respectively, the final year being estimated because the actual accounts have not been finalised, but in any event is a period after the relevant date. Mr Malinowski says that since 2003 his company has conducted over 1 million searches, and helped over 50,000 customers to switch their energy suppliers, primarily through the website theenergyshop.com, although they also provide a telephone based service.

13. Mr Malinowski says that his company has a relationship with almost all of the main energy suppliers in the UK, as well as energy regulators. He refers to the evidence provided by some of the energy suppliers, mentioning in particular the Statements from Atlantic Electric and Gas, Scottish Power and E.O.N (previously known as Powergen) who, he says, all confirm that in relation to the ENERGYSHOP trade mark they have only dealt with his company. Mr Malinowski says that although the Statement from E.O.N. confirms a relationship from January 2005, this does not include his company's relationship with Powergen which dates back to September 2003. Mr Malinowski refers to Exhibit JM1, which consists of copies of e-mails from suppliers. These all refer to ENERGYSHOP but originate from well after the relevant date; they cast no light back.

14. Exhibit JM2 includes an ENERGYSHOP news release dated 27 January 2003, referring to energywatch, a consumer watchdog service, granting approval of The Energy Shop as an online cost saver service. Mr Malinowski says that his was the first company to gain this accreditation. He goes on to refer to an e-mail from Caroline McNabb of energywatch, confirming that during 2003-2004, 525,000 consumers requested a copy of the energywatch factsheet, Mr Malinowski saying that since February 2003, some 2 million domestic consumers will have heard of his company's services via this factsheet. The exhibit also includes a copy of the energyshop leaflet which Mr Malinowski says is posted to over 45,000 households each month. The example shown dates from April 2006, and amongst others, shows TheEnergyShop.com as a company that can assist with switching suppliers. Mr Malinowski says that his company also markets its products through e-mail marketing, online advertising, via search engines such as Google, Yahoo and MIVA, etc, but provides no detail.

15. Mr Malinowski says that since January 2003 his company has spent £550,000 promoting

the service provided under ENERGY SHOP, THE ENERGY SHOP, and TheEnergyShop.com, with the current budget running at some £75,000 per quarter, all of which has resulted in extensive media coverage.

16. Exhibit JM3 consists of a list of articles in the period 31 January 2003 through to 30 April 2006, all stated to have been related to at least one of the ENERGY SHOP names, primarily TheEnergyShop.com. The exhibit also includes copies of the related articles. The earliest is shown as appearing in a publication entitled UTILITY WEEK, and mentions ENERGYSHOP having been granted accreditation by Energywatch as a price comparison service. Later articles that appeared in trade, regional and national publications refer to the company using the ENERGY SHOP, THE ENERGY SHOP, and TheEnergyShop.com, primarily by the latter. Mr Malinowski states that his company issues reports under the name TheEnergyShop, examples of which he shows as Exhibit JM4. The exhibit consists of two reports issued in January/February 2004, and March 2005, written by Joe Malinowski. The front covers state “A REPORT BY TheEnergyShop®” with each page having a footer www.TheEnergyShop.com. Beyond stating that the report is “provided to the press leading to quotations in articles, to energy suppliers and to other interested parties” Mr Malinowski does not provide any details.

17. Exhibit JM5 consists of a publication entitled “Domestic Retail Market Report – September 2005” that was published by the Office of Gas and Electricity Markets on 6 February 2006, and which Mr Malinowski says relies heavily on his company’s data and analyses. The report contains several instances where the data is attributed to TheEnergyShop.com. Exhibit JM6 consists of a print from the Houses of Parliament Trade and Industry website taken on 1 June 2006, that Mr Malinowski says also draws on the data compiled by his company. The data relates to the period from April 2003, and contains a number of mentions where the source data is stated to have come from TheEnergyShop.com.

18. Mr Malinowski goes on to comment on some of the submissions made by the opponents. He challenges the claim to them having kept natural gas and electricity price comparisons for, inter alia, the UK because they are not on the tariff distribution lists. He also states that as can be seen from the supporting statements, the opponents are not known to the energy suppliers. Mr Malinowski challenges the claims that the Google search results are indicative of reputation, stating that when the search is limited to the UK from a UK IP address using the terms ENERGYSHOP, ENERGY SHOP as can be seen from Exhibit JM7, his company’s website appears more highly ranked than the opponents’ website. Mr Malinowski accepts that in a significant number of cases his company’s website will be higher placed because they pay for placement. Referring to Exhibit JM8, Mr Malinowski refutes the opponents’ claim that Archive.org does not hold any records relating to his company’s website. The exhibit is a print from the WAYBACKMACHINE website showing theenergyshop.com as having made amendments to its website. Mr Malinowski concludes his Statement by commenting on the opponents’ claims relating to the likelihood of confusion, noting in particular that this is unlikely because Canada and the UK are separate energy markets.

19. The second Witness Statement is dated 6 June 2006, and come from Ben Latham, Online Acquisition Manager of E.ON. Mr Latham says that he has been working with Energy Services Online Limited since January 2005, during which time “we have referred to them as both Energy Shop” and The Energy Shop”. He says that he is not aware of, or worked with

any other company of this name.

20. The third Witness Statement is dated 19 May 2006, and come from Chris Salveta, Six Sigma Blackbelt with Scottish Power Energy Retail Limited. Mr Salveta says that prior to his appointment to this position in September 2006, he had held the post of Ecommerce Marketing Manager for five years. He says that in this role he maintained an ongoing working contact with energy brokers such as Energy Shop, and can confirm that contact with this company extends back to 2003, and to Joe Malinowski in his capacity as owner. Mr Salveta says that he has never heard of, or dealt with any other organisation under this name.

21. The final Witness Statement is dated 1 June 2006, and comes from Richard Stoate, who between April 2002 and June 2004 had been employed as Sales Systems and Process manager for Atlantic Electric and Gas Limited, at that time a licensed supplier of electricity and gas. Mr Stoate says that supplies were distributed through a number of channels including online brokers such as The Energy Shop. Mr Stoate says that he had overall responsibility for managing such broker relationships. Mr Stoate says that his company first began trading with Energy Services Online Limited in January 2003, and continued until 8 April 2004. He says that this company was known both as Energy Shop and The Energy Shop, the main contact being Joe Malinowski. He says that he has never heard of or done business with any other company of that name.

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

## **DECISION**

23. The opposition is founded on Section 5(2)(b), which reads as follows:

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

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

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

24. An earlier trade mark is defined in Section 6 of the Act as follows:

“6.- (1) In this Act an “earlier trade mark” means-

(a) ...

(b) ...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.”

25. In relation to these proceedings the opponents assert that they are the proprietors of a well known trade mark. The provisions relating to claims of this nature start with Sections 55 and 56 of the Act, which reads as follows:

“55.(1) In this Act –

(a) ‘the Paris Convention’ means the Paris Convention for the Protection of Industrial Property of March 20<sup>th</sup> 1883, as revised or amended from time to time,

(aa) ‘the WTO agreement’ means the Agreement establishing the World Trade Organisation signed at Marrakesh on 15<sup>th</sup> April 1994, and

(b) a ‘Convention country’ means a country, other than the United Kingdom, which is a party to that Convention.”

and

“56.(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who-

(a) is a national of a Convention country, or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country, whether or not that person carries on business, or has any goodwill, in the United Kingdom. References to the proprietor of such a mark shall be construed accordingly.”

26. As mentioned in the Statement of Case, Canada has been a member of the WTO Agreement since 1 January 1995. In the *PACO/PACO LIFE IN COLOUR* trade mark case [2000] RPC 451, the Registrar’s hearing officer held that (a) a trade mark could only be well known in respect of the goods or services in respect of which it has been used, and (b) accordingly PACO RABANNE was not a well-known trade mark for clothing even though it had a reputation in relation to perfume. In his decision in the Le Mans trade mark case BL-0-012-05, Mr Arnold QC sitting as the Appointed Person stated the following:

“Conclusion (a) is a commonsense proposition of law which counsel for the opponent in the present case accepted.

In reaching conclusion (b) Mr James referred to paragraph 31 of the Opinion of Advocate General Jacobs in Case C-375/97 *General Motors Corp v Yplon SA* [1999] ECR I-5421. Although it is primarily concerned with Articles 4(4)(a) and 5(2) of the Directive, I think it is worth quoting the relevant section of the Opinion in full:

“”30. Both in the proceedings before the Court, and in general debate on the issue, attention has focused on the relationship between ‘marks with a



reputation' in Article 4(4)(a) and Article 5(2) of the Directive and well-known marks in the sense used in Article 6*bis* of the Paris Convention for the Protection of Industrial Property. Well-known marks in that sense are referred to in Article 4(2)(d) of the Directive.

31. General Motors, the Belgian and Netherlands Governments and the Commission submit that the condition in the Directive that a mark should have a 'reputation' is a less stringent requirement than the requirement of being well known. That also appears to be the view taken in the 1995 WIPO Memorandum on well-known marks.

32. In order to understand the relationship between the two terms, it is useful to consider the terms and purpose of the protection afforded to well-known marks under the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs). Article 6*bis* of the Paris Convention provides that well-known marks are to be protected against the registration or use of a 'reproduction, an imitation, or a translation, liable to create confusion' in respect of identical or similar goods. That protection is extended by Article 16(3) of TRIPs to goods or services which are not similar to those in respect of which the mark is registered, provided that use of the mark would 'indicate a connection between those goods or services and the owners of the registered trade mark and provided that the interests of the owner of the registered trade mark are likely to be damaged by such use'. The purpose of the protection afforded to well-known marks under those provisions appears to have been to provide special protection for well-known marks against exploitation in countries where they are not yet registered.

33. The protection of well-known marks under the Paris Convention and TRIPs is accordingly an exceptional type of protection afforded even to unregistered marks. It would not be surprising therefore if the requirement of being well-known imposed a relatively high standard for a mark to benefit from such exceptional protection. There is no such consideration in the case of marks with a reputation. Indeed as I shall suggest later, there is no need to impose such a high standard to satisfy the requirements of marks with a reputation in Article 5(2) of the Directive.

34. The view is supported by at least some language versions of the Directive. In the German text, for example, the marks referred to in Article 6*bis* of the Paris Convention are described as 'notorisch bekannt', whereas the marks referred to in Article 4(4)(a) and Article 5(2) are described simply as 'bekannt'. The two terms in Dutch are similarly 'algemeen bekend' and 'bekend' respectively.

35. The French, Spanish, and Italian texts, however, are slightly less clear since they employ respectively the terms 'notoirement connues', 'notoriamente conocidas', and 'notoriamente conosciuti' in relation to marks referred to in Article 6*bis* of the Paris Convention, and the terms

‘jouit d’une renommée’, ‘goce de renombre’, and ‘gode di notorietà’ in Article 4(4)(a) and Article 5(2) of the Directive.

36. There is also ambiguity in the English version. The term ‘well known’ in Article 6*bis* of the Paris Convention has a quantitative connotation (The *Concise Oxford Dictionary* defines ‘well known’ as ‘known to many’) whereas the term ‘reputation’ in Article 4(4)(a) and Article 5(2) might arguably involve qualitative criteria. The *Concise Oxford Dictionary* defines reputation as ‘(1) what is generally said or believed about a person’s or thing’s character or standing...; (2) the state of being well thought of; distinction; respectability;...(3) credit, fame, or notoriety’. Indeed it has been suggested that there is a discrepancy between the German text compared with the English and French texts on the grounds that the ‘reputation’ of a trade mark is not a quantitative concept but simply the independent attractiveness of a mark which gives it an advertising value.

37. Whether a mark with a reputation is a quantitative or qualitative concept, or both, it is possible to conclude in my view that, although the concept of a well-known mark is itself not clearly defines, a mark with a ‘reputation’ need not be as well known as a well-known mark.”

The Advocate General refers in one of his footnotes to Mostert. Mostert at 8- 17 suggests the following criteria derived from a number of sources for assessing whether a mark is well-known:

- (i) the degree of recognition of the mark;
- (ii) the extent to which the mark is used and the duration of the use;
- (iii) the extent and duration of advertising and publicity accorded to the mark;
- (iv) the extent to which the mark is recognised, used, advertised, registered and enforced geographically or, if applicable, other relevant factors that may determine the mark’s geographical reach locally, regionally and worldwide;
- (v) the degree of inherent or acquired distinctiveness of the mark;
- (vi) the degree of exclusivity of the mark and the nature and extent of use of the same or a similar mark by third parties;
- (vii) the nature of the goods or services and the channels of trade for the goods or services which bear the mark;
- (viii) the degree to which the reputation of the mark symbolises quality goods;
- (ix) the extent of the commercial value attributed to the mark.

59. In September 1999 the Assembly of the Paris Union for the Protection of Intellectual Property and the General Assembly of the World Intellectual Property Organisation (WIPO) adopted a Joint Recommendation concerning Provision on the Protection of Well-Known Marks. Article 2 of the Joint Recommendation provides:

(1)(a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. the degree of knowledge or recognition of the mark in the relevant sector of the public;
2. the duration, extent and geographical area of any use of the mark;
3. the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
4. the duration and geographical area of any registration, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;
5. the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;
6. the value associated with the mark.

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching the determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factor listed in subparagraph (b), above.

(2)(a) Relevant sectors of the public shall include, but shall not necessarily be limited to:

- (i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
- (ii) persons involved in channels of distribution of the type of goods

and/or services to which the mark applies;  
(iii) business circles dealing with the type of goods and/or services to which the mark applies.

(b) Where a mark is determined to be well known in at least one relevant sector of the public in a Member State, the mark shall be considered by the Member State to be a well-known mark.

(c) Where a mark is determined to be known in at least one relevant sector of the public in a Member State, the mark may be considered by the Member State to be a well-known mark.

(d) A Member State may determine that a mark is a well-known mark, even if the mark is not well-known or, if the Member State applies subparagraph (c), known, in any relevant sector of the public of the Member State.

(3)(a) A Member State shall not require, as a condition for determining whether a mark is a well-known mark:

(i) that the mark has been in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, the Member State;

(ii) that the mark is well known in, or that the mark has been registered or that an application for registration of the mark has been filed in or in respect of, any jurisdiction other than the Member State; or

(iii) that the mark is well known by the public at large in the Member State (b) Notwithstanding subparagraph (a)(ii), a Member State may, for the purpose of applying paragraph (2)(d), require that the mark be well known in one or more jurisdictions other than the Member State.”

60. Two points of interest emerge from Article 2 of the Joint Recommendation. The first is that the list of six criteria contained in Article 2(1)(b) is not inflexible, but provides as it were a basic framework for assessment. The second is that *prima facie* the relevant sector of the public consists of consumers of and traders in the goods or services for which the mark is said to be well known.”

27. To assess whether the opponents’ mark is well known it is necessary to see how the facts sit within the “basic framework” of Article 2(1)(b), but the first question is to define who is likely to form the relevant sector of the public referred to in that Article. Article 2(a) gives guidance on the factors that contribute to this determination. The opponents essentially provide a service that enables domestic and business energy users to compare the prices of different suppliers, and where appropriate, assist in the transfer of their account to a new supplier. Insofar as all households and businesses probably use electricity, and potentially also gas, the group of actual and potential customers must be all domestic and commercial establishments. It therefore seems to me that the categories listed as those being involved in distribution and the business circle encompasses other price comparison providers, regulatory

and consumer organisations, and the energy generators/distributors. The plain fact here is that there is no evidence of any awareness amongst the relevant sectors of the public, in fact, the reverse is the case. The best that the opponents' evidence gets is a claim to recognition based on the rankings attributed to their website in a search of the world wide web, which as the evidence from Messrs Latham, Stoate and Salveta shows, is not necessarily an indicator of any sort of recognition, at least not in the UK.

28. Turning to the duration, extent and geographical area of any use of the opponents' marks. The evidence shows the opponents to have been using the name Energyshop from November 1997 as the domain name Energyshop.com. There is no evidence that shows how many times this has been accessed, be it from the UK or elsewhere. Mr Scott states that for the year ending September 2004, his company's sales under EnergyShop.com amounted to \$4.18 million Canadian Dollars, which at today's exchange rate comes out at just under £2 million, but what I do not know is whether any of these sales have been beyond the confines of Canada. The only claimed use by the opponents that relates to the UK is to having kept natural gas and electricity price comparisons for the UK, a claim disputed by Mr Malinowski who says that this cannot be the case because they are not on the tariff distribution lists, a challenge that goes unanswered. Other than use that could have occurred through access on the Internet, there is no other evidence of use within the UK, or indeed anywhere.

29. Turning to the duration, extent and geographical area of any promotion of the mark. There simply is no evidence showing, or even claiming that there has been any advertising or promotion of the mark, that publicity has been gained in any way, or that the opponents have been present at any fairs or exhibitions, be it in the UK or anywhere.

30. As I have already indicated, the mark had been registered as a domain for approaching seven years by the relevant date, and there are two trade mark registrations that were registered in 2003 and 2004. Apart from the domain name which by its nature is world-wide, this registration activity appears to have been exclusively located in Canada, at least there is no evidence that shows this to have gone beyond the confines of that country. The mere fact that they have registered ENERGYSHOP as a trade mark is not evidence that reflects use or recognition of the mark. The opponents have claimed use, a claim that has not been challenged, but I think it is reasonable to infer that in relation to the proffering of their services, any use has been within Canada.

31. There is no record of any other proceedings where the opponents have sought, and been successful in preventing the use of the ENERGYSHOP name by a third party, but that of itself means little; there may not have been any other attempts to register or use the name. There is no evidence that the opponents' ENERGYSHOP mark has been accorded the status of a well known mark in its home state of Canada, let alone in any other country.

32. The final question is the value associated with the mark. It is undoubtedly the case that to any business, the banner under which they trade in their goods and services is invaluable. It may well be that the question being posed is more to do with the asset value rather than the "badge of origin" question, and in that respect I am almost completely unsighted. It no doubt has a value but how can I assess this?



33. Taking all of the above into account, and even accepting that they provide a framework

rather than a rigid formula, I do not see that the opponents have come anywhere near to establishing that their mark is known, let alone well known, be it anywhere other than Canada. Even in that country the level of awareness of the name has not been established. I do not see any basis on which I can conclude that use of the mark applied for in connection with any of the goods or services specified would result in confusion, and the opposition is dismissed.




34. The opposition having failed, the applicants are entitled to a contribution towards their costs. I therefore order the opponents pay the applicants the sum of £1,750. 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 13th day of August 2007**

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


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**CANADIAN TRADE-MARK DATA**  
 \*\*\* Note : Data on trade-marks is shown in the official language in which it was submitted.

The database was last updated on: 2005-03-30

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 ONTARIO

**TRADE-MARK:**

**Energyshop.com**

**DISCLAIMER TEXT:**  
 The right to the exclusive use of .COM is disclaimed apart from the trade mark.

**INDEX HEADINGS:**  
 ENERGYSHOP.COM  
 COM, ENERGYSHOP.  
 SHOP, ENERGY

**SERVICES:**  
 (1) Energy marketing in natural gas and electricity through the internet.

**CLAIMS:**  
 Used in CANADA since February 05, 1998.

**ASSOCIATED MARKS:**  
 TMA583,735

ACTION	DATE	BF	COMMENTS
Filed	31 October 2001		
Created	31 October 2001		
Formalized	31 October 2001		
Search recorded	11 December 2002		
Examiner's	11 December	11 April 2003	

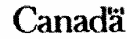
first report	2002	
Approved	12 February 2003	
Translation requested	04 March 2003	26 March 2003 20030319074532
Translation received	19 March 2003	
Extracted for Advertisement	19 March 2003	Vol.50 Issue 2527 2003/04/02
Advertised	02 April 2003	Vol.50 Issue 2527
Allowed	20 June 2003	
Allowance notice sent	20 June 2003	20 December 2003
Default notice sent	14 January 2004	14 March 2004
Note to file	09 March 2004	The Notice of Allowance was faxed to 419-484-0859. The registration fee will be faxed in today.
Remove default	06 April 2004	
Registered	06 April 2004	

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CANADIAN TRADE-MARK DATA

\*\*\* Note : Data on trade-marks is shown in the official language in which it was submitted.

The database was last updated on: 2005-03-30

APPLICATION NUMBER: 1119674 REGISTRATION NUMBER: TMA583735
STATUS: REGISTERED
FILED: 2001-10-31
FORMALIZED: 2001-10-31
ADVERTISED: 2003-02-05
REGISTERED: 2003-06-13
REGISTRANT: M3 & W Inc. 10271 Yonge St

Richmond Hill
M4G 2C8
ONTARIO

TRADE-MARK:

Energysshop

INDEX HEADINGS:

ENERGYSHOP
SHOP, ENERGY

SERVICES:

(1) Energy marketing in natural gas and electricity through internet,

telephone and personal visits.

CLAIMS:

Used in CANADA since February 05, 1998.

ASSOCIATED MARKS:

TMA607,044

Table with 4 columns: ACTION, DATE, BF, COMMENTS. Rows include: Filed (31 October 2001), Created (31 October 2001), Formalized (31 October 2001), Search recorded (11 December 2002), Approved (16 December 2002), Translation requested (07 January 2003, 29 January 2003, 20030122084813)

Translation received	22 January 2003	
Extracted for Advertisement	22 January 2003	Vol.50 Issue 2519 2003/02/05
Advertised	05 February 2003	Vol.50 Issue 2519
Allowed	25 April 2003	
Allowance notice sent	25 April 2003	25 October 2003
Registered	13 June 2003	

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Last Modified: February 18, 2003



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