

O-204-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2478145
IN THE NAME OF JPMORGAN CHASE & CO
OF THE TRADE MARK:**

ABI

**AND THE OPPOSITION THERETO
UNDER NO. 98295
BY CLIVE ANTHONY ASHFIELD**

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BACKGROUND

1. On 25 January 2008, JPMorgan Chase & Co, which I will refer to as JPM, filed an application for the above trade mark. Following examination, the application proceeded to publication in the *Trade Marks Journal* on 29 August 2008 for the following specification in class 36:

Banking and financial services, including liquid capital market investments and benchmark indices.

2. Clive Anthony Ashfield filed a notice of opposition to the trade mark application, claiming that registration would be contrary to sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (the Act). The Act states:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

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

(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.”

3. Mr Ashfield relies upon all of the services of his earlier trade mark registration to oppose all of the services of the application. Mr Ashfield’s registration is as follows:

2253637

ABI.ORG.LIMITED

Class 35: *Business advice and consultancy*

Class 36: *Financial services and insurance services.*

4 JPM requested that Mr Ashfield prove use of his trade mark for all the services for which it is registered. Mr Ashfield's trade mark completed its registration process on 8 June 2001, more than five years prior to the publication date of the application. Section 6(A) of the Trade Marks Act 1994 ("the Act") states:

- "(1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

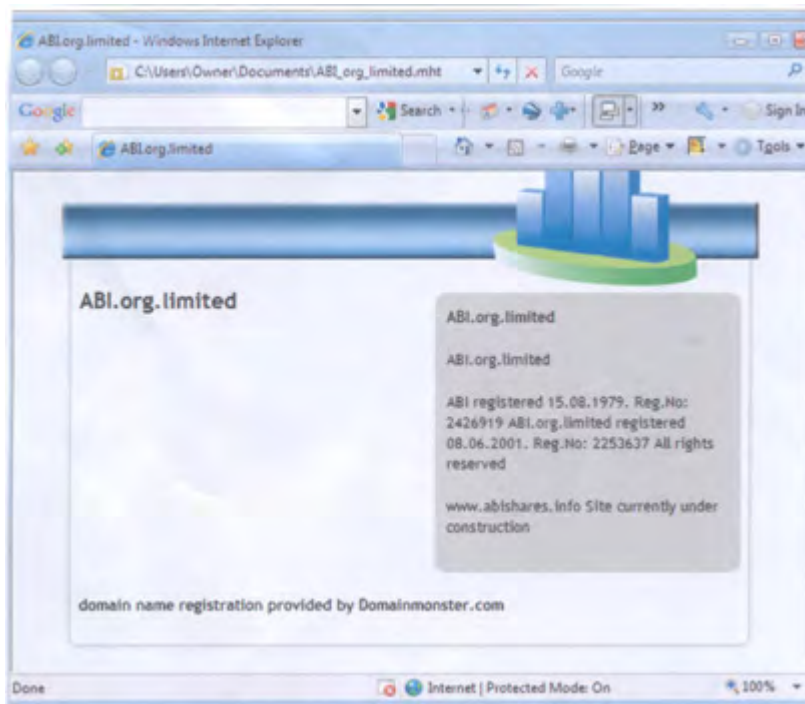
5. JPM filed a counterstatement which, in addition to requesting that Mr Ashfield provide proof of use of his trade mark within the five years prior to publication of the application, also:

- denies that the marks are identical
- denies that the marks are similar
- admits that its ‘financial services’ are identical to Mr Ashfield’s ‘financial services’
- denies any similarity between any of the other services
- denies a likelihood of confusion
- asks for the opposition to be dismissed and an award of costs to be made in JPM’s favour

6. Mr Ashfield filed evidence to show use of his registration and made submissions within the evidence. JPM filed submissions, in reply to which Mr Ashfield filed further evidence. Both parties were advised that they had a right to a hearing and that if one was not requested a decision would be made from the papers and any written submissions received. Neither party asked for a hearing. I have borne all the evidence and submissions in mind in making this decision, and in applying the relevant legislation and caselaw applicable to the facts of this case.

Mr Ashfield’s evidence

7. Mr Ashfield’s first witness statement is dated 24 August 2009. He states that he is the author of the mark ABI, first used in 1979 by his company. He states that he has used it in his ongoing marketing campaign which began in 1986 and uses ABI continuously on his website and in literature. As of 24 August 2009, Mr Ashfield states that his website “is currently under construction” to be used for stocks, shares equities and investments”. Exhibit CAA5 is a screenshot of what appears to be a website holding page:



This exhibit is the only instance in the evidence which shows the mark ABI.ORG.LIMITED (apart from the trade mark registration certificate).

8. Mr Ashfield states that the annual amount spent on promoting his campaign before the date of application (25 January 2008) was £1,200 per year from 1986 to 2009, totalling £27,600. Exhibits CAA1 and CAA2 are his trade mark registration and company name registration certificates, respectively. The latter is dated 15 August 1979 and gives the company name as ABI. The trade mark registration certificate shows the details I have recorded at the beginning of my decision.

9. Mr Ashfield states that he uses the mark ABI every single day in his “campaign to gain independent legislation in the insurance/equity industry”. Exhibits CAA3 and CAA4 are campaigning documents. Mr Ashfield explains that CAA3 was sent to the general public in his campaign for independent legislation in the insurance industry prior to 25 January 2008. This exhibit contains two documents. The first looks to be a flyer, which refers to a particular insurer and the BBC ‘Watchdog’ programme and concerns over shares. There are two mentions of ABI: the first says “ABI recommend you log on to www.fraud-forgery.com”. The second is at the bottom of the flyer and says “The above is without prejudice and sanctioned by ABI with”. The second document is in the form of a letter addressed “Dear Shareholder”. The letter exhorts the reader to refrain from purchasing shares from the same particular insurer: “ABI© advise members of the public to buy products from other companies...” CAA4 is a circular which starts with “Sanctioned by ABI®”, refers to the same insurer in the text as being fraudulent, and is headed:

“This circular could be in your interest and those of your family and friends. Please copy and distribute (**Thousands of these are distributed monthly**)”

Mr Ashfield states that this document was sent to all shareholders of Legal & General prior to January 2008. None of the documents in CAA3 or CAA4 bear a date.

10. Mr Ashfield's second witness statement is dated 18 February 2010. This is in response to challenges to his first set of evidence by JPM in its written submissions. Exhibit 1 is a repeat of the company name registration certificate, exhibit 2 is a repeat of the trade mark registration certificate. Mr Ashfield states that he has used that mark ABI in his marketing campaign for independent legislation in the insurance/equity industry every single day for 23 years and ABI.ORG.LIMITED since 2001, which is within the relevant period between 30 August 2003 and 29 August 2008 (these dates are mentioned in the applicant's written submissions). He states that ABI.ORG.LIMITED has been used constantly on his "web sites" including during the period 30 August 2003 to 29 August 2008, although there is no evidence of the websites except for the holding page for a website which is under construction (CAA5). Mr Ashfield says:

"I do not date the leaflets/letters of my campaign as there is little point but each time a new leaflet/letter is produced, and accompanying letter is sent to the Chief Executive for their attention prior to distribution throughout the UK. You will note in these letters I request the Chief Executive to copy the letter and accompanying leaflet and distribute to all directors on the main board. The dated letter states that if I do not hear from Legal & General within a stated time, I will commence distribution throughout the UK."

Documents 3 and 4 and 6 to 15 are letters to Legal and General dated 8 May 1999, 26 September 2000, 1 March 2001, 7 January 2002, 1 August 2003, 16 September 2004, 18 April 2005, 19 May 2006, 5 January 2007, 25 January 2008, 26 November 2008 and 6 February 2009. Document 4 is a letter dated 19 January 2001 to the then Prime Minister, Tony Blair. None of the letters refers to ABI in any format.

11. The remainder of Mr Ashfield's second witness statement consists of submissions in response to those of JPM. I will not summarise them here as they are not evidence of fact but will refer to them as necessary in making my decision.

Decision

12. For the benefit of Mr Ashfield who is a litigant-in-person, the relevant legislation is set out above. The Trade Marks Act 1994 is harmonised with EC Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks. Consequently, I must follow the judgments of the European Union courts (the Court of Justice of the European Union (ECJ) and the General Court (GC)) in addition to those of the High Court and the Court of Appeal of England and Wales. I must apply the courts' reasoning to the facts of this case.

13. In addition to section 6A of the Act, section 100 states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

It is therefore for Mr Ashfield to prove in accordance with the established caselaw of the courts that he has made genuine use of the trade mark in suit, or that there are proper reasons for non-use, in the relevant period. The relevant period is the five years prior to and ending on the date of publication of the application, i.e. from 30 August 2003 to 29 August 2008, as per section 6A(3).

Does the evidence establish genuine use?

14. The genuine use provisions in the Act (and the Directive) ensure that proprietors have five years after registration in which to commence or make use of their mark in the course of trade for the goods and services for which the mark is registered. In the case of an earlier mark relied upon in an opposition, as here, the requirement is that the earlier mark, if registered, must have been genuinely used five years prior to the application’s publication. The reason for these provisions is to reduce the potential for conflict when new applications are sought to be registered: it would be unreasonable to refuse to register a new trade mark application in the face of a mark which is over five years old if that earlier registered mark has not been put to genuine use by its proprietor for the goods or services for which it is registered.

15. Ms Anna Carboni, sitting as the appointed person in *BreadTalk*, O-070-10, summarised a set of principles from the following leading ECJ genuine use cases: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85 (ECJ); *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR. I gratefully adopt her summary:

- (1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].
- (2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].
- (4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].
 - (a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

16. Mr Ashfield says he is not a man of means but ABI is his life; he does everything in his power to make the public aware of the underhandedness of insurance companies. He regards the mark as belonging to him and which “is essential for [him] to continue [his] campaign etc”. I have no doubt that to Mr Ashfield his use of ABI is real, external and is anything but token use for the sole purpose of keeping his mark on the trade mark register. My task is to decide whether, in accordance with what was said in the above cases, whether Mr Ashfield’s use during the relevant period was real in a commercial sense; that is, whether his use was use according to the essential function of a trade mark. As stated above, the essential function of a trade mark is to guarantee the identity of the origin of the marked product or service to the consumer or end-user. The guarantee of origin must be in respect of the goods or services for which the mark is registered. So my starting point is to look at the use which Mr Ashfield has made of his mark in relation to the services for which Mr Ashfield has chosen to register his mark.

17. Mr Ashfield’s trade mark is registered for *business advice and consultancy and financial services and insurance services*. The statements and exhibits he has provided all point to what he calls his campaign (which appears to be levelled at one insurance company). His aim is to educate the public as to what he refers to as the underhandedness of insurance companies, partly based it appears upon his own experiences. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, the court addressed the issue of how to decide a fair way to describe the use that a proprietor has made of his mark. It stated that the court should inform itself of the nature of the trade in question and then decide how the consumer would describe the proprietor’s use. I must be careful not to give too wide a meaning to the services which are registered. A campaign is a particular way of giving advice, but I consider that to the average consumer or member of the public (for it is the general public to which Mr Ashfield states he sends his leaflets to) the primary aim of a campaign is to

raise awareness. I do not think that this falls within the ambit of business advice/consultancy or financial/insurance services on a natural reading of those terms as they are applied in trade or commerce¹. It is unnecessary that Mr Ashfield has actually made a charge for what he does or that his use has been significant in its quantity, but he does have to show that the scale of his use is at an appropriate level (“warranted”) to have maintained or created a share in the financial or business advice sector. I cannot assess whether or how many leaflets were distributed during the relevant period and how many people would have seen them. Mr Ashfield relied upon the public to distribute the circular exhibited at CAA4. Finance and business advice is a large economic sector so requires exploitation on a more substantial scale than Mr Ashfield has been able to show, even if I had decided that his use fell within the ambit of the services for which he has registered his trade mark. Mr Ashfield’s exhibit CAA5, which shows that his website carrying the mark as registered was under construction but not active, is an example of non-use. For there to be proper reasons for non-use, they must be those which arise independently of Mr Ashfield’s control (as per the ECJ in *Hauptl v Lidl Stiftung & Co KG*, Case C-246/05, [2007] ETMR 61), but no such reasons are given.

18. Copies of trade mark and company name registration certificates do not prove actual use. There is the further problem of the use of ABI in a different form to which it is registered, a potential obstacle to establishing use in a form differing in elements which do not alter the distinctive character of the mark (section 6A(4)(a)). However, given that I have already identified that the use does not amount to genuine use of the services registered and, even if it did, is unquantifiable, there is no need to go on to consider whether use of a mark different to that registered qualifies as genuine use.

Conclusion

19. There has been no genuine use of the mark for any of the services for which it is registered. The consequence of this is that Mr Ashfield has failed to meet the use conditions set out in section 6A(3) of the Act. In accordance with section 6A(2), I cannot refuse JPM’s application for registration on the basis of Mr Ashfield’s earlier mark because he is not entitled to rely upon his trade mark registration as a basis for opposing JPM’s trade mark application. There is, therefore, no need to address the ground of opposition itself. The opposition fails and JPM’s application should proceed to registration for all the services for which the application has been made.

Costs

20. JPM has been successful and is entitled to an award of costs as per the scale of costs published on the Intellectual Property Office’s website in Tribunal Practice Notice 6/2008. JPM has referred to Tribunal Practice notice 2/2004 in its submissions with regard to the possibility of a higher award of costs where a statement of use has no legitimate support in evidence. Balancing the facts that (i)

¹ In *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16 Jacob J held that: “In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Mr Ashfield is unrepresented and clearly not familiar with the genuine use aspects of trade mark law; (ii) there was not much evidence to consider and (iii) the inconvenience to which JPM has been put in the face of a statement of use without legitimate support, I consider the following award to be appropriate.

Considering the notice of opposition and preparing a counterstatement	£200
Commenting on Mr Ashfield's evidence	£600
Written submissions in lieu of a hearing	£200
Total:	£1000

21. I order Clive Anthony Ashfield to pay to JPMorgan Chase & Co the sum of £1000. This sum 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 24 day of June 2010

**Judi Pike
For the Registrar,
the Comptroller-General**