

O/322/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003254422

BY F AND G KITES LIMITED

FOR THE FOLLOWING TRADE MARK:



IN CLASS 9

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO

UNDER NO. 411190 AND 411191 BY

G4S PLC AND G4S CASH SERVICES (UK) LIMITED

BACKGROUND AND PLEADINGS

1. On 4 September 2017, Securicor Group Limited, which changed its name to F and G Kites Limited (“the applicant”), applied to register the mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 September 2017 and registration is sought for the following goods:

Class 9 Electronic monitoring and detection apparatus and instruments; electronic apparatus and instruments for detecting body heat, movement and/or light; infra-red light detection apparatus and instruments; passive infra-red receiver motion detection devices; intruder alarms and detection devices; fire alarm apparatus; smoke detectors; carbon monoxide detectors; panic attack alarm apparatus; control panels for intrusion detection apparatus; infra-red receiver motion detection devices; wireless intruder alarms and detection devices; wireless control panels for intrusion detection apparatus; communications apparatus and installations; monitoring apparatus and installations; fire and environmental monitoring systems; closed circuit television systems; radio transmission apparatus; apparatus and installations for receiving and/or transmitting alarms and/or communications; social alarm equipment; networked monitoring systems; telephones; telephone handsets; telephone equipment; care management systems comprising of tele-health devices and apparatus and equipment for monitoring tele-health devices and apparatus; personal alarm devices; fall detectors; panic buttons; tele-health devices, apparatus, installations and systems; impact sensors; sensors; personal alarm radio triggers; control panels; detectors; emergency call buttons, call assistance buttons; sounders; electronic door control apparatus and installations; remote indicators; control devices; digital diallers; pressure mats; carbon monoxide detectors; pull cord switches; temperature sensors; video communication equipment; tone pads; speech trigger devices; handsets; cordless communication equipment; digital door entry management systems; electronic control systems and apparatus; apparatus and systems for receiving communications; apparatus and systems for

transmitting communications; call handling systems; visual display units; speech communication systems; data communication systems; apparatus for initiating, generating and transmitting calls for assistance, alarm calls and emergency calls; electronic apparatus and instruments for recording, transmitting and playback of tones, speech and images; wireless telephones; message display screens; receivers; transmitters; central control units; central consoles; signalling stations; indicator switches; system wiring; terminals for signalling and speech communication; pagers; mobile alarms; emergency call buttons; hand triggers for activating personal alarms; hand held radio triggers and pagers; electric control apparatus, systems, devices and installations; programmable control apparatus; remote control apparatus; remote control apparatus for use with heating, lighting, steam generating, drying, ventilating, air conditioning, water supply, security and safety apparatus; temperature controllers; temperature controlling apparatus; thermostats; energy control devices; thermostat control apparatus; thermal sensors for use in thermostats; thermal controls; boiler control apparatus; communications controllers; multiple control signal transmission units; network controlling apparatus; communication interface units; wireless communication apparatus; communication networks; security control apparatus; electronic and automatic access security apparatus; security video cameras and television monitors; meters; meters for measuring and monitoring energy; smart meters, namely meters for testing, displaying and reporting on-going energy usage; electrical meters; gas-flow meters; visual display units; apparatus, equipment and instruments for measuring the efficiency, performance and consumption of gas boilers; mobile communication terminals; mobile data communications apparatus; data transmitting apparatus; computer hardware; computer firmware; computer software; downloadable applications (computer software) for mobile telephones, handheld electronic devices, tablet computers, computers, personal digital assistants, electronic organisers and electronic notepads; downloadable electronic publications; apparatus and instruments for the storage of information, including data, and/or sound and/or images;

apparatus and instruments for the retrieval of information, including data, and/or sound and/or images; apparatus and instruments for the transmission of information, including data, and/or sound and/or images; sound, video and data recordings; audio and video players; apparatus and instruments for conducting measurements relating to healthcare; electronic telehealthcare monitors for the collection of information and data; apparatus and instrument for use in conjunction with telehealthcare monitors for the delivery of information and data; electronic devices, including telephones and computers for the collection and transfer for information and data relating to the healthcare of individuals; electronic devices for use in obtaining relevant information for determining the healthcare needs of individuals; electronic tags; electronic tags for goods; electronic tags for inventory control purposes; electronic tags for security control purposes; electronic security tags; encoded identification tags; encoded identification strips; parts and fittings for all the aforesaid goods; none being for use in connection with water treatment and/or water purification.

2. The application is opposed by G4S Plc (“the First Opponent”) and G4S Cash Services (UK) Limited (“the Second Opponent”) (together “the opponents”). The First Opponent opposes the application based upon sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the Trade Marks Act 1994 (“the Act”). The Second Opponent opposes the application based upon sections 5(2)(b), 5(3) and 3(6) of the Act.

3. For the purposes of its opposition based upon sections 5(2)(b) and 5(3), the First Opponent relies on the following marks:

SECURICOR

EUTM no. 6649008

Filing date of 6 February 2008; registration date of 21 January 2009

(“the First Earlier Mark”)



UKTM no. 2391942

Filing date 13 May 2005; registration date 17 March 2006

("the Second Earlier Mark")

4. For the purposes of its opposition based upon sections 5(2)(b) and 5(3), the Second Opponent relies on the following marks:

SECURICOR

EUTM no. 268813

Filing date 13 May 1996; registration date 19 October 1999

("the Third Earlier Mark")

SECURICOR

UKTM no. 1233504

Filing date 14 January 1985; registration date 14 January 1985

("the Fourth Earlier Mark")

SECURICOR

UKTM no. 1286840

Filing date of 1 October 1986; registration date of 6 September 1991

("the Fifth Earlier Mark")

SECURICOR

(UKTM no. 1286843)

Filing date of 1 October 1986; registration date of 5 June 1992

("the Sixth Earlier Mark")

SECURICOR

UKTM no. 1286845

Filing date of 1 October 1986; registration date of 2 March 1990
("the Seventh Earlier Mark")

SECURICOR

UKTM no. 1286846

Filing date of 1 October 1986; registration date of 30 November 1990
("the Eighth Earlier Mark")

5. Under section 5(2)(b) the opponents claim that there is a likelihood of confusion because the respective goods are identical or similar and the marks are similar.

6. Under section 5(3) the opponents claim that their marks have a reputation for all goods and services for which they are registered and that use of the applicant's mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and/or repute of the earlier marks.

7. For its opposition under section 5(4)(a), the First Opponent claims that the sign **SECURICOR** has been used throughout the UK since 1953 in respect of the following goods and services:

"Security apparatus, equipment and instruments.

Services supplied in the protection and guarding of people, buildings, property and assets."

8. Neither of the opponents originally sought to rely upon section 3(6) of the Act. However, on 22 October 2018, the opponents filed a Form TM7G to request permission to add grounds to their notices of opposition. On 26 October 2018, the Registry wrote out to the parties as follows:

"Having reviewed the comments on the TM7G, the Registry is invoking Rule 62 of the Trade Mark Rules and proposes the following Preliminary View:

That the amendment filed on the TM7G, that is the additional claim under Section 3(6), be admitted into proceedings. In so doing, the Registry is also allowing the extension of time requested in the TM8 filed on 28 September 2018.

If either party disagrees with the preliminary view, they have two weeks (from the date of this letter) in which to request a Case Management Conference (CMC). The request should be made on or before 9 November 2018.”

9. No objection to the preliminary view was raised by the applicant. The opponents’ section 3(6) ground of opposition was, therefore, permitted to proceed. For the purposes of their opposition under section 3(6), the opponents state:

“The reputation of the Opponent’s earlier mark SECURICOR in the security field is such in the UK that the Applicant must have known or ought to have known about it, particularly since the Contested Application covers goods which belong to the same field. Consequently, the choice of such a distinctive mark by the Applicant in respect of Class 9 goods cannot be a coincidence.

The Applicant has also tried to register several other very famous marks, which shows that the Applicant is clearly trying to unfairly benefit from third parties’ reputation. As such, the Opponent submits that the Applicant’s behaviour falls short of the standards of acceptable commercial behaviour and its Application should be rejected on the grounds of Section 3(6) TMA.”

10. The applicant filed counterstatements denying the claims made and requested proof of use of the opponents’ marks.

11. The opponents are represented by Stevens Hewlett & Perkins and the applicant is unrepresented. The opponents filed evidence in the form of the first and second witness statements of Timothy Weller dated 23 March 2018 and 20 April 2018 respectively. The applicant filed evidence in the form of the witness statement of Martin Oliver dated 23 June 2018. The opponents filed evidence in reply in the form of the third witness statement of Timothy Weller dated 24 August 2018. The opponents also

filed further evidence in respect of their section 3(6) ground of opposition in the form of the witness statement of Julie Gonard dated 3 October 2018. No further evidence regarding the section 3(6) ground of opposition was filed by the applicant. No hearing was requested and only the opponents filed written submissions in lieu (these were dated 2 January 2019 and 30 May 2019 respectively). This decision is taken following a careful perusal of the papers.

EVIDENCE

Opponents' Evidence

12. As noted above, the opponents' evidence in chief consists of two witness statements of Mr Weller, who is the Chief Financial Officer of the First Opponent; the parent company of the Second Opponent. Mr Weller has held this position since October 2016 and has been associated with the opponents since 1 April 2013. Mr Weller's first statement is accompanied by 6 exhibits and his second is accompanied by 2 exhibits. I have read this evidence in its entirety, but I will summarise only the points that I consider to be most relevant.

13. Mr Weller explains that Securicor Plc was a predecessor to the opponents and was founded in 1935. After 1939, the business was developed "into a leading security business¹" and the original name (Security Corps) was shortened to Securicor in the 1950s. In 2004, a merger resulted in the business being renamed Group 4 Securicor. Mr Weller states that the mark SECURICOR "was in continuous use in the UK in relation to a wide variety of security services and goods sold within the security industry until 2004²". Search results from the opponents' website display information about use of the SECURICOR mark up to the merger and how this formed part of the name G4S³. The name G4S in word only form appears multiple times in articles dated from 2005 to 2016. The following mark appears on the opponents' website⁴:

¹ First witness statement of Timothy Weller, para. 4

² First witness statement of Timothy Weller, para. 4

³ Exhibit 2 to the first witness statement of Timothy Weller

⁴ Exhibit 2 to the first witness statement of Timothy Weller



14. In 2004, turnover for Securicor Plc had grown to £656.2million, with turnover in the UK of £298.5million⁵. An undated print out from the Collins English Dictionary shows that SECURICOR was marked as a “noun trademark” with the following definition⁶:

“A well-known security company which transports money between shops, banks etc; it is also involved in prison management.”

15. Although the print out is undated, a graph on the print out shows usage up to 2008. Mr Weller has also provided the results of an internet search for SECURICOR branded vans, although all of the resulting images are undated⁷.

16. Group turnover for Securicor Plc was £1,170million for the year ending September 1998, £947.6million for the year ending September 1999, £637.5million for the year ending September 2000, £725.6million for the year ending September 2001, £1,400million for the year ending September 2002 and £1,323million for the year ending September 2003. The turnover is mainly broken down into distribution, security and communications fields. Each year turnover in the UK was the highest in the figures broken down by region⁸.

17. Group turnover for Group 4 Securicor Plc was £3,173million for the year ending December 2004. Group revenue for Group 4 Securicor Plc was £4,129million for the year ending December 2005 and £4,353million for the year ending December 2006. Revenue for the UK in the year ending December 2005 was 1,578million and revenue in the UK and Ireland in the year ending December 2006 was £928.9million⁹.

⁵ Exhibit 2 to the first witness statement of Timothy Weller

⁶ Exhibit 5 to the first witness statement of Timothy Weller

⁷ Exhibit 6 to the first witness statement of Timothy Weller

⁸ Exhibit 1 to the second witness statement of Timothy Weller

⁹ Exhibit 2 to the second witness statement of Timothy Weller

18. As noted above, the opponents' evidence regarding their oppositions under section 3(6) of the Act consists of the witness statement of Ms Gonard, which is accompanied by 9 exhibits. Ms Gonard is a Chartered Trade Mark Attorney acting on behalf of the opponents.

19. Ms Gonard notes that Mr Martin Oliver is recorded as the Director of 35 active companies at Companies House, including the applicant. 33 of these businesses have their registered addresses at the same location in Newcastle¹⁰. Ms Gonard has provided print outs from the Companies House website which provide further information about some of these companies, in particular¹¹:

a. The applicant company was called SECURICOR GROUP LIMITED between 4 September 2017 and 21 September 2017;

b. Cellnet Mobile Limited was called CELLNET TELECOMMUNICATIONS GROUP LIMITED between 31 August 2017 and 20 September 2017 (and was also called 41675 GROUP LIMITED between 20 September 2017 and 10 August 2018);

c. Simple Simon Said Limited was called TRAVELWONGA.COM LIMITED between 3 July 2017 and 31 January 2018;

d. NNP INSLATION REC LIMITED was called NIKE NICOTINE PRODUCTS LIMITED between 13 June 2017 and 21 September 2017;

e. AD DISTRIBUTION NETWORK LIMITED was called APPLE DISTRIBUTION LIMITED between 13 June 2017 and 19 September 2017; and

f. NOW EXPOSE LIMITED was called NOW PUBLICATIONS LIMITED between 11 September 2017 and 9 October 2017 (and was also called

¹⁰ Exhibit JG1

¹¹ Exhibit JG2

PROPERTYDEALERS.COM LTD between 30 November 2016 and 11 September 2017).

20. Ms Gonard states that these companies were clearly named after famous brands – Securicor, Cellnet (a predecessor to Telefonica UK Limited, now trading as O2¹²), Wonga (described as the “UK’s best-known payday lender”¹³), Nike (“the world’s largest supplier of athletic shoes and apparel”¹⁴), Apple (the world’s most valuable brand with a revenue of \$228.6billion¹⁵) and Now (although it is not clear to me from Ms Gonard’s statement what business she is referring to here, it appears from the evidence that this is a reference to the newspaper, the News of the World).

21. Ms Gonard has provided the results of a search for trade marks held by companies owned by Mr Oliver¹⁶. These include the following:



22. Ms Gonard notes that Hoover, Nivea, Adidas, Alexa (being a virtual assistant developed by Amazon) and Yahoo are all well-known brands in the UK¹⁷. With regard to the mark VAEPE (stylised) shown above, Ms Gonard states:

“Unlike all the other marks listed above, I am not aware that the mark VAEPE has a reputation. However, a search on the UKIPO trade marks database has

¹² Exhibit JG5

¹³ Exhibit JG9

¹⁴ Exhibit JG6

¹⁵ Exhibit JG7

¹⁶ Witness statement of Julie Gonard, para. 9

¹⁷ Exhibit JG6

revealed that two identical marks, for identical and similar goods, are already registered in the UK under nos. 2618356 and 2633872 in the name of a third party, Vaepe Limited. Details of those registrations together with the results of a search for VAEPE on the search engine Google Image showing use of the mark are attached under Exhibit JG8. Consequently, it cannot be a coincidence that Pametrada Storage Ltd chose to register this mark.”

23. Ms Gonard goes on to make the following submissions:

“16. The Opponent submits that the Applicant has no bona fide intention to use the Contested Mark. The Applicant has filed numerous applications reproducing famous names for a variety of goods services, from Classes 16 and 34 to 38, which are in no way complimentary. There does not seem to be any commercial logic for these applications.

17. Furthermore, the attached evidence shows a pattern of behaviour which falls below the standards observed by reasonable people in the relevant trade. Mr Martin Oliver could not have ignored the reputation of all the marks he based his applications on, including the SECURICOR brand. He can only have chosen them in order to take unfair advantage of the reputation of the earlier marks, instead of making his own investments in order to attract customers.”

Applicant's Evidence

24. As noted above, the applicant's evidence consists of the witness statement of Mr Martin Oliver, the Managing Director of the applicant. This is a position that Mr Oliver has held since September 2017.

25. Mr Oliver notes that the Second Opponent was incorporated as SECURICOR LIMITED on 10 July 1939, changed its name to SECURICOR CASH SERVICES LIMITED on 22 March 1996 and changed its name again to G4S CASH SERVICES

LIMITED on 11 July 2005¹⁸. Mr Oliver infers from this that the Second Opponent no longer wishes to be known as SECURICOR from 11 July 2005 onwards.

26. Mr Oliver has provided an extract from the opponents' website which states that in 2006 the "G4S brand identity [was] rolled out worldwide¹⁹". Mr Oliver states that Securicor is not subsequently mentioned in the history of the business between 2006 and 2018. He states that this shows there was no intention to use the mark. Mr Oliver has provided a copy of an article regarding Group 4 Securicor dated 25 December 2005²⁰. The article states:

"[The] director of communications at Group 4 Securicor, anticipates that the roll-out on uniforms, vehicles, stationary, signage and promotional goods globally will take up to 18 months.

She states We're not going to spend a huge amount of money changing things immediately, instead we will do it gradually, introducing the new material as it's needed. It should be completed by the end of 2006.

However, Ms McGrath adds that ideally every company within the group will changes its registration name to G4S within the year.

When Securicor and Group 4 Falck merged in July 2004 the logo became a combination of the strongest elements of each brand and in each country there was a different focus, depending on the strongest brand locally.

However, research carried out internally on 300 managers and externally on 300 customers revealed that this was not working.

[She] comments, People thought we were putting old things together rather than looking to the future [...]

¹⁸ Exhibit 1 to the witness statement of Martin Oliver

¹⁹ Exhibit 2 to the witness statement of Martin Oliver

²⁰ Exhibit 3 to the witness statement of Martin Oliver

She states that so far the feedback has been positive the guards love the new uniform and that already people are calling the company G4S as it's shorter."

27. Mr Oliver has provided a copy of an article from the Ipswich Star dated 6 March 2013 concerning the conviction of a security guard who had previously been employed by the opponents²¹. In that statement the G4S Risk Director is quoted as saying "We would like to thank the police and Crown Prosecution for its efforts in bringing [the individual] to justice and continuing to pursue this case. [He] was employed by Securicor for five months before disappearing in 1993 with £1.2m. Although the Securicor brand has disappeared, the case was not forgotten."

28. The results of an internet image search for the term "g4s" have been provided by Mr Oliver²². Mr Oliver notes that none of the images make any reference to Securicor. He submits that the opponents have made no recent use of the SECURICOR mark and there is, therefore, no current reputation.

Opponents' Evidence in Reply

29. As noted above, the opponents' evidence in reply consists of the third witness statement of Mr Weller. This was accompanied by 1 exhibit. Mr Weller states that the change of a company name at Companies House is an administrative matter only and does not reflect the businesses' intention or otherwise to trade under a particular name.

30. Mr Weller states that the name SECURICOR remains in the public consciousness as one associated with the G4S family of companies and states that when the application in issue was made, the opponents had plans for the brand's future.

31. Mr Weller states that the fact that people has started calling the opponents G4S does not mean that use of the mark SECURICOR had stopped. Indeed, Mr Weller claims that it is still being used. Mr Weller notes that the reference to the SECURICOR

²¹ Exhibit 4 to the witness statement of Martin Oliver

²² Exhibit 5 to the witness statement of Martin Oliver

brand in the article provided by Mr Oliver dated 6 March 2014 shows that the mark remained in use at that date.

32. Mr Weller has provided a print out of the results of an internet search for the term “G4S SECURICOR”²³. Most of the examples are undated. However, Mr Weller has provided an example taken from what appears to be a presentation (entitled Marketing Management) which is dated 23 December 2008 and displays the following mark:



33. Mr Weller has also provided print outs of articles dated 29 April 2009, 18 July 2012 and 15 September 2017 which display the same mark printed on vans. The article dated 18 July 2012 confirms that the opponents were contracted to provide security for the London Olympic games. The article dated 15 September 2017 is entitled “Abusive practices in UK detention centres – G4S and Home Office under fire” and states as follows:

“The Security Company G4S Group, Custodial & Detention Service (UK) currently operating Brook House IRC reacted by suspending nine staff and commenced an investigation into the allegations [...]

The multinational G4S Group is the largest secure outsourcing company in the UK, operating two detention facilities in the country.”

DECISION

34. Section 5(2)(b) of the Act reads as follows:

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

²³ Exhibit 1 to the third witness statement of Timothy Weller

(a)...

(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.”

35. Section 5(3) of the Act states:

“5(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

36. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, an international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if

registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

37. The opponents’ marks qualify as earlier trade marks under the above provisions.

38. Section 5(4)(a) of the Act states:

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

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

b) ...

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

39. Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

Proof of Use

40. The first issue is whether, or to what extent, the opponents have shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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 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 of 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 or international trade mark (EC), 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.”

41. Section 100 of the Act is also relevant, which reads:

“100. 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.”

42. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 30 September 2012 to 29 September 2017.

43. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-

4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] to [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37];

Verein at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not always the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

44. As some of the earlier marks are also EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, will also be relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope

should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)".

45. The court held that:

"Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

46. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are

to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State." On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to

that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

47. The General Court (“GC”) restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

48. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5-year period. In making the required assessment I am required to consider the relevant factors, including:

- a) The scale and frequency of the use shown;
- b) The nature of the use shown;
- c) The goods for which use has been shown;
- d) The nature of those goods and the market(s) for them; and
- e) The geographical extent of the use shown.

49. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

50. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

51. I also note Mr Alexander’s comments in *Guccio Gucci SpA v Gerry Weber International AG* (O/424/14). He stated:

“The Registrar says that it is important that a party puts its best case up front – with the emphasis both on “best case” (properly backed up with credible exhibits, invoices, advertisements and so on) and “up front” (that is to say in the first round of evidence). Again, he is right. If a party does not do so, it runs a serious risk of having a potentially valuable trade mark right revoked, even where that mark may well have been widely used, simply as a result of a procedural error. [...] The rule is not just “use it or lose it” but (the less catchy, if more reliable) “use it – and file the best evidence first time round – or lose it” [original emphasis].

52. The burden of proving use lies with the opponents. However, only one document from the opponents’ evidence can be identified as being dated within the relevant period. This is an article dated 15 September 2017 and displays the Second

Registered Mark in its registered form printed on to the side of the van. The rest of the opponents' evidence is either undated or is dated outside of the relevant period. Mr Weller states that the mark SECURICOR was used in the UK until 2004 after which the opponents used Group 4 Securicor and/or G4S. I have no examples of the marks being used in relation to the goods and services for which they are registered during the relevant period. No financial information is available which relates to the relevant period either for goods and services offered under the SECURICOR mark or the G4S mark. The extract provided from the Collins English Dictionary is undated and, in any event, the use graph finishes in 2008 which is well before the relevant period. Whilst members of the public may still recall use of the SECURICOR mark, that is not sufficient to demonstrate genuine use of the marks during the relevant period.

53. Consequently, I am unable to find that there has been genuine use of any of the marks during the relevant period. The effect of this finding is that the opponent's oppositions under sections 5(2)(b) and 5(3) must fail.

Section 5(4)(a)

54. I turn next to the First Opponent's opposition under section 5(4)(a). The proof of use requirements do not apply to the opposition based on section 5(4)(a) of the Act and so the First Opponent's failure to establish genuine use does not prevent its opposition from proceeding on this ground. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

55. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of section 5(4)(a) of the Act and concluded as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceeding as follows:

"Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made."

56. There is no suggestion that the applicant has used his mark prior to the date of the application. The relevant date for assessing whether section 5(4)(a) applies is, therefore, the date of the application which is the subject of these proceedings - 4 September 2017.

Goodwill

57. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

"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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

58. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“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 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 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 probabilities that passing off will occur.”

59. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any

absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

60. Mr Weller’s evidence is that the mark SECURICOR “was in continuous use in the UK in relation to a wide variety of security services and goods sold within the security industry until 2004²⁴”. It seems to me that, particularly given the financial evidence submitted by the First Opponent, there can be no doubt that in 2004 the First Opponent had established a substantial goodwill and that the name SECURICOR was attached to the First Opponent’s business and distinctive of that goodwill. However, the relevant date for assessing the First Opponent’s objection under section 5(4)(a) in the present case is 4 September 2017. It falls to me to determine, therefore, whether the First Opponent still had goodwill at the relevant date and whether the sign SECURICOR remained distinctive of that goodwill at the relevant date.

61. The First Opponent has provided financial information for the business up to the end of December 2006. At that date, revenue in the UK and Ireland was £928.9million. Group revenue for the same year was £4,353million. Goodwill arises from trading activities and it seems clear to me that the First Opponent has established a substantial goodwill at least until 2006. The position after that date is far less clear. I have no financial information for the business to determine whether it continued trading at such a level. The most useful evidence provided by the First Opponent in this regard are two articles, the first of which was dated 18 July 2012 and confirmed that the First Opponent was contracted to provide security for the Olympic games in London in 2012 and the second was dated 15 September 2017 and described the First Opponent as “the largest secure outsourcing company in the UK”. The article confirmed that, at that date, the First Opponent was operating two detention facilities in the UK. Whilst I note that the latter article is dated 11 days after the relevant date, it is a reasonable inference, when taking the evidence as a whole, that the First Opponent was still very much trading on a large scale in the UK at the relevant date.

²⁴ First witness statement of Timothy Weller, para. 4

62. Whilst the evidence is far from complete, I am satisfied that it is sufficient to establish that the First Opponent still had a reasonable goodwill in the UK at the relevant date in relation to “services supplied in the protection and guarding of people, buildings, property and assets”. I have seen no evidence to suggest that the First Opponent has been engaged in the providing of “security apparatus, equipment and instruments” and I do not consider that the First Opponent has demonstrated any goodwill in relation to these goods.

63. The next question to be determined is whether the sign SECURICOR remained attached to the First Opponent’s business and distinctive of that goodwill at the relevant date. The First Opponent accepts that in 2004 a merger resulted in the business being renamed Group 4 Securicor. The applicant alleges that the renaming of the business at Companies House to G4S Cash Services Limited in 2005 is evidence of the First Opponent’s desire to no longer be known as Securicor. I am not convinced by this argument. A business can register any name at Companies House and trade under an entirely different trade mark. The First Opponent’s print out of the Collins English Dictionary records usage of the mark as a trade mark up until 2008, although it is not clear whether this is because use stopped after that date or whether this is related to the date of the article itself (the print out provided is undated). The applicant provided an extract from the First Opponent’s website which states that the G4S brand identity was rolled out worldwide in 2006. The applicant has provided a copy of an article dated 25 December 2005 to support this in which the director of communications at the First Opponent is quoted as stating that people are already calling the company G4S due to the name being shorter. However, I note that the company is still described as Group 4 Securicor in that article. The applicant has also provided a copy of an article dated 6 March 2013 in which the First Opponent’s Risk Director was quoted as saying that the “Securicor brand has disappeared”. Mr Weller’s evidence in reply to this is that the SECURICOR sign continues to be used. The more recent articles provided by the First Opponent (the most recent being dated after the relevant date on 15 September 2017) all display the following sign:



64. It seems to me that there has certainly been a move away from the sign SECURICOR by the First Opponent and it has, in fact, ceased using the sign SECURICOR solus as its trade mark. However, the word SECURICOR, at the relevant date, continued to form part of one of the marks used by the First Opponent. I recognise that the evidence before me of the First Opponent's use of the composite sign which includes the word SECURICOR is far from extensive. However, it is possible for a mark to remain distinctive of a party's goodwill even after they have ceased to use it. In *Ad-Lib Club Limited v Granville* [1971] FSR 1 (HC), Vice Chancellor Pennycuick stated that:

“It seems to me clear on principle and on authority that where a trader ceases to carry on his business he may nonetheless retain for at any rate some period of time the goodwill attached to that business. Indeed it is obvious. He may wish to reopen the business or he may wish to sell it. It further seems to me clear in principle and on authority that so long as he does retain the goodwill in connection with his business he must also be able to enforce his rights in respect of any name which is attached to that goodwill. It must be a question of fact and degree at what point in time a trader who has either temporarily or permanently closed down his business should be treated as no longer having any goodwill in that business or in any name attached to it which he is entitled to have protected by law.”

65. This case concerned a situation in which a business had ceased to trade. That is, of course, not the case here. The First Opponent was, at the relevant date, still trading. However, this situation is analogous to the present case and the same issues arise where a party seeks to rely on a mark that it no longer uses. A similar situation arose in the case of *Thermawear Limited v Vedonis Limited* [1982] R.P.C. 44, in which Mr Justice Whitford noted:

“Since the plaintiffs have not used the word THERMAWEAR since 1974 save to a very small extent and as part of their company name the plaintiffs can only succeed in passing off if they are in a position to establish a sufficient residual reputation.”

66. It is important to remember that the First Opponent has not ceased to use the sign SECURICOR entirely. The continued use of the sign as part of a composite mark (as shown above) cannot be ignored. It is clear from the evidence that in 2004 (and subsequently) the financial success of the First Opponent was significant. For some time, this financial and reputational success was strongly associated with the sign SECURICOR. I consider that the extent of the First Opponent's success under the sign, combined with its continued use of the word SECURICOR as part of a composite mark (at least used from time to time) by the First Opponent would serve to maintain an association between the sign SECURICOR and the First Opponent in the mind of the public. I consider that the sign remained distinctive of the First Opponent's goodwill at the relevant date.

Misrepresentation and damage

67. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville*

Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

68. *Halsbury's Laws of England* Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309, 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 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.”

69. In its Notice of Opposition, the First Opponent states:

“Use by the Applicant of the sign SECURICOR in connection with apparatus, equipment and instruments for use in the security industry would misrepresent a connection in the course of trade between the Applicant and Opponent sufficient to deceive the Applicant’s customers and, as a result, to damage the Opponent’s business.”

70. I have found that the First Opponent has a reasonable goodwill in relation to “services supplied in the protection and guarding of people, buildings, property and assets”. The sign SECURICOR was, at least, reasonably distinctive of such services

provided by the First Opponent at the relevant date. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same field of business activity (see *Harrods Limited v Harroddian School Limited* [1996] RPC 697 (CA)), however the closeness of the parties' respective fields of activity is a factor which must be taken into account. I note that many of the applied for goods are products that are intended for or could be used within the security industry. Clearly, the nature of the goods and services will be different. However, the users and purpose will overlap. The fields of activity clearly overlap. It follows that the First Opponent does not face an exceptionally heavy burden of proof of misrepresentation and damage as per *Harrods* (as cited above).

71. With regard to the similarity between the marks, the applied for mark is a stylised version of the made-up word SECURICOR, with the letters ECURICOR surrounded by a box and the S presented in larger, more stylised font. Notwithstanding the stylisation and presentational differences, the applicant's mark is clearly identifiable as the word SECURICOR and is highly similar to the First Opponent's sign. The made-up word SECURICOR is the only element of the First Opponent's mark and the most dominant element of the applicant's mark. I therefore find that the marks are highly similar. The sign in issue is a made-up word (although it is allusive to goods or services in the security industry). I consider it to be distinctive to a medium degree. Further, the applicant has provided no explanation as to how it came to choose its applied for mark. It is not necessary for a finding of passing off that there was an intention to deceive. However, the surrounding circumstances of the applicant choosing to register various famous marks, including the First Opponent's mark points to an intention to benefit from the First Opponent's goodwill. The House of Lords stated in *Office Cleaning Services v. Westminster Office Cleaning* (1964) 63 RPC 39 that:

“Confusion innocently caused will yet be restrained. But if the intention to deceive is found, it will be readily inferred that deception will result. Who knows better than the trader the mysteries of his trade?”

72. In *Specsavers v Asda* [2012] EWCA Civ 24, Kitchen LJ cited *Slazenger & Sons v Feltham & Co* (1889) 6 R.P.C. (Lindley J) as follows:

“It has long been established that if it is shown that a defendant has deliberately sought to take the benefit of a claimant’s goodwill for himself the court will not ‘be astute to say that he cannot succeed in doing that which he is straining every nerve to do.’”

73. Taking all of the circumstances into account, I find that there is a likelihood that a substantial number of the First Opponent’s customers, or potential customers, for its security services would, at the relevant date, have believed that the goods which could be used within the security industry covered by the application were connected with the First Opponent’s security services. Damage could arise in a number of ways, as articulated by Warrington LJ in *Ewing v Buttercup Margarine Company Limited* [1917] 2 Ch. 1 (COA):

“To induce the belief that my business is a branch of another man’s business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me.”

74. Given that the fields of activity within which the parties goods and services operate, there is potential for customers of the First Opponent to be lost to the applicant. Customers, or potential customers, who would otherwise have engaged the First Opponent’s security services may choose to purchase the applicant’s security-based goods as an alternative, in the belief that they are goods sold by the First Opponent. There may also be damage to the reputation of the business. The section 5(4)(a) ground therefore succeeds in respect of the following goods:

Electronic monitoring and detection apparatus and instruments; electronic apparatus and instruments for detecting body heat, movement and/or light; infra-red light detection apparatus and instruments; passive infra-red receiver motion detection devices; intruder alarms and detection devices; panic attack alarm apparatus; control panels for intrusion detection apparatus; infra-red receiver motion detection devices; wireless intruder alarms and detection devices; wireless control panels for intrusion detection apparatus; communications apparatus and installations; monitoring apparatus and

installations; environmental monitoring systems; closed circuit television systems; radio transmission apparatus; apparatus and installations for receiving and/or transmitting alarms and/or communications; social alarm equipment; networked monitoring systems; telephones; telephone handsets; telephone equipment; personal alarm devices; panic buttons; impact sensors; sensors; personal alarm radio triggers; control panels; detectors; emergency call buttons, call assistance buttons; sounders; electronic door control apparatus and installations; remote indicators; control devices; digital diallers; pressure mats; temperature sensors; video communication equipment; tone pads; speech trigger devices; handsets; cordless communication equipment; digital door entry management systems; electronic control systems and apparatus; apparatus and systems for receiving communications; apparatus and systems for transmitting communications; call handling systems; visual display units; speech communication systems; data communication systems; apparatus for initiating, generating and transmitting calls for assistance, alarm calls and emergency calls; electronic apparatus and instruments for recording, transmitting and playback of tones, speech and images; wireless telephones; message display screens; receivers; transmitters; central control units; central consoles; signalling stations; terminals for signalling and speech communication; pagers; mobile alarms; emergency call buttons; hand triggers for activating personal alarms; hand held radio triggers and pagers; electric control apparatus, systems, devices and installations; programmable control apparatus; remote control apparatus; remote control apparatus for use with security and safety apparatus; communications controllers; multiple control signal transmission units; network controlling apparatus; communication interface units; wireless communication apparatus; communication networks; security control apparatus; electronic and automatic access security apparatus; security video cameras and television monitors; visual display units; mobile communication terminals; mobile data communications apparatus; data transmitting apparatus; computer hardware; computer firmware; computer software; downloadable applications (computer software) for mobile telephones, handheld electronic devices, tablet computers, computers, personal digital assistants, electronic organisers and electronic notepads; downloadable electronic publications; apparatus and instruments for the

storage of information, including data, and/or sound and/or images; apparatus and instruments for the retrieval of information, including data, and/or sound and/or images; apparatus and instruments for the transmission of information, including data, and/or sound and/or images; sound, video and data recordings; audio and video players; electronic tags; electronic tags for goods; electronic tags for inventory control purposes; electronic tags for security control purposes; electronic security tags; encoded identification tags; encoded identification strips; parts and fittings for all the aforesaid goods; none being for use in connection with water treatment and/or water purification.

75. I can see no reason why a substantial number of the First Opponent's customers or potential customers would believe that the following goods were connected in anyway with the First Opponent, notwithstanding the similarity of the marks (and consequently I find no misrepresentation or damage):

Fire alarm apparatus; smoke detectors; carbon monoxide detectors; fire monitoring systems; care management systems comprising of tele-health devices and apparatus and equipment for monitoring tele-health devices and apparatus; fall detectors; tele-health devices, apparatus, installations and systems; carbon monoxide detectors; pull cord switches; indicator switches; system wiring; remote control apparatus for use with heating, lighting, steam generating, drying, ventilating, air conditioning and water supply apparatus; temperature controllers; temperature controlling apparatus; thermostats; energy control devices; thermostat control apparatus; thermal sensors for use in thermostats; thermal controls; boiler control apparatus; meters; meters for measuring and monitoring energy; smart meters, namely meters for testing, displaying and reporting on-going energy usage; electrical meters; gas-flow meters; apparatus, equipment and instruments for measuring the efficiency, performance and consumption of gas boilers; apparatus and instruments for conducting measurements relating to healthcare; electronic telehealthcare monitors for the collection of information and data; apparatus and instrument for use in conjunction with telehealthcare monitors for the delivery of information and data; electronic devices, including telephones and computers for the collection and transfer for information and data relating to the healthcare of

individuals; electronic devices for use in obtaining relevant information for determining the healthcare needs of individuals; parts and fittings for all the aforesaid goods; none being for use in connection with water treatment and/or water purification.

76. For the avoidance of doubt, my conclusions would have been the same, even if it had not been the applicant's intention to deceive.

Section 3(6)

77. I now turn to the oppositions under section 3(6) of the Act. Again, the proof of use requirements do not apply to this section and so the opponents' failure to establish genuine use does not prevent their oppositions from proceeding on this ground. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch), as follows:

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but 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": see *Gromax Plastics Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge,

the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion

(see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

78. In deciding the section 3(6) ground, I must determine whether the opponents have proved on the balance of probabilities that in seeking to register the trade mark shown on the cover page of this decision for the goods in issue, the conduct of the applicant, judged by the ordinary standards of honest people, was somehow dishonest or otherwise fell short of the standards of acceptable commercial behaviour. The relevant date for assessing whether the application was made in bad faith is the date of the application – 4 September 2017.

79. The applicant is a company, not Mr Oliver himself. However, Mr Oliver has confirmed he is the director of the applicant. I note that the applicant company was subject to a name change following the application in issue, but it remains the same legal entity. Professor Ruth Annand, sitting as the Appointed Person, held in *Joseph Yu v Liaoning Light Industrial Products Import and Export Corporation* (BL O/013/15) that:

“22. [A] claim of bad faith is not avoided by making an application in the name of an entity that is owned or otherwise controlled by the person behind the application.”

80. Mr Oliver has given evidence that he is the Managing Director of the applicant. Accordingly, his motives can be attributed to the applicant.

81. It is the opponents' case that Mr Oliver is the director of 35 active companies at Companies House (a fact established by the opponent's evidence) and that through these companies he has registered various marks which are based upon and/or closely resemble well-known trade marks owned by third parties. These marks include NIVEA, NIKE, ADIDAS and YAHOO. The opponents have provided evidence to demonstrate that all of the marks registered by Mr Oliver (with the exception of one) are well-known. To my mind, the reputation of many of these marks is clear. The opponents submit that there is an established pattern of Mr Oliver registering famous

marks and that this demonstrates that, in the present case, he is seeking to unfairly take advantage of the opponents' reputation.

82. Mr Oliver filed no evidence by way of reply to the opponents' bad faith claim. The only response to the allegations under section 3(6) are those contained within the amended counterstatement:

"We do not agree that the sign could in any way be confused with the marks owned by G4S Plc firstly their appearance are not similar in colour or style.

We consider that SECURICOR has no reputation throughout the world, G4S Plc rebranded the company worldwide in 2006 to G4S, indeed G4S Plc changed its name from Group 4 Securicor Plc to G4S PLC on the 1st June 2007.

They no longer use the name or sign of SECURICOR.

Securicor is not used on any company websites and has not been for over 9 years.

By re-branding G4S Plc no longer wished to be known as SECURICOR.

G4S Plc has reputation in the mark G4S not SECURICOR."

83. The words SECURICOR, NIVEA, NIKE, ADIDAS and YAHOO are all invented words. They are not ordinary dictionary words that one might expect more than one party to select as their trade name by coincidence. They are invented words that have been coined by the businesses which use them as their trade marks. I acknowledge that evidence of a pattern that Mr Oliver has registered a number of famous marks is not, of itself, sufficient to justify a finding of bad faith in respect of any application made by Mr Oliver (or a company over which he has control). However, it is important to bear in mind that the present application concerns a mark which is an invented word (albeit an allusive one), which remains associated with the opponents' business, notwithstanding the fact that there has been a move away from use of the mark SECURICOR solus in recent years. The applicant offers no explanation as to why he

chose the mark SECURICOR or why companies operated by him have registered other famous marks such as those listed above. The applicant has not sought to deny that he was aware of the connection between the mark SECURICOR and the opponents. Rather, he was of the view that the decision by the opponents to rebrand meant that the opponents no longer wished to use the mark. On the balance of probabilities, I consider that Mr Oliver knew of the opponents' use of the mark applied for at the relevant date.

84. I acknowledge that Mr Oliver states that he was of the view that the opponents had ceased to use the mark SECURICOR. Even if Mr Oliver believed this to be the case and thought this left him free to register the applied for mark, his view of whether he acted correctly is not relevant to the decision I must make. Rather, I must assess the applicant's behaviour and state of knowledge by reference to the ordinary standards of honest people. I do not consider that the pattern of registering well-known marks (a pattern followed in the present application), is consistent with a party acting in good faith. Mr Oliver ought to have been aware of the potential consequences for customers of the opponents to assume that there was a connection between the businesses and for the opponents to be adversely affected by this. In the absence of any detailed explanation of evidence filed by the applicant to rebut the prima facie case established by the opponents, I consider the applicant's conduct to fall below the standards of acceptable commercial behaviour judged by the ordinary standards of honest people. The opposition under section 3(6) succeeds in its entirety.

CONCLUSION

85. The oppositions are successful and the application is refused.

COSTS

86. The opponents have been successful and are entitled to a joint contribution towards their costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponents the joint sum of **£1,500** as a contribution towards the costs of the proceedings, calculated as follows:

Preparing a statement and considering the applicant's statement	£350
Preparing evidence and considering the applicant's evidence	£600
Preparing written submissions in lieu	£350
Official fee	£200
Total	£1,500

87. I therefore order F and G Kites Limited to pay G4S Plc and G4S Cash Services (UK) Limited the total sum of £1,500. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 06th day of June 2019

S WILSON

For the Registrar

ANNEX

SECURICOR (EUTM no. 6649008)	
Class 6	Storage and transportation boxes (of common metal) for cash, securities, valuables and documents; safes.
Class 9	Life saving apparatus and instruments; nautical apparatus and instruments; weighing and measuring apparatus and instruments; security systems; electric and electronic apparatus and instruments, not included in other classes, and apparatus and instruments for alarm, signalling, control and supervision; apparatus and instruments for watch, surveillance, supervision, control and security check, including navigational instruments and apparatus for the tracking of vehicles and persons; apparatus for recording, reproduction and transmission of sound and images; alarm apparatus and instruments, including safety alarms, fire alarms, smoke alarms, gas and poison alarms, flood alarms, theft and burglary alarms and assault alarms; parts and accessories (not included in other classes) for the aforesaid alarm apparatus; fire extinguishing systems; fire extinguishing apparatus and instruments, including hand-operated apparatus and instruments; fire engines; fire hoses; powder and foam fire extinguishers; emergency hammers and fire ropes; evacuation and rescue equipment, including ladders, lines, ropes, lifesaving boats and rafts; lifejackets and lifebelts; fire escapes and rollers; rescue cloths; signal rockets; fireproof clothing; fireproof boots and fire helmets; safety clothing, including security masks, security goggles and gloves; bullet-proof waistcoats; reflecting bands and signs for wear for the prevention of traffic accidents; security equipment for securing persons, animals, intangibles and valuables against accidents, smoke, poison, fire and flood; detectors including smoke detectors; smoke and gas alarms; diving and smoke diving equipment, including diving suits and masks; sensors including sensors for registering movement, sound, smoke, chemicals and gas; signalboards; teaching apparatus and instruments; electric and electronic surveillance and supervision apparatus, including television and video surveillance and supervision apparatus, detectors, sensors, parts and accessories (not included in other classes) for all the aforesaid goods; electronic control and security apparatus and instruments, including for security check and access control, including perimeter protective systems; magnetic cards and electronic keycards for access control; security software for security management and as support for guarding and reception services; patrol control systems; electronic storage and transportation boxes for securing cash, securities, valuables and documents.
Class 35	(Commercial assistance with) recruitment of private detectives; security management services; management of community sentences; information and consultancy and advisory services in relation to the aforesaid services; reception services with relation to physical access control; counting and sorting money; coding cheques and other

	banking documents; information, consultation and advisory services in relation to the aforesaid services.
Class 37	Installation, repair and maintenance services, including installation, maintenance and repair of alarm apparatus, supervision apparatus, security check apparatus, television and video surveillance apparatus, detectors, including for access control, sensors, control, security and protection apparatus; lifesaving apparatus, fire extinguishing apparatus; information about installation, repair and maintenance of alarm, supervision, control and security apparatus; recovery and repair services in case of accidents by storm or floods; vehicle repair, including emergency repair services; assistance for land vehicles in the form of help for starting motors, opening doors and change of wheels; installation, maintenance and repair services in respect of automated teller machines; consultancy in relation to the installation, operation, maintenance, and repair services of automated teller machines; information and consultancy and advisory services in relation to the aforesaid services.
Class 38	Telecommunications for alarm and supervision centres; receiving and transmission of alarm and supervision reports; receiving and transmission of images; information and consultancy and advisory services in relation to the aforesaid services.
Class 39	Technical inspection, directing and supervision of transports; services of rescue posts; rescue and salvaging operations (transport); ambulance transportation of persons and animals; transportation of persons and animals, including transportation of sick people and patients; evacuation of persons and animals in case of danger or accidents; life saving services in connection with ship wrecks (salvage); towing, including crane and vehicle transport; lease of replacement cars; lease of vehicles and equipment for the transportation of persons and animals; alarm emergency transport services and alarm emergency intervention services, including alarms in connection with theft, burglary, fire, smoke, gas, chemical leakage, assault and safety (transport); mobile guarding patrol services; provision of services for the secure transportation of offenders, provision of services for the secure transportation of offenders, of the mentally ill, asylum seekers and immigrants; transport, including guarded transport of valuables, cash, banknotes, coins, foreign currencies, checks, securities and documents, including credit cards, phone cards and computer data storage and official documents, including passports and driving licenses; consultancy concerning transport of valuables; storage of cash, securities, documents and valuables for others; lease and rental of means of transport; lease and rental of security vehicles and equipment for the transport of valuables; bringing, as well as collection, distribution and delivery of cash; replenishing of automated teller machines; information and consultancy and advisory services in relation to the aforesaid services.
Class 45	Security services, including fire extinguishing, fire fighting, and fire fighting by firemen equipped with smoke masks (so-called smoke diving); extinguishing of petroleum products with special fire fighting vehicles using water, foam and/or powder; rescue

services, also of persons from highness by using high lift platforms or fire fighting ladders; security services in connection to the measurement of air concentration and gas-escape; security services in connection to the control of repumping water and dangerous combustible substances; security services in connection to the control of stable quenching equipments; consultancy and evaluation with respect to security and risk issues, including concerning the securing of persons and valuables, minimising of damages and lost value; lease of equipment for saving persons, animals, and intangibles; alarm services, including consultancy and information in relation to the security of persons and in relation to the security of real estate and intangibles; consultancy in relation to the security of commercial companies against accidents, theft and burglary; consultancy in relation to security and access control; lease and rental of alarm and protective apparatus; mobile security patrols, including preventive rounds in and around premises and buildings; alarm and electronic surveillance monitoring services; consultation services in the field of security; technical consultancy in relation to the security of buildings, commercial companies and outdoor spaces; guarding services, including surveillance, supervision and search of buildings, outdoor spaces and commercial companies; security services in and around airports and in aeroplanes; security services in and around (sea)ports and in ships; reception services in commercial companies; security services, namely supervising and securing persons and intangibles; access control regarding persons and goods; access and security control of buildings, of embassies, of airports, of train and bus stations, in commercial companies, at conferences, exhibitions and other events; technical consultancy concerning the securing of buildings, commercial companies and outdoor spaces; shop control, including provision of shop detectives; VIP security and body-guarding; provision of guarding services for major events, including exhibitions, sport, concert, seminars and meetings; justice services; support services to the courts; police support services; supervision of offenders on community service; prison services, namely detention and rehabilitation of criminal offenders and correctional services for criminal offenders, provision of services for the electronic monitoring of criminal offenders, provision of secured accommodation for juveniles and illegal immigrants, provision of remand centers; provision of correctional services for offenders; security patrol and security guard services; alarm and electronic surveillance monitoring services; consultation services in the field of security and correctional facilities; provision of probation services; provision of bailiffs; fine enforcement; information and consultancy and advisory services in relation to the aforesaid services.



(UKTM no. 2391942)

Class 6	Transportation boxes for securing cash, securities, valuables and documents.
Class 9	<p>Life saving apparatus and instruments; nautical apparatus and instruments; weighing and measuring apparatus and instruments; security systems; electric and electronic surveillance and detection apparatus and instruments and electric and electronic apparatus and instruments for use in the installation thereof; cables, cable amouring; circuit panels and locks; control units; apparatus and instruments for alarm, signalling, control and supervision; apparatus and instruments for watch, surveillance, supervision, control and security check, including navigational instruments and apparatus for the tracking of vehicles and persons; apparatus for recording, reproduction and transmission of sound and images; alarm apparatus and instruments, including safety alarms, fire alarms, smoke alarms, gas and poison alarms, flood alarms, theft and burglary alarms and assault alarms; parts and accessories (not included in other classes) for the aforesaid alarm apparatus; fire extinguishing systems; fire extinguishing apparatus and instruments, including hand-operated apparatus and instruments; fire engines; powder and foam fire extinguishers; emergency evacuation and rescue equipment, including ladders, lines, ropes, lifesaving boats and rafts; lifejackets and lifebelts; fire escapes and rollers; fire proof and insulating blankets and sheets, including those for use in rescue operations; fireproof clothing; fireproof boots and fire helmets; safety clothing, including security masks, security goggles and gloves; bullet-proof waistcoats; reflecting bands and signs for wear for the prevention of traffic accidents; security equipment for securing persons, animals, intangibles and valuables against accidents, smoke, poison, fire and flood; detectors including smoke detectors; smoke and gas alarms; diving and smoke diving equipment, including diving suits and masks; sensors including sensors for registering movement, sound, smoke, chemicals and gas; signalboards; teaching apparatus and instruments; electric and electronic surveillance and supervision apparatus, including television and video surveillance and supervision apparatus, detectors, sensors, parts and accessories (not included in other classes) for all the aforesaid goods; electronic control and security apparatus and instruments, including for security check and access control, including perimeter protective systems; magnetic cards and electronic keycards for access control; security software for security management and as support for guarding and reception services; patrol control systems; electronic storage for securing cash, securities, valuables and documents.</p>
Class 35	<p>Recruitment of and commercial assistance with recruitment of private detectives; business management of court order sentences including community service sentences; information and consultancy and advisory services in relation to the aforesaid services; reception services with relation to physical access control; counting and sorting money being business assistance; encoding cheques and other banking</p>

	documents; information, consultation and advisory services in relation to the aforesaid services.
Class 37	Installation, repair and maintenance services, including installation, maintenance and repair of alarm apparatus, supervision apparatus, security check apparatus, television and video surveillance apparatus, detectors, including for access control, sensors, control, security and protection apparatus, lifesaving apparatus, fire extinguishing apparatus; information about installation, repair and maintenance of alarm, supervision, control and security apparatus; recovery and repair services in case of accidents by storm or floods; vehicle repair, including emergency repair services; assistance for land vehicles in the form of help for starting motors, opening doors and change of wheels; installation, maintenance and repair services in respect of automated teller machines; consultancy in relation to the installation, operation, maintenance, and repair services of automated teller machines; servicing of rescue posts; information, consultancy and advisory services in relation to the aforesaid services.
Class 38	Telecommunications for alarm and supervision centres; receiving and transmission of alarm and supervision reports; reception and transmission of images; information, consultancy and advisory services in relation to the aforesaid services.
Class 39	Technical inspection, directing and supervision of transports; rescue and salvaging operations (transport); ambulance transportation of persons and animals; transportation of persons and animals, including transportation of sick people and patients; evacuation of persons and animals in case of danger or accident; life saving services in connection with ship wrecks (salvage); towing, including crane and vehicle transport; lease of replacement cars; lease of vehicles and equipment for the transportation of persons and animals; alarm emergency transport services and alarm emergency intervention services, including alarms in connection with theft, burglary, fire, smoke, gas, chemical leakage, assault and safety (transport); mobile guarding patrol services; provision of services for the secure transportation of offenders, of the mentally ill, asylum seekers, immigrants and others; transport, including guarded transport of valuables, cash, banknotes, coins, foreign currencies, checks, securities and documents, including credit cards, phone cards and computer data storage and official documents, including passports and driving licenses; consultancy concerning transport of valuables; storage of cash, securities, documents and valuables for others; lease and rental of means of transport; lease and rental of security vehicles and equipment for the transport of valuables; collection, distribution and delivery of cash; replenishing of automated teller machines; information, consultancy and advisory services in relation to the aforesaid services.
Class 45	Security services, including fire extinguishing, fire fighting, fire fighting by firemen equipped with smoke masks (so-called smoke diving); rescue services, also of persons from height by using high lift platforms or fire fighting ladders; security services

	<p>in connection with the measurement of air concentration and gas-escape; security services in connection with the control of repumping water and dangerous combustible substances; security services in connection with the control of stable quenching equipments consultancy and evaluation with respect to security and risk issues, including the securing of persons and valuables, minimising damages and lost value; alarm services, including consultancy and information in relation to the security of persons to the security of real estate and intangibles; consultancy in relation to the security of commercial companies against accidents, theft and burglary; consultancy in relation to security and access control; lease and rental of alarm and protective apparatus; mobile security patrols, including preventative rounds in and around premises and buildings; alarm and electronic surveillance monitoring services; consultation services in the field of security; technical consultancy in relation to the security of buildings, commercial companies and outdoor spaces; guarding services, including surveillance, supervision and search of buildings, outdoor spaces and commercial companies; security services in and around airports and in aeroplanes; security services in and around (sea) ports and aboard ships; reception services in commercial companies; security services, namely supervising and securing persons and intangibles; access and security control of premises, buildings, and land including, embassies, airports, train and bus stations, commercial companies, and at conferences, exhibitions and other events; technical consultancy concerning the securing of buildings, commercial premises and outdoor spaces; shop control, including provision of shop detectives; VIP security and body-guarding; provision of guarding services for major events, including exhibitions, sport events, concert, seminars and meetings; support services to the courts; police support services; supervision of offenders on community service; prison services, namely detention and rehabilitation of criminal offenders and correctional services for criminal offenders, provision of services for the electronic monitoring of criminal offenders, provision of secured accommodation, including for juveniles, illegal immigrants and others, provision of remand centres; provision of correctional services for offenders; security patrol and security guard services; alarm and electronic surveillance monitoring services; consultation services in the field of security and correctional facilities; provision of probation services; information, consultancy and advisory services in relation to the aforesaid services.</p>
<p>SECURICOR (EUTM no. 268813)</p>	
<p>Class 9</p>	<p>Scientific, nautical, surveying, electric, electronic, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing equipment; computers; computer programs</p>

	and software; fire-extinguishing apparatus; burglar alarms and fire alarms; alarm devices; talking machines; electrical apparatus for the screening of mail; electronic access control apparatus; radios; telephones and mobile telephones; parts and fittings for all the aforesaid goods.
Class 38	Telecommunications; message sending, telephone and radio communication and broadcast transmission services; cellular telephone communication; electronic mail; facsimile transmission; consultancy services relating to telecommunications; transfer of information or data by radio or telephone.
Class 39	Transport; packaging and storage of goods; guarded transportation of valuables; delivery of goods after transportation; rental of strongrooms; rental of vehicles; booking of seats for travel; consultancy services relating to transportation and to storage; agency services for arranging travel; armoured vehicle transport services; courier services; transportation of goods by air, land and sea; arranging the transportation of goods by air, land and sea; supply of office equipment; storage of archives; storage of information and data; warehousing.
Class 42	Security guard and patrol services; room hire; lithographic printing; alarm and electronic surveillance monitoring services; consultancy services relating to security, to computers, to information technology.
SECURICOR (UKTM no. 1233504)	
Class 9	Electrical, photographic, cinematographic, signalling, checking (supervision), monitoring (other than medical), radio, television, and telephone apparatus and instruments; burglar alarms and fire alarms, none for use with vehicles; talking machines; cash registers; electrical apparatus for screening of mail; electronic access control apparatus parts and fittings included in Class 9 for all the aforesaid goods.
SECURICOR (UKTM no. 1286840)	
Class 36	Banking, insurance and safe deposit services; leasing of real estate property; issue of travellers' cheques; deposit of valuables; cash processing; bank note checking; consolidation of moneys; investment services; all included in Class 36.
SECURICOR (UKTM no. 1286843)	
Class 39	Guarded transportation of valuables, delivery of goods after transportation, rental of strongrooms, rental of vehicles and the booking of seats for travel; consultancy services relating to transportation and to storage; agency services for arranging travel; armoured vehicle transport services; courier services for the delivery of goods; transportation of goods by air and land; arranging the transportation of goods by land, sea and air; supply of office equipment; storage of archives; all included in Class 39.
SECURICOR (UKTM no. 1286845)	
Class 41	Animal training services; training services relating to the use of fire fighting equipment, to security apparatus and to the carrying out of searches; rental of video cassette tapes and of sound recordings; training of personnel in management, finance, security,

	security systems, transportation, storage, guarding, office services, distribution, banking, cleaning, installation and repair, message sending, radio communications, broadcasting, booking courier services, editing, duplicating, metal plating, interior designing, and interior garden landscaping, provision and supply of tickets,; record master production; archive library services; recording studio services; all included in Class 41.
SECURICOR (UKTM no. 1286846)	
Class 42	Security guard and patrol, room hire, lithographic printing, alarm and electronic surveillance monitoring services; care and rental of potted plants; rental of clothing, of soap dispensers and of towel dispensers; consultancy services relating to security, to computers, to information technology and to interior design relating to plants and interior garden landscaping; all included in Class 42.