

O/033/12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS
2531351 and 2531358**

**IN THE NAME OF BOB ETHERINGTON LTD
TO REGISTER IN CLASSES 16 AND 41 THE TRADE MARKS: PRESENTATION
SKILLS FOR QUIVERING WRECKS AND COLD CALLING FOR CHICKENS**

AND

**CONSOLIDATED OPPOSITIONS THERETO UNDER NOS 100181 AND
100182**

BY SPOKEN WORD LIMITED

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Background and Pleadings

1. Bob Etherington Ltd (the applicant) applied to register the word only trade marks COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS on 11th November 2009. The applications were published in the Trade Marks Journal on 11th December 2009 in respect of the following goods and services:

Class 16:

Printed matters, printed publications, books, books for educational purposes, manuals, teaching manuals, handbooks, information manuals.

Class 41:

Education, providing of training, arranging and conducting of seminars, publication of printed matters, the provision of online electronic publications, publication and production of motion picture films and videos, publication and production of audio recordings, arranging and conducting of workshops, written courses, advisory and consultancy services for all the aforesaid.

2. Spoken Word Ltd (the opponent) opposes the trade marks in respect of both classes 16 and 41 on the basis of several grounds. Firstly under Section 5(4)(a) of the Trade Marks Act 1994 ("the Act"), on the basis of the earlier rights COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS, which it is claimed have been used in respect of seminars, training sessions, workshops. The opponent claims to enjoy a goodwill and that this will be damaged should the applicant use an identical sign which constitutes a misrepresentation. Secondly, under Section 5(4)(b) of the Act as the applicant wrote two books entitled COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS while in the employment of the opponent. The opponent claims that it owns the copyright in these books which is being breached by the applicant's trade mark applications. Finally in respect of Section 3(6) in that Bob Etherington of the applicant was employed by the opponent during the time the earlier rights were devised and use commenced. Mr Etherington then left the opponent company, set up a company in direct competition, and applied to register the trade marks the subject of these proceedings.

3. The applicant filed a counterstatement in which the grounds of opposition are denied. Specifically, the applicant argues that Bob Etherington authored the aforementioned books in his own time and owns the copyright in said books; from 2006 onwards, the opponent has not held any seminars under COLD CALLING FOR CHICKENS and that since 2006 any goodwill is that of the applicant. Both sides filed evidence. Further, both filed submissions in lieu of a hearing. Though not summarised, the submissions have been fully taken into account in reaching this decision.
4. As already outlined above, the opposition is based upon several grounds, namely 3(6), 5(4)(a) and 5(4)(b). Following a thorough reading of the evidence filed and the information therein and full consideration of the key issues in these proceedings, I am of the view that it is the opposition based upon Section 5(4)(a) which represents the opponent's best chance of success. So in the interests of procedural economy, I will consider this ground of opposition and the parts of the evidence relevant to it first and consider the remaining grounds and associated evidence only in the event that it becomes necessary.

DECISION

Section 5(4)(a) – Passing off

5. Section 5(4)(a) reads as follows:

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

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

(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”.

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

(1) that the opponent's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent;

and

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

The Relevant Date

7. The relevant date for determining the opponent's claim will be the filing date of the application in suit (*Last Minute Network Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Joined Cases T-114/07 and T-115) . The earlier right must have been acquired prior to that date (Article 4.4(b) of First Council Directive 89/104 on which the UK Act is based). The relevant date in these proceedings is, therefore, 11th November 2009.

Opponent's evidence

8. This consists of a witness statement, dated 3rd August 2010, from Frances Tipper, a Director of the opponent company. The following information relevant to Section 5(4)(a) is contained therein:
 - Ms Tipper explains that the opponent is involved in providing seminars, training sessions and workshops to businesses or individuals interested in improving their selling, presentation, negotiation and communication skills. In 2002, the Directors of the company created the concept of COLD CALLING FOR CHICKENS (CCFC) and PRESENTATION SKILLS FOR QUIVERING WRECKS (PSQW) to be used as titles of seminars and training workshops.
 - Bob Etherington of the applicant company had been employed as Managing Director of the opponent company from 2003 to December 2008. According to Ms Tipper, Mr Etherington had announced his impending retirement and resigned from the opponent company in December 2008, with it later transpiring that he had set up the applicant company whilst still involved with the opponent company, the date of incorporation being 15th September 2008 (as supported by a printout from Companies House, exhibited at Exhibit FT6).
 - Ms Tipper states that the opponent has been using COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS continuously since 2002 upon and in relation to seminars, training sessions and workshops. Exhibit FT3 is a sample of course material in respect of CCFC; Exhibit FT7 is a copy of the Training Manual for the training session given under CCFC and Exhibit FT10 is a copy of a flyer showing seminars run under CCFC and PSQW in July 2002.
 - According to Ms Tipper, the opponent delivers its training courses to large well known companies such as Morgan Stanley. Exhibit FT8 is an invitation from Morgan Stanley to deliver such courses under CCFC, along with a copy of the training agreement, dated August 2008. Ms Tipper claims to have personally delivered courses under PSQW for other well known companies in 2007-2008. The earlier rights are still being used to this day as demonstrated

by Exhibit FT9 which is a printout from the opponent's website. The same exhibit also includes a sample list of attendees in relation to CCFC in 2007.

- Sales and advertising figures under CCFC are as follows¹:

| Year | Sales from seminars (£) | Sales from workshops (£) | Total sales (£) | Advertising and promotion (£) |
|------|-------------------------|--------------------------|-----------------|-------------------------------|
| 2002 | | | 5,000 | 12,250 |
| 2003 | | | 10,000 | 8,500 |
| 2004 | | | 25,000 | 27,000 |
| 2005 | 35,000 | 8,000 | 43,000 | 30,000 |
| 2006 | 35,000 | 10,000 | 45,000 | 40,000 |
| 2007 | 30,000 | 30,000 | 60,000 | 38,000 |
| 2008 | 0 | 38,000 | 38,000 | 10,000 |
| 2009 | 0 | 36,000 | 36,000 | 2,000 |

- Sales and advertising figures under PSQW are as follows:

| Year | Sales from seminars | Sales from workshops | Total sales | Advertising and promotion |
|------|---------------------|----------------------|-------------|---------------------------|
| 2002 | | | | £12,250 |
| 2003 | | | | £8,500 |
| 2004 | | £8,000 | £8,000 | |
| 2005 | 0 | £10,000 | £10,000 | |
| 2006 | 0 | £16,000 | £16,000 | |
| 2007 | 0 | £26,000 | £26,000 | |
| 2008 | 0 | £32,000 | £32,000 | £2,000 |
| 2009 | 0 | £44,000 | £44,000 | £2,000 |

- Exhibit FT11 is an article published in Families Magazine, dated 10 June 2003, regarding the start up of the opponent company and advertising seminars and workshops under CCFC and PSQW; Exhibit FT12 is a selection of advertisements run by the Evening Standard, Standard Lite and Metro newspapers.
- Whilst employed by the opponent company, Bob Etherington took part in several radio shows advertising services under CCFC and PSQW as supported by Exhibit FT13 which is a CD containing radio interviews on BBC Radio 4 and LBC.
- Exhibit FT17 is evidence of a mail shot in respect of books entitled "COLD CALLING FOR CHICKENS" and "PRESENTATION SKILLS FOR QUIVERING WRECKS". Ms Tipper provides context for this evidence in that it was agreed that these books would be provided to further publicise the corresponding training events. There are emails attached to this evidence

¹ Ms Tipper explains that she between 2002-2004 she cannot say with certainty the proportion of sales between seminars and workshops. As such, only "total" sales figures are provided.

which place the mail shots as having taken place prior to the relevant date in these proceedings, in July 2008. Further, the mail shots clearly show the books as being offered by the opponent, Spoken Word Limited.

9. The remainder of Ms Tipper's witness statement contains submissions which I will not summarise here. However, they have been taken into account in reaching my decision and will be referred to as and where necessary throughout this decision.

Applicant's evidence

10. This is a witness statement, dated 4th November 2010, from Bob Etherington, a Director of the applicant company and a witness statement from Martin Liu, the UK Publisher for Marshall Cavendish International. The content of these witness statements have been noted, though not all have been summarised here. The following information relevant to Section 5(4)(a) is contained therein:

- Mr Etherington confirms that he was a Director of the opponent company until 31st December 2008. During this period, Mr Etherington explains that he developed various public seminars for cold calling and presentation skills. According to Mr Etherington, he suggested that the cold calling seminar be called CCFC and the presentation skills seminar be called PSQW.
- Mr Etherington challenges the sales figures provided by Ms Tipper. In his recollection there were no seminars after 2007 in respect of CCFC and in respect of PSQW there were no seminars after 2004 and there were no workshops held under this name.
- Mr Etherington claims that other companies are also using CCFC and PSQW and so he does not accept that the opponent has a reputation in such terms as if that was the case, they would not ignore use by other companies. The reason for their failure to protect these rights, according to Mr Etherington, is that they did not have any rights in CCFC after 2007 and PSQW after 2004 respectively.
- Mr Etherington accepts that he appeared on the radio while working for the opponent company, but that there was no mention of the disputed rights.
- In respect of the course run for Morgan Stanley, Mr Etherington indicates this was not a success. Further courses run for the company did not mention either of the earlier rights relied upon.
- According to Mr Etherington, the opponent offered CCFC as a half day public seminar in newspapers such as Metro, Evening Standard and London Lite, twice per year from 2002-2006 onwards and three times in 2007. He does not accept that such limited advertising is sufficient for the opponent to claim goodwill and reputation in these titles.

- The CCFC seminars were not successful from 2006 and have not been advertised since 2007 as shown by Exhibit RE7, a print out of the opponent's website on 23rd March 2010 which only shows a page for a seminar in September 2007. Further, the opponent only held seminars under CCFC from 2002 to September 2007. Any workshops held for cold calling was always named COLD CALLING and never CCFC as shown in the workbook in Exhibit RE5.
- Mr Etherington confirms that he plans to fully utilise the trade marks applied for in respect of training courses. Further, all goodwill in the terms have been built by him since the books he authored with these titles were published in 2006. This is, according to Mr Etherington, supported by Exhibit RE14 which is the result of a search on the web engine Google and which, according to Mr Etherington, shows his name primarily associated with the books. He claims, therefore, that it is the opponent who is seeking to unfairly benefit from his goodwill. In respect of the books, Mr Etherington appears to accept that they were offered by the opponent as support for its training events. In his witness statement, at paragraph 26, he claims that it was his idea to use them to promote training events.
- Mr Liu confirms in his witness statement that he approached Mr Etherington to ascertain whether or not he had any interest in writing business books because he was aware of Mr Etherington being a successful sales trainer. He confirms that these books were published in 2006. He claims that in 2007 the books were selling well, though no detail regarding volume of sales are provided.

Opponent's evidence in reply

11. This is a witness statement, dated 4th March 2011, from Frances Tipper. The following information relevant to Section 5(4)(a) is contained therein:
 - Ms Tipper accepts that Mr Etherington suggested the name CCFC. Further, she claims that she suggested the name PSQW. In any case, the seminars developed under these names were worked on by both as a team.
 - In reply to Mr Etherington's comments regarding the opponent's sales figures in respect of CCFC and PSQW, Ms Tipper asserts that he is mistaken and does not have access to the relevant records. In order to demonstrate that CCFC has been used after 2007 and is still used by the opponent company, Ms Tipper relies upon several exhibits. Firstly, Exhibit FT1 is a proposal for a seminar to be presented to a client in 2010 entitled CCFC. Secondly, Exhibit FT2 is a workshop overview with agenda for training to be supplied under CCFC. Thirdly, Exhibit FT3 are five invoices dated 2008, 2009 and 2010 sent to clients for training courses under CCFC. In order to show that PSQW has been used after 2004, Ms Tipper relies upon Exhibit FT4 which is a series of emails dated 2005 to 2006 giving geographical details to attendees of seminars under PSQW; Exhibit FT5 which contain copies of two agendas for seminars presented under PSQW dated 2006 and 2007; Exhibit FT6 contains

three “course outline” documents under PSQW for the years 2005, 2007 and 2008; Exhibit FT7 contain two proposals to be presented to clients in 2010 and Exhibit FT8 is a sample of four invoices dated 2009 and 2010 sent to clients for training courses under PSQW.

- In reply to Mr Etherington’s claim that other companies make use of the terms CCFC and PSQW, Ms Tipper notes that the majority are from American websites. Of the sites relating to the United Kingdom, Ms Tipper notes that they are in respect of the books written by Mr Etherington.

Goodwill

12. I note that in the notice of opposition, the opponent claims that the business attracts a protectable goodwill in respect of the following services: seminars, training sessions, workshops. In order to make an assessment of whether or not goodwill exists in such activities, I must be in possession of sufficient information to reach an informed conclusion.

13. In relation to goodwill, this was explained in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 at 223 as:

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

14. It is also worth noting that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature². However, being a small player does not prevent the law of passing-off from being relied upon as it can be used to protect a more limited goodwill³.

Preliminary issue – Earlier rights

15. As already stated, the opponent claims that it has used the earlier rights COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS, in respect of seminars, training sessions and workshops. I note from the evidence filed that these terms comprise the title of the services provided, be they seminars, training session or workshops. This is an important issue because titles of works can be subject to particular scrutiny in respect of the law of passing-off, the key consideration being whether or not such titles have trade mark significance which is capable of

² *Hart v Relentless Records* [2002] E.W.H.C. 1984

³ See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

constraining the use or registration of a later mark. Christopher Wadlow⁴ informs me at page 651, paragraph 8-96 that:

“The titles of newspapers, magazines and other periodical publications undoubtedly have trade mark significance. Liability for passing off may therefore arise from using the same title or one confusingly similar, for another publication or even in a totally different field of business”.

16. Wadlow goes on to concede that successful actions are rare, not helped by the practice of choosing titles which are clearly descriptive of content, area or frequency of publication or are made up of words which are too well used to be distinctive in the field. Examples of such in respect of newspapers would be *Star*, *Post* etc. According to Wadlow, the usual rule applies that where a mark is prima facie descriptive or otherwise of low inherent distinctiveness then relatively small differences will suffice to distinguish.
17. According to Wadlow, the position as regards newspapers, magazines and periodical publications can be sharply contrasted with that in respect of a book, play, film or similar work. He states that when many different issues of a work have a common title then that title may be properly regarded as having trade mark significance, such as legal or medical text books which go into many editions. The same conclusion does not necessarily apply to a single work. Even a title that is novel cannot normally be said to be distinctive of the publisher of the book. Rather, it is merely distinctive of the book itself.
18. It is true that the earlier rights relied upon are not in respect of magazines, newspapers, periodical publications or books. However, they are the titles of the seminars etc provided. In considering the position as regards titles of works, it seems to me that these earlier rights are analogous to the position as regards magazines, newspapers and periodical publications rather than a single work such as a sole book whose content remains the same. The opponent's marks have, according to the evidence, been used over a period of time in respect of seminars, workshops and the like and so have, at least potentially, had the opportunity to become associated with one undertaking. This points to the titles having acquired trade mark significance rather than merely being distinctive of the seminars etc themselves. Further, the content of a training seminar will not remain constant but is likely to evolve and change over time as new information and knowledge becomes known and techniques are discovered. Finally, though they may be allusive of the services on offer (perhaps even strongly so), they are not clearly descriptive and have at least some distinctiveness, a fact which also lends itself to each of the rights potentially acquiring trade mark significance. The impact of this will be discussed later in the decision where appropriate.

Analysis of evidence of goodwill

⁴ The Law of Passing-Off: Unfair Competition by Misrepresentation, 3rd Ed, Thomson, Sweet & Maxwell.

19. I note from the evidence filed in the form of flyers, leaflets, course materials, attendee lists, invoices and sales and turnover figures that each of the earlier rights has been used in respect of seminars, workshops or training sessions from the early to mid 2000s onwards. In the main, the signs are clearly displayed throughout the evidence. I note that, in the main, the earlier signs are used in conjunction with the opponent's company name and so the earlier titles are likely to be seen as secondary indicators of origin. Nonetheless, they do indicate origin as I am persuaded that the opponent's customers are likely to believe that all the training events under the earlier signs in question are provided under the control of a single undertaking. As such, I have little hesitation in concluding that goodwill exists in respect of seminars, training sessions, workshops and the like and that the earlier signs are associated with that goodwill.
20. However, this is not the end of the matter as Mr Etherington of the applicant has claimed that from 2006 onwards, any goodwill in the signs was associated solely with him. This is based upon his authorship of two books, the titles of which correspond with the trade marks applied for (and the earlier rights relied upon). Related to this, Mr Etherington claims that he owns the copyright in the books he authored, which he considers is linked to his claim to goodwill. In respect of the latter, I comment only that even if Mr Etherington is the owner of the copyright in the books he authored, this is not decisive of the question of whether there is goodwill in the titles. Further, it does not entitle Mr Etherington to use the trade marks applied for (as he appears to imply). In considering the evidence filed by Mr Etherington in support of his claim to goodwill in his business associated with the two relevant signs, I note that this is solely comprised of the results of a search from the website "google" which is dated after the relevant date in these proceedings. These hits appear to show, at best, that the aforementioned books are associated with Mr Etherington in the sense of him being listed as the author (though this is not demonstrated by the hits across the board). The fact of authorship is supported by the witness statement of Mr Liu. It is true that Mr Liu hints that Mr Etherington was known to him as a successful sales trainer, but this was not specifically in respect of the earlier signs here and so is not pertinent to issues of goodwill. In respect of the google search, there is no other context provided in respect of these results and the complete content of each of these hits is also not provided. There is, in essence, nothing concrete to demonstrate any association with Mr Etherington other than his authorship. Further, this evidence does not demonstrate that any goodwill in respect of seminars, training sessions and workshops etc and associated with COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS, is in any way linked directly to him.
21. By contrast, the evidence from the opponent, in my view, convincingly demonstrates that the earlier rights are associated with it as Spoken Word Limited is consistently mentioned in conjunction with the earlier rights throughout. I conclude therefore that there is goodwill in the business of seminars, training sessions and workshops as claimed by the opponent, that this goodwill is in respect of the earlier rights COLD CALLING FOR CHICKENS and PRESENTATION SKILLS FOR QUIVERING WRECKS and

that it is associated clearly with Spoken Word Limited, the opponent. Further, bearing in mind the evidence of the mail shot of the books with the same titles clearly being offered by the opponent, I am of the view that, on balance, the opponent's goodwill in the marks also extends to books used to support the seminars etc.

Misrepresentation and damage

22. I must now go on to consider if there has been misrepresentation and whether any such misrepresentation is such as to cause damage to the opponent. In this respect, I am mindful of the comments of Morritt L J in the Court of Appeal decision in *Neutrogena Corporation and Anr. V Golden Limited and Anr.* [1996] RPC 473 when he confirmed that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of the opponent's customers or potential customers would be misled into purchasing the applicant's products in the belief that it was the opponent's. Further, Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that "he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill".

23. Firstly, I must make an assessment of the respective signs. In these proceedings, they are clearly identical.

24. Whilst there is no requirement for there to be a common field of activity of the respective parties, see *Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] FSR 155, the level of similarity of the respective goods and services is, nonetheless, a relevant factor.

Contested services in Class 41

25. There are a number of contested services which are clearly in a common field of activity to those of the earlier rights. These are education at large, the provision of training, arranging and conducting of seminars, arranging and conducting of workshops, written courses, advisory and consultancy for all the aforesaid. Though the earlier rights may not be bestowed with the highest degree of distinctive character, they do nonetheless contain a spark of distinctiveness. Importantly, the signs are identical. As such, it seems to me to be inevitable that misrepresentation will occur and damage will result. The oppositions based upon Section 5(4)(a) therefore succeed.

26. The remaining services are in respect of publication and production of a variety of different mediums including printed matter, electronic publications,

audio recordings and motion picture films and videos and advice and consultation in this regard. To my mind, these services could be ancillary to the kind of training services for which the opponent has demonstrated goodwill. Further, these signs are identical. These factors leads me to conclude that, a substantial number of the opponent's customers would be misled into buying these services in the belief that they were associated with the opponent. On balance therefore, there is a misrepresentation and damage is likely. The oppositions under Section 5(4)(a) also succeed in respect of these services.

Contested goods in Class 16

27. *Printed matters, printed publications, books for educational purposes, manuals, teaching manuals, handbooks, information manuals.* are all products which would be used during seminars, training sessions and workshops. Indeed, they can be seen as integral to the provision of such services. There is therefore a common field of activity. Bearing in mind the identity of the signs, I consider that misrepresentation will occur and that damage to the opponent is inevitable. The oppositions succeed under Section 5(4)(a) in respect of these goods also.

28. This leaves the remaining goods, namely *books* at large. To my mind, this category of goods is broad enough to include items which can be used during seminars and the like or as a support to such services. And so in respect of identical signs, as such, the opposition succeeds under Section 5(4)(a) in respect of books also.

29. The sum of all this is that the oppositions under Section 5(4)(a) succeed entirely. As such, there is no need for me to consider the remaining grounds as they do not place the opponent in any better position.

COSTS

30. The opponent has been successful and is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither party sought a hearing. In the circumstances I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing oppositions - £400

Filing notice of oppositions and considering counterstatements- £300

Filing evidence and submissions and considering the applicant's evidence - £500

Total - £1200

31. The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 31st day of January 2012

**Louise White
For the Registrar,
The Comptroller-General**