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The Rolls Building,
7 Rolls Buildings,
London EC4A 1NL

Monday, 7th January 2013

Before:
MR. GEOFFREY HOBBS QC
(Sitting as the Appointed Person)

In the matter of THE TRADE MARKS ACT 1994

- and -

In the matter of Registration No. 2448261 in the name of
VICTORIA MCCANN.

- and -

In the matter of a request for a declaration of invalidity
thereto under No. 83601 by WNBFI INC.

In the Matter of an Appeal to the Appointed Person from the
decision of Mr. G. W. Salthouse for the Registrar, dated 10th
January 2012.

(Transcript of the Stenograph Notes of Marten Walsh Cherer Ltd.
1st Floor, Quality House, 6-9 Quality Court,
Chancery Lane, London WC2A 1HP
Telephone: 020 7067 2900 email: info@martenwalshcherer.com)

MR. MALCOLM CHAPPLE (instructed by Hallmark IP Ltd) appeared on
behalf of WNBFI Inc.

MS. VICTORIA MCCANN appeared in person.

D E C I S I O N
(As approved by The Appointed Person)

1 THE APPOINTED PERSON: On 2nd March 2007, Victoria McCann
2 applied under number 2448261 to register the denomination
3 PRONATURALMUSCLE as a trade mark for use in relation to
4 "online services" in Class 35 and "online website" in Class
5 42.

6 In an official letter dated 12th April 2007, the
7 Registry objected to the application for lack of clarity as to
8 the nature of the services for which protection by
9 registration was requested.

10 The applicant was asked to explain what the expressions
11 "online services" and "online website" were actually intended
12 to cover. She replied on 11th July 2007 stating: "The online
13 services would be supply of advice on nutrition and on-line
14 personal training. We also sell and promote nutritional
15 products that we recommend for natural athletes. The website
16 in general is a promotional tool for two natural bodybuilders
17 who have both reached a professional status in the sport of
18 body building and are pro, as in 'for' the promotion of
19 natural bodybuilding and training. This is why we chose the
20 name Pronaturalmuscle." In the light of that explanation, the
21 Registry allowed the application to proceed to registration
22 for "retail services provided online connected with
23 nutritional products" in class 35 and "the hosting of an
24 online website to promote nutritional advice and advice on
25 personal training" in class 42. The trade mark was registered

1 on 5th September 2008.

2 On 14th October 2009, WNBF Inc applied to the Registrar
3 of Trade Marks for a declaration to the effect that the
4 registration was wholly invalid. Objections to validity were
5 raised under Sections 5(2) (b), 5(3) and 5(4) (a) of the Trade
6 Marks Act 1994 on the basis of rights claimed by virtue of
7 prior registration and use of the denomination PRO NATURAL in
8 respect of "conducting bodybuilding championships among
9 drug-free athletes and bodybuilding exhibitions" in class 41.
10 In addition, an objection to validity was raised under Section
11 3(6) of the Act on the ground that the relevant application
12 for registration had been filed in bad faith. The Applicant's
13 Statement of Grounds in support of that objection asserted as
14 follows: "(11)The proprietor of UK Trade Mark Registration
15 No. 2448261 Victoria McCann, is a professional bodybuilder and
16 former competitor in the Applicant's competitions. In June
17 2006 the proprietor of UK Trade Mark Registration No. 2448261
18 achieved 4th place in a PRO NATURAL bodybuilding competition.
19 The proprietor of UK Trade Mark Registration No. 2448261
20 appealed against the decision which was not upheld. The
21 competition in June 2006 was the final PRO NATURAL
22 bodybuilding competition organised by the Applicant in which
23 the proprietor of UK Trade Mark Registration No. 2448261
24 competed.

25 "(12) In 2006 relations between the proprietor of UK

1 Trade Mark Registration No. 2448261 and the Applicant dipped
2 sharply. The Applicant had founded a British Bodybuilding
3 Federation in 2002, a body which was affiliated with the
4 Applicant until June 2006. In September 2006, as a result of
5 what the Applicant believed to be unfair and incorrect
6 comments being issued about the Applicant, and there not being
7 an opportunity to settle the manner amicably, litigation was
8 commenced in the High Court, a case which is still pending.

9 "(13) Subsequent to the commencement of the Court case
10 referred to in paragraph 11, the Applicant became aware of the
11 registration and use of the domain name
12 'pronaturalmuscle.com'. As a result an application to
13 transfer the domain name was filed with the WIPO Arbitration
14 and Mediation Centre, the result of which was that the domain
15 name pronaturalmuscle.com was transferred to the Applicant.

16 "(14) In view of the actions of the proprietor of UK
17 Trade Mark Registration No. 2448261, the registration was made
18 in bad faith and should therefore be cancelled under Section
19 3(6)."

20 It should at this point be noted that these assertions
21 failed to allege, let alone set out a basis upon which it
22 could be concluded, that the relevant application for
23 registration had been filed for an improper purpose or in an
24 improper manner: cf. CAMPBELL v HUGHES [2011] RPC 21
25 paragraphs 32 to 34. To put it another way, the averments

1 made in those paragraphs of the Statement of Grounds could all
2 be true without providing a sufficient and proper basis for
3 concluding that Ms. McCann had acted contra bonos mores when
4 applying to register PRONATURALMUSCLE as a trade mark for use
5 in relation to services of the kind specified which, it must
6 be emphasised, did not cover bodybuilding championships or
7 bodybuilding exhibitions: See Red Bull GmbH v. Sun Mark Ltd
8 [2012] EWHC 1929 (Ch) at paragraph [133].

9 For reasons which it is not necessary to go into, Ms.
10 McCann failed to file a defence to the invalidity application
11 within the period set by the Registrar for that purpose. That
12 led to a decision of the Registrar upholding the invalidity
13 application for default of defence on 17th February 2010.
14 However, the decision was subsequently set aside under Rule 43
15 of the Trade Marks Rules 2008 on 13th April 2011. WNBF's
16 invalidity application was then re-served on her and she
17 proceeded to file a defence and counterstatement in answer to
18 it on 16th May 2011. The counterstatement pleaded as follows:
19 "The name for the website 'pronaturalmuscle' was chosen as it
20 is a play on the words:- professional, natural and muscle.
21 The respondent is a professional bodybuilder who has chosen to
22 build her muscle naturally, ie. without the use of drugs such
23 as steroids etc.. Pronaturalmuscle was chosen to promote a
24 DVD produced by the respondent in December 2005.

25 "The respondent checked for any trademarks on the

1 descriptive name, Pronaturalmuscle, and found none. The
2 respondent later found that the complainant, the WBNF, had PRO
3 NATURAL trademarked in the U.S.A. Legal advice was sought and
4 the respondent was assured that 'pronaturalmuscle' was not
5 infringing the PRO NATURAL trademark and was sufficiently
6 different from said trademark, that no confusion should arise.

7 "An application for the trademark to Pronaturalmuscle
8 for use in internet services was sought and this was
9 registered under Registration Certificate No. 2448261 as of
10 the date 02 March 2007. The complainants PRO NATURAL was not
11 registered by the Trade Marks Registry in Great Britain until
12 later in the year, namely 12 October, 2007.

13 "The mark Pronaturalmuscle has only been used within the
14 terms of it's registration. The mark has not been used to
15 promote or conduct bodybuilding competitions in Great Britain
16 or anywhere else in the world.

17 "The domain name <pronaturalmuscle.co.uk> is DESCRIPTIVE
18 and the respondent is making fair use of it, ie, pro, natural
19 are precisely descriptive of the 'muscle'.

20 "PRO NATURAL, as it stands, could mean many things. Not
21 until you add 'muscle' to it does it become something
22 affiliated with bodybuilding/fitness/products etc. - at least
23 to a layman. The name PRO NATURAL is not precise at all. It
24 is merely a generic name.

25 "The Respondent does not dispute that the Complainant

1 has rights - rights to use PRO NATURAL."

2 What then followed was a near total failure by each side
3 to bring forward evidence of any real probative value in
4 support of its case against the other.

5 The evidence filed on behalf of WNBFF consisted of a
6 Witness Statement dated 22nd July 2011 in which Mr. Andrew
7 Murch, of the trade mark attorneys acting for it in these
8 proceedings, produced a copy of a WIPO Arbitration and
9 Mediation Centre Administrative Panel Decision dated 6th
10 June 2008 in which the Sole Panellist had upheld its complaint
11 relating to the registration of the domain name
12 pronaturalmuscle.com in 2005 and ordered that the domain name
13 be transferred to WNBFF.

14 The Administrative Panel Decision was presented to the
15 Registrar in Mr. Murch's witness statement as if it was a
16 ruling which effectively determined the present invalidity
17 proceedings under the 1994 Act adversely to Ms. McCann. In
18 paragraph 2 of his witness statement he said: "Whilst various
19 items of evidence could be filed to support claims in the name of
20 the Applicant for Cancellation, much has been considered by
21 WIPO and both comments and claims deemed to be facts."

22 In paragraph 12 of his witness statement he said: "As
23 regards bad faith, the claims and decision of WIPO is
24 sufficient to show that this has been proven." However, it
25 was made explicitly clear in the Administrative Panel Decision

1 that the person, against whom the Panellist's decision had
2 been issued was "The Dot Cafe Daniel Jones". It was also made
3 explicitly clear that there had been no response from anyone
4 served with WNBF's complaint. The Sole Panellist's
5 observations upon facts and matters of which he, the
6 Panellist, had no information or knowledge beyond that which
7 WNBF had provided to him did not involve the determination of
8 contested issues. Still less did they involve the
9 determination of contested issues arising within the
10 parameters of the legislative provisions of the 1994 Act which
11 WNBF had invoked in support of its objections to Ms. McCann's
12 UK trade mark registration.

13 For her part, Ms. McCann filed a document dated 23rd
14 September 2011 in which she set out her responses to the
15 witness statement put forward on behalf of WNBF. These were
16 expressed in the form of contentions and were not solemnised
17 by a statement of truth so as to possess the status of
18 evidence properly so-called.

19 With regard to paragraph 2 of Mr. Murch's witness
20 statement, she expressly denied his assertion that various
21 items of evidence could be produced to support WNBF's claims
22 for cancellation of her registration.

23 With reference to the Administrative Panel Decision, she
24 repeatedly maintained that, "the panel's view is accepted but
25 strongly refuted". See paragraphs 8, 9 and 10 of her

1 statement in response.

2 It is tolerably clear that she was thereby acknowledging
3 that the decision was extant, but rejecting the suggestion
4 that it could be taken to prove the case raised by WNBFB in the
5 present proceedings.

6 WNBFB did not seek to counter her position in that
7 connection by adducing evidence to substantiate the facts and
8 matters narrated in the Administrative Panel Decision. The
9 invalidity application proceeded, without recourse to a
10 hearing, to a determination on the basis of the papers on
11 file. The registration of the trade mark in suit was found to
12 be unobjectionable under Sections 5(2) (b), 5(3) and 5(4) (a) of
13 the Act for the reasons given by Mr. George Salthouse on
14 behalf of the Registrar of Trade Marks in a written decision
15 issued under reference BL O/003/12 on 10th January 2012. He
16 found the registration to be unobjectionable under Section
17 5(2) (b) on the basis stated in paragraph 22 of his decision:
18 "Despite the similarity of the marks the differences in the
19 services is such that there is no likelihood of consumers
20 being confused into believing that the services provided by
21 the registered proprietor are those of the applicant or
22 provided by some undertaking linked to them. The invalidity
23 under Section 5(2) (b) therefore fails."

24 The objections to registration under Sections 5(3) and
25 5(4) (a) were found to be untenable on the basis that they

1 could not succeed unless WBNF had used its PRO NATURAL trade
2 mark in United Kingdom prior to March 2007 and no evidence of
3 any such use had been filed in the present proceedings. It
4 seems to me to be implicit in his findings to that effect that
5 he declined to attribute evidential status to the contents of
6 the WIPO Administrative Panel Decision of 6th June 2008.

7 He nevertheless upheld WBNF's objection to validity
8 under Section 3(6) of the Act for the reasons he gave in
9 paragraphs 40 and 41 of his decision: "(40) In the instant
10 case the registered proprietor has simply denied that she had
11 any knowledge of the applicant's use of the mark PRO NATURAL.
12 This is simply untenable. The registered proprietor competed
13 in competitions run by the applicant under the mark PRO
14 NATURAL and was also head of the BBNF which was affiliated to
15 the applicant organisation until mid July 2006. It would
16 appear that the registered proprietor ceased competing in PRO
17 NATURAL competitions only following a dispute when she was
18 placed fourth in a competition she believed that she should
19 have won. Following this she persuaded the BBNF to affiliate
20 with a rival organisation to the applicant. It would also
21 appear that following this rift that she, along with others,
22 sought to register a domain name which featured at its
23 beginning the applicant's 'pronatural' mark, and allegedly
24 posted detrimental comments on a website regarding the
25 applicant, questioning the honesty and integrity (amongst

1 other things) of its chief officer. This is the subject of a
2 High Court action which has yet to be resolved. It is also
3 alleged, and not denied, that she styled herself as holding
4 the Pro natural Universe title.

5 "(41) The registered proprietor was clearly aware of the
6 applicant's use of the mark PRO NATURAL. Ms. McCann is a
7 bodybuilder based in the UK yet took part in competitions
8 organised under the PRO NATURAL mark by the applicant. This
9 would suggest that amongst the UK bodybuilding fraternity the
10 mark would have resonance and would be recognised as belonging
11 to WNBFF. In particular because of the issue of drug use in
12 bodybuilding, an organisation such as the applicant which
13 subjects competitors to drug tests and also lie detector tests
14 is going to have a raised profile. In offering nutritional
15 products and also web hosting or even offering advice on
16 nutrition and personal training the registered proprietor was
17 clearly seeking to ride upon the applicant's 'clean drug-free'
18 coat tails. I have no doubt that the registered proprietor
19 submitted the application in bad faith. The invalidity action
20 under Section 3(6) is therefore successful."

21 Ms. McCann was ordered to pay WNBFF £500 as a
22 contribution towards its costs of the proceedings in the
23 Registry. She subsequently appealed to an Appointed Person
24 under Section 76 of the 1994 Act contending that there had
25 been no bad faith on her part in relation to the filing of the

1 relevant application for registration and that the Hearing
2 Officer's decision to the contrary was wrong and should be
3 reversed.

4 I have had the benefit, which the Hearing Officer did
5 not have, of being able to consider the matters arising with
6 the assistance of oral submissions and argument from both
7 sides of the dispute.

8 The first point I wish to emphasise is that there is no
9 appeal by WNBFF against the Hearing Officer's findings to the
10 effect that it had no right to object on the basis of prior
11 registration or use of the denomination PRO NATURAL to Ms.
12 McCann's registration of the denomination PRONATURALMUSCLE for
13 use in relation to services of the kind specified in class 35
14 and class 42.

15 That being so, the question whether there was bad faith
16 in the filing of Ms. McCann's application for registration
17 must be answered on appeal, just as it had to be answered at
18 first instance, with due regard for the fact that the filing
19 of that application was innocuous relative to the pleaded
20 legal and commercial interests of WNBFF in the denomination PRO
21 NATURAL. And, if the filing of that application was innocuous
22 relative to those interests, her awareness of the existence of
23 those interests cannot, of itself, establish that the
24 application was filed for an improper purpose.

25 That brings me to the second point I wish to emphasise.

1 There was, as I have already said, no sufficient and proper
2 basis for a finding of bad faith in the averments made in
3 paragraphs 11 to 14 of WNBf's Statement of Grounds. More
4 specifically, with regard to the WIPO Administrative Panel
5 Decision, it could not be said that the decision to uphold
6 WNBf's complaint against 'The Dot Cafe Daniel Jones' in
7 respect of the domain name PRONATURALMUSCLE.com necessarily or
8 inevitably established that WNBf's application for invalidity
9 in respect of Ms. McCann's UK trade mark 2448261 was
10 well-founded.

11 The parties were not the same and the scope of the
12 inquiry was not the same as between the two sets of
13 proceedings. The former proceedings were uncontested. The
14 latter proceedings were contested. There would, to say the
15 least of it, be difficulties in the way of any argument to the
16 effect that the Administrative Panel Decision had given rise
17 to any issue estoppel or res judicata against Ms. McCann in
18 the present proceedings. There would, again, to say the least
19 of it, be difficulties on the way of any argument to the
20 effect that the findings and conclusions of the Administrative
21 Panel Decision were admissible as evidence against Ms. McCann
22 in the present proceedings having regard to the reasoning of
23 decisions such as that of the House of Lords in *Three Rivers*
24 District Council v Bank of England (No. 3) [2001] UKHL 16;
25 [2003] 2 AC 1 at paragraphs [5] and [31] to [33].

1 Added to which the Hearing Officer seems to me to have
2 attributed no evidential status to the contents of the
3 Administrative Panel Decision and WNBF has not sought to
4 challenge his approach in that connection. So what actually
5 was the basis of the Hearing Officer's finding of bad faith in
6 relation to the filing of the relevant application for
7 registration?

8 The answer appears to me to reside in the statements in
9 paragraph 41 of his decision, firstly to the effect that,
10 "...amongst the UK Bodybuilding fraternity the mark would have
11 resonance and would be recognised as belonging to WNBF"; and,
12 secondly, to the effect that: "In offering nutritional
13 products and also web hosting or even offering advice on
14 nutrition and personal training the registered proprietor was
15 clearly seeking to ride upon the applicant's 'clean drug-free'
16 coat tails."

17 The first of those statements does not appear to me to
18 sit at all easily with his findings as to the absence of any
19 evidence of use or distinctiveness acquired through use of the
20 denomination PRO NATURAL by WNBF in the United Kingdom.

21 The second of those statements involves a finding
22 adverse to Ms. McCann on a ground which had never at any stage
23 been alleged, let alone substantiated by any evidence filed on
24 behalf of the applicant for invalidity. In addition, it gives
25 less than due weight to his determination that the filing of

1 the relevant application for registration was innocuous
2 relative to the pleaded legal and commercial interests of WNB
3 in the denomination PRO NATURAL, and does not explain how or
4 why it should be regarded as improper for Ms. McCann to be
5 wanting to promote her activities and those of her
6 organisation BNB as being centred on "natural", that is to
7 say "clean drug-free", endeavours. For these reasons the
8 Appeal will be allowed and the Hearing Officer's decision will
9 be set aside.

10 It now remains to be considered what should be done with
11 regard to the costs of the proceedings in the Registry and on
12 appeal.

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15 Appeal allowed.

16 Hearing Officer's decision under Section 3(6) and his decision
17 as to costs set aside.

18 Application for invalidity dismissed, with no order as to
19 costs in relation to the proceedings at first instance or on
20 appeal.

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