TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 1570095 BY HARRODS LIMITED TO REGISTER A MARK IN CLASS 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO 43446 BY THE HARRODIAN SCHOOL LIMITED

TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994

IN THE MATTER OF Application No 1570095 by Harrods Limited to Register a mark in Class 41

and

IN THE MATTER OF Opposition thereto under No 43446 by The Harrodian School Limited

BACKGROUND

On 28 April 1994 Harrods Limited applied under the Trade Marks Act 1938 to register the trade mark HARRODIAN in respect of a specification which reads:

> Operation of cookery schools; provision of fitness training and conduct of gymnastic and sporting activities; training in equestrianism and carriage driving; operation of nursery schools and provision of pre-school facilities; provision of sports tuition; all included in Class 41.

The application is numbered 1570095.

On 9 November 1995, The Harrodian School Limited filed a notice of opposition to this application. The grounds of opposition in summary are:

> Under Section 9 in that the trade mark applied for is not adapted to distinguish the services of the Proprietor.
>
> Under Section 10 in that the trade mark applied for is not capable of distinguishing the services of the Proprietor.
>
> Under Section 11 because of the use by the opponents of their trade mark use by the applicants of the trade mark applied for is likely to deceive or cause confusion.
>
> Under Section 68 on the grounds that the applicant has no intention of using the trade mark applied for on all of the services set out in the specification.

The opponents close their grounds of opposition by stating that the High Court has already ruled that they are entitled to the trade mark HARRODIAN in respect of educational services, at least.

The applicants filed a counter-statement denying the above grounds and putting the opponents to proof over their allegations. They state that they have used the word HARRODIAN since at least the beginning of the century [1900's] as the adjectival form of HARRODS, which is the trade name and registered trade mark of the applicants. They claim that from 1929 to 1990 they have used the trade mark HARRODIAN in respect of a sports and social club. On the basis of the applicants' use and reputation in the mark HARRODIAN the applicants deny that the mark is likely to deceive or cause confusion.

Both parties ask for the exercise of the Registrar's discretion and an award of costs in their favour. Both sides filed evidence and the matter came to be heard on 6 April 2000 when the applicants for registration were represented by Ms Jessica Jones, of Counsel, instructed by D Young & Co and the opponents by Mr Thomas Mitcheson, of Counsel, instructed by J A Kemp & Co.

By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

At the start of the hearing Mr Mitcheson, for the opponents, informed me that they would only be relying upon their grounds of opposition under Sections 11 and 68 of the Trade Marks Act 1938. For the record therefore I dismiss the opposition insofar as it was based upon Sections 9 and 10.

Opponents' Evidence

This consists of a statutory declaration dated 25th October 1996 by Adrian Chetwynd Hayes. Mr Hayes is a Chartered Patent Agent and Registered Trade Mark Attorney in the firm of J.A. Kemp & Co.

He states that he has reviewed the witness statements made by Sir Thomas Alford Houstoun Boswall and Lady Houstoun-Boswall in the action before the Chancery Division of the High Court of Justice, number CH-1993-H No 2496, between Harrods Limited and The Harrodian School Limited. In that connection he exhibits at Exhibits ACH-1 and ACH2 a copy of the witness statements and their annexes of Sir Thomas Alford Houstoun-Boswall and Lady Houstoun-Boswall, respectively. Mr Hayes states that these witness statements identify the use which has taken place by the opponents of the trade mark HARRODIAN.

Mr Hayes goes on to state that he has also reviewed the judgment of the Court of Appeal on the subsequent appeal by Harrods Ltd from the abovementioned Court action. At ACH-3 he exhibits a copy of the Judgment of the Court of Appeal together with a copy of the corresponding "Times Law Report".

I summarise the contents of the exhibits to Mr Hayes' statutory declaration as follows:

Exhibit ACH-1 - Witness Statement of Sir Thomas Alford Houstoun-Boswall.

This is a witness statement of Sir Alford Houstoun-Boswall dated 29 March 1994 together with 15 Annexes. Sir Houstoun-Boswall is the co-principal of The Harrodian School and Chairman of The Merlin School. He states that he has been involved with The Merlin School since 1986 when he set up the school with the Head Mistress, Ms Jane Addis. He had planned to increase his involvement with the educational system and intended to develop a co-educational preparatory school and had been looking for a suitable site for such a school since 1988.

Sir Houstoun-Boswall explains that he had been aware of The Harrodian Club for some time as The Merlin School used to rent the grounds of the Club for physical education activities before being told by House of Fraser (its then owners) that the Merlin school would no longer be able to rent the grounds. Upon hearing this he contacted the House of Fraser's property agents, Savills, in the hope that the site could be purchased to convert into a new school as the combination of the location and playing fields made the site the finest opportunity in London for a large scale educational establishment. Sir Houstoun-Boswall instructed his then solicitors to write to Savills putting forward his first offer to purchase The Harrodian Club (this correspondence is annexed) and he claims that in the very early stages of the negotiations the vendors were made aware of his intentions to use the site as a school. Sir Houstoun-Boswall goes on to explain how negotiations subsequently broke down, recommenced and broke down again during 1990 and 1991 (copies of correspondence and draft agreements exchanged between the parties during this period are exhibited). Negotiations were recommenced again and the purchase of The Harrodian Club was finally agreed in January 1993 (copies of various documents and correspondence are exhibited).

Sir Houstoun-Boswall states that throughout the lengthy negotiations, the property was always referred to as "The Harrodian Club". The Agreement for Sale and Purchase referred to the property as such, and the property has been registered with The Land Registry as "The Harrodian Club" (a copy of the entry from the Land Registry is exhibited). Sir Houstoun-Boswall says that there was never any doubt in his mind that the property he was purchasing was know as "The Harrodian Club" and that at no time during the purchasing process did anyone raise any concerns over the name of the property, nor was there any restriction on the use of the property's name sought or volunteered. He therefore chose the name "The Harrodian School" as the building was a landmark building in the area and, he claims, people knew it as "The Harrodian" or "The Harrodian Club". It had been bought as The Harrodian Club and that he simply changed the word "Club" to "School" in keeping with the new use of the property. Sir Houstoun-Boswall states that if Harrods had told him when purchasing the property that he could not use the name HARRODIAN, then he would have thought of another name.

The school opened in September 1993 with 65 pupils and at the date of the witness statement had 75 pupils. Some 200 families were being interviewed for the autumn 1994 intake which would result in some 40/50 further pupils being chosen to start in September 1994.

Exhibit ACH-2 - Witness Statement of Lady Houstoun-Boswall

Lady Houstoun-Boswall states that she is the co-principal of The Harrodian School and had been involved in the establishment and development of the school since it was set up at the beginning of 1993.

Lady Houstoun-Boswall states that she felt a good co-educational school was needed in London. In the early part of 1993 the Department for Education was informed that a new independent school was being opened. By the end of 1993, Her Majesty's Inspectorate had visited the school and given provisional registration.

Lady Houstoun-Boswall states that many parents heard about the school though an article in *The Mail on Sunday*, dated 7 February 1993, (a copy of which is exhibited as Annex 3 to her witness statement) and later by word of mouth. In addition about 500 copies of the prospectus were despatched to interested parties.

Mr Hayes exhibited a copy of the judgment of the Court of Appeal in which the Court confirms what has been said in the evidence of the Houstoun-Boswalls that is that the disputed name (HARRODIAN) was first used in 1993 by the opponents in connection with the school.

Applicant for Registration's Evidence

This consists of two statutory declarations dated 18th November 1997 and 3rd April 1998 both by Michael Rogers. Mr Rogers is the Legal Director of Harrods Limited and he is authorised to make the declarations on their behalf. He states that the matters in his declarations are both from his personal knowledge and from information available to him and obtained from books, records and documents of Harrods Ltd kept in the ordinary course of their business.

In his first declaration dated 18th November 1997, he states that Harrods Ltd have used the name HARRODIAN, being the adjectival form of the words "Harrods", since at least the beginning of this century [1900s] in relation to a vast range of goods and services and in various publications. At Exhibit MR1 to his declaration, he exhibits copies of documentary references, some of which are undated, showing use of the word HARRODIAN in relation to a range of goods such as cots, oak panelling, footwear and kites, but not on any services the subject of this application for registration and the use shown some considerable time ago.

Mr Rogers goes onto state that at least since the beginning of the century, Harrods' staff have been referred to as "Harrodians" and various staff societies have commonly been referred to by reference to the term "Harrodian". He lists as examples The Harrodian Horticultural Society, The Harrodian Amateur Dramatics Society, The Harrodian Operatic Society, The Harrodian Co-Operative Banking and Credit Society, The Harrodian Orchestra and The Harrodian Light Orchestra. He also states that there is a memorial in Harrods' London store for those members of staff who were killed in the First World War headed "Harrodians Who Died for their Country". Mr Rogers exhibits to his declaration at exhibit MR2 copies of references to various "Harrodian" societies, a picture of the Memorial and a copy of an undated article concerning staff at Harrods from *The Sunday Times* entitled "The Harrodian Way of Life".

Mr Rogers goes on to explain that the word HARRODIAN has been used continuously from 1929 to 1990 in relation to a sports and social club based at Mill Lodge in Barnes. Prior to 1929, the club was called "The Harrods Sports Club" and was the home of the Harrodian Amateur Athletics Association and other Harrodian sports clubs and teams. After 1929, however, the club itself was known as "The Harrodian Club". He states that social activities undertaken at the club - which was the focal point of staff social activities - included theatrical and operatic events, orchestral performances, dances, fitness classes, bingo evenings and garden parties. From 1988 onwards, training courses for Harrods' staff were held at The Harrodian Club. Mr Rogers explains that originally members of the club were drawn solely from Harrods' staff but from 1968 onwards, associate members were allowed to use the club's facilities. Associate members were initially drawn from the families of Harrods' staff but membership was later further extended to people who were not connected with Harrods in any way. These, together with independent organisations having no connection with Harrods, such as The Merlin School owned by Sir Thomas and Lady Houston-Boswall, (now owners of the Harrodian School), were the principal users of the facilities of The Harrodian Club by the time it closed in 1990.

Mr Rogers states that the services provided at the Harrodian Club were protected by Harrods through registration of the trade mark HARRODIAN, he refers in particular to registration numbers 390725, 1400987 and 1400988. Details of which are as follows:

Registration Number	**Mark**	**Class**	**Specification of Goods/Services**
390725	HARRODIAN	5	Sanitary clothing
1400987	HARRODIAN	41	Provision of amusement parks; provision of gymnastic instruction; provision of sport facilities; organisation of competitions; physical education services; production of shows; provision of recreation facilities; all included in Class 41
1400988	HARRODIAN	42	Public bath facilities; campground facilities; cafe, cafeteria, canteen, snack-bar, restaurant and catering services; healthcare and massage services; room rental services; all included in Class 42.

Mr Rogers then proceeds to explain that the trade mark HARRODIAN continues to be used by Harrods, and that they intend to expand the use of this trade mark in the future. As an example Mr Rogers explains that Harrods Ltd proposes to convert a furniture depository into "The Harrods House Hotel", which will be of similar style to "The Ritz" in Paris, which is under the same ownership as Harrods Ltd. He exhibits an undated article which makes reference to the plans to open the Hotel. Mr Rogers explains that the intention is to call the

central bar in the Hotel, "The Harrodian Bar"; the fitness centre in the Hotel will be named "The Harrodian Health Club" and that a cookery school will be named "The Harrodian School of Cookery". It is claimed that the cookery school will be built on the goodwill associated with The Harrods Gourmet Club which currently has over 2000 members.

Mr Rogers goes on further to state that the word HARRODIAN, being the adjectival form of Harrods which he says he has never seen used in any other context, is necessarily associated with Harrods and to the best of his knowledge, information and belief, Harrods have not given permission to any third party to use the mark HARRODIAN. As far as he is aware the sale of The Harrodian Club did not include the sale of the name HARRODIAN, but no exhibit is produced to support this statement. He states that the Harrodian School Limited have nevertheless been using the name HARRODIAN since, he believes, Spring 1993 shortly after they purchased The Harrodian Club.

In his second declaration dated 3 April 1998 Mr Rogers sets out in detail the training and education provided by the applicants which they started for members of its staff aged 14 to 18 in 1919 when it commenced a "Continuation School" for such staff. In 1920 there were 350 pupils and each student attended for a period of two hours; a third of the time spent in physical culture and drill, the remainder taken up with non-vocational education including English, Mathematics, Language and the like, provided by qualified teachers. Evening classes have been offered by Harrods for staff over the age of 18 since the early years of this century [1900s]. In 1920 an advert in the Harrodian Gazette included both commercial (for example, shorthand, typing, book-keeping) and recreational (physical exercise, singing, elocution) activities. Classes on offer in recent years include German, Japanese and assertiveness training.

Mr Rogers then explains that Harrods started a three year Retail Certificate course for its staff in 1950. This required attendance for six hours a week of which three hours were during business hours. An article relating to this Certificate appears in Exhibit MR1. Mr Rogers also states that between the late 1920s and the 1960s, selected employees in the drapers trade were sent for a period of 8 weeks to a summer school in Oxford. A copy of an article from "The Harrodian Gazette" dated September 1925 in relation to this exercise is exhibited to his declaration. It is further stated that Harrods have provided and organised a continuous programme of vocational education and training from 1920 onwards, promoting education and training at all levels. It is stated that for many years education/training courses were provided by Harrods at Burnham Beeches and from 1988 onwards at The Harrodian Club until that was sold in 1993. Since then education/training has been provided in premises in Hans Crescent, London. At Exhibit MR10, Mr Rogers provides details of Harrods' educational programmes and training schemes from 1920 to 1997, including copies of pages from "Harrods Training and Development Brochure 1997". Mr Rogers states that Harrods, where appropriate, send staff on external education/training courses.

Mr Rogers concludes by stating that Harrods provide education and training over a very wide range of different areas and have done so since the early years of the century [1900]. As to the trade mark HARRODIAN, this is the adjectival form of "Harrods" and therefore identified with Harrods and with their activities including provision of education and training.

Opponent's Evidence in Reply

The opponent's evidence in reply consists of a statutory declaration dated 6th October 1998 by Monica Anne Marshall. Ms Marshall is a Chartered Patent Agent, Registered Trade Mark Attorney and partner in the firm of J.A. Kemp & Co.

She states that she is acquainted with the papers filed in these proceedings. Ms Marshall states that the Statutory Declaration of Mr Hayes refers to the action before the Chancery Division of the High Court of Justice No CH-1993-1 No 2496 between Harrods Limited and The Harrodian School Limited. She has reviewed the Witness Statement of Michael Cole, the Director of Public Affairs at Harrods, together with the transcript of his cross examination which took place during the High Court proceedings. These are attached at exhibits MAM1 and MAM2 respectively and which are referred to later in this decision.

Ms Marshall then states that she has also reviewed the High Court judgement, a copy of which has been exhibited, and in particular she refers to the following passage by Mr Justice Harmon:

> "The evidence from Mr Cole, a director of Harrods Limited who gave evidence before me, was that there was no present contemplation of setting up or arranging for any educational service as such. There are plans, but they are plans and not facts although fairly well advanced, to establish what is hoped to be called the Harrodian School of Cookery in a new enterprise for Harrods which is the operation of a hotel. That is as I say a new field for the plaintiff, but is one which plainly is fairly well advanced in conception and has become a matter of intention and not a matter of hope as I find."

Ms Marshall further states that she has reviewed the petition by Harrods Limited for leave to appeal to the House of Lords from the Court of Appeal decision to uphold that of the High Court. She has been informed by the solicitors for The Harrodian School Limited that the application by Harrods Limited for leave to appeal to the House of Lords was refused.

That concludes my summary of the evidence filed in this case and which I consider relevant to the matters in hand.

Decision

I deal first with the ground of objection based upon Section 11 which reads:

> "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or scandalous design."

The established test for an objection under this Section is set down in *Smith Hayden and Company Ltd's Application* (Volume 1946 RPC 63 RPC 101) later adapted by Lord Upjohn in the *BALI Trade Mark case* [1969] RPC 496. Adapted to the matter in hand the test may be expressed as follows:

> Having regard to the user of the mark HARRODIAN, is the tribunal satisfied that the mark applied for, HARRODIAN, if used in a normal and fair manner in connection with any services covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

The test requires me to consider the actual user of the opponents' trade mark and normal and fair use of the trade mark applied for. The position must also be considered at the material date of 28 April 1994 when the application in suit was made.

It was argued that the onus of proving that there was no reasonable probability of deception lay with the applicants and that it is sufficient for a mark to be rejected if there was the likelihood of confusion, even though the end consumer was not deceived. Mr Mitcheson further argued that it would be sufficient that a number of persons were likely to be confused as to the source of the services and that it did not have to be all persons nor even a significant number. He drew attention to the following passages to support his arguments:

In *BALI Trade Mark case* [1969] RPC 496:

> "It is sufficient if the result of the registration of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two [services] came from the same source. It is enough if the ordinary person entertains a reasonable doubt.", and

In *Bass, Ratcliff & Gretton v Nicholson & Sons* [1931] 48 RPC 227 at 251 (and approved by the House of Lords in *Bali* at 489):

> "What is required for that purpose is proof that the mark before that date was in fact used as a trade mark, that is, was used by the trader in his business upon or in connection with his [services], and it is not necessary to prove either the length of the user or the extent of the trade. In other words, the character and not the length or extent of user is the only thing that has to be established."

The opponents' starting point is that their use of HARRODIAN prior to the date of application is not challenged and that the length of use by them before the material date is irrelevant taking account of the passage from *Bass, Ratcliff & Gretton*. It was the character that mattered. Therefore, given the use of the trade mark by the opponents, Mr Mitcheson argued that it would be enough for that fact to give rise to the prospect of people wondering whether services offered under the applicants' HARRODIAN trade mark might be connected with the opponents.

Ms Jones submitted that the applicants had use of the term HARRODIAN over a very long period in relation to a wide range of goods and services, including services which were the subject of this application. Thus by reference to a comment in Kerley (10-5 p 148) endorsed in WELSH LADY [1964] RPC 459:

> "Where a trade mark has been long used by a person who is applying to register it, it will not be refused on the ground of recent use of a similar mark by another trader. The mark does not by such recent use become calculated to deceive."

In addition, it was submitted that the applicants' earlier registrations for the term HARRODIAN, referred to by Mr Rogers in his evidence must also be taken into account because these registrations should have an accumulative effect under Section 11. By reference to Kerley (10-3 p 145) I assume that this submission relates to use by the registered proprietor on goods or services which are outwith these registrations which may be taken into account in determining matters under Section 11.

Before considering these submissions, I first of all consider whether the applicants' trade mark and that of the opponents, and the respective services are sufficiently similar to warrant consideration of the opposition based upon Section 11. In that connection I rely upon the test set out by Parker J in PIANOTIST [1906] 32 RPC 774 which states:

> "You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

The two trade marks consist of the word HARRODIAN and therefore they are identical. The specification of services of the application is as follows:

> Operation of cookery schools; provision of fitness training and conduct of gymnastic and sporting activities; training in equestrianism and carriage driving; operation of nursery schools and provision of pre-school facilities; provision of sports tuition; all included in Class 41.

The opponents claim to use their trade mark on "educational and sporting facilities" which they say are the same or similar to the applicants' services. Though submissions were made to me on the point I have no evidence to assist me. Nor is there evidence in fact that the opponents provide sporting facilities other than as part of their educational services. I intend therefore to consider the matter by reference to the applicants specification of services against the opponents educational services.

It seems to me that the opponents 'educational services' are in respect of those associated with the education of children in a co-educational preparatory school. Thus, the direct clash exists between those services and the applicants' operation of nursery schools and provision of pre-school facilities. The physical education which the opponents are likely to provide as part of

their educational services for children are of a different nature to the 'provision of fitness training and conduct of sporting activities' which the applicant's specification covered. Therefore there is no clash there. Nor is there any clash between the opponents services and the remainder of the applicants' specification; operation of cookery schools; training in equestrianism and carriage driving are terms that are outwith the normal use of the term educational services. In simple terms I do not see that these activities would appear on the curriculum of a preparatory school.

The next question is whether in respect of those services which do clash have the opponents established use which would, if the applicants used their trade mark, cause deception and confusion? It was not disputed that the opponents began their use of the trade mark HARRODIAN in connection with their preparatory school early in 1993. The applicants submitted, nevertheless, that this use was not sufficient to displace their reputation in the word HARRODIAN in connection with the site itself and generally, through its use, in connection with a range of other goods and services.

In the evidence before the High Court and the Court of Appeal in the passing off dispute between the two parties, and referred to in the evidence in this case, it was established that the applicants use of the term HARRODIAN had ceased a long time ago either as a trade mark on goods or services provided by the applicants or as an adjective. The following extract from the cross examination by Mr Simon Thorley QC of Mr Michael Cole, the then Director of Public Affairs of the applicants, is relevant:

> MR THORLEY: Mr Cole, advertising; let us draw a line at 1940 when we ceased to deal with margarines and chocolates under the Harrodian name. In the last 50 years, the emphasis in your advertising has been on Harrods to the exclusion of Harrodian. Is that correct? – A. Yes, the emphasis certainly.
>
> Q. There has been no public advertising involving the word "Harrodian"? – A. Not that I know of.
>
> Q. You have not sought to foster any public connection between the word "Harrods" and "Harrodian"? – A. Except by the use of the large display board outside the club which was well known in the area as being the club of the Harrodians.
>
> Q. You have not, for example, called it the "Harrodian sale", at Christmas? – A. No, January.
>
> Q. You have not called it the "Harrodian car-park"? – A. It is called the Harrods car-park.
>
> Q. You do not have a Harrodian account card? – A. We have a Harrods account card.
>
> Q. I have one. I do not know whether you have one. What is more worrying is that Mrs Thorley has one, but we do not need to worry about that. It is Harrods? – A. Yes, sir.

> Q. The adjectival use that you have made in the last 50 years is of Harrods and not of Harrodian? – A. Yes.

Also, in his Judgment Millet L J, on appeal from the decision by Mr Justice Harmon in the passing off action, said in relation to the word HARRODIAN:

> "In my judgment the evidence clearly supported the Judge's findings that the use by the plaintiffs (the applicants) in connection with facilities to be provided to the public in the Harrods House Hotel and by the proposed School of Cookery will be a revival of a usage which is long obsolete."

Taking account of those statements and the evidence before me I am unable to hold that the applicants had any use or reputation in the word HARRODIAN at the date of this application. The word HARRODIAN has not been used in association with any service in a way which enables me to do so. Thus I must compare the HARRODIAN trade mark the subject of this application on the basis that it is one which was unused at the relevant date.

As indicated earlier, it was not disputed that the opponents have use of their trade mark which, though not extensive, is of some significance. Not only were prospectus sent out early in 1993 but there was a press article referred to in the evidence and interviews with the parents of prospective pupils. All of which, in my view, served to bring the name of the school and therefore the term HARRODIAN to the attention of the general public. Or at least sufficient of them to ensure that if the applicants were to use their HARRODIAN trade mark on the services which clash with the educational services of the opponents, and identified above, then sufficient numbers would be confused as to the source of the services. This is because it is only the opponents who have made use of the word HARRODIAN recently and therefore if anyone other than them used the word on the same service or services of the same description then confusion is bound to occur. That being so the opposition under Section 11 of the Act succeeds. However, if the applicants were to limit their specification to those services which are not the same or of the same description as those provided by the opponents under their HARRODIAN trade mark then, this ground of opposition would disappear.

I turn to the ground of opposition based upon Section 68 the relevant part of which reads as follows:

> "68. ... "service mark" means a mark (including a device, name, signature, word, letter, numeral or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person."

The opposition under this section is based upon the allegation that the applicants have no bona fide intention to use the trade mark in relation to the services applied for. The opponents submit that there is no credible evidence of any intention to use the mark. Given the history of proceedings between the parties they infer that the main reason Harrods filed the present application was in order to frustrate the activities of the Harrodian School and that the trade mark the subject of the application can be characterised as a "ghost" mark (Imperial Group

Ltd v Philip Morris [1982] FSR 72) because there was no primary or indeed any intention to trade in the services applied for.

In this respect the comments of the Court of Appeal (which reflect the findings of Harman J. and which were made very soon after this trade mark was applied for) are relevant:

> "The Plaintiffs, however, have never run a school and have no plans to do so whether under the name "Harrods" or otherwise". (Millett LJ).

> "The Plaintiffs do not contemplate re-opening a staff club for their employees. The Plaintiffs' current plans for the new Harrods House Hotel include plans to name the central bar "The Harrodian Bar" and to open a fitness centre called "The Harrodian Health Club". They also plan to establish a cookery school on the lines of L'Ecole Defendant Gastronomie Francaise Ritz-Escoffier at the Ritz Hotel in Paris, which claims to offer a complete programme in French gastronomy. The Plaintiff's plans are still at an early stage but currently the favoured name for the school is The Harrodian School of Cookery". (Millett LJ).

The evidence filed in these proceedings do not cause me to believe that the situation at the date of application in this case (or even now) is any different. I do not consider that the applicants have, when challenged, demonstrated an intention to use the trade mark HARRODIAN in connection with the provision of nursery schools or pre-school facilities. But I am satisfied that they have an intention plans to use it on cookery school services and the conduct of gymnastic and sporting activities. That leaves the provision of equestrianism and carriage driving on which there is no evidence either way. That being so I intend to give the applicants the benefit of the doubt because I do not consider that to do so would in any way prejudice the opponents. The objection based upon Section 68 of the Act therefore succeeds but only insofar as the operation of nursery schools and the provision of pre-school facilities is concerned.

In view of my findings the exercise of the Registrar's discretion is not appropriate and the application for registration stands refused because the objections have been upheld in relation to Sections 11 and 68 of the Act. However, the objections apply to only some of the services covered by the specification of the application for registration. If the applicants limit their specification of services so as to read as follows:

> Operation of Cookery Schools; conduct of gymnastic and sporting activities; training in equestrianism and carriage driving; all included in Class 41

then the objections will be overcome and the application may proceed to registration. I therefore allow one month from the expiry of the prescribed appeal period for the applicants for registration to file Form TM21 to amend the specification accordingly. If there is no appeal or no Form TM21 filed limiting the specification of services within the period set out above then the application for registration will be refused.

As the opponents have succeeded only in part I do not consider it appropriate to award them the full costs from the scale. I order the applicants to pay to the opponents the sum of £200 as a contribution towards their costs.

Dated this 8 day of August 2000

M KNIGHT
For the Registrar
the Comptroller-General