

O/828/21

TRADE MARKS ACT 1994

IN THE MATTER OF:

UK TRADE MARK NO. 3392729:

“THOMSON ENVIRONMENTAL CONSULTANTS”

**REGISTERED IN THE NAME OF THOMSON ECOLOGY LIMITED
FOR SERVICES IN CLASS 35**

AND

**APPLICATION NO. 503410 FOR A DECLARATION OF INVALIDITY THEREOF
BY THOMSON ENVIRONMENTAL SERVICES LIMITED**

BACKGROUND AND PLEADINGS

1. Thomson Ecology Limited (“**the Proprietor**”) is the registered proprietor of the following UK trade mark registration no. 3392729 (“**the Contested Registration**”):

Word mark: Thomson Environmental Consultants
(“**the Contested Mark**”)

Filing date: 16 April 2019

Registration date: 19 July 2019

Registered for the following services in Class 35:

Acquisitions (Business -) consulting services; Administration of businesses

The invalidity claim

2. On 27 October 2020, Thomson Environmental Services Limited (“**the Cancellation Applicant**”/“**TESL**”) applied to declare the Contested Registration invalid, based on grounds under section 5(4)(a) of the Trade Marks Act 1994 (“**the Act**”). The claim is that as at the filing date of the Contested Registration (16 April 2019) – which is the “**relevant date**” for assessing matters in these proceedings (at least in the first instance) - the Cancellation Applicant had UK use-based rights in THOMSON ENVIRONMENTAL SERVICES in relation to:

“water treatment products and services; water disinfection services; plumbing services; chlorination services; site surveys; water sampling; water analysis; water quality reports; laboratory services; health and safety advisory services relating to the use and storage of water stored within buildings; advisory and consultancy services in relation to the use and transportation of water; advisory and consultancy services in relation to water compliance issues; consultancy and advisory services in relation to the prevention of Legionella bacteria from contaminating water supplies and the removal of Legionella bacteria from water supplies; engineering and remedial services in relation to water supply and storage systems; training services in relation to health and safety legislation and practice; risk assessment and audit services in relation to water treatment and water hygiene.”

3. The Cancellation Applicant claims to have used the sign THOMSON ENVIRONMENTAL SERVICES throughout the UK since 1993. TESL claims that use of the Contested Mark “Thomson Environmental Consultants” would constitute a misrepresentation because relevant consumers would mistakenly believe that the parties are connected or that TESL had somehow authorised use when this is not the case. TESL claims that damage to its goodwill is an inevitable consequence.
4. In its statement of grounds, the Cancellation Applicant acknowledges that the services under the Contested Registration are not obviously connected with the services in relation to which TESL claims to have generated protectable goodwill. Rather, the claim is that it is clear from the mark itself that the Proprietor intends to use it in the sector of environmental consultancy and that, as such, use of the mark in relation to “*Acquisitions (Business -) consulting services; Administration of businesses*” would constitute passing off.

The defence

5. The Proprietor filed a notice of defence with a counterstatement from which I note the following points;
 - i. it denied that the Cancellation Applicant had goodwill in the trading name THOMSON ENVIRONMENTAL SERVICES that is protectable by an action for passing off under section 5(4)(a).
 - ii. it states that any goodwill that the Cancellation Applicant may have is preceded by a greater degree of goodwill on the part of the Proprietor - and other companies under common control within the Proprietor’s group of companies¹ - with respect, *before 1993*, to the following words:

THOMSON and/or
THOMSON ENVIRONMENTAL and/or
CONSULTING ENVIRONMENTAL SCIENTIST and/or
THE ENVIRONMENTAL CONSULTANCY BUSINESS and
THOMSON ENVIRONMENTAL CONSULTANTS

¹ “Group” as construed in accordance with section 1261(1) of the Companies Act 2006.
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And, since 1993, in connection with THOMSON and THOMSON ENVIRONMENTAL CONSULTANTS.

- iii. That without prejudice to the foregoing, the word THOMSON has distinctive character within certain fields of applied environmental science (soil, water and air sampling and analysis in terrestrial and marine environments), whereas “ENVIRONMENTAL” and “CONSULTING” are descriptive words and that neither descriptor enhances any case for passing off in combination with THOMSON.
- iv. The word THOMSON is used in the course of trade by the Proprietor (and other companies in its group) with first use as a brand name dating from 1978. THOMSON is the personal name of Ms Nancy Thomson and has been, and is being, used in connection with the provision of environmental services in the outdoors. Its first use was under the unincorporated trading name THOMSON LABORATORIES in 1978, then incorporated in 1981 as THOMSON LABORATORIES LIMITED.² This company was acquired around January 1992 and the name changed to THOMSON MTS LTD, which itself used the trading name THOMSON ENVIRONMENTAL at such time.
- v. Accordingly, THOMSON was used in a succession of corporate names prior to the incorporation of the Cancellation Applicant in 1993, all of which names, including that of the Proprietor, were adopted in good faith and without any misrepresentation since Ms Thomson has enjoyed a leading personal reputation in the field of environmental science and still does.
- vi. The Proprietor admits to providing consulting services, which it specifies as “ecological advice, appraisals, surveys and ecological impact assessments, none of which appear to be offered by the Cancellation Applicant.” The Proprietor submits in its counterstatement that the services of the Cancellation Applicant “*seem to be delivered exclusively within buildings, such as water contamination. Persons and institutions seeking environmental services would easily be able to distinguish “indoor” from “outdoor” services and would not in any reasonable circumstances be materially confused or else infer any connection or association between the parties.*”

Papers filed, the hearing and representation

6. As summarised below, both parties filed both evidence and submissions in chief during the evidence rounds and the Cancellation Applicant also filed evidence in reply. I have read all the papers filed and shall refer to their contents where I consider it warranted to do so. An oral hearing of the matter was held before me by video conference on 23 August 2021. The attorneys for the Cancellation Applicant are Elkington and Fife LLP, and Chris McLeod of that firm attended at the hearing; the attorneys for the Proprietor are Moore Barlow LLP, who engaged Nick Zweck of counsel to represent at the hearing. Skeleton arguments were filed in advance of the hearing.

EVIDENCE / SUBMISSIONS FILED

Cancellation Applicant's evidence and submissions in chief

First Witness Statement of Robert Anthony Bardsley-Smith (5 March 2021)

+ Exhibits RBS1 - 4

Written submissions (5 March 2021)³

The Proprietor's evidence and submissions in chief

Witness Statement of Heidi Kane (23 April 2021)

Witness Statement of Nancy Elizabeth Thomson + Exhibits NET1 - 5

Written Submissions (23 April 2021)

Cancellation Applicant's evidence and/or submissions in reply

Second Witness Statement of Robert Bardsley-Smith (16 June 2021)

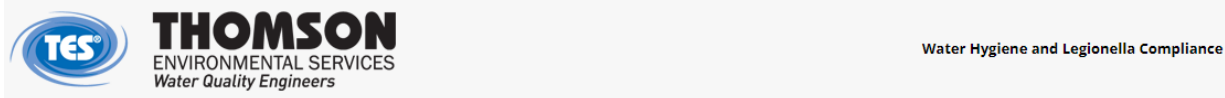
+ Exhibits RBS1 - RBS6

7. From the Cancellation Applicant's evidence, I note the following. Mr Bardsley-Smith has been the managing director of Thomson Environmental Services Limited ("TESL") since its incorporation in December 1993. He states that TESL has traded continuously as Thomson Environmental Services in the UK since that date. **Exhibit RBS2⁴** shows extracts from TESL's website – which, I note, is thomsonwater.co.uk - from various points

³ These submissions largely repeat the position set out in the statement of grounds.

⁴ This Exhibit RBS2 relates to the First Witness Statement Robert Bardsley-Smith, not to the exhibit of the same designation to the second of that witness's statement.

in time between 2010 and 2020, where TESL's services are promoted by reference to the following signs:



10. Mr Bardsley-Smith's Second Witness Statement, filed in reply, took no issue with the account given by Ms Thomson of businesses in which she has been centrally involved and which have featured the name Thomson (see my summary below). Rather the evidence in reply referred to a number of real-life instances where there appears to have been a degree of confusion between the two parties. I do not here mean by my use of the word "confusion" to imply any finding in a trade mark sense – suggesting responsibility for the source of goods or services – rather I mean it in the more ordinary sense of a mix-up or uncertainty resulting from the self-evident closeness of the parties' respective sign/mark. Mr Bardsley-Smith refers to TESL's accountant of twenty years being "*unable to locate TESL's company details, because the companies within the group identified as Thomson Environmental Consultants had the same address as TESL and very similar company names to TESL.*" He refers too to TESL receiving misplaced telephone calls and misdirected emails from existing or potential customers of the Proprietor or other companies within its Group as well as misdelivered parcels. These examples tend to indicate a mistake in the wrong direction for passing off – where TESL has been mistaken for the Proprietor (or another of its group), rather than vice versa. However, Mr Bardsley-Smith states at paragraph 8 of his Second Witness Statement that goods meant for TESL have been wrongly delivered to the Proprietor's registered address, including delivery of a new van. Moreover, the Witness Statement of **Heidi Kane** filed as part of the Proprietor's evidence explains that during the seven years or so of her time as receptionist at the Proprietor's group of companies Ms Kane too has encountered "a few minor examples" of comparable mix-ups and misdirected communications.
11. Turning now to the other evidence filed on the part of the Proprietor. Nancy Elizabeth Thomson is authorised to give her statement on behalf of the Proprietor. She gives an account of her qualifications and credentials in her field, including having been a fellow of the Institute of Directors and a staff member at the Environmental Science Research Unit (ESRU). Ms Thomson's statement gives evidence concerning the use, in connection with the provision of environmental services, of the word THOMSON by successive companies in which Ms Thomson has been centrally involved, dating from 1978 through to the Proprietor (and other companies in its group).
12. The points below give an account of those entities:
- i. Unincorporated entity started trading in 1978 as **THOMSON LABORATORIES**;

- ii. **THOMSON LABORATORIES LIMITED** incorporated in 1979,⁵ which, according to Ms Thomson, presented itself, among other things, as “consulting environmental scientists”;
- iii. Around 1992, MTS International Limited bought the above company. This is supported by **Exhibit NET2**, which is a copy of the minutes of a meeting of the Board of Directors of that company (held on 17 January 1992), concerning the acquisition by MTS International Limited of the “entire issued share capital of Thomson Laboratories Limited”. The same exhibit shows Ms Thomson as the majority shareholder of Thomson Laboratories Limited. It also shows a copy of the minutes of a meeting of the Board of Directors of Thomson Laboratories Limited (held on 17 January 1992, and chaired by Ms Thomson), where it was resolved that Thomson Laboratories Limited changed its name to **THOMSON MTS LIMITED**.



- v. In 1993 Thomson-MTS Limited was bought by the RPS Group. The RPS is a large, international multi-disciplinary consultancy, but when it bought Thomson-MTS Limited it chose to trade as **RPS THOMSON LTD**.

Ms Thomson’s evidence then continues as follows:

5 I note this differs from the year 1981 given in the counterstatement, but in any event it follows “soon after” the unincorporated entity, as Ms Thomson put it in her statement.

- vi. RPS Thomson Ltd was dissolved in July 2002;
 - vii. The Proprietor was incorporated in 2002, originally under the name NVT Environment Limited, but in 2003 changed its name to THOMSON ECOLOGY LIMITED (whose initials are **TEL** – a point I note only for ease of reference below).
 - viii. Ms Thomson started the Proprietor company and has been one of its directors since 4 July 2002. The Proprietor focuses on terrestrial and freshwater ecology.
 - ix. Ms Thomson is, as at the date of her witness statement, also director of a number of other companies (“**the Group**”).⁶ For ease of reference, I shall refer to the companies by the abbreviations Ms Thomson herself uses:
 - a. **Habitats** - i.e. THOMSON HABITATS LIMITED (02296072) – incorporated in 2007 – to assist with physical implementation of on-site ecological plans;
 - b. **Unicomarine** – i.e. THOMSON UNICOMARINE LIMITED (02296072) – acquired around 2010 and focusing on sea-bed flora and fauna;
 - c. **TEC** – i.e. THOMSON ENVIRONMENTAL CONSULTANTS LIMITED (12386733). **TEC** is an umbrella owns the Proprietor (**TEL**) and all companies in the Group.
 - d. **EOT** - i.e. THOMSON ENVIRONMENTAL CONSULTANTS EOT LIMITED (12532418). EOT is an employee-ownership trust company established to hold the shares on behalf of the employees who now own the Group companies. Both TEC and EOT were incorporated only in 2020 – so after the relevant date. Ms Thomson states that EOT is the “person with significant control” of all relevant Group companies.
13. Ms Thomson also refers to the Group’s broadening of its scope of services – from terrestrial and marine ecology to environmental impact assessments, data management, hydrology and hydrogeology, freshwater ecology and arboriculture. She refers too to its offices in five locations across England and Wales, employing approaching 165 staff, and an annual turnover of between £7 - 9 million in 2018 and 2019.
14. At paragraph 17 Ms Thomson states that the Group uses THOMSON ENVIRONMENTAL CONSULTANTS as its overall new brand and that that “rebranding” took place in 2018, to “preserve the continuity and goodwill derived from earlier environmental consultancy entities that used the Thomson name since 1978.” Ms Thomson highlights the use of her

⁶ Ms Thomson states her understanding that these constitute a group of companies as defined by section 1261(1) of the Companies Act 2006

personal surname as the distinctive component of the Contested Registration and the logic of its appearance as part of the corporate names.

DECISION

Applicable legislation

15. Section 47 of the Act provides that the registration of a trade mark may be declared invalid on the ground that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied. Section 5(4)(a) of the Act states that:

“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 or law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

[...]

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.”

16. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark ...”

17. The essential requirements that a claimant must establish to sustain a passing off claim are:⁷

- (a) a protectable goodwill in the UK owned by the claimant at the relevant date;
(b) a misrepresentation made by the defendant which is liable to deceive the public; and
(c) damage to the claimant’s goodwill caused by the misrepresentation.

18. The concept of goodwill has been described as “*the benefit and advantages of the good name, reputation and connection of a business*” and “*the attractive force which brings in custom*”.⁸

7 The “classical trinity” per Lord Oliver in *Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341 HL, the “Jif Lemon” case.

8 House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217

19. 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 which 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 of 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.”

20. I also note the following from *Kerly’s Law of Trade Marks and Trade Names*:⁹ “It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get-up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the claimant; but the property which is protected by an action for passing off is not the claimant’s proprietary right in the name or get-up which the defendant has misappropriated, but the goodwill and reputation of their business which is likely to be harmed by the defendant’s misrepresentation.”¹⁰
21. In assessing whether the facts of this case furnish the elements necessary for a passing off action to succeed, and particularly whether a misrepresentation arises, I turn my mind to aspects including the following:
- i. The strength of the Cancellation Applicant’s goodwill and the extent of its coverage;
 - ii. The similarity of the parties’ respective sign/mark;
 - iii. The distinctiveness of the three elements of the parties’ respective sign/mark;
 - iv. The difference between the respective services;
 - v. The parties’ respective fields of activity;
 - vi. The Proprietor’s ability to rely on prior use of its trade mark.
22. As a preliminary point, I note that since section 5(4)(a) involves establishing a notional case of passing off, the submissions filed on behalf of the Cancellation Applicant characterised the burden of proof “as therefore lower than would be the case in court proceedings”. The submissions filed on behalf of the Proprietor addressed this contention, stating that even if the Cancellation Applicant is not obliged to prove its case for passing off on the balance of probabilities in these proceedings (since the tribunal is not the forum in which the passing off case would be heard), the Cancellation Applicant must nevertheless show a prima facie case with evidence to demonstrate “at least a triable issue” and establishing to the satisfaction of the tribunal the presence of the classical trinity of elements required for passing off.

23. Mr Zweck's skeleton argument referred me, with his own emphasis added, to the often-cited observations of Floyd J (as he then was) in *Minimax v Chubb Fire*:

7. In *REEF Trade Mark* [2002] RPC 19, Pumfrey J (as he then was) said this in relation to assessing a passing off claim in these circumstances:

"27. There is one major problem in assessing a passing of 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 RPC 97 as qualified by *BALI Trade Mark* [1969] RPC 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."

8. Those 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."¹¹

¹¹ *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) at [7]-[8]:
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24. The Cancellation Applicant claims goodwill dating back to 1993. The evidence is that the TESL was incorporated in December 1993. Nothing is said of relevant activity before that date and no evidence is given as to the scale or pace of its initial business, so it is not possible to say how quickly it may have established a customer base and significant goodwill. It seems likely that the earliest TESL may have developed actionable goodwill would have been in the years after 1993. I accept that the Cancellation Applicant's evidence shows use of the sign invoked for the claim i.e. use of the sign "Thomson Environmental Services" and that that use is, at least broadly, shown to have been in respect of the claimed services. Noting the promotional expenditure and particularly the annual revenue levels from customers in England, and the provision of such services for well over twenty years, I find that TESL had, by the relevant date (the filing date of the Contested Registration) generated business goodwill in respect of those services, which are concerned principally with water hygiene. As to the *strength* of the goodwill and reputation, the promotional evidence is very modest and the annual revenue levels of over a million pounds in the recent years cited, while respectable, do not provide compelling evidence of an especially strong goodwill or high level of consumer recognition or reputation - certainly the goodwill is associated only with a particular field of activity, focussed on water hygiene.
25. It is self-evident, and Mr Zweck acknowledged the point, that there is a strong similarity between the Contested Mark and the sign relied on by the Cancellation Applicant. However, nor, clearly, are they identical – differing as between "services" and "consultants". Moreover, for services of the sort claimed, the words "environmental services" - i.e. the second and third element of the sign used by the Cancellation Applicant – are directly descriptive and entirely non-distinctive. The distinctive component is the word THOMSON. (This is not only inherently the case, but the evidence of the use of the sign also tends to give prominence to the presentation of that word.) In my view, the average consumer will perceive the word THOMSON as a surname that is fairly commonplace in the UK, which in my view tends prima facie to moderate its level of inherent distinctiveness, at least to a certain extent.¹²
26. I find firstly that the evidence in this case rules out any fraudulent intent on the part of the Proprietor, notwithstanding that a fraudulent intent is not a necessary part of the cause of

¹² I do not consider this observation to conflict with the ruling of the Court of Justice of the European Union ("the CJEU") in *Nichols plc v Registrar of Trade Marks*, Case C-404/02, at its paragraphs 22 – 31. I accept of course that a surname may be distinctive and may be made all the more so by use for particular goods or services.

action. I also note while there is no rule that a defendant in a passing off action must operate in the same field of activity as the claimant, the more remote the activities of the parties, the stronger the evidence needed to establish misrepresentation and the real likelihood of damage that are prerequisites of a right of action in passing off. The field of environmental services evidently has some breadth – dealing with different aspects such as marine and freshwater ecology as well as soil, air, stored water, gases, contaminants and so on. Services in the “environmental” field are innately specialised and selection of a service provider will likely involve considered engagement and a high degree of attention on the part of the average consumer, who, for trade mark purposes, is deemed reasonably well-informed and reasonably circumspect and observant.

27. The particular services in respect of which TESL has goodwill focus essentially on water hygiene and Legionella compliance. By contrast, the Proprietor’s services under the Contested Registration are *Acquisitions (Business -) consulting services; Administration of businesses*. The respective services, as the Cancellation Applicant acknowledged in its statement of grounds, are not obviously connected. In my view, and taking into account that terms used for registered trade mark services should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms,¹³ these services are entirely dissimilar. That both the Contested Mark and TESL’s sign indicate that both parties’ interests lie somewhere in the environmental field, does not change the inherent nature or purpose of the services themselves.
28. While I have noted the various instances of mistakes made in communications involving one or other of the parties, I do not consider such instances centrally relevant to the task before me of determining whether use of the Contested Registration would be actionable under the common law tort of passing off. There is an obvious similarity between the Contested Mark and the sign relied on by the Cancellation Applicant, and seemingly as a matter of happenstance in this instance the companies also have similar physical location addresses. Such mix-ups are therefore entirely understandable, but they do not elucidate the critical considerations of earlier actionable goodwill, misrepresentation and consequent damage to the business of the Cancellation Applicant.
29. I must assess whether the Contested Registration is likely to deceive a substantial number of the TESL’s customers or potential customers.¹⁴ Taking account of matters in

¹³ As confirmed by Lord Justice Arnold in *Sky v Skykick* [2020] EWHC 990 (Ch).
¹⁴ *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21

the round - including the difference between the marks, the non-distinctiveness of “environmental services”, the evidence too that the shared distinctive element “Thomson” appears for several decades to have been present in the names of various corporate entities in the broad environmental field, the limited evidence as to strength and reach of Cancellation Applicant’s goodwill, the rather niche and focused specialism of the TESL’s water hygiene interests, the degree of attention likely to be paid by the circumspect average consumer, and, above all, the distance of TESL’s services from the business-focussed services under the Contested Registration – I find that no misrepresentation arises. Since I find no misrepresentation, there is inevitably no consequent damage, neither in the form of diversion of trade nor otherwise. The section 5(4)(a) claim fails.

30. **OUTCOME:** The application to invalidate the Contested Registration fails and Trade Mark No. 3392729 remains registered for its services in Class 35.

31. That finding is the end of the matter, but it is perhaps worthwhile that I nonetheless comment on questions arising around antecedent use, which common law recognises may be significant in various ways. In *Advanced Perimeter Systems Ltd v Keycorp Ltd (Multisys Trade Mark)* [2012] RPC 14, Daniel Alexander QC (sitting as the Appointed Person) said:

“41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs Q.C. sitting as the Appointed Person in Croom’s Trade Mark Application [2005] R.P.C. 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user’s mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney co. Inc. v Penneys Ltd.* [1975] F.S.R. 367; *Cadbury-Schweppes Pty Ltd v The Pub Squash Co. Ltd* [1981] R.P.C. 429 (PC); *Barnsley Brewery*

Company Ltd v RBNB [1997] F.S.R. 462; Inter Lotto (UK) Ltd v Camelot Group plc [2003] EWCA Civ 1132, [2004] R.P.C. 9: “date of commencement of the conduct complained of.” If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

32. In *Casablanca* Trade Mark, BL O/349/16, Thomas Mitcheson QC, sitting as the Appointed Person, observed:

“35. I think it is clear from the remainder of §165 of the judgment of Kitchin LJ that generation of goodwill *by the applicant* is not required.¹⁵ This is because he goes on to explain that it is the opponent who must show that he had the necessary goodwill and reputation to render that use actionable *on the date that it* (i.e. the applicant’s use) began.

36. This is entirely consistent with the more lengthy discussion of the topic in the decision of Daniel Alexander QC in the *Multisys* case (*Advanced Perimeter Systems Ltd v Keycorp Ltd* [2012] R.P.C. 14). See the passage at §§35-45 which reviews many of the authorities which were cited to me, including the earlier Croom decision of Geoffrey Hobbs QC. It is correct that, as the Opponent pointed out, §49 of Croom refers to the build up of goodwill (rather than mere use) as justifying the designation of senior user, but it does not appear that the precise point in issue in *Multisys* or the present case was in issue there, and in any event I consider that I am bound by *Assos* and I would have followed the later *Multisys* case anyway.

37. Accordingly the relevance of the activities of the applicant is limited to establishment of the date that the actionable use began. Once that date is established, the only question of goodwill arises in respect of the opponent’s activities. As the Applicant in the present case pointed out, self-evidently it would only be in very exceptional circumstances that a party would have established goodwill at the point in time at which it commenced the use complained of. The establishment of goodwill would take much longer. But the authorities recognise that it is the date that the activity commenced which is the crucial one,

15 This refers to the judgment of Lord Kitchin in the Court of Appeal case *Roger Maier and Assos of Switzerland SA v. ASOS plc and AOS.com Limited* [2015] EWCA Civ 220

and so in my judgment it cannot be necessary for goodwill to have been accrued at that time.

38. That does not mean that it is irrelevant what happens after the first alleged date of commencement. Clearly if the activity ceased or changed materially between the date of commencement and the date of application for the trade mark then this must be taken into account, as it may mean that the true date of commencement of the activity complained of is later or that the activity complained of cannot properly be said to have properly commenced at all (if it was later abandoned). This is all a matter of fact and degree and is no doubt why Kitchin LJ expressed it as “*a matter which must be taken into account*” rather than as being determinative of the issue. However it does not mean that what is required is anything more than the commencement of the activity which is carried on in such a way as to fix the date of assessment. There is no greater requirement to prove goodwill on that date.”

33. At my paragraph 5(ii) above, I have noted the references in the counterstatement to “*a greater degree of goodwill*” claimed by the Proprietor (and its Group). As to that, a defence against a section 5(4)(a) claim does not require a proprietor to show that it has an earlier goodwill – it would be enough to be able to show relevant earlier use. In any event the relative *strength* of parties’ goodwill is not relevant. What is relevant is whether the evidence establishes that the Proprietor is in a position to rely on any actionable use made of the Contested Mark that predates the earlier right relied on by the Cancellation Applicant. In considering that prospect, I note the following:

- i. The Proprietor was incorporated in 2002, by which date the Cancellation Applicant had operated for nearly a decade.
- ii. It was only in 2003 that the Proprietor’s corporate name featured the word “Thomson” (when NVT Environment Limited changed its name to THOMSON ECOLOGY LIMITED). Other companies in the Group were incorporated later still.
- iii. Although Ms Thomson refers to the rebranding as THOMSON ENVIRONMENTAL CONSULTANTS in 2018, Mr Zweck states at paragraph 16 of his skeleton argument that the Proprietor accepts that it did not use that Contested Mark “THOMSON ENVIRONMENTAL CONSULTANTS” prior to the date of the application for registration (16 April 2019).

- iv. Ms Thomson's evidence gives an account of the development of the companies in which she has been involved and whose names have included "Thomson". One of those was Thomson-MTS Limited, which "team of consulting environmental scientists" until 1993 (pre-dating the incorporation of the Cancellation Applicant) traded by reference to the branding "THOMSON ENVIRONMENTAL" (**Exhibit NET3**). However, that use is not use by Proprietor (or companies in the Group).
 - v. In my view, certainly at the point that RPS Thomson Ltd was dissolved in July 2002, matters are not made clear. I note of course the direct coincidence in July 2002 between the ending of RPS Thomson Ltd and the incorporation of the Proprietor, but the evidence does not explain the connection between the businesses – for instance the position is not at all clear as to any transfer of ownership and whether or not goodwill may be inferred to have transferred from RPS Thomson Ltd to the Proprietor. That Ms Thomson is shown to have served as a director of both legal entities is insufficient. It seems to me that on the evidence as presented, it is possible that there may at this point been a disjuncture in the relevant business connections.
 - vi. Moreover, although the counterstatement claims goodwill for the Proprietor "*since 1993, in connection with THOMSON and THOMSON ENVIRONMENTAL CONSULTANTS*", the evidence is not entirely clear - subsequent to RPS THOMSON LTD - as to the form of trading names actually deployed by TEL (the Proprietor), Habitats and Unicomarine. Paragraph 12 of Ms Thomson's Witness Statement refers to the Proprietor's corporate name change in 2003, but stops short of expressly stating by what name it traded, which may simply be an oversight, but which contrasts with the references to trading names at earlier stages.
34. In the circumstances, even if the Proprietor may have generated its own subsequent goodwill of which the name Thomson is distinctive, the position is too opaque to conclude that the Proprietor is the beneficiary of *earlier* use of a relevant sign.

COSTS

35. The Proprietor is entitled to a contribution towards its costs of defending its registration, in line with the scale set out in Tribunal Practice Notice 2/2016. I have effectively found that the evidence as filed by the Proprietor was not sufficiently robust to establish an unbroken corporate chain back to any relevant earlier use of an offending sign predating

the goodwill claimed by the Cancellation Applicant. I accordingly moderate the sum awarded in respect of that evidence.

36. In the circumstances I award the Opponent the sum of **£1600**, which is calculated as follows:

Preparing a statement and considering the other side's statement: £250

Preparing evidence and considering / commenting on the other side's evidence: £600

Preparation for and attending hearing: £750

37. I order Thomson Environmental Services Limited to pay Thomson Ecology Limited the sum of £1600. The above sum should be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 11th day of November 2021

Matthew Williams

For the Registrar
