

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 1492834
BY DR KHURSHID AHMAD KHAN TO
REGISTER A MARK IN CLASS 41**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 44311 BY THE AMERICAN COLLEGE
IN LONDON LIMITED**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 1492834**
by Dr Khurshid Ahmad Khan to register a
mark in Class 41

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IN THE MATTER OF Opposition thereto
under No 44311 by The American College
in London Limited

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DECISION

20 On 3 March 1992 the late Dr Khurshid Ahmad Khan, of Redhill, Surrey, applied under
Section 17(1) of the Trade Marks Act 1938, to register the mark THE AMERICAN
UNIVERSITY, LONDON (AUL) in Class 41, in respect of:- “University education services”.
The application is numbered 1492834.

25 Later, on 3 March 1995 Dr Khan filed form TM15 giving notice to the Registrar, under
paragraph 11 of Schedule 3 to the Trade Marks Act 1994, of his claim to have the
registrability of the mark determined in accordance with the provisions of that Act.

30 On 11 March 1996 The American College in London Limited, of London EC4, filed notice of
Opposition to this application. The grounds of opposition are, in summary:-

- (i) the mark does not fulfil the requirements of Section 1(1) of the Act;
- (ii) registration of the mark is therefore prohibited by Section 3(1)(a);
- 35 (iii) the application for registration was made in bad faith and is therefore barred by
Section 3(6);
- (iv) the applicant has no bona fide intention of using the mark in relation to
40 University education services; application was therefore not made in
accordance with Section 32 of the Act;
- (v) under Section 5(4)(a), because use of the mark is liable to be prevented by
virtue of a rule of law protecting an unregistered trade mark.

The opponents ask the Registrar to refuse the application in the exercise of his judgement “and/or discretion”. They also ask for an award of costs.

5 I must mention at this point that refusal in opposition proceedings under the Trade Marks Act 1994 can only be by application of one or other of the substantive provisions of that Act; the Registrar has no discretion to refuse an application that otherwise meets the requirements of those provisions.

10 The opponents subsequently filed evidence in support of the opposition. The applicant filed a counterstatement denying these various grounds, but did not file any evidence. The matter came to be heard on 26 February 1998, when the opponents were represented by Mr Keith Havelock, of D Young & Co. Dr Khan was not represented at the hearing.

Opponents’ evidence

15 In support of their opposition the opponents filed a Statutory Declaration by Joseph H Houghton, of the American College in London Limited (the college), which is owned by the American College, of Peachtree Road NE, Atlanta, Georgia, USA. Mr Houghton states that the college is the proprietor and user in the United Kingdom of the trade mark THE AMERICAN COLLEGE IN LONDON, which is also the name under which the college does business.

25 Mr Houghton goes on to state that the college has used and done business under the trade mark THE AMERICAN COLLEGE IN LONDON in the United Kingdom since at least the year 1978.

30 Mr Houghton exhibits copies of the college’s newsletter *The American College Collegian* dated Winter 1995 and Summer 1996, both of which contain evidence of the use of the Trade Mark since 1978 says Mr Houghton, and he also exhibits copies of College’s prospectuses for 1982, 1991-1993, and 1995-1997.

35 Mr Houghton asserts that registration or use of the mark applied for is calculated to deceive and cause confusion and he exhibits a copy of each of two instances of confusion dated 13 September 1991 and 31 July 1991. These show confusion to have already arisen as a result of the use of the mark applied for, says Mr Houghton.

40 Mr Houghton asserts that the mark applied for was sought to be registered in bad faith and in respect of university education services without a bona fide intention that it should be so used. Mr Houghton goes on to assert that the applicant is not entitled to use or register a name or mark including the word UNIVERSITY.

45 He exhibits a copy of an extract of a company search in respect of the London College of Science & Technology trading as the American University, London, showing that it has applied voluntarily to be struck off, but that a third party has objected; he also exhibits a copy of The Times Law Report of a dismissal of the Appeal of the London College of Science and Technology Limited against their convictions, with details of the convictions.

Mr Houghton exhibits copies of correspondence between the Principal Trading Standards Officer of Islington Council, London N1 and the Trade Marks Registry, including a copy of a judgement in the case of London College of Science & Technology v London Borough of Islington, rejecting the Appeal of the London College of Science & Technology Limited against the prosecution for offences under the Business Names Act 1985. Mr Houghton draws particular attention to the Principal Trading Standard Officer's statement that in the circumstances and in view of the Court Decision, the Applicant "should not be able to trade mark the name American University, London".

As stated earlier, the applicant did not respond to this evidence, and I therefore turn to consider the grounds of opposition.

These are found in Sections 1(1), 3(1)(a), 3(6) and 5(4)(a). Objection is also made under Section 32. I will deal with the matter first under Section 5(4)(a). That section reads as follows:-

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

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

(b)

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

Guidance on the application of this provision in opposition cases before the Registrar is found in a recent decision (as yet unreported) by Mr Geoffrey Hobbs QC, sitting as the Appointed Person (Section 76(2) and Section 77 of the Act) in an appeal against the Registrar's decision in the WILD CHILD case (Opposition No 43414 to Application No 2013102). In the course of a very full statement of the law of passing off Mr Hobbs cited the following extract from Halsbury's Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165.

“The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

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

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

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

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The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House."

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

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"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:

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(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

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(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.

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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.

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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;

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(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;

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(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.

5 In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

10 With all this in mind I now turn to an assessment of the evidence filed by the opponent in these proceedings. That evidence shows that the opponents have run an educational establishment in London, under the name THE AMERICAN COLLEGE IN LONDON, since 1978. The reputation of an educational establishment, whether good or bad, is fairly rapidly acquired in the relevant market, I believe, and is, perhaps, a very significant part of its identity, so far as prospective students are concerned. My assessment under points (a) and (b) above, therefore, is that it seems quite reasonable to conclude that the opponents have a
15 substantial reputation in a field of activity identical with that in which the applicant operates or proposes to operate. Under point (c), I find that the names of these two establishments are confusingly similar; indeed, actual confusion appears to have taken place.

20 I do not have sufficient information before me to make a determination under points (d) and (e), but that does not prevent me from concluding, in the light of my considerations under points (a) (b) and (c), that deception and confusion are likely; and I further conclude that the opponents would most probably win a passing off action against the applicant. I therefore find that the opposition under Section 5(4)(a) is successful and the application is refused accordingly.

25 At the hearing Mr Havelock went on to make a skilful and concise case against the application under Section 3, but I do not feel it necessary to make a finding under that Section. I say this because in the course of these opposition proceedings it has emerged, by means of a letter from the Principal Trading Standards Officer, of Islington Council, that the
30 word “University” is controlled by the Business Names Act 1985. Anyone wishing to use the word must first receive approval from the Secretary of State. The American University of London’s application for such approval was refused, chiefly on the grounds that that educational establishment lacked independent accreditation.

35 These observations having been received, it would appear that whatever the outcome of these opposition proceedings, whether before the Registrar or on appeal, the Registrar would be bound eventually to refuse this application under the terms of Section 3(3)(b) and/or Section 3(4) of the Act, which read as follows:-

40 “(3) A trade mark shall not be registered if it is -

- (a)
- 45 (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.

5 Finally, I must address the issue of costs. The applicant is deceased, I am sorry to say. I therefore do not know what use, if any, the opponents can make of a costs order from this tribunal. However, the opposition having succeeded I believe they are entitled to the usual token award of costs. I therefore award them costs in the sum of **£750**.

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Dated this 18th day of March 1998

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M J TUCK
For the Registrar
the Comptroller-General