

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2199452
IN THE NAME OF PETER J GERBER OPTICIANS LTD
IN RESPECT OF THE TRADE MARK IN CLASSES 9
AND 42**

AND

**OPPOSITION No 50363 THERETO BY
PETER J GERBER ESQ**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2199452**
in the name of Peter J Gerber Opticians Ltd in
respect of the trade mark in Classes 9 and 42

and

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OPPOSITION No 50363 thereto by Peter J Gerber Esq

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BACKGROUND

On 8 June 1999, Peter J Gerber Opticians Ltd of Clacton on Sea applied to register the trade mark PETER J GERBER OPTICIANS LTD in respect of contact lenses in Class 9 and optical services; eye examination and consultancy in Class 42 under No 2199452. The trade mark was accepted and published for the purposes of opposition.

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On 29 October 1999, Peter J Gerber of Ipswich filed notice of opposition to the application for registration. The grounds of opposition are, in summary:-

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Under Section 3(6) of the Act - in that the application was made in bad faith because:

- (a) the opponent was a founding shareholder and Director of the applicant until March 1999 when he resigned and sold all of his interest;
- (b) the opponent has since established his own ophthalmic opticians;
- (c) the substantial goodwill he had built up as an optician means that the public and former patients who wish to have a consultation with him are confused as to which practice they should contact.

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Under Section 3(3)(b) - because the trade mark is of such a nature as to deceive the public.

The applicant filed a Statement of Grounds which states as follows:-

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1. The registration of the trade mark applied for would not be contrary to section 5 of the Trade Marks Act 1994 as alleged by the opponents.
2. The registration of the mark applied for would not interfere with the legitimate conduct of the opponent's business. The applicant has used the mark in the United Kingdom continuously since 1984.

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3. The applicant admits the existence of the registration and the application in paragraph 1 of the grounds of opposition but make no admission as to the validity of the or their relevance to the proceedings.

5 4. The applicant denies the statements made in paragraphs 3, 4, 5 of the grounds of opposition.

5. The applicant asks that the opposition be dismissed and an award of costs be granted to the applicants.

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I do not understand the reference to Section 5 of the Trade Marks Act, nor do I understand the applicant's admittance to the existence of the registration and the application mentioned in paragraph 1 of the Statement of Grounds of Opposition. There is no such reference in the Statement of Grounds of Opposition. However, overall I take the applicant's counterstatement to mean that they are denying all of the grounds of opposition set out by the opponent.

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Only the opponent filed evidence in these proceedings. Both sides were asked if they wished to be heard in this matter, neither side did so. On behalf of the Registrar and after careful consideration of the Statement of Grounds of Opposition, the Counterstatement and the evidence filed in these proceedings I give the decision below.

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Opponent's evidence

25 This consists of a Statutory Declaration by Mr Peter John Gerber of Ipswich. He states that he was involved in setting up the applicants, Peter J Gerber Opticians Ltd in 1984, and that the goodwill which has been established by that company was primarily due to his reputation. He believes that the public would like to use his services personally rather than merely the company which bears his name and that priority should be given to the public's right to have access to the professional services of their choice. This may be prevented if the trade mark in suit is granted to the applicants.

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He recounts the fact that during the last six months 20 of his patients have visited or telephoned the applicant's premises asking for him personally and that they were confused when told that he had stopped practising there.

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DECISION

The first ground of opposition is based upon Section 3(3)(b) which states:

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

(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).

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In order to succeed under this ground an opponent has to show that in relation to the goods or service covered by the application, the trade mark in suit is likely to give rise to potential for

deception of the public. But it must be something inherent within the trade mark itself which would give rise to an expectation of a particular kind or quality of goods or services, for example, it might indicate a particular quality of goods such as 'ARCTIC MAHOGANY' for windows. It is not a ground of objection which may be used to consider the position of the applicant's trade mark in relation to other earlier rights. In the circumstances, the ground of opposition based upon Section 3(3)(b) is dismissed.

The other ground of opposition is based on Section 3(6) of the Act which states as follows:

S.3-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

In GROMAX PLASTICULTURE LTD v DON & LOWE NONWOVENS LTD Mr Justice Lindsey at page 379 said:

"I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the Courts (which leads to the danger of the Courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances."

In the case before me the applicant for registration is a limited company which has been in being since 1984. That company was, it is claimed, founded by the opponent who had a one third shareholding in it until he resigned his Directorship and sold his shares in 1999. As far as I am aware, the company remains in being and continues to trade in the area of ophthalmic services.

The fact that the opponent resigned his position in the applicant company and sold his shares in it may not, of course, mean that he cannot provide services under his own name (see Section 11 of the Act). Equally, his departure from the applicant company does not mean that it is required either to change its name or to alter its trading activities in any way. At least I am given no information by either party which would indicate that there was any contractual obligation by either side which might suggest otherwise.

The fact that the applicant company has now decided to seek to register its name as a trade mark is, in my view, part of the trading activities which continue absent the opponent either as a Director or shareholder. Certainly there is nothing in the evidence before me which would suggest that the applicant company has undertaken any act which could be described as falling short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. That being so, the ground of opposition based upon Section 3(6) of the Act is dismissed.

The opponent has failed under both grounds of opposition and the applicant for registration is entitled to a contribution towards his costs. I therefore order the opponent to pay to the applicants the sum of £150. This sum to be paid within 7 days of the expiry of the appeal period or within 7 days of the final determination of this case if any appeal against this decision is unsuccessful.

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Dated this 18th day of October 2000

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M KNIGHT
For the Registrar
the Comptroller-General

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