

O-210-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3088010
BY
AARON ASSOCIATES (UK) LIMITED
TO REGISTER THE MARK**

AARON ASSOCIATES

**IN CLASS 35 AND 41
AND OPPOSITION 404562 THERETO BY
AARON & PARTNERS LLP**

Background and pleadings

1. Aaron Associates (UK) Limited (the Applicant) applied to register the trade mark **AARON ASSOCIATES** in the UK on 05/01/2015. It was accepted and published in the Trade Marks Journal on 20/03/2015 in respect of the following services:

Class 35

Accountancy services; Accountancy

Class 41

Courses and training relating to accountancy; education advisory services relating to accountancy

2. Aaron & Partners LLP (the Opponent) partially opposes the trade mark (in respect of its Class 35 services only) on the basis of Section 5(2)(a) and (b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Under section 5(4)(a) the Opponent relies on the use of the sign **Aaron** since 01/01/1970. Under the other grounds it relies on its earlier UK trade mark **Aaron** (UK 2443123) filed on 9 January 2007 and registered 28 December 2007.
3. In respect of section 5(2)(a) and (b) the following services are relied upon in this opposition:

Class 35

Preparation of reports relating to business; consultancy, advisory and information services relating to the aforementioned services.

Class 36

Preparation of reports relating to finance; consultancy, advisory and information services relating to trusteeship

Class 45

Legal services relating to insolvency, business rescue, debt recovery, wills trusts, probate, employment, company formation and registration, company and commercial matters; preparation of reports, provision of consultancy, information and advisory services relating to all the aforementioned services.

4. In respect of section 5(3) the above services are relied upon plus:

Class 16

Leaflets, brochures, manuals; educational and instructional materials, all relating to legal services.

Class 45

Legal services; notarial services; technical and legal research; dispute resolution; intellectual property and transport disputes.

5. Under section 5(4) the Opponent's pleadings indicate that the unregistered mark 'aaron' has been used for the following goods and services:

Insolvency advice and consultancy; taking of insolvency appointments; advice on capital taxes and income tax; advising on and filing of tax returns; advising on and filing of annual accounts; advice in relation to trusts and trust accounts; probate services; financial advice; corporate finance advice; advising in relation to capital taxes and income tax returns; preparation of reports relating to business; consultancy, advisory and information services relating to the aforementioned services

Preparation of reports relating to finance; consultancy, advisory and information services relating to trusteeship

Legal services; notarial services; technical and legal research; legal services relating to insolvency, business rescue, debt recovery, wills trusts and probate, employment, company formation and registration, company and commercial matters; preparation of reports, provision of consultancy, information and advisory services relating to all the aforementioned services

Leaflets, brochures, manuals; educational and instructional materials, all relating to legal services

6. As the earlier mark was registered more than five years before the date of the Application, it is subject to the proof of use provisions in Section 6A of the Act.
7. The Applicant filed a counterstatement denying the claims made and putting the Opponent to proof of use, reputation and goodwill.
8. Both sides filed evidence in the form of witness statements, one for the Opponent and eleven for the Applicant. These are summarised below. Neither side filed further written submissions and no hearing was requested. This decision is taken on the basis of the papers before me.

Evidence

For the Opponent

9. The Opponent produces a witness statement from David Simon Matthew Edwards (hereafter referred to as Mr Edwards), Partner in the Opponent, having been with the firm since 1985. This witness statement is a mixture of evidence and submissions, in which Mr Edwards states:
 - a. The firm was founded in 1967 by Julian Aaron, at which time it was known as Aaron & Partners, trading as such between 1970 and 2004 when the business became an LLP, trading as such to the present.
 - b. During its years of operation it has provided all of the services for which it is registered, as well as providing “tax planning services”, “insolvency services”, “business advice”. Mr Edwards also states that the Opponent has “prepared tax returns for its clients continuously for the last 32 years”.
 - c. The Opponent has a qualified accountant as a member of the LLP.

7. In addition to the trade mark relied upon, the Opponent is proprietor of a number of other trade marks, however these are not set out in the statement of case, nor has there been an application to amend. Consequently these marks may not be relied upon.
8. Mr Edwards further makes the following points in relation to the marks and the services:

The Services

- a. Legal services and accountancy services are closely interlinked. Alternate Business Structures are now available facilitating accountants, solicitors and other professionals to form partnerships together.

The Marks

- b. Word of mouth and online considerations may lead to consumers in receipt of recommendations for the Opponent's services being misdirected to the Applicant.
 - c. The Opponent is not geographically restricted, having offices in Manchester and Shrewsbury, which may lead consumers to believe a similarly named organisation in Croydon was the same company or a linked economic undertaking.
9. The Applicant's use of the mark is said by the Opponent to "clearly" infringe the Opponent's earlier mark. Accordingly it is said by the Opponent that the Applicant can have no legitimate intention to use the mark it has applied for, and that the application should be refused on this basis. However this is not a pertinent argument. If the Opponent is unsuccessful in these proceedings and the Applicant's mark proceeds to registration, it cannot be said to be clear that the Applicant's mark would infringe any rights of the Opponent.

For the applicant

10. The Applicant's evidence comprises 11 witness statements from a range of clients, consultants and company directors, which I have numbered App1 - 11 below:

App1	Mirza Hussain. Director of the Applicant
App2	Sheikh Sayed Ali Abbas Razawi. Director of the Applicant
App3	Alexander Philips, Solicitor. Referee of the Applicant
App4	Toufak Ahangari, Company Director. Client of the Applicant
App5	David A O'Flaherty, individual. Client of the Applicant
App6	Hamid Hamidi, taxi driver. Client of the Applicant
App7	Richard J. Gilder, prison officer. Client of the Applicant
App8	Attila Farago, Company Director. Client of the Applicant
App9	Sevil Pretara, Company Director. Client of the Applicant
App10	Uchenna Okam, Company Director. Client of the Applicant
App11	Hasan Mirza, Accountant. Consultant to the Applicant

11. These statements carry very little evidential weight, being little more than near-facsimile assertions that the named individual would not be confused between a firm of lawyers and a firm of accountants bearing the same or a similar name. The assessments that must be undertaken under sections 5(2) and 5(3) are from the viewpoint of the average consumer. The statements above are not a sufficiently wide or impartial grouping to be said to represent the average consumer, nor do they establish that a substantial number of people would not be deceived, as is the relevant test under section 5(4).
12. The following points of substance arise in App1 by Mirza Hussain, Director of the Applicant:
 - a. The Applicant was incorporated on 10/02/2004, having taken over from his father's sole trader business, which traded under the name Aaron Associates.
 - b. Mr Hussain's father's name was Mirza Hamid Hussain, and Mr Hussain believes that his father chose the name 'Aaron' for its particular alphabetical properties and the commercial advantages therein. 'Associates' was selected as a common word used in business names.
 - c. Finally he notes that the Applicant does not employ lawyers or offer legal services.

Proof of use

12. The proof of use requirements are found in Section 6A of the Act:

6A(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

13. Section 100 of the Act is also relevant, stating that:

100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

14. The Opponent has filed no evidence of the sort usually used to prove use of a mark, but has merely stated that the mark has been used. The Opponent may have filed screenshots of the company website, published company literature, reports of cases in which the firm acted, accounts, client numbers, turnover, promotional expenditure, or other evidence of this ilk, but it did not. In *Awareness Limited v Plymouth City Council*, Case BL O/230/13, Mr Daniel Alexander Q.C. as the Appointed Person stated as follows (emphasis added):

22. The burden lies on the registered proprietor to prove use [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but **if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid.** That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. **A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive.** By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.

15. The Opponent's best case under Sections 5(2) and 5(3) may be said to lie in its services in section 45, 'Legal services relating to insolvency', as these are its services of closest similarity to the Applicant's 'Accountancy'. Its best case under 5(4) lies in its claim to have goodwill in respect of 'preparation and filing of annual accounts'.
16. I have only the Opponent's witness statement to consider. I begin by noting that its veracity is not challenged, although this does not mean that bare assertions should be accepted. The witness statement notes the length of time for which the Opponent has traded under the name Aaron & Partners, and gives an indication of the Opponent's geographical spread (Manchester and Shrewsbury). It also lists the services for which it is said to have been used: a) "all the services for which the various trade marks of the firm are registered", b) tax planning services, c) insolvency services, d) business advice, e) the preparation of tax returns. In relation to a, it has already been stated that only the mark pleaded may be relied upon and consequently only the services listed in paragraphs 3 and 4 are relevant.
17. However, there is a great deal that the witness statement does not show. In relation to d), as a term this is unspecific and unquantified. In relation to b), c) and e), these are also unquantified assertions, unsupported by evidence of the scale of use, the extent of use of the mark or of promotion of the business. For example, a statement that the firm has prepared tax returns for clients continuously for 32 years does not go far enough – how many clients, is this promoted as a service to the general public or offered only to a select few? What proportion of the Opponent's turnover relies on these services? I am unable to say.
18. Further, the witness statement does not show the actual mark used in the course of trade, which would have a bearing on the outcome and without which I am unable to say whether the use of the mark counts as genuine use for the purposes of the Act.
19. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and

purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.

20. I am further assisted by the words of Mr Justice Kitchin in *Almighty Marketing Limited v Milk Link Limited* [2005] EWHC 2584 (Ch) in which he said of the burden of proof (albeit in an invalidity action), that it was:

16. [...] not therefore satisfied by a proprietor who simply asserts, through a relevant witness, that the trade mark has been used. Such a bare assertion would provide no evidence as to the actual use made by the proprietor. The evidence must provide a sufficient explanation of how the mark has been used for the tribunal to conclude that the proprietor has an arguable defence to the application.

21. I am not provided with proper reasons for non-use – it is clear that the Opponent's case is that the mark has been used, but in the absence of any other evidence I am forced to conclude that Opponent's Witness Statement does not 'show' use, and is simply insufficiently solid to prove use of the mark, particularly in circumstances where proof of use has been specifically requested.

22. This finding is fatal for the Opponent's case under Sections 5(2) and 5(3). Further, in the absence of more evidence than is given in this Witness Statement, I can make no finding as to the Opponent's goodwill under the sign 'Aaron'. Whilst it is likely that the firm would have acquired some goodwill after trading for so many years, assertions of use in relation to vague terms such as 'business advice' and unquantified claims relating to tax planning and insolvency services are simply not enough to establish that the firm's goodwill extends to these services.

23. Accordingly, the Opponent's case must be dismissed in its entirety.

Conclusion

24. The Opposition has failed in its entirety. The application may proceed to registration.

COSTS

25. The applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the applicant the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Preparing evidence and considering the other side's evidence:	£500
Total:	£700

26. I therefore order Aaron & Partners LLP to pay Aaron Associates (UK) Limited the sum of £700. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25th day of April 2016

**Andrew Wall
For the Registrar**