

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION **m** 2055655
BY ASK TRAINING LTD
TO REGISTER THE TRADE MARK **ASK**

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION **m** 46811 BY
ATTITUDES SKILLS & KNOWLEDGE LTD

TRADE MARKS ACT 1994

IN THE MATTER of trade mark
application **m** 2055655 by
ASK Training Ltd

5 and

IN THE MATTER OF opposition
thereto under opposition **m** 46811
by Attitudes Skills & Knowledge Ltd

DECISION

10 ASK Training Ltd applied on 6 February 1996 to register the trade mark ASK in class 41.
Following examination, the application was advertised for opposition purposes in respect of
the following services:

“Training services relating to the rail industry; training in respect of engineering, safety,
signalling and/or telecommunications.”

15 The application is opposed by Attitudes Skills & Knowledge Ltd. I summarise the grounds of
opposition as follows:

20 **Ž** Section 3(1) - The opponent claims that registration of the mark ASK would be
contrary to Section 3(1) of the Act, in that the mark is devoid of any distinctive
character and/or that it consists exclusively of signs or indications which may
serve, in trade, to designate the kind or other characteristics of the services,
and/or that it consists exclusively of signs or indications which have become
customary in the current language or in the bona fide and established practices
of the trade.

25 **Ž** Section 3(6) - Registration of the mark ASK is contrary to section 3(6) of the
Act, in that the application was made in bad faith.

Ž Section 5(4)(a) - Registration of the mark ASK is contrary to Section 5(4) of
the Act, in that its use in the United Kingdom is liable to be prevented by virtue
of any rule of law protecting an unregistered trade mark or other sign used in
the course of trade.

30 The opponent also asks the Registrar to refuse application **m** 2055655 in the exercise of his
discretion. However, under the Trade Marks Act 1994 the Registrar does not have discretion
to refuse an application as he did under the old law. An application can only be refused if it
fails to comply with the requirements of the Act and Rules in one or more respects.

On 14 August 1997, in response to the notice of opposition, the applicant filed a counter-statement denying each of the grounds pleaded.

Both parties ask for an award of costs in their favour.

5 The opponent filed evidence in support of the opposition in the usual way, but on 12 November 1997, the agents who had been acting for the applicant wrote to the Registrar as follows:

As we have been unable to make any contact with the Applicants for some considerable time, and have therefore been without instructions over the same period of time, we believe we have no option but to request that we be formally withdrawn as the Agent and address for service in connection with Trade Mark Application No. 2055655 and the related opposition No. 46811.

Staff in the Registry wrote directly to the applicant in December 1997 inviting them to file evidence in support of the application, and again in April 1998 advising the applicant of their right to request a hearing. The applicant has not replied to either letter.

10 The opponent has agreed to seek the Registrar's decision on the basis of the papers filed in these proceedings, and without recourse to a hearing. Acting on the Registrar's behalf and after a careful study of all the papers, I now give this decision.

The Evidence

15 Only the opponent filed evidence in these proceedings; a statutory declaration by Robert Terry dated 7 November 1997. Mr Terry is the Group Managing Director of ASK Europe plc, a position he has held since November 1994. The opponent, Attitudes Skills & Knowledge Ltd is a subsidiary of ASK Europe plc. Other subsidiary companies of Ask Europe plc are ASK Multimedia Limited, ASK Delta Limited and Graphical User Interface Design and Evaluation Limited. Ask Europe plc and its subsidiary companies are collectively
20 known as the ASK group of companies.

Mt Terry says that the term "ASK" is an acronym for the words "Attitudes", "Skills" and "Knowledge". He says further that these words and the ASK acronym are in everyday usage within the training industry. At RT1, Mr Terry exhibits a collection of extracts from various standard training text books that demonstrate the common usage of the words "Attitudes",
25 "Skills" and "Knowledge". He also exhibits an extract from a publication called "Performance Management", which demonstrates usage of the acronym ASK. Exhibit RT3 is a printout of a Web page from the Internet relating to the training services provided by an American company, ASK International, which demonstrates usage of the acronym ASK and the relationship between that acronym and the words "Attitudes", "Skills" and "Knowledge".
30 Mr Terry confirms that ASK International is not related to Ask Europe plc.

Turning to his own company's use of the mark ASK, Mr Terry says that the trade mark ASK was first used in the United Kingdom by Attitudes Skills & Knowledge Limited and other companies within the ASK group in respect of training services in 1994.

5 The turnover figures for training services rendered by the ASK group in relation to the ASK trade mark are stated as follows:

1994/5	£ 977, 801
1995/6	£ 1, 395, 501
1996/7	£ 2, 399, 114

10 Mr Terry declares that the ASK trade mark has been used in relation to training services throughout the United Kingdom, as well as in Europe, Africa and North America, and that the following sums have been spent in promoting the ASK trade mark by means including promotional leaflets and brochures:

1994/5	£ 6, 470
1995/6	£ 31, 748
15 1996/7	£ 20, 164

That concludes my review of the evidence, and I turn to consider the respective grounds upon which this opposition has been brought.

Section 3(1)

20 From the wording used to particularise the opponent's case under section 3(1), it is clear that the opposition is based on subsections b, c & d. This part of the Act reads:

“3.-(1) The following shall not be registered

(a)

(b) trade marks which are devoid of any distinctive character,

25 (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

30 (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

35 I do not propose to consider the merits of the opposition under each subparagraph of section 3(1) separately. In the evidence filed, the opponent has presented a single case which broadly covers all three categories of absolute grounds. Mr Terry says that the term “ASK” is an acronym for the words “Attitudes”, “Skills” and “Knowledge”, and that these words and the ASK acronym are in everyday usage within the training industry. The applicant has not

challenged Mr Terry's evidence, either directly in cross-examination or by filing evidence to rebut Mr Terry's declaration. The Registrar's published practice in relation to three letter marks is that they "should be accepted in the prima facie case unless they are objectionable as descriptive words, acronyms, etc."

5 When this application was accepted following examination, I am certain that the Registrar was unaware that the term ASK was in everyday usage within the training industry as an acronym for the words "Attitudes", "Skills" and "Knowledge". I am equally confident that if the Registrar had known this, then, in accordance with his published practice, the application would have been refused, subject to the proviso at the end of section 3(1).

10 As I have already indicated, the applicant has not filed any evidence in support of the application, and there is therefore no evidence of use of the mark by the applicant which I can consider in connection with the proviso to section 3(1). I therefore find that the opposition under section 3(1) succeeds.

15 Strictly speaking, I do not need to consider the remaining grounds of opposition since the opposition has succeeded and application must be refused. Nevertheless, I offer the following brief comments in the event that my decision in relation to section 3 is overturned on appeal.

Section 3(6) - Bad faith

This section of the Act reads:

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

In my opinion this ground of opposition has not been supported in evidence, and thus I cannot conclude that the application was made in bad faith. The opposition under section 3(6) fails accordingly.

Section 5(4)

25 Section 5(4) 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

30 (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.

The notice of opposition does not indicate in what way the application should be considered contrary to section 5(4); moreover, it does not even specify whether the opposition is based upon paragraph (a) or paragraph (b) of section 5(4). In the *WILD CHILD* case¹, Mr Geoffrey Hobbs QC (sitting as the appointed person) considered a similar situation. At lines 4 to 20 of page 459 he said:

The Scope of the Opposition

In the interests of justice and fairness it is plainly necessary for an objection to registration under section 5(4) to be framed in terms which: (i) specify whether the objection is raised under subsection (4)(a) or subsection (4)(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “*earlier right*” entitled to recognition and protection under the relevant subsection; and (iii) state whether the objection is raised in relation to all or only some (and, if so, which) of the goods or services specified in the registration or application for registration of the relevant trade mark. If an objector fails to provide sufficient information as to the nature or extent of his objection the registrar “*may direct that such ... information ... as he may reasonably require shall be filed within such period as he may specify*” under rule 51 of the Trade Marks Rules 1994. The direction may doubtless be given by the registrar of his own motion or upon the application of a party to the proceedings before him.

In the *WILD CHILD* case, the hearing officer took the view that the opponent was claiming protection for an unregistered trade mark or sign under section 5(4)(a) and that the asserted “*earlier right*” was a right by virtue of the law of passing off. Having regard to Mr Hobbs’ comments (above) concerning the interests of justice and fairness, I decline to take a similar view in these proceedings; not least because the evidence filed by the opponent in support of the notice of opposition does not give any firm indication as to how the objection to registration under section 5(4) is being pursued. The opposition under section 5(4) fails accordingly.

Costs

The opponent, having been successful in these proceedings, is entitled to a contribution towards the costs of mounting the opposition. I therefore order the applicant to pay to the opponent the sum of **£535**.

Dated this 24th day of November 1998

**Mr S J Probert
Principal Hearing Officer
For the Registrar, the Comptroller-General**

¹WILD CHILD Trade Mark [1998] RPC 455