



BARKERBRETTELL

PATENTS TRADE MARKS COPYRIGHT DESIGNS

COMPANY NAMES TRIBUNAL – AN UPDATE

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Since 1 October 2008, the UK Intellectual Property Office has been operating a Company Names Tribunal which passes judgement as to whether a company name has been registered for opportunistic purposes.

An application can be filed to object to a company's registered name if one of the following grounds applies:

- the company name is the same as a name associated with the applicant, in relation to which the applicant has goodwill, or
- the company name is sufficiently similar to such a name, that its use in the UK would be likely to mislead by suggesting a connection between the company and the applicant

It is only possible to use the Company Name Tribunal when the applicant wishes to file a complaint about a company name which is opportunistic. Hence, an application which is filed because the applicant is aggrieved that someone has a company name that is too similar to its registered trade mark is unlikely to succeed unless it can show that the purpose of registering that particular company name was to extract money or to prevent the applicant from registering the name itself.

The process provides a more cost and time effective alternative to court action because of the straightforward requirements for an application. The application fee is currently £400. An applicant does not need to own a registered trade mark, show that the objectionable name is being used in relation to goods or services, show damage or a likelihood of damage; show that its name and the offending name are identical, or have its name registered as company name.

There are, however, a number of defences which are available following the filing of an application before the Company Names Tribunal. These are:

- a) the name was registered before the start of the activities on which the applicant relies to show it has goodwill/reputation
- b) the company is operating under the name, or is planning to do so, and has incurred substantial start-up costs, or has operated under the name but is now dormant
- c) the name was registered in the ordinary course of a company formation business and the company name is available for the sale to the applicant on the standard terms of that business (an "off the shelf" company)
- d) the name was adopted in good faith
- e) the interests of the applicant are not adversely affected to any significant extent.

If the holder of the company name does not defend its company name registration within the time limit allowed by the Company Names Tribunal, there will be an automatic order made for the company to change its company name registration to something which does not offend the applicant's rights.

If the holder of the company name does defend its registration, then the Company Names Tribunal will set timescales for each side to file evidence in support of its case. If the applicant does not file any evidence to support its case, the Company Names Tribunal may dismiss the application. If the applicant files evidence demonstrating its goodwill/reputation in the particular name in question at the time the company name was registered (or the registration holder admits as much) and the registration holder fails to file any evidence in defence of its

registration of the company name, the Company Names Tribunal will order a change of name, as described above.

If the registration holder fails to change the name by the date specified, the Company Names Tribunal may determine a new name for the company and order the Registrar of Companies to make the change without the holder's consent.

When considering the first twenty five cases considered by the Company Names Tribunal, two were withdrawn, one was struck out and twenty two resulted in findings for the applicant or brand owner. However, it should be noted that only two of the applications actually resulted in substantive decisions and all but one of the remaining applications was unopposed.

The two applications resulting in substantive decisions relate to (1) Unilift South Wales Ltd where the objecting party was Barloworld Handling Limited which owns the company name Unilift Ltd, and (2) Credo Financial Solutions Ltd, which was the subject of an objection by Credo Group (UK) Ltd. From these cases, it is clear that the Company Names Tribunal is not an alternative to passing off.

The following general points have emerged from the case law:

- Evidence of confusion carries no weight
- Ownership of a trade mark will not be determinative or contribute to an argument as to goodwill or reputation
- It should not be assumed that a potentially wider interpretation of goodwill/reputation by the Company Names Tribunal means that substantive evidence need not be filed. A witness statement, affidavit or statutory declaration should be filed, detailing the basis for the claim to goodwill or reputation along with all supporting documentation
- If a company name holder has a defence under one of the circumstances a), b) or c) set out above, then the applicant must show that the registration is opportunistic or obstructive for it to succeed in its application.

Therefore whilst the Company Names Tribunal is a useful addition to the options available for companies, it is not a quick and easy alternative to a passing off or trade mark infringement action, and a successful result for a brand owner is certainly not guaranteed.