

O-259-04

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2114596
IN THE NAME OF CHARLES ROBERT MAXWELL**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81264
THERE TO BY ANDREW JOHN PRESTON**

IN THE MATTER OF trade mark registration No. 2114596
in the name of Charles Robert Maxwell

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 81264 thereto by Andrew John Preston

BACKGROUND



1. The trade mark was filed on 1 November 1996 and has been registered since 10 October 1997 under number 2114596. It stands in the name of Charles Robert Maxwell and is registered in respect of:

Class 42: Provision of hot and cold food; provision of alcoholic and soft drinks.

2. On 25 April 2003, Andrew John Preston filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action as sections 47(2)(b) and 5(4)(b) of the Act.

3. In the statement of case the applicant asserted that the similarities between registration 2114596 and his logo, as applied for under trade mark application number 2299730, are not coincidental; that the registered proprietor of 2114596 consciously copied the applicant's logo as his premises are in the same London street.

4. On 22 May 2003 a copy of the application for invalidation and the statement of grounds were sent to the address for the registered proprietor recorded on the register. The documents were sent by recorded delivery but returned by Royal Mail marked "addressee has gone away". The forms were then resent by normal mail to the same address. The registered proprietor did not file a counter-statement to defend his registration. The consequences of failure to defend the registration were set out in the letter dated 22 May 2003, namely that the application for declaration of invalidity could be granted in whole or in part.

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to make the case that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

8. With this in mind, on 31 July 2003, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

9. On 11 September 2003 the applicant for the declaration of invalidity provided a witness statement, with additional submissions, to support the case the applicant alleged against the proprietor of the trade mark in suit.

10. The witness statement was made by Andrew John Preston, the applicant for invalidity, dated 6 August 2003. In the statement he says that he is the applicant for trade mark registration 2299730, a series of three which includes his logo; that this logo has been used as a sign outside his premises from January 1995; after his “12 Bar Club” had commenced operation Charles Robert Maxwell opened a bar in Denmark Street opposite his premises; that the sign used by Mr Maxwell for his bar was the same as that of the trade mark in suit; that the similarity in the signs was an effort to suggest a link between the two enterprises and that the design of the sign used by Mr Maxwell was derived from that originally used by the applicant; when the applicant came to register his own trade mark he found that Mr Maxwell had already registered his similar sign; He alleges that Mr Maxwell has ceased to do business and has since disappeared. The applicant believes that Mr Maxwell acted improperly in copying parts of the applicant’s sign.

11. The agent for the applicant, Gallafent & Co, provided submissions and first they refer to a document they claim to have received, with the address of the registered proprietor and a hand written statement: “This person is using this address illegally. They are neither resident here or occupying business premises here. Mail is received regularly so the address is probably being wrongly used deliberately.”; they stated that as the address

on record is no longer valid, with no forwarding arrangements, the proprietor of the trade mark has lost interest in defending this action and it should succeed; that the similarity of the signs, along with the opportunity and motive suggested in the applicant's witness statement, are sufficient to move the burden of proof to the proprietor, who has failed to file a defence in these proceedings; they also indicated that they were content to have a decision from the papers filed.

12. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

DECISION

13. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of section 5(4)(b). The relevant parts of the Act are as follows:

“47. - (1)

(2) The registration of a trade mark may be declared invalid on the ground-

(a) , or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(3)

(4)

(5)

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

“5. - (1)

(2)

(3)

(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) , or

(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.”

14. The outcome of this invalidation action, if successful, would have the effect that the registration will be deemed never to have been made (Section 47(6)). In other words it will take matters back to the filing date of the registration (1 November 1996). I must, therefore, consider the position as at that date. Although neither Section 5(4)(b) nor Article 4.4(c) of the Directive, First Council Directive 89/104 of 21 December 1988, to approximate the laws of the Member States relating to trade marks (on which the domestic law is based), make reference to dates, I believe it is right to proceed by analogy with the dates that would apply for Section 5(4)(a) (passing-off etc) purposes. In that respect the Directive does make it clear in Article 4.4(b) that the rights, in this instance copyright, must have been acquired prior to the date of application for registration of the trade mark in suit.

15. With regard to section 5(4)(b) of the Act, in relation to copyright a number of factors have to be considered, section 153 of the Copyright, Design and Patents Act 1988 sets out certain qualification requirements relating to the author of the work (section 154), or the country of first publication (section 155) which must be satisfied before any copyright can subsist. Under section 154(1)(a) the applicant, as a British citizen, is a qualifying person and under section 155(1)(a) the logo qualifies for copyright protection as it was first published in the United Kingdom.

16. It is asserted in the witness statement that the copyright to the artistic work, the logo, originated in January 1995, being used as a sign to denote a business and has been used as such since that date. There is no explicit statement as to how the logo was devised, by whom and at what date, it must therefore be assumed that the rights belong to the applicant as it forms part of his trade mark application number 2299730.

17. Having determined that there is an earlier right, in this case, copyright, the question is whether the applicant’s use of the trade mark would be an infringement of that copyright. The correct approach to the determination of copyright infringement is well established and was set out recently in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] FSR 113 at 124 where Lord Hope of Craighead stated:

“The first step in an action for infringement of artistic copyright is to identify those features of the defendant’s design which the plaintiff alleges have been copied from the copyright work. The court undertakes a visual comparison of the two designs, noting the similarities and the differences. The purpose of the

examination is not to see whether the overall appearance of the two designs is similar, but to judge whether the particular similarities relied upon are sufficiently close, numerous or extensive to be more likely the result of copying than of coincidence. It is at this stage that similarities may be disregarded because they are commonplace, unoriginal, or consist of general ideas. If the plaintiff demonstrates sufficient similarity, not in the works as a whole but in the features which he alleges have been copied, and establishes that the defendant had prior access to the copyright work, the burden passes to the defendant to satisfy the judge that, despite the similarities, they did not result from copying."

18. First of all, I must consider the registration against the applicant's logo and, below, the images are shown side by side.

trade mark registration No. 2114596



Applicants logo



In comparing the two I note that there is little similarity in the words in the two signs, the only common word being "BAR" which appears in the bottom of the registration and in the upper part of the applicant's mark. However, in the figurative elements, that is the outer circular line, the central dark circle, the vertical bar at the left and the six horizontal lines crossing from the vertical bar across the central circle to the right outer edge of the outer circular line the signs are identical. This arrangement of figurative elements brings to mind the concept of a stringed musical instrument, a guitar. In a guitar, as in all string instruments, the front face of the instrument is the soundboard. In the soundboard is a large hole called the sound hole, this hole is normally round but F-shaped pairs of holes, as in a violin, are sometimes seen. Attached to the soundboard is a piece called the bridge, which acts as the anchor for one end of the six strings. The bridge has a thin, hard piece embedded in it called the saddle, which is the part that the strings rest against. Thus the central dark circle is the sound hole, the left hand vertical bar the bridge or saddle and the six horizontal lines the strings.

19. The facts set out in the witness statement, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case has been made out that, at the date of the application for registration by Charles Robert Maxwell of the trade mark in suit, Andrew John Preston had a copyright which was protectable under the

relevant United Kingdom statute. The application for a declaration of invalidity made under section 47(2)(b) based upon section 5(4)(b) of the Act therefore succeeds.

20. As to costs, the applicant has been successful, and I order Charles Robert Maxwell to pay them £500. This sum is to be paid within seven days the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of August 2004

**Graham Attfield
For the Registrar
the Comptroller-General**