

O-072-10

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION No. 2333823  
STANDING IN THE NAME OF SALLY BISHOP**

**AND**

**IN THE MATTER OF A REQUEST FOR A DECLARATION  
OF INVALIDITY THERETO UNDER NO. 83372  
BY THE NED HERRMANN GROUP, INC**

## BACKGROUND

1. On 3 June 2003, Sally Bishop applied to register the following trade mark:



2. The application was examined, amended, and then accepted and published for opposition purposes on 15 August 2003 in Trade Marks Journal No. 6493 for the following services in classes 35 and 41:

**Class 35** – Psychological testing for the selection of personnel; consultancy services relating to the aforesaid.

**Class 41** - Training and consultancy services relating thereto.

As no opposition to the application was received, the registration procedure was completed on 28 November 2003.

3. On 6 November 2008, The Ned Herrmann Group, Inc (Herrmann) applied for a declaration of invalidity under sections 3(6) and 5(4)(b) of the Trade Marks Act 1994 (the Act). They frame their attack in the following terms:

### **Under section 3(6)**

“because the then applicant was well aware that the mark was owned by the predecessor in title to the applicant for revocation, having been certified by them in 1988, and applied for registration in her own name, without any authorisation from the owner of the mark, shortly after resigning as a certified practitioner.”

### **Under section 5(4)(b)**

“The mark consists exclusively of a geometrical design. This design was originated by Laura Herrmann in 1986. At the time of its origination, Laura Herrmann was an employee of a predecessor in title of the applicant for revocation. The copyright in the design is an earlier right, and the use of the mark in the United Kingdom is accordingly liable to be prevented by virtue of that earlier right. Neither the original proprietor of the earlier right nor any successor in title has consented to the registration of the mark.”

4. On 27 January 2009, Ms Bishop filed a counterstatement which was subsequently amended on 11 February 2009. Her first counterstatement indicated (by reference to a letter dated 31

December 2008 from Gallafents LLP, Herrmann's professional representatives in these proceedings), that the parties were in negotiations to settle the matter, and a stay of proceedings for two months was sought for negotiations to continue.

5. In her amended counterstatement Ms Bishop said:

"This trade mark was registered because I had signed authority to use this logo whether or not it was copyrighted. It was the refusal of The Ned Herrmann Group to protect it which led me to do so. I had repeatedly said it should be done for the protection of all who had gained the right to use it. I have never claimed an exclusive right to use it. I have never suggested the Ned Herrmann Group may not use it."

6. Only Herrmann filed evidence in these proceedings. While neither party asked to be heard, both parties filed written submissions in lieu of a hearing; I will refer to these as appropriate later in this decision. However, before I summarise the evidence filed, I note that on 12 August 2009 Ms Bishop filed a Form TM22 to surrender the registration. In addition, I note that there are documents on the official file which although not strictly in evidence in these proceedings are open to public inspection, and which help to place the parties' positions into context. I shall refer to these documents as necessary below.

7. In the letter which accompanied the Form TM22 Ms Bishop explains that she was prepared to transfer this registration into Herrmann's name, but had been awaiting their agreement to let her phase out her use of the trade mark. As this agreement was not forthcoming, she explains that she preferred to surrender the registration rather than to assign it. This, she explains, will have the effect of allowing her business the time to phase out their use of the trade mark.

8. Despite the surrender of the registration, Gallafents confirmed in a letter dated 28 August 2009 that Herrmann wished to continue with their application, in order to have Ms Bishop's registration treated as having never been made.

## **EVIDENCE**

9. This consists of a witness statement, dated 9 June 2009, from Laura Herrmann. Ms Herrmann explains that she is the daughter of Ned Herrmann the founder of the Ned Herrmann Group, Inc. Ms Herrmann says:

"2. In around 1986, I designed, for use in my father's business, an original distinctive roundel design, which was intended to be used by my father's company on various materials, including books and stationery, used by the company.

3. At the time the design was created, I intended to transfer the ownership of the copyright in the design to my father's company, and I subsequently did so.

4. I have inspected the design the subject of UK Trade Mark Registration 2333823 and confirm that it is a copy of the design I did.”

## **DECISION**

10. Section 47 of the Act reads as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

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

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, 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.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(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.”

## **Sections 3(6) – the bad faith objection**

11. Section 3(6) reads:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

12. In their written submissions Herrmann say:

“With respect to the objection based on section 3(6) of the Act, we refer to the observations made on the effective Form TM8 in these proceedings which make it entirely clear, without the necessity for evidence being filed by the applicant for the declaration of invalidity, that the proprietor knew at the time that the mark in question was owned by The Ned Herrmann Group. The counterstatement contains no denial of the assertions made on Form TM26 in this connection, and the Registered Proprietor has offered no evidence.

Furthermore, the observations on the effective Form TM8 in these proceedings acknowledges that, at the relevant time, The Ned Herrmann Group had refused “to protect it” and it is clear that the proprietor, knowing the position of the Group, then nevertheless proceed to apply.”

13. In her written submissions Ms Bishop says:

“Whilst I received no formal consent to my registration of this trade mark in the UK, neither was there any objection to my announcement that I would do this if the Ned Herrmann Group continued to fail to protect it in the area in which I was licensed to use it. I only carried this through after a long period of first suggesting that they did it. There has never been any question that I registered the trade mark to prevent them from using it. Indeed I did so so that both they and I were protected.”

“..On the contrary, I would have been very prepared to transfer the trade mark over to them (as I did with the others that they required) if they had simply agreed to a short time frame over which I could remove it from stationery...It was the lengthy period of indecision by the Ned Herrmann Group and their eventual non-cooperation with such a small pre-condition which protracted the negotiation and led to stale mate....”

14. In *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ETMR 56 the European Court of Justice (ECJ) said:

“It is also apparent from that provision that the relevant time for determining whether there was bad faith on the part of the applicant is the time of filing the application for registration.”

I must therefore consider the position at the date Ms Bishop applied to register the trade mark i.e. 3 June 2003.

15. In *Royal Enfield Trade Mark* [2002] RPC 24, Mr Simon Thorley QC sitting as the Appointed Person said:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud should not lightly be made (see Lord Denning MR in *Associated Leisure v Associated Newspapers* [1970] 2

QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v Garrett* (1878) 7 Ch D 473 at 489). In my judgment precisely the same considerations apply to an allegation of bad faith made under Section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference.”

16. Although the ECJ has now provided guidance (in the case mentioned at paragraph 14 above) on what may or may not constitute bad faith, for the benefit of Ms Bishop who is unrepresented, the following summary taken from the decision of the Appointed Person in *Melly's Trade Mark Applications* [2008] ETMR 41 provides a helpful summary of the way in which the objection should be approached:

“49. Section 3(6) of the 1994 Act implements the optional provisions of Art.3(2)(d) of Directive 89/104 to approximate the laws of the Member States relating to trade marks [1989] OJ L40/1 (the Trade Marks Directive). It enables applications for registration at the national level to be rejected (in the same way as Art.51(1)(b) of the Community Trade Mark Regulation enables applications for registration at the Community level to be invalidated) if and to the extent that they are found to have been made in bad faith. Bad faith is an absolute, hence free-standing, ground for refusal of registration. It can be raised in relation to matters arising between applicants and third parties as well as between applicants and the Registrar. Even after an application has proceeded to registration, it remains open to the Registrar to challenge the antecedent request for protection: Section 47(4) of the Act provides that: "In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration."

50. The focus of attention is the propriety of the applicant's conduct. Not generally, but specifically in relation to his request for protection of the trade mark in question for the goods or services in question in the particular circumstances of the disputed application for registration. The relevant question is whether the applicant's conduct should be regarded as improper in that connection.

51. The expression "bad faith" has moral overtones which appear to make it possible for an application to be rendered unacceptable by behaviour otherwise involving no breach of any duty, obligation, prohibition or requirement that is legally binding on the applicant. The underlying concept is not amenable to exhaustive codification. However, I do not think it could be correct for courts and tribunals across the European Union to adopt divergent standards for the determination of "bad faith" objections within the framework of the harmonised rules which now govern the protection of trade marks at the national and Community level. There is, as yet, [FN50] no guidance from the supervising courts in Luxembourg as to the scope and application of such objections. In that state of affairs, I think it is necessary, in accordance with s.3 of the European Communities Act 1972, to have regard to the well-established principle [FN52] that Community law should be interpreted and applied so as to confer no legitimacy on improper behaviour. In its judgment delivered on 20 September 2007 in *Tum v Secretary of State for the Home*

Department ( C-16/05) [2008] 1 W.L.R. 94 the ECJ stated at [64]:

"... it must be borne in mind that, according to settled case law, Community law cannot be relied on for abusive or fraudulent ends ( Case C-255/02 Halifax and Others [2006] ECR I-1609, paragraph 68) and that the national courts may, case by case, take account -- on the basis of objective evidence -- of abuse or fraudulent conduct on the part of the persons concerned in order, where appropriate, to deny them the benefit of the provisions of Community law on which they seek to rely (see inter alia Case C-212/97 Centros [1999] ECR I-1459, paragraph 25)." I believe that to be an apposite statement of the basis on which bad faith invalidates applications for registration under the parallel provisions of Art.3(2)(d) of the Trade Marks Directive, Art.51(1)(b) of the Community Trade Mark Regulation and s.3(6) of the 1994 Act. I also consider it to be consonant with the existing case law on bad faith in the United Kingdom and at the Community Trade Marks Office.

52. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* Lindsay J. 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." This statement of approach has been regarded as a touchstone for the determination of bad faith objections in the United Kingdom. It has been assimilated into the approach of the Boards of Appeal at the Community Trade Marks Office. It does not allow applications for registration to be made "for abusive or fraudulent ends".

53. The mental element required for a finding of bad faith has been much discussed. The discussion has centred on the test for determining dishonesty in English law, that is to say the "combined test" as explained by the House of Lords in *Twinsectra Ltd v Yardley* and clarified by the Privy Council in *Barlow Clowes International Ltd (In Liquidation) v Eurotrust International Ltd*. In her decision in *Ajit Newspaper Advertising Marketing & Communications Inc's Trade Mark (No.2283796)* Professor Annand considered whether the "combined test" makes it necessary to give effect to the applicant's belief in the propriety of his own behaviour when deciding whether he applied for registration in bad faith. She said not, on the basis that his own perception of propriety could not provide a conclusive answer to the question whether he actually had applied for registration in bad faith. I agree with her analysis. It supports the view that the relevant determination must ultimately be made "on the basis of objective evidence" rather than upon the basis of evidence as to the beliefs and opinions of the applicant with regard to the propriety of his disputed application for registration. I note in this connection that in the *Harrison v Teton Valley Trading Co Ltd--CHINA WHITE* case the Court of Appeal upheld the Hearing Officer's finding of bad faith: (1) notwithstanding that the applicant for registration had deposed to the fact that he "recognised no bad faith in my

decision to develop and market the drink CHINA WHITE" and was not cross-examined on the evidence he had given; and (2) notwithstanding that the Registrar's Hearing Officer had accepted the applicant's evidence and concluded that at the date of the disputed application for registration the applicant "saw nothing wrong in his own behaviour".

17. No evidence has been filed by either party which goes to this ground of objection. I have therefore only the pleadings and submissions to assist me in reaching a conclusion. Herrmann argue that the manner in which the ground was pleaded by them and the lack of a denial on Ms Bishop's part in her counterstatement, together with her comment to the effect that she only applied to register the trade mark because Herrmann had "refused to protect it", are sufficient for me to find in their favour without the need for them to provide supporting evidence. At first sight this may appear an attractive approach. However, if one keeps in mind the comments of the Appointed Person in *Royal Enfield Trade Mark*, it is clear that a claim to bad faith is a serious allegation and:

"..should not be upheld unless it is distinctly proved and this will rarely be possible by a process of inference."

18. Herrmann asks me to infer that Ms Bishop acted in bad faith when she applied to register the trade mark, a process which the Appointed Person suggests is rarely possible in such circumstances. In the absence of evidence to show, for example, the nature of the relationship between the parties and which provides me with concrete information on what Ms Bishop was and was not entitled to do under that relationship, I am not prepared simply to infer that she acted in bad faith when she filed the application.

19. Whether a licensee who registers a trade mark of a principal who, despite repeated requests from the licensee, fails to protect the trade mark used by the licensee is guilty of an act of bad faith can only be determined, in my view, following a full investigation of the factual matrix surrounding the relationship between the parties; this inevitably requires the filing of evidence.

**20. In summary, and in the absence of evidence which distinctly proves Herrmann's allegations, I am not prepared to infer, given the serious nature of such a claim, that the application for registration was filed by Ms Bishop in bad faith. The ground based on section 3(6) of the Act is dismissed accordingly.**

#### **Sections 5(4)(b) – the copyright objection**

21. Section 5(4)(b) of the Act reads:

"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)...



(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.”

22. In their written submissions Herrmann say:

“Turning now to the ground under section 5(4)(b) of the Act, we observe that the observations on the effective Form TM8 in these proceedings fail to deny any one of the assertions made on Form TM26. The applicant for the declaration of invalidity has filed evidence in support of the assertions save for the final one, viz. that the original proprietor of the earlier right and any successor in title had not consented to the registration of the mark.

We submit that the observations on the effective Form TM8 by the proprietor not only failed to deny this assertion, but actually support it. As noted above, as stated by the proprietor “it was the refusal of The Ned Herrmann Group to protect it which led me to do so.”

We submit that it is entirely clear from this that no consent to the registration was ever given and the proprietor simply proceeded on her own initiative to apply for and secure [the registration].”

23. On 12 November 2009 I wrote to Gallafents. The relevant part of my letter reads:

“Having reviewed the pleadings I note that the applicant claims, inter alia, that the registration offends section 5(4)(b) of the Trade Marks Act. In support of this claim a witness statement of Laura Herrmann dated 9 June 2009 has been provided. I have also read your written submissions of 27 October.

However, in order for me to consider this claim further, it will be necessary for you to provide me with the following information:

The nationality of the creator of the “roundel design” at the time of the “roundel design’s” creation;

The jurisdiction in which the “roundel design” was created.

The answers to the above questions should be provided by Ms Herrmann in the form of a witness statement. In addition, and bearing in mind Ms Herrmann’s responses to the above questions, it will then be necessary for you to provide written submissions on what you consider to be the relevant legislation that I need to take into account in reaching a conclusion on the copyright issue, including any relevant legislation which bears on the duration

of copyright in the jurisdiction which Ms Herrmann identifies.”

24. In response to my letter, Gallafents provided a facsimile copy of a further witness statement from Ms Herrmann dated 22 November 2009 (the original witness statement was received by the Intellectual Property Office on 14 December 2009). The relevant part of Ms Herrmann’s statement reads:

“2. For the whole of my life I have been a United States citizen.

3. The design of the distinctive roundel referred to in my earlier statement was done in the United States of America.

4. The design was first published in the United States when adopted by my father’s company as a trade mark and applied to books and stationery published and distributed by that company.”

25. In response to my other questions Gallafents say:

“We submit that the relevant legislation which needs to be taken into account... is British legislation, not United States legislation. This submission is based on the membership of the Universal Copyright Convention by the United Kingdom and the United States of America.

The work in question became a published work when first used in the United States..Pursuant to the first paragraph of Article II [of the Convention], and remembering that the author of the work was a national of the United States, this means that, in the case of the work in question, it shall enjoy in the United Kingdom (which falls within the category “each contracting state”) the same protection as the United Kingdom accords to works of UK nationals first published in the UK.

Those rights are set out in the Copyright, Designs & Patents Act 1988 and we submit that the protection given by the Act to this work is one which enables its use to be controlled and in particular, provides the grounds for invalidity set out in Section 5(4)(b) of the Trade Marks Act.

While, for reasons stated above, we submit that the relevant law for consideration is British law and not United States law, and accordingly we believe that the registrar does not need to take any of it into consideration, we attach three pages of extracts from the copyright law of the United States of America relating to the subject matter of copyright, both in general and with respect to the national origin, and including the definition of pictorial, graphic and sculptural works referred to in Section 102(a)(5) of the US Copyright law. We submit that the work in question in these proceedings is a pictorial or graphic work.

Also included is a copy of Section 302 of the Copyright law which sets out the

duration of copyright in the United States of America in respect of works created on or after 1<sup>st</sup> January 1978 and which accordingly applies to the work in question.”

26. I note that Gallafents’ letter was copied to Ms Bishop and that no comments have been received from her.

27. In their written submissions Gallafents argue it is the legislation of the United Kingdom as opposed to the United States of America that I need to consider in relation to the claim to copyright. That is, they say, because both countries are parties to the Universal Copyright Convention (UCC). While I do not intend to provide a summary of the origins and development of the UCC here, useful guidance in this regard can be found in paragraphs 24-79 to 24-87 of Copinger and Skone James on Copyright (fifteenth edition 2005).

28. Although no website address is provided by Gallafents, attached to their letter is, they say:

“a sheet reproducing the first few lines and title of a table from the UNESCO website setting out the membership of both parties to that Convention, followed by Article II of the Convention itself.”

29. The relevant parts read as follows:

“Universal Copyright Convention as revised on 24 July 1971, with Appendix Declaration relating to Article XVII and Resolution concerning Article XI. Paris, 24 July 1971

<b>States</b>	<b>Date of deposit of instrument</b>	<b>Type of instrument</b>
1. United Kingdom of Great Britain and Northern Ireland	19/05/1972	Ratification
4. United States of America	18/09/1972	Ratification

#### **Article II**

1. Published works of nationals of any Contracting State and works first published in that State shall enjoy in each other Contracting State the same protection as that other State accords to works of its nationals first published in its own territory.

2. Unpublished works of nationals of each Contracting State shall enjoy in each other Contracting State the same protection as that other State accords to unpublished works of its own nationals.

3. For the purpose of this Convention any Contracting State may, by domestic legislation, assimilate to its own nationals any person domiciled in that State.”

30. I note that at the date that Ms Bishop applied to register her trade mark i.e. 3 June 2003, both countries were party to the UCC (paragraph 24-87 of Copinger and Skone James refers).

31. It is clear from the extract provided by Gallafents that both the United Kingdom and the United States of America were parties to the UCC in 1971. It is also clear from the information contained in Copinger and Skone James that they were still parties to the UCC at the time when Ms Herrmann created her design in 1986, and when Ms Bishop applied to register her trade mark in 2003. I am therefore satisfied that at all material times both countries were parties to the UCC. As Ms Herrmann has confirmed that she is a national of the United States of America, and that her design was first published in the United States when it was adopted by her father's company as a trade mark applied to books and stationery published by that company, it appears to me that Herrmann are entitled to rely on the wording of paragraph 1 of Article II of the Convention; I intend to proceed on that basis.

32. In their letter Gallafents refer me to the Copyright, Designs & Patents Act 1988 (CDP) as being the appropriate law governing Herrmann's claim under section 5(4)(b) of the Act. However, as the work that is the subject of the protection claimed for the purpose of the action was created in 1986, I must also take into account the provisions of the Copyright Act 1956 which was still in force at that time. When that Act was repealed the Transitional Provisions of the CDP Act 1988 contained the following provisions (Schedule 1 thereof) in relation to 'General principles: continuity of law'.

"3. The new copyright provisions apply in relation to things existing at commencement as they apply in relation to things coming into existence after commencement, subject to any express provision to the contrary.

4.-(1) The provisions of this paragraph have effect for securing the continuity of the law so far as the new copyright provision re-enact (with or without modification) earlier provisions.

(2) A reference in an enactment, instrument or other document to copyright, or to a work or other subject-matter in which copyright subsists, which apart from this Act would be construed as referring to copyright under the 1956 Act shall be construed, so far as may be required for continuing its effect, as being, or as the case may require, including, a reference to copyright under this Act or to works in which copyright subsists under this Act.

(3) Anything done (including subordinate legislation made), or having effect as done, under or for the purposes of a provision repealed by this Act has effect as if done under or for the purposes of the corresponding provision of the new copyright provisions.

(4) References (expressed or implied) in this Act or any other enactment, instrument or document to any of the new copyright provisions shall, so far as

the context permits, be construed as including, in relation to times, circumstances and purposes before commencement, a reference to corresponding earlier provisions.

(5) A reference (express or implied) in an enactment, instrument or other document to a provision repealed by this Act shall be construed, so far as may be required for continuing its effect, as a reference to the corresponding provision of this Act.

(6) The provisions of this paragraph have effect subject to any specific transitional provision or saving and to any express amendment made by this Act.”

33. I must now determine if Ms Herrmann’s design is a work. The 1956 Act deals with copyright in ‘artistic work’ in Section 3(1) and includes:

“the following, irrespective of artistic quality, namely .... drawings ...”.

34. The Transitional Provisions in Schedule 1 to the 1988 Act provides at 1(3) that:

“References in this Schedule to “existing works” are to works made before commencement ...”

and at 2(1) that:

“In relation to the 1956 Act, reference in this Schedule to a work include any work or other subject matter within the meaning of that Act.”

35. In terms of the test for what may be held to constitute an artistic work, Copinger and Skone James indicates as follows:

**“3-53 Nature of copyright in artistic works.** The essential nature of an artistic work is that it is a thing to be *looked* at in some manner or other. What matters is that which is *visually* significant.”

**“3-54 Simple artistic works.** Provided that the subject matter can be fairly said to fall within one of [the] categories of protected subject matter (drawing, diagram, etc.), it will in principle be protectable, even though it is elementary or commonplace, the issue in the case of simple works being one rather of originality. All that it is necessary is that there be some visual significance in the product of the artist’s work.”

36. In light of those observations, I have no hesitation in concluding that the design created by Ms Herrmann in 1986 constitutes a work that is protectable under copyright law.

37. In their pleadings Herrmann explicitly state that at the time Ms Herrmann created her design she was an employee of a predecessor in title to the current applicant. In addition, in her witness statement of 9 June 2009, Ms Herrmann says that ownership of the copyright in her design was transferred to her father's company. As none of these claims have been challenged, I am prepared to accept that Herrmann is the owner of the copyright in the design originally created by Ms Herrmann in 1986.

38. Even if that were to be considered too generous a view of the matter, I also note that (insofar as it is relevant) The Trade Marks (Relative Grounds) Order 2007 which came into force on 1 October 2007 reads as follows:

“2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

3....

4....

5. (1) Only the persons specified in paragraph (2) may make an application for a declaration of invalidity on the grounds in section 47(2) of the Trade Marks Act 1994 (relative grounds).

(2) Those persons are—

(a)...

(b) in the case of an application on the ground in section 47(2)(b) of that Act, the proprietor of the earlier right.

(3)...

Transitional provisions

6. (1)...

(2) Article 5 shall not apply to an application for a declaration of invalidity which relates to a trade mark the application for the registration of which was published before the coming into force of this Order.”

39. The combined effect of the paragraphs of the Order I have reproduced above, and in particular paragraph 6(2) of the Transitional Provisions, is that because Ms Bishop's application for registration was published on 15 August 2003 i.e. before the coming into force of the Relative Grounds Order on 1 October 2007, and as I am satisfied that Ms Herrmann's design meets the other qualifying criteria mentioned above, it is not necessary for Herrmann to be the

proprietor of the earlier right relied upon under section 5(4)(b) of the Act to succeed in these proceedings.

**40. In summary, I am satisfied that Herrmann is the owner of the copyright in a work which is identical to the trade mark the subject of Ms Bishop's registration. I conclude therefore that use of Ms Bishops' trade mark was liable to be prevented under the law of copyright, and the application for invalidation based on section 5(4)(b) of the Act should succeed. In accordance with section 47(6) of the Act the registration is declared invalid and is deemed never to have been made.**

41. As Herrmann have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to Herrmann on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparing evidence	£500
Preparation of written submissions	£300
<b>Total:</b>	<b>£1200</b>

42. I order Sally Bishop to pay to the Ned Herrmann Group, Inc the sum of £1200. This sum is to be paid within seven days of 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 25 day of February 2010**

**C J BOWEN  
For the Registrar  
The Comptroller-General**