

O/574/17

TRADE MARKS ACT 1994

TRADE MARK REGISTRATIONS 2198456, 2311354, 2574627 & 2574641

IN THE NAME OF MR A.A.COOPER

AND

APPLICATIONS 501346-49 BY CONSOLIDATED DEVELOPMENTS LIMITED

TO REVOKE THE REGISTRATION OF THE TRADE MARKS FOR NON-USE

Background and pleadings

1. On 26th September 2016, Consolidated Developments Limited (“the applicant”) applied to revoke four trade marks in the name of Mr A.A.Cooper (“the proprietor”) on grounds of non-use.

2. The contested marks are as follows:

Registration No.	Trade mark	Class Number(s)	Date registration process competed	Requested dates of revocation
2198456	TIN PAN ALLEY	15	8 th December 2000	9 th December 2005 or 26 th September 2015
2311354	TIN PAN ALLEY	35	21 st February 2003	22 nd February 2008 or 26 th September 2016
2574641	TIN PAN ALLEY	16, 35, 41, 42 & 43	12 th August 2011	13 th August 2016 or 26 th September 2016
2574627	TPA	16, 35, 41, 42 & 43	12 th August 2011	13 th August 2016 or 26 th September 2016

3. The grounds for revocation are based upon Section 46(1)(a) and/or (b) of the Trade Marks Act 1994. Essentially, the applicant says that the marks have not been put to genuine use during the 5 year period following the completion of the registration process (“the original period”) or, alternatively, there was no genuine use of the marks during the 5 year period between 26th September 2011 and 25th September 2016 (“the relevant period”).

4. The proprietor filed a counterstatement denying the claims. According to the proprietor, the marks were used during the original and/or relevant periods or preparations for such use commenced before the proprietor was notified about the applications for revocation.

5. The proprietor defends the registration of the trade mark in the goods/services shown in annex A.

6. The proceedings are consolidated.

The evidence

7. On 21st March 2017, the proprietor filed evidence in support of his trade mark registrations. This consists of a witness statement by Mr Andrew Cooper dated 20th March 2017 together with 12 exhibits. Mr Cooper is the leader and treasurer of the Tin Pan Alley Traders Association. According to him, because of its long association with British popular music, Denmark Street in London is known in the UK as ‘tin pan alley’ (by analogy with the name given to a district of Manhattan, New York, which was associated with popular US music in the late 19th and the early part of the 20th century).

8. Mr Cooper says that he acquired trade marks 2198456 and 2311354 on 16th November 2009. He applied and registered trade marks 2574627 and 2574641 in 2011. He registered the website www.tinpanalley.co.uk on 14th August 2011. According to Mr Cooper, the home page of his website provides links to the websites of 12 retail outlets. A copy of what appear to be current pages from the website are

in evidence.¹ The website appears to be intended to promote the history, musical legacy and the current traders of Denmark Street, London. The brands of the 12 traders identified by Mr Cooper are shown on one of the pages under the heading 'Links'. Most of these traders have physical locations in Denmark Street, London. The TIN PAN ALLEY mark appears on each page of the website.

9. Mr Cooper also provided copies of the websites of the 12 retailers concerned.² Again, these appear to be current pages, but Mr Cooper says that he has been “hosting and maintaining links to these websites” since at least 2012. In support of this claim he exhibits invoices sent to the 10 businesses on 12th July 2012 for “Hosting and maintenance of [business name] website, including link from TPA site.”³ The invoices are on headed notepaper. ‘Andrew Cooper’ is written in large letters, below which appears ‘T/A Tin Pan Alley’. The invoices are numbered consecutively. Each is for £240 or £140. The period over which the identified services were, or were to be, provided is not specified. Oddly, 4 of the 10 invoices are addressed to businesses other than those Mr Cooper names in his statement as the ones to which he has provided website links. The other 6 invoices are addressed to half the businesses named in his statement.

10. According to Mr Cooper, he sells merchandise from his website. His current website has a merchandise page showing T-shirts, watches, badges, mugs, keyrings, fridge magnets, place mats and pens bearing the TIN PAN ALLEY mark, mostly in the form shown below.



¹ See exhibit AA1

² See exhibit AA3

³ See exhibit AA4

Similar use of the mark on “*promotional material*” in the nature of pens, plectrums, note books, stickers and mouse mats is shown in exhibit AA9. Again there is nothing to date this material to within the original or relevant periods. Mr Cooper does not claim that the pictures date from these periods.

11. It does not appear to be possible to purchase goods directly via the tinpanalley.co.uk website. And no prices are shown. Rather, enquiries are directed to ‘andy@tinpanalley.co.uk’.

12. There are no sales figures for any goods. However, Mr Cooper provides copies of 7 invoices sent to 4 businesses between 17th May 2012 and November 2016 for 177 T-shirts.⁴ Six of these invoices (152 T-shirts) relate to sales in the relevant period. The first 2 invoices, dated in 2012, are from ‘The London P.A. Centre’. The later invoices, starting from December 2014, are from ‘Andrew Cooper, T/A Tin Pan Alley’. All the invoices are for “*Tin Pan Alley*” T-shirts. Pictures of the T-shirts are in evidence.⁵ They have logos including the words TIN PAN ALLEY on the chest part of the T-shirts. One of the logos is shown in paragraph 10 above.

13. Copies of invoices from the supplier of the T-shirts are also in evidence.⁶ They show that between May 2012 and May 2016, Mr Cooper purchased 525 T-shirts. The shirts were sold to him as Fruit of the Loom products. The supplier – Clothes2Order – customised the garments with logos on the centre chest and centre back. I take these to be the TIN PAN ALLEY logos mentioned above.

14. According to Mr Cooper, he has spent “*substantial sums*” promoting the trade marks TIN PAN ALLEY and TPA. He does not say how much he spent, but he exhibits a copy of an email he received from Standfirst media on 21st January 2009 agreeing to include a double page advert spread in the February and March editions of an unnamed publication. There is no mention of TIN PAN ALLEY/TPA. I also note that this was before Mr Cooper says that he acquired or registered the contested marks.

⁴ See exhibit AA5A

⁵ See exhibit AA5

⁶ See exhibit AA6

15. Mr Cooper exhibits proofs of advertisements which he says appeared in Play Music and Sound of Sound music publications “in the period 2008 to 2013”. Copies of 12 advertisements are in evidence.⁷ The first six carry dates in 2008 and 2009 which are before the date that Mr Cooper says that he acquired or registered the contested marks. Consequently, these cannot show use of the contested marks by the proprietor or with his consent. Only one advertisement shows use of TIN PAN ALLEY in the original or relevant periods.⁸ This is dated 6th December 2013 and therefore falls within the relevant period. It is shown below.



I note that TIN PAN ALLEY appear in a mocked-up London road sign logo (as in paragraph 10 above) and opposite a sign for the London Underground station at Tottenham Court Road. I also note that the business being advertised was prominently identified as ‘London P.A.Centre’. It is not entirely clear which goods (if any) or services were being promoted, but the firm’s goods/services appear to have been (or been related to) sound systems.

16. Mr Cooper claims that the contested marks have been licensed to Tin Pan Alley Productions in respect of ‘production of TV programmes; TV entertainment services; audio and visual recording services; radio entertainment; advice, information and

⁷ See exhibit AA7

⁸ See page 106 of the evidence

consultancy for all the aforesaid services'. He further claims that Tin Pan Alley Productions has used the trade marks in the UK in relation to the licensed services. In this connection, he provides copies of articles that appeared in the UK press relating to a forthcoming 10 part TV series entitled 'Tin Pan Alley TV'.⁹ According to the initial reports, the TV show was due to be broadcast in early 2016. Mr Cooper says that it was broadcast then. However, the only articles which mention actual broadcast dates indicate that the show was broadcast on Showbiz TV in October 2016 (after the end of the relevant period).

17. Mr Cooper has not provided a copy of the licence in favour of Tin Pan Alley Productions. So far as I can see, the press coverage of the forthcoming TV series made no reference to the proprietor. Nor can I see any reference to the name TIN PAN ALLEY being used under licence. Further, there is no evidence that Mr Cooper received any licence income.

18. Mr Cooper claims that he has also licensed Mr Henry-Scott Irvine to use the contested marks, and that Mr Irvine commenced a crowd-funding campaign in July 2016 to fund a documentary to be entitled 'Tin Pan Alley'. A copy of a Facebook page set up by Mr Irvine is in evidence.¹⁰ It bears out Mr Cooper's claims in this respect. However, Mr Cooper has not provided a copy of any licence in favour of Mr Henry-Scott Irvine. Further, there is nothing to show that the prospective TV documentary was ever made.

19. Finally, Mr Cooper claims that he rented his premises at 23 Denmark Street to Music Industry suppliers to hold open evenings and demonstration days to showcase new products etc. However, he does not claim or show any use of TIN PAN ALLEY/TPA in relation to such rental services (or date such rental services, or show any resulting income). Therefore, this evidence is manifestly irrelevant.

⁹ See exhibit AA10

¹⁰ See exhibit AA11

Representation

20. The applicant is represented by Mishcon de Reya LLP, solicitors. The proprietor is represented by Stevens, Hewlett & Perkins, trade mark attorneys.

Case management

21. The applicant decided not to file evidence. Therefore, the parties were advised on 2nd June 2017 that the written stage of the procedure was closed. On 5th June they were asked whether they wished to be heard or to file written submissions in lieu of a hearing. Written submissions had to be filed by 3rd July 2017.

22. Neither side asked to be heard. The applicant replied on 3rd July 2017 providing written submissions and opting for a decision from the papers.

23. On the same date, the proprietor filed a Form TM9R seeking a retrospective extension of time to file additional evidence. The extension sought was from 31st March 2017 (the deadline set for the proprietor to file his evidence) until 31st July 2017. The application for the extension indicated that the proprietor had recently been able to locate a licence dated 7th April 2014 in favour of Mr Gary Chandler-Honor to use the contested marks in relation to *'production of radio and TV programmes; TV entertainment services'* and similar services. A signed copy of the licence was attached to the application.

24. On 5th July 2017 the registrar appointed a case management conference ("CMC") for 20th July. The CMC was to determine the application for a retrospective extension of time and consider possible directions for the future conduct of the proceedings.

25. The CMC took place as scheduled. The proprietor was represented by Mr John Sutton of Stevens, Hewlett & Perkins. The applicant was represented by Ms Sally Britton of Mishcon de Reya. Following the CMC, I exercised the registrar's discretion under Rule 20(4) of the Trade Mark Rules 2008 and gave directions under Rules

62(3) and 68. I communicated the decision/directions to the proprietor's representative as follows

"Following the case management conference ("CMC") today I direct that:

(1) Mr Cooper's application for a retrospective extension of time **until 30 July 2017** to file evidence of a licence to use TIN PAN ALLEY in relation to services in class 41, and use of that mark by the licensee, is allowed.

(2) No further time should be allowed to file this evidence.

(3) If the evidence is filed, Consolidated Developments Ltd will have **until 18th September 2017** to file submissions and/or evidence in reply.

(4) Consolidated Developments Ltd should have its reasonable costs for the additional work involved in dealing with Mr Cooper's additional evidence, irrespective of the outcome of the proceedings.

(5) Assuming that the additional evidence is filed, Mr Cooper must provide security for £2000 in costs to cover any costs awarded to the other side for this work at the conclusion of the proceedings.

(6) This sum should be deposited in a separate client or mutually agreed bank account **by 7th August 2017**, and you should inform the registrar and the other party that this has been done.

(7) If the additional evidence is filed, but no security is provided by the due date, the evidence will be treated as not having been filed and points (3) to (6) above will fall away.

[The proprietor's representative] explained that Mr Cooper's business had gone into liquidation some years ago and his records were scattered across several locations. He had only recently found a copy of the licence. This was why he had not filed evidence of the licence granted to Mr Chandler-Honnor, and associated evidence of use of the mark by the licensee, within the period allowed for filing evidence of the marks.

As to the materiality and importance of the evidence, you drew my attention to the fact that Mr Cooper had been unable to locate a copy of the licence granted to Tin Pan Alley Productions, which he had covered in his existing evidence. Therefore, there was (at least) a question mark over the probative value of his existing evidence of use of the mark in relation to services in class 41. [The applicant's representative] objected on behalf of her client to the application, principally on grounds of lateness, delay and additional cost. However, she was, in my view, unable to identify any prejudice to her client which could not be compensated for in costs.

I find that the additional evidence is extremely late and no satisfactory

explanation for the delay has been provided. Nevertheless, the Rules provide for additional evidence at any time, so lateness as such cannot exclude the possibility of accepting additional evidence. I took into account that the additional evidence sounded as though it could be highly material to Mr Cooper's case, at least so far as registration of the mark in class 41 is concerned. I also took into account the other three factors identified by Carr J. in paragraph 34 of his judgment in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel)* [2016] EWHC 3103; namely:

i) The justice and fairness of subjecting the opposite party to the burden of the evidence in question at the stage that the registry proceedings have reached, including the reasons why the evidence was not filed earlier;

ii) Whether the admission of the further evidence would prejudice the opposite party in ways that cannot be compensated for in costs (e.g. excessive delays); and

iii) The fairness to the applicant of excluding the evidence in question, including prejudice to the applicant if it is unable to rely on such evidence.

It was unreasonable for Mr Cooper to leave it until after the conclusion of the evidence rounds before filing part of his evidence of use. However, and after some hesitation, I decided on the course set out in the above directions. This gives Mr Cooper a chance to file the available evidence of use prior to a first instance decision while compensating the other side for the additional reasonable cost of dealing with Mr Cooper's additional evidence after the evidence rounds were closed.

Again assuming that the additional evidence is filed, Consolidated Developments Ltd will be required to provide an accurate estimate of the actual additional costs at the conclusion of these proceedings. The explanation for the lateness in filing some of Mr Cooper's evidence placed a question mark over his ability to meet any costs awarded against him. [The proprietor's representative] indicated that, if required, he had access to sufficient funds to deposit security. That is why I directed that he should provide security so as to ensure that my decision that he should bear Consolidated Developments Ltd's additional reasonable costs can be put into effect.

It follows that if he does not provide security, Mr Cooper's additional evidence will not be admitted.

Finally, I should point out that filing evidence of the licence in favour of Mr Chandler-Honor without evidence of use of the TIN PAN ALLEY mark by him will be of no assistance to your client. Therefore, the evidence of the former will not be admitted without evidence of the latter.

A copy of this letter goes to Ms Sally Briton at Michcon de Reya."

26. The proprietor’s representative emailed the registrar on 28th July stating that the proprietor had been unable to track down Mr Chandler-Honnor. Therefore, no additional evidence would be filed.

27. The proprietor did not provide written submissions by the deadline of 3rd July 2017. Further, no such submissions were filed with the proprietor’s representative’s communication of 28th July 2017, and none have been received since.

The law

28. Section 46(1) of the Act states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c).....
.....

(d).....

(2) For the purpose of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made to the registrar or to the court, except that –

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

29. Section 100 is also relevant, which reads:

“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.”

30. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,¹¹ Arnold J. stated that:

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the

¹¹ [2016] EWHC 52

latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. In *Awareness Limited v Plymouth City Council*,¹² Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“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.”

32. The applicant’s representatives written submissions contain numerous criticisms of the proprietor’s evidence. The main points appear to be that:

- any sales of goods that may have been made via links from the proprietor’s website are not sales under the contested marks;
- the parties linked to the proprietor’s website trade under their own marks;
- the evidence does not establish that the parties linked to the proprietor’s website retailed relevant goods during the original or relevant periods;
- the proprietor has not filed evidence showing the number of people who accessed the linked sites via his website, or that any sales occurred as a result;
- any use of the TIN PAN ALLEY mark in relation to services falling in class 35, including advertising services, is token use and not genuine use;

¹² Case BL O/236/13

- the supposed use of TIN PAN ALLEY in relation to merchandise such as mugs, T-shirts, watches, fridge magnets and keyrings is irrelevant because the contested marks are not registered for such goods;
- the proprietor has not provided any sales figures for merchandise sold under the contested marks;
- the invoices for “*hosting and maintenance of websites, including a link from the TPA site*” are all dated the same day in 2012, provide no bank detail for payment or VAT number, and total just £2100, which is token use when considered over a 5 year period;
- in any event, the invoices do not show use of the contested marks in accordance with their essential function;
- it is not clear where the advertisements in exhibit AA 7 were placed, and in any event, they show use of the trade name ‘London P.A. Centre’;
- the contested marks appearing in those advertisements were not used in accordance with their essential function;
- only one of the advertisements in question was placed during the relevant period;
- the proprietor has not explained how or where the promotional material shown in exhibit AA8 (consisting of a note pad, pen, plectrum, note book, stickers and mouse mat) were used or who they were distributed to;
- the use shown of the TIN PAN ALLEY on merchandise mark appears decorative;
- decorative use is not sufficient to establish genuine use of the contested marks in relation to goods in classes 15 or 16;
- the claimed licensed use of TIN PAN ALLEY by Tin Pan Alley Productions is not established by a licence document, and none of the material put forward to support the existence of the TV programmes shows any connection with the proprietor;
- the TV show was not broadcast until after the end of the relevant period and such use of TIN PAN ALLEY as occurred within the relevant period was insufficient to constitute genuine use over a 5 year period.

- There is no evidence of a licence in favour of Mr Irvine and, in any event, the use identified is insufficient to establish genuine use of the contested marks in relation to the production of TV programmes etc. during the relevant period.

Use of TIN PAN ALLEY in relation to musical instruments in class 15

33. The use of the mark TIN PAN ALLEY mark as the name of the proprietor's website with links to the websites of third parties who may themselves sell musical instruments is not use of the mark 'in relation' to musical instruments. And even if I am wrong about that, such use is manifestly not in accordance with the essential function of a trade mark. In *Canon v MGM*,¹³ the CJEU confirmed that:

“.....according to the settled case-law of the Court, the essential function of a trade mark is to guarantee the identity of the origin of the marked products to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”

34. Merely providing electronic links to third party websites on which goods bearing various third party brands are marketed in no way distinguishes the goods of one undertaking, let alone “...offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality...”.

35. The only printed advertisement in evidence which is (a) within the original or relevant periods, and (b) by the proprietor of the trade mark at the time, reveals no use of the TIN PAN ALLEY mark in relation to musical instruments. And the evidence does not show any other relevant use of the mark. Consequently, I find that there is no evidence of use of the mark in relation to musical instruments.

¹³ 1999 ETMR 1 at para 28 on page 8

Use of TIN PAN ALLEY in relation to printed publications; printed matter; directories, brochures; writing instruments, ballpoint pens; bumper stickers; newsletters; decalcomania; note cards; in class 16

36. The evidence does not appear to show any use of the mark in relation to printed publications, printed matter, directories, brochures, bumper stickers, newsletters or decalcomania. There is evidence of the mark appearing on printed matter in the form of advertisements for Mr Cooper's business, but this is clearly not use of the mark for the purpose of creating or maintaining a market for printed materials.

37. There is some evidence of TIN PAN ALLEY appearing on pens and notepads. However, (a) these are not dated within the original or relevant periods, and (b) there are no sales or advertising figures for such goods. This may be because these are promotional items intended merely to encourage the sale of other goods or services as per paragraph 30(4) above. Indeed, Mr Cooper himself describes the notepads bearing the words TIN PAN ALLEY as "*promotional material*".

38. I conclude that the proprietor has not shown any use or genuine use of the mark in relation to the goods in class 16.

Use of TIN PAN ALLEY in relation to 'bringing together'/retail services in class 35

39. The proprietor's website does not "*bring together*" the goods of the 12 businesses to whose websites it provides links. I acknowledge that in *Land Securities Plc and Others v Registrar of Trade Marks*,¹⁴ Floyd J. (as he then was) found that a trade mark could be registered for:

"The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and other services, enabling customers to conveniently view and purchase goods and services and make use of such facilities in a shopping centre or mall."

¹⁴ [2008] EWHC 1744 (Pat)

40. However, the 'bringing together' service in that case was provided by a shopping centre bringing together a variety of retailers and other service providers. That is a far cry from simply providing links from a website. In any event, the registered services in this case refer to the bringing together of goods. The proprietor plainly does not 'bring together' the goods marketed by the third parties in question. He has no say in the selection of the goods they choose to market. Such goods are not even visible from the proprietor's website. Therefore, for this reason alone, the links to third party websites cannot count as use of the words TIN PAN ALLEY by the proprietor in relation to the registered 'bringing together' services in class 35, or like retail services.

41. As far as the proprietor's own retail services are concerned, the only goods for which the proprietor has identified any actual trade during the relevant period are T-shirts. The documented sales of T-shirts are very modest in volume. And, as the applicant points out, it is not clear that these goods were promoted on the proprietor's website during the original or relevant periods. Further, even if these goods were advertised on the proprietor's website during the relevant period, I am not satisfied that simply advertising the proprietor's own T-shirts on a website constitutes *electronic shopping retail services connected with the sale of clothing* (or other similar descriptions of the proprietor's class 35 services). It is true that in *Netto Marken*¹⁵ the CJEU held that it was possible to register a trade mark for services involved in the bringing together of other services, even where some of the latter services were provided by the trade mark proprietor itself. The court explained that:

“...even though the assortment of services offered by Netto Marken-Discount could include services provided by itself, that in no way casts doubt on the fact that the supply described in its application for registration, by means of the words ‘the bringing together, for the benefit of others, of a variety of services enabling customers conveniently to purchase those services’, is capable of being categorised..... as a service. At the risk of depriving the applicant in the main proceedings of the possibility of having that sign registered as a trade mark with respect to that bringing together service, its

¹⁵ Case C-420/13

application for registration with respect to Class 35 of the Nice Classification cannot be rejected on the sole ground that the assortment of services which it intends to provide to the consumer could also include services offered by itself.”

42. By analogy, services for the bringing together or retailing of goods may therefore include services where some of the goods brought together are the proprietor’s own goods. Indeed, given that the subject matter of the services in class 35 is the bringing together of a selection of goods for the convenience of the public, and other related services intended to encourage consumers to purchase those goods from the trade mark owner, the trade origin of the goods themselves does not appear to be particularly important. Therefore, provided there is sufficient selection in the range and/or quality of goods brought together so as to constitute a service to consumers, such retail services may be protected by a trade mark in class 35. I see no reason, in principle, why that should not be possible even where the selection of goods conveniently ‘brought together’ and marketed are all the trade mark proprietor’s own goods.

43. However, in *Apple Inc. v Deutsches Patent- und Markenamt*,¹⁶ the CJEU ruled that a trade mark used in connection with retailing goods may be protected for services intended to induce the consumer to purchase the goods, provided that those services do not form an integral part of the offer for sale of the goods (emphasis added). The court stated:

“26.it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple’s application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by

¹⁶ Case C-421/13

means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of 'service'." or otherwise provide retail services

44. Simply showing that a T-shirt was advertised for sale on the trade mark owner's website does not appear to reveal any use of the mark corresponding to the name of the website in relation to services. Where (a) the selection of goods in question is just one or two of the proprietor's own garments, and (b) there is no evidence that these garments could even be purchased on-line, there is plainly no service being provided which is not "*an integral part of the offer for sale of the goods.*" Therefore, the proprietor's use of TIN PAN ALLEY on a website offering its own T-shirts for sale shows no use of that mark in relation to services for the bringing together of clothing in class 35 (or like terms).

45. Turning to the advertisement from the relevant period shown in paragraph 15 above, I find that the words TIN PAN ALLEY were used in that advertisement merely to identify the location of the proprietor's physical location in Denmark Street, London. The name used to designate the proprietor's business and its goods/services (whatever they may have been) was the 'London P.A. Centre'.

46. There is no other evidence of use which could possibly qualify as use of the mark in relation to 'bringing together' type services or other retail services. Consequently, I find that no use of the mark has been shown in relation to these services in class 35.

Use of TIN PAN ALLEY and/or TPA in relation to advertising services in class 35

47. The high point of the proprietor's case under this heading is his evidence that he has been "*hosting and maintaining links to* [the third party websites shown on his current website]" since at least 2012. I accept that, in principle, this could constitute a form of advertising service.

48. The applicant points out that the copies of invoices for these services in evidence are consecutively numbered and all issued on the same day. The first of those points appears to call into question the authenticity of this evidence and, by extension, the

truth of Mr Cooper's claim to have provided such services since 2012. However, the applicant has not sought to cross examine Mr Cooper on his evidence and, in my view, there nothing about the invoices themselves which is self-evidently incredulous. In these circumstances, I accept the truth of Mr Cooper's evidence on this matter.

49. Was the advertising service provided under the contested marks? The customers for the advertising service were the businesses whose brands appeared on the proprietor's website. The end users of the service included those members of the public who visited the proprietor's website and saw the advertisements for third party websites with associated links.

50. It is true that the only evidence of use of the contested marks with customers is use of TIN PAN ALLEY on the 10 invoices issued in July 2012. These were issued on headed notepaper which identified the proprietor as 'Andrew Cooper 'T/A Tin Pan Alley'. The services were described as "*Hosting and maintenance of [the business's] website, including link from TPA site.*" The total income from these invoices appears to have been about £2100. This is the only recorded transaction of this kind during the relevant period. The commercial value of the link from the Tin Pan Alley website as an 'advertising service' therefore appears to have been very small. However, the service appears to have been real in the sense that it was a serious effort to create or maintain a market for such services. Further, as the proprietor identified himself as trading as TIN PAN ALLEY, I am satisfied that the services were provided under the mark. This conclusion is not undermined by the fact that the mark was also the trading name of the proprietor's business. That is quite commonly the case where a business provides services to others.

51. I also take into account the use of the mark on the proprietor's website in relation to advertising services provided to end users, i.e. to those to whom the adverts were directed. It is true that there is no evidence as to the number of end users concerned, but if 10 businesses were prepared to pay the proprietor to include their marks on his website it is reasonable to infer that they must have expected there to be sufficient visitors to the proprietor's website to justify their investment. I therefore

infer that there were some UK visitors to the proprietor's website who would have benefitted from the advertisement of third party websites.

52. I conclude that the evidence shows genuine use of TIN PAN ALLEY in relation to a form of advertising service. Specifically, the provision of advertising space on a website.

53. Although the invoices mentioned above referred to the proprietor's website as 'TPA', this was plainly just short hand for TIN PAN ALLEY. The letters TPA were not used as a trade mark, either on the invoices or on the website. Therefore, no qualifying use of TPA has been shown.

Use of TIN PAN ALLEY and/or TPA in relation to production of radio and television programmes, television entertainment services etc. in class 41

54. Although Mr Cooper gives evidence that TIN PAN ALLEY was licensed to Tin Pan Alley Productions, he has not provided a copy of the licence or any other evidence which supports this claim. Further, he does not say when the licence was granted or provide any further information about it beyond the list of services he says it covered.

55. The applicant appears to challenge the existence of such a licence. Again, it has not sought to directly challenge the truth of Mr Cooper's evidence, for example by requesting cross examination.

56. In these circumstances, I should be slow to disbelieve Mr Cooper. Nevertheless, I find that the evidence in question is so lacking in detail or documentary support that, in this instance, it is really just an unsupported assertion. I reject it as insufficiently solid. Further, even if I accepted Mr Cooper's evidence on this point, it does not establish (because he does not say) that a licence in favour of Tin Pan Alley Productions was given in writing (as required by s.28(2) of the Act) or that the licence was granted during the relevant period and before Tin Pan Alley Productions used that name to promote its forthcoming TV series. Consequently, such evidence

cannot show that any use of TIN PAN ALLEY by Tin Pan Alley Productions during the relevant period was use of the mark with the consent of the proprietor.

57. As to Mr Cooper's evidence that a licence was also granted to Mr Irvine in relation to the same services, I find it insufficiently solid for the same reasons. Further, I see no evidence of any relevant use of the mark by Mr Irvine during the relevant period. Further still, the use Mr Irvine appears to have had in mind appears purely descriptive of the subject matter of the prospective TV documentary programme, which would not be trade mark use.

58. For the reasons given above, I find that there is no evidence of genuine use of the contested marks in relation to services in class 41.

Use of TIN PAN ALLEY and/or TPA in relation to graphic design services, creating, maintaining and hosting the web sites of others in class 42

59. There is no evidence of use of the contested marks in relation to graphic design services.

60. There is evidence that Mr Cooper invoiced 10 businesses in July 2012 in relation "hosting and maintaining" websites. However, in his evidence Mr Cooper says that he has been "hosting and maintaining links to these websites" since at least 2012. Mr Cooper does not appear to be a provider of technological web hosting services. He is not (and was not) an Internet Service Provider. Properly understood I believe his evidence to mean that he has been hosting the links to these parties' websites on his own website since 2012. That is not a web hosting service within the normal meaning of that term, or a service which falls in class 42.

61. Consequently, there is no evidence of use of the contested marks in relation to creating, maintaining and hosting the web sites of others in class 42.

Use of TIN PAN ALLEY and/or TPA in relation to rental of meeting rooms, provision of exhibition and gallery facilities in class 43

62. There is no evidence of use of the contested marks in relation to these services.

Conclusion

63. The proprietor has shown genuine use of TIN PAN ALLEY in relation to advertising services in the form of providing advertising space on websites for others. No other genuine use of the contested marks has been shown by the proprietor, or with his consent, within the original or relevant periods.

Fair specification

64. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,¹⁷ Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

¹⁷ [2016] EWHC 3103 (Ch)

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

65. In this case I consider an average consumer would regard:

‘Providing advertising space on websites, for others’

- as a fair description of the proprietor’s class 35 services.

Outcome

66. Trade mark 2198456 will be revoked for non-use with effect from 9th December 2005.

67. Trade mark 2311354 will be revoked for non-use with effect from 22nd February 2008.

68. Trade mark 2574627 will be revoked for non-use with effect from 13th August 2016.

69. Trade mark 2574641 will be revoked for non-use with effect from 13th August 2016, except in relation to:

Class 35: Providing advertising space on websites, for others

Costs

70. The applicant has mostly succeeded. The applicant is therefore entitled to an award of costs. This should take account of the cost of the CMC mentioned above, which turned out to be rather a waste of time and resources because the proprietor was unable to obtain the evidence it had sought additional time to file.

71. I assess the proprietor's appropriate contribution towards the applicant's costs as follows:

£800 for the official filing fees for four TM26Ns;
£400 towards the professional costs for completing these forms and considering the proprietor's counterstatements;
£500 towards the cost of considering the proprietor's evidence and filing written submissions in reply;
£200 towards the cost of considering the applicant's request for a retrospective extension of time and taking part in a CMC.

72. As the proprietor succeeded for one of the trade marks in respect of one specific service in class 35, I will reduce the costs awarded against the proprietor by £200.

73. I therefore order Mr Andrew Cooper to pay Consolidated Developments Limited the sum of £1700 within 14 days of the end of the period allowed for appeal.

Dated this 21st day of November 2017

Allan James

For the Registrar

Annex A

Trade mark	Goods/services
2198456	Class 15: Musical instruments
2311354	<p>Class 35: The bringing together, for the benefit of others, of apparatus and equipment for recording, transmission or reproduction of sound, sound effects and/or images, amplifiers, loudspeakers, disco units, public address systems, microphones and microphone stands, mixers, mixer amps, monitors for sound reproduction, headsets, head-set systems, data processing equipment, software, microphone transducers, music software, sound systems, synthesisers, midi-file players, track sequencers, software for music composition, arranging and transposition, software for use in the teaching of musical instruments and music theory, metronomes, electronic instrument tuners, electronic practice mutes for instruments, black boxes, power supply units, electric cables for use in music or sound recording or production, sound recordings, discs, cassettes, compact discs, tapes, DVDs, CD ROMs, videos and video recordings, cassettes and cartridges for use with or containing video and/or sound recordings, electronic publications, digital music, musical instruments, music and sound generators, music synthesisers, analysers and instruments, electric and electronic musical instruments, music accessories, replacement parts for musical instruments, percussion items, hand held apparatus, devices and equipment for use in the playing of musical instruments such as sticks, bows, dampers, plectrums, hammers and beaters, musical instrument cases, bags and carrying devices, instrument mutes, mouthpieces, lyres, music stands, metronomes, turning apparatus for sheet music, tuning forks and hammers, conductors' batons, parts, fittings and accessories for all the aforesaid goods, printed publications, books, magazines, journals, catalogues, newsletters, periodicals, printed music, sheet music, manuscript papers, stationery, pens and other writing implements, enabling customers to conveniently view and purchase those goods from an Internet website, or from a retail outlet or from a mail order catalogue or on-line from a computer database; consultancy, advisory and information services in relation to all the aforesaid services.</p>
2574641	<p>Class 16: Printed publications; printed matter; directories, brochures; writing instruments, ballpoint pens; bumper stickers; newsletters; decalcomania; note cards.</p> <p>Class 35: The bringing together for the benefit of others of a variety of goods, namely, apparatus and equipment for recording, transmission or reproduction of sound, sound effects and/or images, amplifiers, loudspeakers, disco units, public address systems, microphones and microphone stands, mixers, mixer amps, monitors for sound reproduction, headsets, head-set systems, data processing</p>

equipment, software, microphone transducers, music software, sound systems, synthesisers, midi-file players, track sequencers, software for music composition, arranging and transposition, software for use in the teaching of musical instruments and music theory, metronomes, electronic instrument tuners, electronic practice mute for instruments, power supply units, electric cables for use in music or sound recording or production, sound recordings, discs, cassettes, compact discs, tapes, DVDs, CD ROMS, videos and video recordings, cassettes and cartridges for use with or containing video and/or sound recordings, electronic publications, digital music, musical instruments, music and sound generators, music synthesisers, analysers and instruments, electric and electronic musical instruments, music accessories, replacement parts for musical instruments, percussion items, hand held apparatus, devices and equipment for use in the playing of musical instruments such as sticks, bows, dampers, plectrums, hammers and beaters, musical instrument cases, bags and carrying devices, instrument mutes, mouthpieces, lyres, music stands, turning apparatus for sheet music, tuning forks and hammers, conductors' batons, parts, fittings and accessories for all the aforesaid goods; watches, musical instruments; CDs, DVDs; clothing; enabling customers to conveniently view and purchase those goods within retail stores; the bringing together for the benefit of others, via the Internet, of a variety of goods, namely, apparatus and equipment for recording, transmission or reproduction of sound, sound effects and/or images, amplifiers, loudspeakers, disco units, public address systems, microphones and microphone stands, mixers, mixer amps, monitors for sound reproduction, headsets, head-set systems, data processing equipment, software, microphone transducers, music software, sound systems, synthesisers. midi-file players, track sequencers, software for music composition, arranging and transposition, software for use in the teaching of musical instruments and music theory, metronomes, electronic instrument tuners, electronic practice mute for instruments, power supply units; electric cables for use in music or sound recording or production, sound recordings, discs, cassettes, compact discs, tapes, DVDs, CD ROMS, videos and video recordings, cassettes and cartridges for use with or containing video and/or sound recordings, electronic publications, digital music, musical instruments, music and sound generators, music synthesisers, analysers and instruments, electric and electronic musical instruments, music accessories, replacement parts for musical instruments, percussion items, hand held apparatus, devices and equipment for use in the playing of musical instruments such as sticks, bows, dampers, plectrums, hammers and beaters, musical instrument cases, bags and carrying devices, instrument mutes, mouthpieces, lyres, music stands, turning apparatus for sheet music, tuning forks and hammers, conductors' batons, parts, fittings and accessories for all the aforesaid goods; watches; musical instruments; CDs, DVDs; clothing; enabling customers to conveniently view and purchase those goods; electronic shopping retail services connected with the sale of apparatus and

	<p>equipment for recording, transmission or reproduction of sound, sound effects and/or images, amplifiers, loudspeakers, disco units, public address systems, microphones and microphone stands, mixers, mixer amps, monitors for sound reproduction, headsets, head-set systems, data processing equipment, software, microphone transducers, music software, sound systems, synthesisers, midi-file players, track sequencers, software for music composition, arranging and transposition, software for use in the teaching of musical instruments and music theory, metronomes, electronic instrument tuners, electronic practice mute for instruments, power supply units, electric cables for use in music or sound recording or production, sound recordings, discs, cassettes, compact discs, tapes, DVDs, CD ROMS, videos and video recordings, cassettes and cartridges for use with or containing video and/or sound recordings, electronic publications, digital music, musical instruments, music and sound generators, music synthesisers, analysers and Instruments, electric and electronic musical instruments, music accessories, replacement parts for musical instruments, percussion items, hand held apparatus, devices and equipment for use in the playing of musical instruments such as sticks, bows, dampers, plectrums, hammers and beaters, musical instrument cases, bags and carrying devices, instrument mutes, mouthpieces, lyres, music stands, turning apparatus for sheet music, tuning forks and hammers, conductors' batons, parts, fittings and accessories for all the aforesaid goods; watches, musical instruments; CDs, DVDs; clothing; advertising services.</p> <p>Class 41: Provision of entertainment, facilities; organising events for entertainment purposes; party planning services; production of radio and television programmes; television entertainment services: audio and video recording services; radio entertainment; presentation of live performances; advice, information and consultancy for all the aforesaid services.</p> <p>Class 42: Graphic design services; creating, maintaining and hosting the web sites of others.</p> <p>Class 43: Rental of meeting rooms; provision of exhibition and gallery facilities</p>
2574627	As per 2574641