

O-006-05

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 16039  
BY ROBERTS RADIO LIMITED  
FOR A DECLARATION OF INVALIDITY  
IN RESPECT OF INTERNATIONAL TRADE MARK No 745600  
**ROBERT**  
STANDING IN THE NAME OF  
DEUTSCHE TELEKOM AG

## **BACKGROUND**

1) International Trade Mark No 745600 for the trade mark ROBERT is protected from 12 September 2000.

2) It is protected for the following specification of goods and services:

In Class 9: “Electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers; but not including radio and television receiving sets and parts and fittings therefor and similar goods to radio and television receiving sets and parts and fittings therefor.”

In Class 16: “Printed matter, especially stamped and/or printed cards of cardboard or plastic; instruction and teaching material (except apparatus); office requisites (except furniture).”

In Class 38: “Telecommunication; operation and rental of equipment for telecommunication, especially for broadcasting and television.”

3) By an application received on 2 February 2004 Roberts Radio Limited applied for a declaration of invalidity, subsequently amended, in respect of this registration. The amended grounds are, in summary:

a) The applicant is the proprietor of the trade mark ROBERTS which was first used in the UK in 1932 in relation to wireless radio equipment and apparatus for the reproduction of sound. Until 11 June 2002 this mark was registered in the UK under number 1155469 in relation to the following goods in Class 9: “Radio and television receiving sets; parts and fittings included in Class 9 for all the aforesaid goods.”

b) The applicant claims to have made substantial use of this trade mark in the UK in relation to the goods covered by the application and to have gained a reputation in the UK as the manufacturer of very high quality electrical audio equipment.

c) It is claimed that Trade Mark 745600 is similar to the applicant’s mark and is protected for identical or similar goods namely: “Electric and electronical apparatus and instruments...apparatus for recording, transmission, processing and reproduction of sound, images or data” in Class 9. Therefore, the mark in suit should be declared invalid under Section 5(4)(a).

4) The registered proprietor filed a counterstatement denying the above grounds, the registered proprietor also points out that its specification has been amended and that the exclusions remove any similarity of goods which might have existed.

5) Both sides ask for an award of costs in their favour, with the registered proprietor seeking an award higher than the normal scale as the applicant did not approach the registered proprietor prior to filing for invalidity and has not responded to the registered proprietor's attempts at settlement.

6) Both sides filed evidence in these proceedings and the matter came to be heard on 28 October 2004 when the applicant was represented by Mr Fiddes of Messrs Urquhart Dykes & Lord. The registered proprietor was represented by Mr Stacey of Messrs Baron & Warren.

#### APPLICANT'S EVIDENCE

7) The applicant filed a witness statement, dated 2 June 2003, by Leslie Burrage the Chief Executive of the applicant company. He states that his company is one of the leading manufacturers of electrical audio equipment in the UK and that the trade mark ROBERTS was first used in the UK in 1932 and has been in constant use ever since. This use, it is claimed, has resulted in the company gaining a significant reputation in its mark.

8) Mr Burrage states that his company produces a wide range of radios, CD players, clock radios, cassette recorders and electrical accessories. Some of the radios can record programmes onto a hard drive within the unit for later playback. He states that his company has the largest share of the radio market in the UK. At exhibits LB/5 & 6 he provides data compiled by the GFK Group who he states are the "recognised market research company for the consumer electronics industry". This data shows the following with regard to the radio market in the UK:

Year	No. of units sold	Market share by volume %	Value of units sold £million	Market share by value %
December 1996	95,600	12.9	4.9	26.1
December 1997	114,200	13.4	6.1	29.8
December 1998	131,400	14.6	7.0	30.8
December 1999	142,300	16.9	7.7	34.6
December 2003	338,600	26.5	17.3	33.7

9) Mr Burrage states that his company has the third largest market share of the clock radio market (incorporating clock radios, CD clock radios and cassette clock radios) in the UK. In November 2003 the applicant held 15% of the market by value with over £5million in sales. He states that although his company sold such products prior to 2003 his company was not shown separately in the GFK survey figures.

10) At exhibit LB/8 he provides print-outs from Internet web sites of three of the applicant's competitors (Panasonic, Philips & Sony Ericsson). This shows that all three offer mobile phones in addition to their range of audio equipment. Mr Burrage opines that, as it is usual for manufacturers of radio and audio equipment to expand into telecommunications, the average consumer would associate the registered proprietor's products with those of the applicant.

11) In addition to the above Mr Burrage also filed the following exhibits:

- LB/1 & 7 A history of the company.
- LB/2 Brochures dated 2002 and 2004 showing the current range of products (radios with and without CD's and cassette players, and clock radios / cassettes / CD's).
- LB/3 UK press cuttings March – August 1999. All mentions of the applicant company and products shown refer solely to radios, with one exception from September 1999 when a portable stereo system was featured.
- LB/4 press cuttings March-April 2004, after the relevant date.
- LB/9 Extracts from a history of the radio and television industry which has a number of references to the applicant company. All mentions of the applicant company are in relation to the production of radios/receivers.

#### REGISTERED PROPRIETOR'S EVIDENCE

12) The registered proprietor filed a witness statement, dated 22 July 2004, by James Maxwell Stacey, the registered proprietor's Trade Mark Attorney.

13) Mr Stacey states that his client's mark was protected as of 15 February 2002 as there was no opposition following the mark being advertised. The specification was amended prior to this to overcome the citation of the applicant's mark number 1155469. He states that the terms "electrical and electronic" were limited as all for use with telecommunication apparatus in order to overcome an objection.

14) Mr Stacey states that the registered proprietor is one of the world's biggest telecommunications companies with interests in fixed line and mobile communications, online Internet service and content provision, Internet access as well as system solutions. There are four core business units within the company which are: T-MOBILE, T-COM, T-ONLINE and T-SYSTEMS. In order to promote a stock floatation a computer animated figure was created and called ROBERT. The character proved very popular and so continued to be used in promoting T-ONLINE and T-COM. Mr Stacey states that in 2003 a decision was made to cease use of ROBERT (the figure and the mark). However, he clarifies that the mark has not been abandoned.

15) Lastly, Mr Stacey points out that his client has already declared that it has no interests in "radios or any other similar or complimentary products such as audio HiFi apparatus". He states that his client offered further limitations in order to settle proceedings but these were all declined with no counter proposals being forthcoming. At exhibit JMS11 he provides a copy of an application sent to the Registry to further limit the specification, however this was not acted upon by the Registry as such requests must be filed through WIPO, where the mark is an International Registration. It is clear from the attachments to his evidence that Deutsche Telekom's remit is to build "one of the world's most advanced network infrastructures". During the year 2000 this involved the purchase of shareholdings in various radio broadcasting companies.

## APPLICANT'S EVIDENCE IN REPLY

16) The applicant filed a witness statement, dated 11 August 2004, by Alan Michael Fiddes its Trade Mark Attorney. At exhibit AMF/1 Mr Fiddes provides an extract from the registered proprietor's own website which shows that one of its phones, a Nokia 6610, has an integrated FM radio. An extract from the Nokia website shows that it also has an alarm clock.

17) At extract AMF/3 Mr Fiddes provides a further extract from the registered proprietor's website which shows that a number of the phones on offer use BLUETOOTH technology. At exhibit AMF/4 is an extract from the Nokia site which shows that this technology allows the user to access the internet from a phone. Mr Fiddes at exhibit AMF/5 provides an extract from the BBC website which shows that radio shows can be listened to via the Internet.

18) Mr Fiddes denies that his client declined any proposals for a settlement. At exhibit AMF/6 he provides copies of two letters sent to the registered proprietor's agent setting out the view that all of the registered proprietor's goods and services overlap with their own and that the goods and services of the two parties were confusingly similar. They did ask for the registered proprietor to specify the exact nature of the goods or services which they planned to use the mark ROBERT on in the UK. It is clear that the response was effectively a reiteration of the specification of the International Registration.

19) That concludes my review of the evidence. I now turn to the decision.

## DECISION

20) The request for the declaration of invalidity is made under the provisions of Sections 47(2) and 5(4)(a) of the Act. These state:

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

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

And:

“5.(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b) .....

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.”

21) In deciding whether the mark in question “ROBERT” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] 14 RPC 455. In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in *Reckitt & Colman Products Ltd - v - Borden Inc* [1990] RPC 341 and *Even Warnik BV - v - J. Townend & Sons (Hull) Ltd* [1979] AC 731 is ( with footnotes omitted) as follows:

‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

- (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and
- (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of “passing off”, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.’

Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

‘To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.’”

22) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...”. The relevant date is therefore 12 September 2000, the date of protection in the UK.

23) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision, and the arguments put forward at the hearing.

24) It is accepted by the registered proprietor that the applicant has both goodwill and reputation as the provider of radios. The evidence shows that the applicant has used its ROBERTS mark in relation to radios (sometimes referred to as receivers) and, on one occasion prior to the relevant date, a portable stereo system. The applicant has claimed that prior to the relevant date it also produced radios with clocks, cassettes and CD players (or a mixture) incorporated in them. However, all corroborative evidence is dated after the relevant date. The applicant also contends that its reputation spreads wider than radios as the relevant public expect companies who produce electronic consumer products to offer a range of such goods. In support of this contention they filed evidence of the ranges offered by companies such as Sony, Panasonic and Philips. Whilst I accept that there are a number of corporations which offer a huge range of products I do not accept that a company which specialises in a segment of this field should benefit from a larger reputation. The applicant company has an enviable reputation for manufacturing high quality radios. This reputation would extend to other audio systems such as hi-fi equipment, but not, in my view, to telephones or televisions etc.

25) In considering the fields of activity of the two parties I take account of the amendment to its specification filed on 20 September by the registered proprietor in relation to its Class 9 specification. The new specification is as follows, with the changes italicised:

“Electrical and electronic apparatus and instruments, all for use with telecommunication apparatus and instruments; optical, measuring, signalling, controlling and/or teaching apparatus and instruments; apparatus for recording, transmission, processing and reproduction of sound, images or data; machine run data carriers; automatic vending machines and mechanisms for coin operated apparatus; data processing equipment and computers; but not including radio and television receiving sets and parts and fittings therefore and similar goods to radio and television receiving sets and parts and fittings, *and not including radios (for receiving and reproducing sound broadcasts and/or audio hifi apparatus.*”

26) It was accepted by both parties at the hearing that, even though these changes have not yet been recorded, this decision should be made on the basis of the new specification. The registered proprietor also has goods in Class 16 and services in Class 38 protected under its trade mark. For ease of reference these specifications are reproduced below:

In Class 16: “Printed matter, especially stamped and/or printed cards of cardboard or plastic; instruction and teaching material (except apparatus); office requisites (except furniture).”

In Class 38: “Telecommunication; operation and rental of equipment for telecommunication, especially for broadcasting and television.”

27) Despite Mr Fiddes contention that the applicant had used its mark on printed publications, the use amounted to promotional material in respect of its radios which is clearly not similar to the goods listed in Class 16. Equally, whilst I accept that the services under Class 38 may be listened to upon the applicant's goods there is a considerable difference between the manufacture of radios and the provision of radio broadcasts. As to the contention that mobile phones can be used to connect to the Internet and that radio programmes can be listened to via the Internet thus making the mobile phone a portable radio; I can understand the linkage but cannot accept that mobile phones and radios are thus similar products or that they are in the same field of activity. To my mind the registered proprietor's goods under Class 16 and its services under Class 38 are not in similar or even close fields of activity to that in which the applicant operates.

28) It is clear that the manufacture of radios, including radios which incorporate clocks/cassettes/CDs would correctly fall under Class 9. On the face of it this might suggest that the two parties were in the same field of activity. However, Class 9 covers a huge range of goods in non-competing areas. The registered proprietor's specification in Class 9 originally contained an exclusion clause which has been extended by the latest amendment. Together these exclusions read:

“ but not including radio and television receiving sets and parts and fittings therefore and similar goods to radio and television receiving sets and parts and fittings, and not including radios (for receiving and reproducing sound broadcasts and/or audio hi-fi apparatus.”

29) The applicant has a reputation for radios, I do not differentiate between portable radios and mains powered versions even though much of the applicant's evidence points to the portable nature of many of their products. There is scant corroborative evidence that the applicant produced anything else prior to the relevant date. However, I am minded to accept the assertion made in the applicant's evidence that they were producing radios which incorporated clocks, CDs and cassette players prior to September 2000. Mr Fiddes contended that the applicant would be inhibited from natural expansion of its product line by the existence of the registration. To my mind the natural expansion for the applicant would be into hi-fi equipment either as individual components or as integrated systems. In my view the exclusions in the registered proprietor's specification allow for the applicant to move into fields related to its current activity. It follows that I regard the fields of activity of the two parties to be remote.

30) The registered proprietor accepts that the marks of the two parties are similar.

31) The registered proprietor has not used the mark in suit in the UK. As such I must take into account the normal and fair use of its mark. It was not in dispute that the relevant consumer would be the general public and that the applicant's goods and some of the registered proprietor's products, such as mobile phones, would be sold in retail outlets.

32) Whilst the applicant has a reputation in radios which might extend to other areas of the audio field these areas are specifically excluded from the registered proprietor's specification. Despite the fact that the marks are virtually identical and that the goods

of both parties would be purchased in retail outlets by members of the public, in my opinion, consumers would not believe the registered proprietor's goods to have emanated from the applicant or from a connected source. Misrepresentation would not occur. The application for invalidity based upon Section 5(4)(a) fails.

33) As the application was not successful the registered proprietor is entitled to a contribution towards its costs. Although the registered proprietor requested costs higher than the scale in its counterstatement at the hearing it was agreed that costs should be within the normal scale. I order the applicant to pay the registered proprietor the sum of £2000. This sum 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 10th day of January 2005

George W Salthouse  
For the Registrar,  
the Comptroller-General