

O-077-16

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION NO 3000125 FOR THE MARK

Dansette

IN CLASS 9

IN THE NAME OF MIKE WOOD

AND

APPLICATION NO 500813

BY MODERN MARKETING CONCEPTS, INC.

FOR THE MARK TO BE DECLARED INVALID

BACKGROUND

1. Mike Wood is the registered proprietor of the trade mark registration shown on the front cover of this decision. It was filed on 2 April 2013 and completed its registration procedure on 19 July 2013. The registration covers the following goods:

Class 9: *Record player turntables*

2. On 27 March 2015 Modern Marketing Concepts, Inc. (“the applicant”) applied to have this mark declared invalid under the provisions of Sections 47(2) and 5(1) or, alternatively, 5(2)(a) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier Community Trade Mark (“CTM”) shown below:

Mark details	Goods relied upon
CTM 11676996 DANSETTE Filing date: 21 March 2013 Date of entry in the register: 31 July 2013 Priority date: 13 March 2013 Priority country: United States of America	Class 9 <i>Turntables; radios</i>

3. The applicant argues that the respective marks are identical and that goods are identical or, alternatively, highly similar.

4. Mr Wood filed a counterstatement denying the applicant’s claim.

5. Only Mr Wood filed evidence. Although neither side wished to be heard, the applicant filed submissions in lieu of attendance.

Preliminary issue

6. Mr Wood contends that the invalidation application should be rejected on the basis that he was using his mark prior to any use made by the applicant. To this end, he provides a witness statement in which he explains that for the last 25 years he has been in the audio repair business and that a major part of that business consists of restoration and repair of vintage audio, including those branded ‘Dansette’. He states that his intention is to “revive” the ‘Dansette’ brand and that he had used the mark during the 4-month period preceding the filing of his application for registration, i.e. he purchased the domain name ‘dansette.eu’, set up a web page promoting the repair, restoration and sale of ‘Dansette’ players and bought stock for eventual

resale. It is not necessary for me to decide whether the evidence filed shows use of the mark, but even if it did (and I am not suggesting this to be the case) it would not assist Mr Wood. In this regard, in its submissions, the applicant points to the guidance contained in Tribunal Practice Notice 4/2009 entitled “Trade mark opposition and invalidation proceedings – defences”, the relevant part of which reads as follows:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark”

“4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the Appointed Person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

7. As far as I am aware, Mr Wood has not sought to invalidate the applicant’s earlier mark, thus, his claim that he has a prior right is irrelevant to the issue I have to decide.

DECISION

8. The application for invalidation is based upon Sections 47(2)(a) and 5(1), or alternatively 5(2)(a) of the Act. These read as follow:

47. - (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 [...]

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

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, or

(b) it has not been so used, but there are proper reasons for non-use.

.....

(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.”

9. Sections 5(1) and 5(2)(a):

“5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or (b) [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

10. An earlier trade mark is defined in Section 6 of the Act, which states:

“6.-(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) Reference in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. As can be seen from the details given above, the mark relied upon by the applicant has a filing date earlier than that of Mr Wood's mark and, as such, is an earlier mark within the meaning of the Act. It can also be seen that the applicant's mark was less than five years old on the date on which the application for a declaration of invalidity was filed and, as such, is not subject to proof of use.

Comparison of marks

12. I turn first to the objection based on Section 5(1) of the Act. If the application succeeds under this ground, there will be no need for me to reach a finding on the applicant's alternative claim based on Section 5(2)(a).

13. In *LTJ Diffusion SA v Sadas* Case C-291/00 the Court of Justice of the European Union (CJEU) stated in relation to what constitutes an identical mark:

"54. In those circumstances, the answer to the question referred must be that Art. 5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

14. The respective marks are shown below:

Applicant's mark	Mr Wood's mark
DANSETTE	Dansette

15. The competing marks consist of the word DANSETTE. I recognise that the applicant's mark is presented in upper case, whilst Mr Wood's mark is registered in title case. However, as this minor presentational difference is so insignificant that it may well go unnoticed by the average consumer, I have no hesitation in concluding that, on the basis of the guidance in *Sadas*, the competing marks should be regarded as identical.

Comparison of goods

16. The respective goods at issue in these proceedings are as follow:

Applicant's goods	Mr Wood's goods
Turntables, radios	Record player turntables

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T- 133/05 the General Court (GC) stated that:

"29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme*

v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

18. The term *Turntables* in the applicant’s specification will clearly encompass *Record player turntables* in Mr Wood’s specification. In my view, the respective goods are, therefore, identical.

19. Under Section 47 and 5(1) of the Act a registered mark shall be declared invalid if it is identical to an earlier mark and the goods which is registered for are identical to the goods for which the earlier mark is protected. I have concluded that both the marks and goods at issue in these proceedings are identical. Therefore, the invalidation action based on Section 5(1) of the Act succeeds accordingly. That being the case, there is no need for me to consider the additional ground based on Section 5(2)(a) of the Act.

Outcome

20. The invalidation has succeeded under Section 5(1) of the Act and the subject registration is hereby declared invalid. Under the provisions of Section 47(6) of the Act, it is deemed never to have been made.

Costs

21. The application for a declaration of invalidity has been successful and the applicant is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide and taking account of the fact that Mr Wood filed evidence, but that this was on the light side, and that the applicant has been professionally represented, I award costs to the applicant on the following basis:

Official fees: £200

Preparing a statement and considering other side’s statement: £200

Commenting on other side’s evidence (in written submissions): £400

Total: £800

22. I order Mike Wood to pay to Modern Marketing Concepts, Inc. the sum of £ 800 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 12th day of February 2016

**Teresa Perks
For the Registrar
The Comptroller - General**