

O-135-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2514638  
BY TIK TIK LTD TO REGISTER  
A TRADE MARK IN CLASS 14**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 100159 BY EDWARD PLATTS**

## BACKGROUND

1. On 27 April 2009, Raj Sedha applied to register the word **smiths** as a trade mark for the following goods in class 14: "Watches and clocks". The application was accepted and published for opposition purposes on 18 December 2009 in Trade Marks Journal No.6816.

2. On 16 February 2010, Edward Platts filed a notice of opposition which consisted of grounds based upon sections 3(6), 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). Mr Platts indicates that his opposition is directed against all of the goods in the application for registration. For the grounds based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act, Mr Platts relies upon one earlier national trade mark registration:

Trade Mark	No.	Application date	Registration date	Goods
SMITHS	2507183	26.01.2009	8.05.2009	14 - Watches and clocks of mechanical, electrical and electronic operation including horological and chronometric instruments

3. In his statement of grounds Mr Platts explains, inter alia, the basis of his opposition under section 3(6) of the Act i.e. that having contacted him regarding his registration before filing the application in suit, Mr Sedha's conduct in filing the application was, in Mr Platts' view, contrary "to normally accepted standards of honest conduct". I also note that on 4 November 2010 a Form TM16 was filed to assign the application from Mr Sedha to Tik Tik Ltd (hereafter "TT"), the TM16 indicating that TT took over ownership of the trade mark on 28 April 2009. While Mr Platts took issue with this assignment, for reasons which will become obvious it is not necessary for me to comment on either of these issues any further.

4. On 23 April 2010, Mr Sedha filed a counterstatement which consisted of a denial of the grounds upon which the opposition had been brought. The core of Mr Sedha's argument can be seen in paragraph 10 of his counterstatement when he says:

"The Applicant challenges the Opponent's statement that its trade mark No. 2507183 is an "earlier mark" as defined in section 6(1) Trade Marks Act 1994. In contrast, because of the prior use of the trade mark SMITHS, the Applicant claims that its mark is the "earlier mark"..."

5. I note that in their notices of opposition and counterstatement the parties indicated they wanted a Preliminary Indication (based upon sections 5(1) and 5(2) of the Act) to be issued. In an official letter dated 12 May 2010 the Case Work Examiner (CWE) responded to this request in the following terms:

“Having reviewed the pleadings the Hearing Officer does not, given the comments in paragraph 5 of Tribunal Practice Notice 4 of 2009 (a copy of which is attached), think a Preliminary Indication is appropriate.”

6. In the same official letter the CWE set a timetable for the filing of evidence. Both parties filed documents which they respectively described as: “Opponent evidence and submissions in reply”, “Applicant’s evidence and submissions” and “Opponent evidence in reply and submissions in reply”. The filing of evidence in trade mark proceedings is governed by section 69 of the Act and rule 64 of the Trade Marks Rules 2008 the relevant parts of which read as follows:

#### Section 69

“69. Provision may be made by rules-

(a) as to the giving of evidence in proceedings before the registrar under this Act by affidavit or statutory declaration;

(b)...

(c)...”

#### Rule 64

“64.—(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

(a) by witness statement, affidavit, statutory declaration; or

(b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

(a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and

(b) shall be dated and signed by—

(i) in the case of a witness statement, the maker of the statement,

(ii) in any other case, the party or legal representative of such party.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6)..."

7. The comments contained in Tribunal Practice Notice 5/2004 are also relevant and read:

"Before the registrar, in inter partes proceedings, there continues to be a practice of combining factual statements and submissions or arguments in the 'evidence' filed by the parties to the dispute. In ACADEMY (O/169/00) Mr Simon Thorley, acting as the Appointed Person said:

"It is as important in proceedings before the Registry as in any other proceedings that a proper line is drawn between that which is truly evidence, which should be the subject of a properly prepared affidavit, statutory declaration or witness statement as the case may be, and submissions or arguments in relation to the matter in dispute which need not. To allow the two to be present in the same document is bound to lead to confusion and misunderstanding."

8. It is clear from the headings of both parties' documents mentioned above that it was their intentions to file a mixture of both evidence and submissions; attached to both parties' documents are a range of exhibits. Those parts of the documents which contained evidence (and the exhibits to which this evidence relates) should, as Mr Thorley pointed out, have been the subject of, for example, a properly filed witness statement; they were not. While, for the reasons given below, these failures have no impact on the proceedings before me (it is not necessary for me to refer to the documents filed), the parties may need to reconsider the status of these documents in the event of any appeal against my decision.

9. Neither party asked to be heard, nor did they file written submissions in lieu of a hearing.

## **DECISION**

10. The opposition is based upon, inter alia, sections 5(1), 5(2)(a) and 5(2)(b) of the Act. These read as follows:

"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) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

11. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“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) References 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.”

12. Mr Platts’ registration is an earlier trade mark and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004, as it had not been registered for five years at the time of the publication of TT’s trade mark application.

13. I turn first to the objection based upon section 5(1) of the Act. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA* [2003] FSR 34, the ECJ said in relation to what constitutes an identical trade mark:

“51 There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

52 However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of

goods or services in question (see, to that effect, Case C-342/97 Lloyd Schuhfabrik Meyer [1999] E.C.R. I-3819 at para.[26]).

53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

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.”

### **Comparison of trade marks**

14. The respective trade marks at issue in these proceedings are the words **SMITHS** and **smiths** presented in upper case and lower case. In their counterstatement TT say of the comparison of trade marks:

“Paragraphs 14 to 20 of the Opponent’s statement of grounds are agreed in principle but denied insofar as the Opponent’s mark is described as the earlier mark.”

15. I note that paragraph 17 of Mr Platts’ statement of grounds reads:

“17. The Sedha application is for a mark which is identical to the earlier mark.”

Having applied the test in *Sadas* to the competing trade marks, I agree with the parties that the word **SMITHS** should be considered identical to the word **smiths**.

### **Comparison of goods**

16. The specification of Mr Platts’ registration reads: “watches and clocks of mechanical, electrical and electronic operation including horological and chronometric instruments” whereas the specification of TT’s application reads: “watches and clocks”. The goods are clearly identical and TT admits as much in their counterstatement.

17. So, the competing trade marks are identical as are the goods; ordinarily that would be an end of the matter. However, I must also deal with TT’s argument that they have “prior use” of their SMITHS trade mark and, in effect, an earlier right. In paragraph 5 above I noted that the CWE indicated to the parties (before any evidence was filed) that a Hearing Officer had declined to issue a Preliminary Indication in these proceedings in view of the comments contained in paragraph 5 of Tribunal Practice Notice 4 of 2009. This 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.”** (my emphasis)

18. A review of the trade marks register at the time of writing this decision confirms that no action has been taken by TT (or anyone else for that matter) to invalidate the registration upon which Mr Platts relies in these proceedings.

**Conclusion**

19. In view of my conclusions at paragraphs 15 and 16 above, Mr Platts’ opposition based upon section 5(1) of the Act must succeed, and it is unnecessary therefore for me to consider the other grounds of opposition any further.

**Costs**

20. As Mr Platts has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, and bearing in mind that the “evidence” filed by both parties was, in the context of these proceedings irrelevant, I award costs to Mr Platts on the following basis:

Preparing a statement and considering the other side’s statement:	£400
Official fee:	£200
<b>Total:</b>	<b>£600</b>

21. I order Tik Tik Ltd to pay to Edward Platts the sum of **£600**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15 day of April 2011**

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