

O-408-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATIONS UNDER NOS 501289 AND 501290 BY
MICHAEL WHITBY

TO CANCEL REGISTRATION NOS 3138366 AND 3137873 IN THE NAMES OF
MARTIN VAUGHAN AND LADY DOROTHY BROOKE

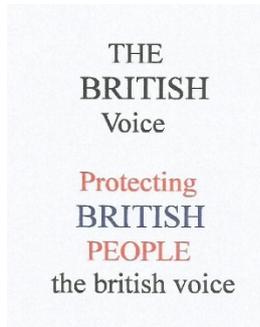
Background

1. This decision relates to applications to cancel two trade mark registrations. The proceedings have been long and convoluted. Neither party has had the benefit of legal representation before the registrar. Both have filed copious amounts of correspondence and documentation with sometimes scant regard to the procedures and timescales set out in the relevant legislation and practice or the issues to be determined. There are indications in the correspondence that one or other party has, at times, refused to copy all material to the other or has refused to accept the receipt of correspondence and documentation sent to it by the other. The parties are well-known to each other. It appears that the applicant and the two registered proprietors were, at one point at least, members of the same political party. At some point they left that party and helped found a new party registered by the Electoral Commission as The British Voice. Indeed, the evidence shows that Mr Whitby and Mr Vaughan were signatories on the form by which that registration was sought. It is clear that the relationship between them later broke down. Both parties have made various accusations against the other including some of serious, criminal behaviour. They have also been opposing parties in various actions before the Courts and Nominet. During the course of the proceedings, the Registrar appointed a Case Management Conference which was intended to assist them and the registrar, but despite them having initially agreed to attend, they later refused to do so. All of this is wholly unsatisfactory and has added to the delays in reaching a conclusion in these proceedings.

2. Whatever else may have ensued between the parties, the only issues before me are the applications (now consolidated) made under the provisions of section 47(2)(b) of the Trade Marks Act 1994 (“the Act”) to cancel the trade mark registrations. His original applications not having been admitted, amended applications were filed by Michael Whitby (“the applicant”) seeking cancellation, by way of declarations of invalidation, of two registered trade marks standing in the name of Martin Vaughan and Lady Dorothy Brooke (“the registered proprietors”). Details of the two registered trade marks are as follows:

(1)

No 3138366



Filing date: 29 November 2015

Date of entry in register: 26 February 2016

(2)

No 3137873



Filing date: 25 November 2015

Date of entry in register: 26 February 2016

3. Both marks are registered for a very large number of goods and services in classes 16, 36, 41 though it is not necessary that I set them out here.

4. In each case, the applications rely on a single ground under section 5(4)(a) of the Trade Marks Act 1994 ("the Act") on the basis of passing off, this being the only ground specified in the Forms TM26(i) and accompanying statement of grounds by which these proceedings were launched. In respect of the first registration, the applicant claims there is an earlier unregistered right in the following mark, used

throughout the UK since 15 October 2014:

THE BRITISH VOICE

Protecting BRITISH People

5. In respect of the second registration, the applicant claims there is an earlier unregistered right in a mark which appears identical to it. He claims this earlier right has been used throughout the UK since 9 December 2014.

6. The registered proprietors filed counterstatements in each case. Again, the originals were not admitted into the proceedings and amended ones were filed. It is sufficient to say they seek to defend their registered trade marks and seek rejection of the applications for cancellation.

7. Neither party sought to be heard and I therefore give this decision after a careful review of all the papers on file and taking the evidence filed and submissions made by both parties into account as appropriate. Much of this material refers to matters not in issue in these proceedings, such as matters of whether the registered proprietors acted in bad faith in applying for the registrations. Furthermore, the witness statements filed contain much which is, more properly, submission rather than evidence of fact. For these reasons I do intend to provide a summary of it here but I will refer to it as appropriate in this decision. That said, I record that the following witness statements were filed:

Applicant's evidence

Witness statements of:

Michael Whitby (1st witness statement)

Susan Whitby

Barry Longstaffe

Joseph Finnie

Paul Lloyd

Leslie Ingram

Geoff Foreman

Peter Clayton

William Kimmet

Alwyn Deacon

Alec Garner

Michael Whitby (2nd witness statement)

Registered Proprietors' evidence

Witness statement of:

Martin Vaughan and Lady Dorothy Brooke

Decision

8. Applications for cancellation of a registration by way of invalidation actions are provided for in section 47 of the Act which states:

“47. - (1) ...

(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,

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

...

(3) An application for a declaration of invalidity may be made by any person, and may be made either 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.

(4) ...

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

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

9. As stated above, these applications were launched on the basis of a claim under section 5(4)(a) of the Act. The relevant parts state:

“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.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.”

10. Whilst section 47(3) of the Act indicates that “any person” may make an application for a declaration for invalidity, section 5(4) of the Act qualifies this and sets out that the applicant must be “entitled” as being “the proprietor” of an earlier right. The Trade Marks (Relative Grounds) Order 2007 clarifies the position.

Regulation 5 states:

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

(2) Those persons are-

(a)...

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

11. The applications the subject of this decision, are applications made under the provisions of section 47(2)(b) of the Act. It is therefore necessary for the applications to have been made by the proprietor of the earlier rights relied upon.

12. In the “Explanatory notes” attached to the Forms TM26(i), Mr Whitby claims:

“As the Chairman/proprietor of our organisation and creator of virtually all aspects of the prior unregistered trade mark rights...I am the person thus entitled to prevent the use of the trade mark”.

13. I disagree. The applications have been made by Michael Whitby in his own (sole) name. He makes no claim to be the proprietor of the earlier rights relied on.

Referring again to the “Explanatory notes” accompanying his applications, Mr Whitby makes the claim that he is the founder and chairman of The British Voice which is “the legitimate owner” of the earlier rights relied upon. Mr Whitby has filed two witness statements (the second of these filed in reply to that of the registered proprietors). In his first witness statement (and repeated in similar terms in his second) he states:

“I have never stated that the trade marks belong to ME. Although I conceived, devised, created and designed virtually all of them, they belong to the members of THE BRITISH VOICE. Ownership of everything I have created for our organisation rests with the members of THE BRITISH VOICE”.

14. I take note that at TBV1A Mr Whitby exhibits a copy of a letter he sent to himself. Dated 15 October 2014, it has the heading “to whom it may concern” and states:

“This is to certify that all of the details concerning THE BRITISH VOICE, including ideas, policies, artwork, design and everything pertaining to that organisation, which was created by Mike Whitby, is the property of the members of said organisation, which will be inaugurated on the 29th November 2014.

Until such date or later, if the inauguration is deferred, this letter and the documents enclosed in this UNOPENED letter, remain the property of Mike Whitby.”

15. It is clear from Mr Whitby’s (unchallenged) evidence that the inauguration did take place, with the inaugural conference being held on 30 November 2014 (see TBV3A-P and the witness statements of Messrs Whitby, Longstaffe, Lloyd, Ingram and Clayton). The evidence shows that the Electoral Commission registered The British Voice as a political party in a decision dated 24 February 2015 and confirmed that decision in an email sent by it on 4 March 2015 (see TBV5N and O). Whatever his role within the party, the applications for cancellation were filed, as I have already indicated, in the name of Mr Whitby alone. Even were I to consider his claim that he is entitled to prevent the use of the trade marks on behalf of the party (which I am not), there is no evidence to support this. On the contrary, attached to his witness statement, at TBV5L, Mr Whitby exhibits a copy of a document headed “THE BRITISH VOICE-Constitution”. The one page document does not set out the structure or roles of individuals within the party but does include the following:

“Our movement involves many members / officers who are democratically elected by our members and are based in Regions throughout the British

Isles, all of whom are unpaid volunteers, with responsibilities but no power.”
(my emphasis).

16. On his own evidence, Mr Whitby is not the proprietor of the earlier rights on which he seeks to rely. In view of this, I find that Mr Whitby is not a person entitled to prevent the use of the trade marks by virtue of the law of passing off. That being the case, Mr Whitby’s applications for declarations of invalidity fail.

Summary

17. The applications for cancellation fail in their entirety.

Costs

18. On 6 December 2017, the registrar wrote to the parties. Included within that letter was the following:

“If you intend to make a request for an award of costs please complete and return, within 14 days from the date of this letter, the attached pro-forma. If the pro-forma is not completed and returned, no costs, other than official fees arising from the action and paid by the successful party (but not including extensions of time), will be awarded. Any request must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs.”

19. The registered proprietors are the successful party in these proceedings but did not complete and return the pro-forma. They did not incur any official fees arising from these proceedings. That being the case, I make no award of costs in their favour.

Dated this 04th day of July 2018

Ann Corbett

For the Registrar