

O/0355/23

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION 913406343

IN THE NAME OF FORMOSAN IP

AND

APPLICATION 504166 BY DANJAQ, LLC

AND METRO-GOLDWYN-MAYER STUDIOS, INC.

FOR THE INVALIDATION OF THE TRADE MARK 'SHAKEN, NOT STIRRED'

Background and pleadings

1. On 3rd March 2023, I issued a provisional decision in these invalidation proceedings¹ in which I held that:

“70. The ground for invalidation based on the applicants’ allegation that the registered proprietor applied to register the mark in bad faith, has failed.

71. The section 3(1)(b) and (c) based grounds for invalidation have failed in respect of the following goods/services:

Class 30: Cocoa and substitutes therefor.

Class 32: Beer and brewery products.

Class 43: Provision of food.

72. I am minded to decide that the section 3(1)(b) and (c) based grounds for invalidation succeed in respect of the remaining goods/services for which the contested mark is registered, including tea.

73. Given the dissolution of the registered proprietor and the consequential vesting (temporary or otherwise) of the company’s assets in the Crown, the Government Legal Service will be advised of this provisional decision and given 28 days to indicate whether the Crown wishes to intervene to defend the trade mark against partial invalidation.

74. I will issue a further final decision once this becomes clear and, if the Crown intervenes, I have considered any submissions made on behalf of the Crown (and given the applicants an opportunity to make submissions in reply).

75. I will deal with costs in my final decision. As things stand, I am minded to direct that each side bear its own costs.”

¹ BL O/0119/23

2. The Government Legal Service was notified of the provisional decision on 6th March and given 28 days to indicate if the Crown wished to make an application to intervene in the proceedings and take over the defence of the trade mark.

3. No such application has been made.

4. Accordingly, my provisional decisions become final.

5. This means that trade mark 913406343 is declared partially invalid. The registration of the mark will be cancelled, except in relation to:

Class 30: Cocoa and substitutes therefor.

Class 32: Beer and brewery products.

Class 43: Provision of food.

6. I direct that each side bears its own costs.

7. As this is a final decision the period for appeal will commence from the date shown below.

Dated this 12th day of April 2023

Allan James
For the Registrar