

IN THE MATTER OF APPLICATION No 9278
BY ANDREW J GRIFFITHS FOR A
DECLARATION OF INVALIDITY

IN RESPECT OF TRADE MARK NO 2000023
STANDING IN THE NAME OF
CLIFFORD GWYN EVANS

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 9278
BY ANDREW J GRIFFITHS
5 FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK No 2000023
STANDING IN THE NAME OF
CLIFFORD GWYN EVANS

10 **DECISION**

Trade mark registration No 2000023 covers “machine tools; motors and engines (except for land
15 vehicles); machine coupling and transmission components (except for land vehicles)” in class 7.

The registration with effect from 1st November 1994, is in the name of Mr Clifford Gwyn Evans.
The mark itself is as follows:



30 By an application dated 6th November 1996 Andrew J Griffiths applied for a Declaration of
Invalidity under the provisions of Section 47 of the Act. The grounds are:

35 i) The registered trade mark was not at any material time capable of distinguishing
the proprietor’s goods from those of other undertakings and is devoid of any
distinctive character, and does not therefore meet the requirements of Section
3(1)(a) and (b)

40 ii) The registered trade mark consists of the prefix AGR. which is common to the
trade for ANDREW GRIFFITHS RACING which is the generic term for the
product, whence its continued existence as a registered trade mark is contrary to
Section 3(1)(d)

45 iii) That the registered trade mark has not been used to an extent to have acquired
a distinctive character, and should be declared invalid under Section 47(1)

iv) Use of the mark by Clifford G Evans was intended to and did deceive the
public.

v) By a High Court injunction dated 15th December 1994 and granted by Consent, Clifford G Evans agreed to be bound by the Order not to advertise, offer for sale or sell any goods marked with the logo AGR. or otherwise use the logo AGR.

5 vi) The original logo was designed by Andrew J Griffiths in 1991 when it was first printed and since that time appeared in the trade continuously. The logo was redesigned and updated by Andrew J Griffiths in September 1993.

10 vii) An unsigned partnership between Andrew J Griffiths and Clifford G Evans was entered into between December 1993 and September 1994.

viii) Artwork was supplied to Clifford G Evans in December 1993 in good faith for printing and general use within the partnership.

15 ix) The name AGR. has existed since 1990 and documented since 1991, the letters standing for Andrew Griffiths Racing.

The registered proprietor failed to file a counterstatement but subsequently responded when informed of a request for an extension of time to file evidence in chief by the applicant. In his
20 letter Mr Evans stated that the mark referred to in the Registry's earlier correspondence regarding the opposition was not the mark registered in his name. This statement is correct in that whilst the Registry used the correct number, the earlier letters, including the letter copying the Application for a Declaration of Invalidity to the proprietor referred to "ACR MODIFIED WORKS TEAM SPEC 5.0". However the mark is a logo and the stylised letters can be read two ways.

25 Given the nature of the mark and the highly unusual wording used I do not believe that Mr Evans could have been in any doubt that the Registry was referring to the mark registered under his name. The first letter from the Registry contained a copy of the form TM26 filed by Mr Griffiths (his ex-partner) and all of the Registry's letters referred to the correct registration number
30 2000023.

I therefore take the view that Mr Evans should have been aware that the Registry was referring to trade mark number 2000023 registered in his name and his failure to submit a counterstatement did not result from ignorance of the attack on his registration.

35 **APPLICANT'S EVIDENCE**

The applicant filed a statutory declaration dated 23rd September 1997, Exhibit 1 of which is an affidavit sworn by Mr Griffiths in December 1994 in relation to the earlier proceedings in the High
40 Court between himself and Mr Evans.

In this affidavit the applicant gives a history of how he came to set up his company as the result of being unhappy with the electric motors he was purchasing to use in his model race cars. The applicant began to create his own electric motors in 1992, and says that within months their
45 performance led others to seek to purchase his creations, sold under a logo (a stylised version of AGR) designed in December 1991 / January 1992 (Fig 1 below).

Shortly after he gave up racing himself and became a technical adviser to others, even creating his own team. Following abortive merger discussions with a limited company, during the summer

of 1993, the applicant was introduced to Mr Evans and a verbal partnership was entered into in October 1993. The applicant designed a new form of the logo which incorporated the primary features of the 1991/2 logo(Fig 2 below) . The dominant feature of the new logo still being the stylised letters “AGR”. Due to disagreements over quality and the philosophy of the partnership Mr Griffiths decided to end the partnership. During two meetings with Mr Evans, on 7 September 1994 and 14 September 1994, it was agreed to dissolve the partnership. Mr Griffiths states that at these meetings and subsequently in a number of letters he made clear his intention to continue trading using the name “AGR Model Technology”. When it became apparent that Mr Evans was continuing to trade using the logo and “AGR” initials, Mr Griffiths sought an injunction to prevent Mr Evans passing off.

Exhibit 2 to Mr Griffiths declaration is the Order made by the High Court. It records that Mr Evans had given an undertaking to cease using “the name AGR Model Technology or the AGR logo”. This Order is dated 15th December 1994. On this basis the proceedings were stayed by consent.

The registered proprietor did not file any evidence in these proceedings.

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

FIG 1.



FIG 2



DECISION

The applicant states in the first ground for invalidity that the mark offends against Section 3(1)(a) which states:

“The following shall not be registered - signs which do not satisfy the requirements of section (1).”

Section 1 states:

“In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

Each trade mark must be considered on its own merits for the purposes of determining whether

it meets the criteria in Section 1(1). The applicant has not shown why this particular trade mark is incapable of distinguishing. Consequently the application under Section 1(1) and 3(1) (a) fails.

5 The applicant also claims that the Registered Proprietor's mark offends against Section 3(1)(b) which states:

“The following shall not be registered - trade marks which are devoid of any distinctive character”.

10 It does not necessarily follow that because a mark is regarded as being “capable of distinguishing” under section 3(1) that it is “distinctive” for the purposes of Section 3(1) (b). The registered mark consists of the stylised letters “AGR” on a background which is approx. 60% solid black with the other 40% being black and white chequered (reminiscent of the chequered flag at motor racing meetings) with the words “Works Team Spec” written across the initials “AGR” and finally the words “modified 5.0” printed sideways on. The letters “AGR” obviously
15 are significant as they are the initials of Andrew Griffiths Racing. Guidance on the meaning of Section 3(1)(b) was provided by Jacob.J. in *British Sugar Plc v James Robertson and Sons Limited (TREAT)* 1996 RPC.281, he asked rhetorically -

20 *“What does devoid of any distinctive character mean?”*

To which his answer was -

25 *“I think the phrase required consideration of the mark on its own assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”*

30 In my opinion, the logo mark in question is easily identifiable as a trade mark and the public would not need to be educated to recognise it as a mark. Further, the applicant has not shown why the mark as a whole is devoid of any distinctive character. Consequently, the application under this heading also fails.

I next consider the ground for invalidity under Section 3(1)(d) which is as follows:

35 *“Trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”*

40 The applicant claims that the prefix AGR “is common to the trade for Andrew Griffiths Racing which is a generic term”. I note that the applicant is not represented by a trade mark professional and has therefore, I believe, misunderstood the meaning of this section. It is intended to cover the use of marks such as “stars” for hotels which, when it first appeared, could have deemed as a trade mark but is now a generic device for all such establishments. The application under this heading
45 fails.

I next consider points 5 & 7 of the Application for Invalidity which relate to Section 5(4)(a) which in so far as it is relevant to the pleadings is as follows:

50 *“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

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(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

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In deciding whether the two marks are similar I rely on the decision of the Appointed Person Mr Geoffrey Hobbs QC in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

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“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.

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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 Erven Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is (with footnotes omitted) as follows:”

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

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(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

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(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

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(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’.

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

5 *‘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:*

10 *(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

15 *(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.*

20 *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:

25 *(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;

30 *(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

35 *(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.*

40 *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.”*

Utilising the same test and applying it to this case, I consider the two marks in their entirety but bear in mind their dominant features and how they would be perceived by the average consumer. I am content that at the relevant date the mark originally used by Mr Griffiths (fig 1) had acquired
45 considerable goodwill and reputation in the relevant market and that the distinguishing feature that characterised that goodwill was the AGR logo. The evidence filed shows numerous references to AGR motors achieving success in various races and there are also photos of Mr Griffiths showing him wearing clothing with version 1 of the logo emblazoned on the front and with captions such as “Andrew Griffiths of AGR motors”.
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The registered proprietor has not filed a counterstatement or any evidence that challenges Mr Griffiths' evidence that the goodwill associated with the business remained his property at all material times.

5 I then move onto the question as to whether use of the registered mark by the registered proprietor would cause the relevant public to come to the conclusion that the goods supplied were sourced from Mr Griffiths with resulting damage to his goodwill.

10 There can be little doubt that the dominant characteristic of the registered mark is the same as that originally used, by Mr Griffiths, the stylised letters "AGR". The slight change from a single colour background to one which is partly solid black and partly black and white chequered is not significant in affecting the dominant feature which the average consumer will remember. The deletion of the "Lightening strike" would not, in my view, be particularly noted by the purchaser as such devices are common place on packaging. Similarly the additional words "works team spec
15 5.0 modified" would, I believe be taken to refer to simply another version of electric motor from the same source.

20 It is my opinion that any member of the relevant public offered goods by the Registered Proprietor using the registered mark would be deceived into believing that the goods were from or connected to the applicant. As such if the goods supplied were inferior in any respect to the goods on offer from the applicant, then the applicant's reputation would suffer, as would his sales. I therefore find that the applicant succeeds under Section 5 (4)(a).

25 This decision is reinforced by the outcome of the High Court case between the parties. In deciding not to contest the injunction sought by Mr Griffiths, and in giving the court an undertaking, Mr Evans chose not to contest Mr Griffiths' action for passing off. I also note that he has decided not to contest this Request for Declaration of Invalidity.

30 I next consider the ground of application made at points 6 & 9 which both refer to Section 3(6) which is as follows:

"A trade mark shall not be registered if or to the extent that the application is made in bad faith".

35 I have already considered the two marks and found them to be similar and the goods to be identical. It is also clear that the registered proprietor knew that the applicant had used his version of the mark (fig 1) prior to the partnership. In providing an undertaking to the court not to use the name AGR or the AGR logo, Mr Evans appears to have accepted that he had no right to use the
40 mark at 15 December 1994.

45 The Court Order was dated only six weeks after Mr Evans filed for registration of the trade mark logo which was the subject of the Court Order. Given this very short time span it is difficult to see that the circumstances could have altered so significantly that, at the time of filing the application with the Registry, Mr Evans was acting in good faith. Accordingly I find that Trade Mark No 2000023 was registered in bad faith contrary to Section 3(6) of the Act.

I direct that Registration No 2000023 be declared invalid and removed from the Register and, in accordance with Section 47(6), shall be deemed never to have been made.

As the applicant has been successful, he is entitled to a contribution towards his costs. I order the Registered Proprietor, Mr Evans, to pay him the sum of £500

Dated this 27th day of October 1998

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**George W Salthouse
For the Registrar
The Comptroller General**

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