

O-083-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2526920
BY
CURB MEDIA LIMITED
TO REGISTER THE TRADE MARK**

CURB

IN CLASS 35

AND

**THE OPPOSITION THERETO
UNDER NO 10084
BY
MIKE CURB**

Trade Marks Act 1994

**In the matter of application 2526920
by Curb Media Limited
to register the trade mark:**

CURB

**in class 35
and the opposition thereto
under no 100084
by Mike Curb**

1. On 23 September 2009, Curb Media Limited (hereafter 'Limited') applied to register the above trade mark. The application was made for the following services which are in class 35¹:

Class 35: Advertising, marketing and publicity; market research; public relations services; advice relating to branding and brand development; auctioneering services; purchasing services; dissemination of advertising, marketing and publicity materials; business organisation, business administration and business management of retail outlets, business centres and car parks; business and management consultancy, assistance and advice; accountancy and auditing; data processing services; compilation of data and directories; retail services connected with the sale of apparel, and of goods relating to fashion, beauty, health, fitness and well being; purchasing and demonstration of goods for others; advice and consultancy relating to all the aforesaid services; including (but not limited to) all the aforesaid services provided online, and by way of the Internet, the world wide web, mobile telephone and/or via communications networks.

2. The application was published in the *Trade Marks Journal* on 30 October 2009. Mike Curb filed notice of opposition to the trade mark application, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Section 5(2)(b) of the Act states:

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

¹ As per the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

....

(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.”

3. Mr Curb relies upon a single earlier Community trade mark (“CTM”) to oppose all the services of the application, as follows:

1508316 CURB

Application date: 15 February 2000

Completion of registration procedure: 20 March 2002

Class 35: Advertising; business management; business administration; office functions; computer database services; computerized on-line ordering and selling services in the field of music and entertainment; advertising via an online electronic communications network.

4. Mr Curb’s trade mark completed its registration procedure on 20 March 2002, which is more than five years before the date on which Limited’s application was published in the *Trade Marks Journal*. Mr Curb’s mark is therefore an earlier trade mark which is subject to the proof of use provisions². He has made a statement of use in his notice of opposition in respect of all the services he relies upon.

5. Limited filed a counterstatement, putting Mr Curb to proof of use in relation to his earlier mark. Only Mr Curb filed evidence. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. In making my decision, I have taken into account Mr Curb’s evidence and the parties’ written submissions filed in lieu of a hearing.

Mr Curb’s evidence

6. This comprises a witness statement and exhibits from Mr Mike Curb, of Nashville, United States of America. He states that the evidence comes from his own knowledge and/or from the records of Curb Records Limited and/or Curb Records, Inc, to which he has full access. Mr Curb states that he is a musician and founder of Curb Records, Inc, an independent record label. He founded his first record company, Sidewalk Records, in the 1960s, launching the careers of

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

popular music artists and also assisting to create musical scores for films. In 1969, Mr Curb merged his record company with MGM; he became President of MGM Records and Verve Records. Mr Curb states that during his career he has composed or supervised over fifty motion picture soundtracks and wrote over four hundred songs. In the 1970s, Mr Curb wrote for and produced Roy Orbison, the Osmond family, Lou Rawls, Sammy Davis Jr., and Solomon Burke. He also signed artists such as the Sylvers, Eric Burdon, War, Richie Havens, the Five Man Electrical Band, Gloria Gaynor, Jonny Bristol, Exile and The Four Seasons. After the sale of MGM and Verve in 1974, Mr Curb states that he proceeded to build Curb Records, Inc and the Curb/Warner label, releasing many top-selling singles from the mid to late 1970s. Mr Curb moved the main office of Curb Records, Inc from Los Angeles to Nashville; in the last decade, the names signed to his label has included Wynonna Judd, LeAnn Rimes, Hank Williams, Jr., Hank III, Tim McGraw, Kimberley Locke, Sawyer Brown, Rodney Atkins, Heidi Newfield and Clay Walker.

7. Having established Curb Records, Inc as a presence in both Nashville and Los Angeles, Mr Curb states that he decided to expand his business to the UK. He created Curb Records Limited in 1999, which is based in London. Mr Curb states that Curb Records Limited's 'stock' is owned by Curb Entertainment International Corporation, an affiliate of Curb Records, Inc, which attends 'film markets' and licences film rights to entities throughout the world, including for use in the UK. Mr Curb states that, according to Curb's³ royalty department, the combined five-year income for physical and digital record sales and licensing in the UK from 2005 to 2009 is just over US\$5,000,000.

8. Mr Curb describes his exhibits as follows (MC1 to 14) (I have made comments, where appropriate):

- Company registration details for Curb Records Limited, incorporated in 1999;
- Listings of albums released in the UK through Curb Records Limited and covers of albums distributed in the UK showing the Curb label. The album listings do not give any dates as to when the albums were released, although I note that CURCD13 SAWYER BROWN is entitled "Greatest Hits 1990-1995. The pictures of the album covers are shown on prints from Amazon.co.uk ("Amazon"), printed on 30 June 2010. These show albums by LeAnn Rimes which can be cross-referenced to the album listings. The dates accorded to the albums on the Amazon prints range from 1998 ("Sittin' on Top of the World") to 2008 ("Whatever We Wanna").

I have been unable to discern the record label Curb (or, indeed, any record label) due to the quality of the prints.

³ It is unclear as to which Curb entity this refers.

- A set of prints from Amazon in relation to an album by Tim McGraw; although printed on 30 June 2010, the description indicates that it was released on 20 October 2009 and the release label was 'Curb Records'. A similar set of prints is shown from hmv.com in respect of 'The Best of LeAnn Rimes', which had a release date of 2 February 2004. The release label is stated as 'Curb'. A print of a search on Amazon is shown with 'The Complete LeAnne Rimes DVD Collection (2006)'; there is also a photocopy of the DVD cover for the DVD collection. This shows, in the positions which would be the back and spine of the DVD case, 'CURB'. Mr Curb states that the DVD also shows third party publishing administration by Curb. This is not explained. A screen print from the itunes website shows the online download details for an album by Wynonna Judd. The album information states that it was released on 3 February 2009 by 'Curb Records, Inc'. Also included is a sales note stating that a Bellamy Brothers record was released through Curb Records on 22 December 2008.
- Three copies of invoices (MS5 to MS7) which Mr Curb describes as:

“Invoice dated 24 July to the attention of Curb Records Limited from Blueprint Management for the promotion and advertising of a recording artist”; “Invoice dated 4th August 2008 to the attention of Curb Records Limited from the Mechanical Copyright Protection Society Ltd for the sales period of April 2008 to June 2008. The Mechanical Copyright Protection Society (MCPS) is a UK organisation which pays royalties to composers, songwriters and music publishers when the music they have created is sold”; “Invoice dated 3rd June 2008 to the attention of Curb Records from 'A.ShoreThing..' for the Public Relations consultancy service in connection with one of Curb's recording artists.” I note that the first invoice says “Please make cheque payable to BLUEPRINT MANAGEMENT”, the second invoice says “Invoice payment should be made to ...MCPS Ltd” and the third invoice says “Payable by Cheque to ANNE SHORE”. These invoices appear to be for services rendered to Curb Records, rather than by Curb Records. The addresses for the three companies raising the invoices are in London.
- A VAT return form for filed by Curb Records dated 28 April 2008 showing that the total value of sales excluding any VAT represents £167,647 for 1 January 2008 to 31 March 2008.
- Copies of licence agreements. The agreements dated 12 January 2009 and 1 June 2009 between Curb Records and Virgin Records Ltd contain Curb's approval for Virgin to use non-exclusively two of Curb's audio recordings (LeAnn Rimes' 'How Do I Live' and the Bellamy Brothers' 'Let Your Love Flow') in the UK and Eire only. This was so that Virgin could include the songs in its 'Love Ballads' and 'Jackie Summer Album'

compilations. The agreements dated 9 January 2009 and 29 October 2009 between Curb Records and Universal Music Operations Ltd contain Curb's approval to use non-exclusively two of Curb's audio recordings; the agreement dated 19 September 2008 between Curb Records and Authentic Media contains a similar approval.

- The final three exhibits are from the social networking websites myspace.com, facebook.com and twitter.com. These are dated 6 July 2010. The 'Curb Music Publishing' profile pages on myspace.com give details of the singer/songwriters signed to Curb Music Publishing. The pages state that Curb Music Publishing has been a myspace.com member since 14 November 2005. Mr Curb describes this exhibit (MC12) as showing that Curb Records advertises and promotes its recording artists and songwriters and that the website would have shown similar information during the relevant period. I note that the pages consistently refer to Curb Music Publishing rather than to Curb Records. The facebook.com profile pages refer to Curb Records, giving the history of Mr Curb's companies already referred to in this evidence summary. Mr Curb states that this exhibit (MS13) shows that Curb Records advertises and promotes its recording artists' tours and album releases by way of the two 'photo albums' created on facebook.com showing that the CURB mark was used in connection with advertising via an online electronic communication network during the relevant period. The details for these two photo albums are as follows:

"Just Jinjer House of Blues Showcase 8-21 by Curb Records 7 photos. Curb Records and our partners at Reprise and Warner Brothers Records had dinner and showcase for Just Jinjer at House of Blues on August 21st. Location: Los Angeles – The Sunset Strip. Created on 27 August 2008";

"Natalie Grant @ R&R Christian Summit by Curb Records 6 photos. Here are pictures from Natalie's performance at the R&R Christian Summit in November 2007. Location: Nashville, TN. Created on 8 January 2008."

The pages from twitter.com are headlined "Get short, timely messages from Curb Records". The pages also say "Get updates via SMS by texting **follow CurbRecords** to **86444** in the United Kingdom". It is difficult to follow the thread of the postings (or 'tweets') which are all dated in July 2009: there appears to be some sort of competition running on Wednesdays where albums are given away if questions about the artist are answered correctly. There are also postings regarding new album releases, videos and artists' profiles.

Decision

Proof of use

9. Section 6(A) of the Trade Marks Act 1994 (“the Act”) states:

- “(1) This section applies where—
- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if—
- (a) within the period of five years ending with the date of publication of the application 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes—
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be

treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

10. In addition to section 6A of the Act, section 100 states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

11. To rely upon its earlier trade mark, Mr Curb has to prove that he has made genuine use of the community trade mark, or that there are proper reasons for non-use, in the relevant period. The relevant period is the five years prior to and ending on the date of publication of the application, i.e. from 31 October 2004 to 30 October 2009, as per section 6A(3) of the Act.

12. Ms Anna Carboni, sitting as the appointed person in *BreadTalk*, O-070-10, summarised a set of principles from the following leading Court of Justice of the European Union (‘CJEU’, formerly the ‘ECJ’) genuine use cases: *Ansul BV v AjaxBrandbeveiliging BV*, Case C-40/01, [2003] ETMR 85 (‘ECJ’); *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR. I gratefully adopt her summary:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

13. Limited has submitted that the use does not demonstrate a commercial, contractual or consensual link between Mike Curb, who is the opponent, and Curb Records Limited, or between Mike Curb and Curb Records, Inc, or between Mike Curb and Curb Entertainment International Corporation. There is also a question over Curb Music Publishing. Genuine use means actual use of the mark by the proprietor or a third party with consent to use the mark (Section 6A(3) and *Ansul*). There is no explicit statement by Mr Curb which clearly shows him giving authority to the commercial entities in the exhibits to use the mark. However, I note the following points from his statement:

- He is the founder of Curb Records, Inc
- He decided to expand what he calls “his business” (i.e. Inc) to the UK and founded Curb Records Limited

- Curb Records Limited's 'stock' is owned by Curb Entertainment International Corporation
- Curb Entertainment International Corporation is affiliated to Curb Records, Inc
- The singers/songwriters signed to Curb Music Publishing appear to release their material via Curb Records (Limited or Inc)
- Mr Curb is the proprietor of the earlier mark
- Mr Curb states "The evidence herein comes from my own knowledge and/or from the records of Curb Records Limited and/or Curb Records [Inc] to which I have full access".

14. Whilst it would have been preferable for Mr Curb to have explained the relationship which he, as the proprietor of the earlier mark, has with the various entities purported to use the mark, it is constructive to look at the picture built by the various facts I have listed. Mr Curb, the proprietor of the mark has full access to the records of Curb Records Limited and Curb Records, Inc. I draw the inference that, as he has full access to the records of Curb Records Limited and Curb Records, Inc, Mr Curb appears to be the common factor between the Curb entities. I consider that (if use is shown) from the facts of this case, the consent⁴ of Mr Curb to the use of the trade mark by Curb Records Limited and Curb Records, Inc can be inferred⁵.

15. I turn next to the requirement that the use must be by way of real commercial exploitation of the mark on the market for the relevant services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market. The services in question are all those relied upon in class 35 for which CTM 1508316 is registered because Mr Curb has made a statement of use in relation to the complete class 35 specification, which is:

⁴ There is no requirement that Mr Curb must have control over the use of the mark: see *EINSTEIN*, Geoffrey Hobbs Q.C. sitting as the appointed person, [2007] R.P.C. 23, and the decision of the registrar *SAFARI* [2002] R.P.C. 23. There are analogies between the present case and *Sunrider Corp. v Office for Harmonization in the Internal Market*, General Court decision T-203/02, as per paragraph 26 of *EINSTEN*: "It seems to have been recognised that the company was 'economically linked' to the trade mark proprietor on the twofold basis that his name featured in the name of the company and he was in a position to produce documents from the company's records relating to its use of his trade mark. There was no evidence of any exercise of control by the proprietor over the quality of the goods sold by the company. The Court none the less found that the necessary element of consent was present."

⁵ See by analogy *Makro Zelfbedieningsgroothandel CV and others v Diesel SpA* Case C-324/08: "35 In the light of the foregoing, the answer to the question referred is that Article 7(1) of Directive 89/104 must be interpreted as meaning that the consent of the proprietor of a trade mark to the marketing of goods bearing that mark carried out directly in the EEA by a third party who has no economic link to that proprietor may be implied, in so far as such consent is to be inferred from facts and circumstances prior to, simultaneous with or subsequent to the placing of the goods on the market in that area which, in the view of the national court, unequivocally demonstrate that the proprietor has renounced his exclusive rights."

Advertising; business management; business administration; office functions; computer database services; computerized on-line ordering and selling services in the field of music and entertainment; advertising via an online electronic communications network.

Advertising; advertising via an online electronic communications network: Mr Curb states that the LeAnn Rimes DVD shows 'third party publishing administration by Curb'; he does not explain what he means by this statement. I assume he is referring to the fact that CURB has arranged for the release of the record; if so, this is at the heart of what record labels do. It does not seem to me that CURB is providing a service to the artist as an independent entity, but that this is part of CURB's business, which would not exist without its signed artists. The position of a signed artist is comparable to that of an employee; the signed artists' records are the record label's products. The social networking exhibits which Mr Curb claims demonstrate advertising are CURB's facebook, myspace and Twitter pages; these are advertising the products which CURB is releasing, i.e. the records of its signed artists. It is advertising its own goods, its own business.

16. Limited has, in relation to the claim to advertising services, drawn attention to the decision of the registrar's hearing officer in *JAMBA*, BL O/369/10, which it submits is analogous with this case. In *JAMBA*, a juice company claimed it had used the mark on advertising services. In fact, it had been advertising its own goods on its website. The hearing officer found:

"Juice may be advertising its business but it is not providing an advertising service that others may avail itself of. Juice may be providing information via a website but it is not providing a communication or telecommunication service itself."

Limited submits that, in Mr Curb's case, the evidence shows that Curb Records has been used in relation to the production of recordings for artists who are signed to the label; Curb Records then sells the records. It does not advertise for others but promotes its own goods as every other business promotes its own goods.

17. In this respect, it is useful to look at Mr Curb's exhibits MS5 to MS7 which are the invoices to Curb Records from BluePrint Management and A.ShoreThing. This means that BluePrint Management and A. ShoreThing are the service providers to Curb Records rather than the other way around. The services which the invoices show that BluePrint Management and A.ShoreThing have provided are "the promotion and advertising of a recording artist" and "Public Relations consultancy service in connection with one of Curb's recording artists". Evidence of third parties billing Curb Records for advertising services is clearly not evidence of Curb Records itself providing advertising services for others. Curb Record's social networking news feeds are advertising its own business.

18. Mr Curb states that the combined five-year income for 'physical and digital record sales and licensing' in the UK from 2005 to 2009 is just over US\$5,000,000. Licensing is not specifically mentioned in Mr Curb's registered list of services and there are no submissions claiming it is as a standalone service on which the mark has been used. Bearing in mind the guidance in *Avnet Incorporated v Isoact Limited* [1998] F.S.R. 16⁶, it is doubtful whether the terms which are listed can be said to encompass 'licensing.' However, even if licensing was considered to be covered by the specification, the evidence which Mr Curb has filed does not support a claim to have used the mark on licensing services, which in class 35 would be licensing services arranged for others. Licensing of intellectual property rights falls in class 45. What Mr Curb has filed in the way of the licensing agreements are copyright licences of his record label's own goods. The licences suffer from the same defects as the exhibits purporting to support a claim to advertising: these are not services of which others may avail themselves: they are part of Curb Records' advancement of its own business.

19. Physical and digital record sales', submits Limited, is evidence of sales of records. I consider that the evidence demonstrates that Curb has been used upon records – it shows up on the Amazon prints in relation to Tim McGraw, LeAnn Rimes and Wynonna Judd. However, audio and video recordings are in class 9. There is no evidence which supports a claim to a service in class 35 which is akin to retail services for the sale of recordings: CURB itself is not used as a mark for providing *computerized on-line ordering and selling services in the field of music and entertainment*. The evidence shows retail services for the audio recordings being provided by Amazon, itunes and HMV, not by Curb Records.

20. There is no evidence at all in relation to *business administration; office functions; computer database services*. There is no specific evidence in relation to *business management*. This term would include business management of performing artists. None of the evidence suggests that a record label provides business management services in the sense that a performing artist has a manager in his or her employ. Record labels produce records as a service (class 41) and as goods (class 9). Like advertising and licensing, the business management of its signed artists is management of its own business.

21. There is no evidence to suggest that the services provided could ever be classed as advertising services or business management services. Mr Curb has not met the tests to satisfy the tribunal that he has made genuine use of his mark or that there are proper reasons for its non-use within the relevant period. The

⁶ Jacob J held: "In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

consequence of this is that Mr Curb has failed to meet the use conditions set out in section 6A(3) of the Act. In accordance with section 6A(2) of the Act, I cannot refuse Limited's application for registration on the basis of Mr Curb's earlier mark because he is not entitled to rely upon his trade mark registration as a basis for opposing Limited's trade mark application. There is, therefore, no need to address the section 5(2)(b) ground of opposition itself. The opposition fails.

Costs

22. Limited has been successful and is entitled to an award of costs on the following basis⁷:

| | |
|--|------|
| Considering the other side's statement and preparing a counterstatement: | £200 |
| Considering and commenting on the other side's evidence: | £600 |
| Total: | £800 |

23. I order Mike Curb to pay Curb Media Limited the sum of £800. 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 28 day of February 2011

**Judi Pike
For the Registrar,
the Comptroller-General**

⁷ As per the scale in Tribunal Practice Notice 4/2007.