

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 10699  
BY DR ROBERT A MOOG  
FOR A DECLARATION OF INVALIDITY  
IN RESPECT OF TRADE MARK REGISTRATION NO. 2056098  
IN THE NAME OF  
ALEXANDER FRANCIS WINTER

## DECISION

1) Trade Mark 2056098 is registered, with effect from 9 February 1996, for a series of two marks as follows:



2) The trade mark is registered in respect of:

“Electronic musical instruments and 1parts and fittings thereof included in Class 15 but not including any such goods incorporating computers or computer software”.

3) By an application dated 26 April 1999, Dr Robert A Moog applied for a declaration of invalidity in respect of this registration. The grounds stated were in summary:

a) The trade name MOOG has, for some twenty-five years been well known in relation to electronic synthesisers. Dr Moog invented the electronic synthesiser in the early 1970's to which the name and trade mark MOOG was applied. MOOG synthesisers were manufactured and marketed for a number of years by an American company, Norlin Industries Inc., under agreement with Dr Moog. Subsequently, Dr Moog assigned his rights in the trade mark MOOG to Norlin Music Inc., but retained the right to use his own name (ROBERT MOOG, BOB MOOG, R.A.MOOG) in connection with his continuing business in relation to the supply of accessories for MOOG synthesisers.

b) Norlin Industries Inc., for a number of years, owned registrations of the trade mark MOOG including in the UK, number 1018178 which expired in 1994. Norlin Industries Inc. subsequently went into receivership in or about 1989. Subsequent to this, some genuine MOOG replacement parts and accessories continued to be manufactured for a while and in early 1995 there was a sale by auction, by the Receiver of a stock of

MOOG parts. As a result, it is the case that even today there are still available within the UK genuine MOOG parts made by or on behalf of Norlin Industries Inc.

c) Accordingly, as at the date of application for registration it is clear that the trade mark MOOG was very well-known, and still in use, in the UK and elsewhere in Europe and in the USA. The proprietor of mark 2056098, Mr A Winter, has at no time acquired any rights to the trade mark MOOG from any of the previous owners of that trade mark. Therefore, at the date of application the mark in suit offended against Sections 3(3)(b) and 3(6).

3) The registered proprietor filed a counterstatement denying all the grounds. The counterstatement also questioned whether any rights arising from the sale of goods by the Receiver accrued to the applicant.

4) Both sides ask for an award of costs in their favour.

5) Only the applicant filed evidence in these proceedings. Neither party wished to be heard. My decision will therefore be based on the pleadings and the evidence filed.

#### APPLICANT'S EVIDENCE

6) The applicant filed five witness statements. The first, dated 20 November 2000, is by Dr Robert A Moog. Dr Moog provides a potted history of the use of the MOOG mark from 1954. He claims that from 1973 - 1984 Moog Music, a division of Norlin Music extensively advertised and sold its products under the MOOG brand. Dr Moog served as the President of Moog Music from 1971 to 1977. In 1978 he left to design, build and sell new electronic instruments which were to be sold under the names R.A.MOOG, ROBERT MOOG and BOB MOOG. In 1984 Norlin Music sold the Moog Music business to two former executives who operated as Moog Electronics. In 1987 Moog Electronics went bankrupt. The company's assets were purchased by an investor group who also offered service and genuine repair parts for Moog Music products.

7) Dr Moog states that Fred McNiff obtained some of the genuine MOOG parts and has sold these from 1991 to the present including in the UK. Dr Moog claims that since 1978 he has written articles and given lectures, demonstrations and workshops on MOOG synthesisers. In addition his name and/or likeness has appeared in advertisements of products designed by him. At exhibits RAM1 are copies of advertisements which appeared in Keyboard magazine between 1995-1996. They relate to a Theremin sold by Big Briar Inc. A number have an image of Dr Moog and most state "Bob Moog says .....". The magazines are clearly produced for the American market.

8) At exhibit RAM2 Dr Moog provides copies of nine advertisements that appeared in Electronic Musician during the years 1995-1996. These are similar to those at exhibit RAM1, featuring an image of Dr Moog and the words "Bob Moog says..." and again relate to products sold by Big Briar Inc. None of the products are called or marked "Moog".

9) Dr Moog states that in July 1994 he presided over the opening of the Museum of Synthesizer Technology in Hertfordshire, an event, he says, widely publicised in the UK. At exhibit RAM3 are pages from a book published for the museum's opening which gives the

history of the synthesizer and Dr Moog's role in designing and developing such machines.

10) Lastly Dr Moog states that in the February issue of Keyboard magazine he featured in an article "depicting me as being intimately associated with MOOG synthesizers. Keyboard magazine is widely read by musicians throughout the English speaking world." A copy is provided at exhibit RAM4. This shows prices in US\$, Canadian\$ and UK£. The article is basically a history of Dr Moog's life but dealing mainly with events in the early 70's.

11) The second statement, dated 21 November 2000, is by Fred McNiff. He explains that he was the general manager of all Moog Music activities until 1991 when the business ceased operations and he purchased a "sizeable inventory of Moog Music replacement parts". He states that virtually all the parts purchased were branded with the MOOG name either on them or on the packaging. Since 1991 he has been selling these parts. At exhibit FM1 he provides copies of an order and invoice to an individual in the UK, dated February 1998. Also included in the exhibit is a letter, dated 8 May 1997, from the UK enquiring about the costs and availability of parts.

12) The third statement, dated 8 September 2000, is by Peter Russell Forrest. Mr Forrest is the person who ordered goods from Mr McNiff. He states that for the last fifteen years he has run a musical recording studio, specialising particularly in electrical and electronic instruments. Mr Forrest claims that as a result of his activities he has acquired a significant knowledge of synthesizers and has written an encyclopaedia on the subject. He states that Dr Moog "is the best known name in the industry".

13) Mr Forrest gives his opinion that at the date of application of the instant mark, 9 February 1996, the trade mark MOOG "was very well known in the UK and indeed there would have been available in the UK genuine MOOG spare parts, made (I believe) by Norlin Music. Indeed, I believe it to be the case that such genuine MOOG spare parts may still be available in the market place to the present day". He states that it is his opinion that the mark MOOG would signify a connection with Norlin Music or Bob Moog.

14) The fourth statement, dated 23 November 2000, is by Richard Nigel Harley Callaghan, the applicant's Trade Mark Attorney. At exhibit RNHC1 he provides a print out from the Registry database of trade mark registration 1018178 which expired in 1994 due to non-renewal. This shows the proprietor as being ECL Industries Inc. He also provides a copy of a printout from the Marquesa database which shows that at the time the registration lapsed it was in the name of Norlin Industries Inc. (of the same address as ECL Industries Inc.) and which was later amended to show the new proprietor as ECL Industries Inc. even though the registration had lapsed. Mr Callaghan does not draw any conclusions from this evidence.

15) The fifth statement, dated 22 November 2000, is by Kanwaldeep Dulay. He states that he has been interested in electronic synthesizers for many years and in 1991 bought a MOOG synthesiser. He states that in his opinion anyone seeing the name MOOG on a synthesiser would associate the product with Dr Moog. He states that since 1991 he has periodically obtained MOOG spares from Mr McNiff in the USA.

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

## DECISION

17) The first ground of opposition is under Section 3(3)(b) which reads:

- “(3) A trade mark shall not be registered if it is -*
- (a) .....*
  - (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”*

18) The applicant claims that the registered proprietor of the mark in suit, Mr Winter, had not acquired the rights to the mark MOOG from any of the previous owners of the mark. By this I assume that they contend that the registered proprietor’s mark is likely to deceive the public into thinking that the proprietor’s goods originate from either the applicant or another previous owner of the mark in suit. However, I note that Section 3(3)(b) is intended to apply where the deception alleged arises from the nature of the mark itself and not who owns it. This is consistent with the heading of Section 3 of the Act which is entitled “Absolute grounds for refusal” and is to be contrasted with Section 5 of the Act which deals with the “Relative” rights of the applicant and other parties. Consequently, the applicant cannot succeed under this heading based upon ownership of the mark in suit. The ground of invalidity based upon Section 3(3)(b) therefore fails.

19) I believe that the applicant was really seeking to apply for invalidity under Section 5(4)(a). For the sake of completeness I will consider the applicant’s position under this heading even though it was not pleaded. Section 5(4) states:

*“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) 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.”*

20) In deciding whether the mark in question “MOOG” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

*“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.

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

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

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

*(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*

*(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.*

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

*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:*

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

*(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.*

*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:*

*(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;*

*(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*

*(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.*

*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.”*

21) The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been “acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...”. The relevant date is therefore 9 February 1996, the effective date of registration of the registered proprietor’s mark.

22) With these considerations in mind I turn to assess the evidence filed in the present proceedings as set out earlier in this decision.

23) It is clear from the applicant’s evidence that Dr Moog severed his connection to the MOOG (solus) trade mark in the late seventies, and that this event was known about in the industry. Although able to trade under various iterations of his own name (R.A.MOOG, ROBERT MOOG and BOB MOOG) the MOOG mark became the property of others.

24) There is some confusion in the applicant’s evidence as to the exact sequence of events. In the statement of grounds it is claimed that Dr Moog assigned his rights to the MOOG mark to Norlin Music Inc. It is also claimed that Norlin Industries Inc. owned the registration of the mark MOOG in the UK. It is stated that Norlin Industries Inc went into receivership in 1989. However, in his witness statement Dr Moog states that during the period 1973-1984 the MOOG mark was used by Moog Music a division of Norlin Music. He states that in 1984 Norlin Music sold the Moog Music business to two former executives who operated as Moog Electronics until going bankrupt in 1987. He states that the assets were purchased by an investor group who also offered service and genuine repair parts for Moog Music products. Further, in his witness statement, Fred McNiff states that he was the general manager of all Moog Music activities until 1991 when the business ceased operation.

25) Whilst there is some confusion as to who owned and used the mark MOOG it is clear that the applicant (Dr Moog) was not involved. His involvement with the mark ceased in 1978 and would seem to have been widely publicised. It is significant that in his advertisements prior to the relevant date Dr Moog is abiding by his agreement in not using the trade mark MOOG. The advertisements refer to an electronic instrument called a Theremin sold by a company called Big Briar Inc. The strap line used in these advertisements is “Bob Moog says.....”.

26) However, the fact that Dr Moog had sold the ownership of the mark in suit is not fatal to the ground of invalidity. One does not have to be the owner of an earlier mark or right in question in order to bring proceedings based upon Section 5(4). If Dr Moog can show that another party, such as Norlin Music Inc., owned the goodwill he could succeed. Neither is the fact that a business has ceased to exist a bar to success, as it is possible to succeed in a passing off action on the basis of residual goodwill.

27) Had Dr Moog sought a declaration of invalidity under section 5(4), I believe that such a case would have failed for the following reasons:

a) It is difficult to know exactly when the sale of MOOG synthesisers ceased in the UK. Mr Dulay gives evidence that he purchased one in 1991 but there are other references in the evidence to the business having gone into receivership or bankruptcy at an earlier date. Accordingly, any business in 1991 may already have been small or residual in nature.

b) The applicant has failed to provide sales or promotional figures for synthesisers, parts and/or fittings in the UK for any period.

c) The only specific evidence of sales is to Mr Forrester in 1998 (after the relevant date) from Mr Dulay’s evidence that he has “periodically” bought parts for his MOOG synthesiser from Mr McNiff since 1991. It is therefore impossible to gauge the existence or extent of any residual goodwill in the business previously conducted under the MOOG mark in the UK at the relevant date in 1996.

d) Even if any such goodwill had existed it is not clear who would have owned it. It is not necessary for the owner to be the applicant in the instant case, but if one cannot say who owns it, then it is difficult to be sure that anyone does own any residual goodwill.

28) Lastly I turn to the ground of opposition under Section 3(6) which states:

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

29) The Act does not define the term bad faith, leaving it to the Tribunal or the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

(i) where the applicant had no bona fide intention to use the mark, or intended to use

it, but not for the whole range of goods and services listed in the application;

(ii) where the applicant was aware that someone else intends to use and /or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

(iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

30) I also take account of the views of Lindsay.J. in *Gromax Plasticulture Ltd v Don and Low Nonwovens Ltd* (1999 RPC 367 at page 379) where the learned judge said:

*“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”*

31) It is well established that in an opposition under Section 3(6) of the Act the onus is on the claimant, reflecting the usual approach under English law that he who asserts must prove.

32) An allegation that the proprietor “deliberately and knowingly adopted the trade mark MOOG so as to suggest a connection with the applicant” is very serious. The proprietor in this case has denied the allegation and has stated that the mark was clearly abandoned some time prior to his application. Although the mark in suit is the applicant’s surname, the applicant had sold the goodwill and so can no longer claim a property right in the name MOOG.

33) Mr Dulay and Mr McNiff provide some evidence of use of the mark in the UK, although the letters exhibited by Mr McNiff are dated after the relevant date. I have no reason to assume that the registered proprietor was aware of any continuing use in 1996 when he applied for the mark. In such circumstances I do not accept that the applicant applied for the mark in bad faith. Therefore the ground of opposition based on Section 3(6) is dismissed.

34) The Registered Proprietor having successfully defended the mark in suit is entitled to a contribution towards costs. I order the applicant to pay the registered proprietor the sum of £335. This sum 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 21<sup>ST</sup> day of May 2002

George W Salthouse  
For the Registrar  
The Comptroller-General