

O-312-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2404283
BY DANIEL JAMES SELBY
TO REGISTER THE TRADE MARK
INDIGO MUSIC
IN CLASS 41**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 94339
BY BRUCE LISTER WELCH**

BACKGROUND

1) On 19 October 2005 Daniel James Selby, of 54 New Hall Street, Macclesfield, Cheshire, SK10 3AA applied under the Trade Marks Act 1994 for registration of the trade mark INDIGO MUSIC in respect of the following services in Class 41:

“Original music and sound composition, recording and production services.”

2) Honest concurrent use with registration Nos. 2262217 and E4170131 was claimed.

3) On 9 May 2006, Bruce Lister Welch of 15 Southview Court, The Woodlands, London, SE19 3EJ filed notice of opposition to the application. The ground of opposition is in summary:

- a) The opponent has been using the name Indigo Music (in a stylised version) for twenty two years. He states that he is registered with the Performing Rights Society and has published and sold music regularly since 1983.
- b) The opponent claims that the services are identical and/or similar and that the marks are confusingly similar. The mark therefore offends against Section 5(4)(a) of the Trade Marks Act 1994

4) The applicant subsequently filed a counterstatement denying the opponent’s claim. He states that the services are not similar and that he has been trading for five years under the mark in suit.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard, but the applicant did supply written submissions which I shall refer to as and when necessary.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 13 November 2006, by Bruce Lister Welch the managing director of Indigo Music. He states that he first used the mark in May 1983. He has used the mark on original music and sound composition, recording and production services. At exhibit A he provides a copy of an email that he sent to the applicant. This email states that Mr Welch has over the years produced a number of works, apart from his song catalogue, for conference, radio and TV. He provides instances of music produced for programmes on BBC2 and also films being shown at festivals in Europe. He points out in the email that a reputation in music is transferable into film and television. He also repeats that he is registered with the Performing Right Society (PRS) and that the opponent should have checked this register before choosing the name for his business.

7) At exhibits B and C he provides copies of DVD covers for films called “Amazing Micro-organisms” and “Outbreak” which, he states, had music composed by his company in 2005. However, neither cover actually shows the name Indigo Music. Both films were shown on BBC2 in 2005. He states that recently a client sent documentation to the applicant believing that they were sending it to the opponent.

APPLICANT'S EVIDENCE

8) The applicant filed four witness statements. The first, dated 10 April 2007, is by Daniel James Selby the Director of Indigo Music, a position he has held since 1999. He states that he registered his business name with "Business Names Registration plc". His mission was to compose and produce original sound and music commercially. He states that he has established a reputation and has attracted a high profile clientele, particularly in the video game, television and advertising sectors. He states that he has also composed music and sound for radio, film, corporate presentations, training material and websites.

9) He states that since inception he has traded only under the name INDIGO MUSIC and is listed as such in many directories, and he has also advertised via an email newsletter. Mr Selby provides a great deal of evidence of his work in the field of television, advertising and video games. He provides documents to support these claims. He also points out that the PRS requires that one registers as either a writer (composer) or as a publisher. He states that the two classes of membership are separate and the criteria for membership acceptance are also quite different.

10) The second witness statement, dated 26 March 2007, is by Dominic Giles a Senior Artist at Bizarre Creations, a video games company. He states that he worked on a video game where Mr Selby composed the music. He states that he believes Mr Selby to be well known in the video games industry.

11) The third witness statement, dated 27 March 2007, is by Steve Mees a Creative Partner in McCann Erikson. He states that he has commissioned the applicant to write music and sound for advertisements. He states that he believes that the applicant has a reputation in the name Indigo Music.

12) The fourth witness statement, dated 5 May 2007, is by Ivo Fiorenza the Managing Director of Amadeus Music which provides music and sound for advertising, films and television. He states that his company has worked with the applicant and that the applicant has a reputation under Indigo Music in the industry.

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

DECISION

14) The only ground of opposition is under section 5(4)(a) which reads:

"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

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."

15) In deciding whether the mark in question “INDIGO MUSIC” 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] 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 Article 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] R.P.C. 341 and *Erven Warnink 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.”

16) 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. The relevant date may therefore be either the date of the application for the mark in suit (although not later), or the date at which the acts first complained of commenced – as per the comments in *Cadbury Schweppes Pty Limited v. The Pub Squash Co Pty Ltd* [1981] RPC 429. In the counterstatement the applicant's claim to have first used their INDIGO MUSIC mark continuously since 1999.

17) In *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 Pumrey J. in considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent’s reputation extends to the goods comprised in the applicant’s specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd’s Application (OVAX)* [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

18) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

19) With these considerations in mind I turn to assess the evidence filed on behalf of the parties in the present proceedings as set out earlier in this decision. The opponent has claimed that he has a reputation in the music industry. However, he has singularly failed to demonstrate that this is the case. He has not filed turnover figures, his claims to have written music for two films is not corroborated, nor are any viewing figures for these films, which appear to be public information type productions, provided. It is stated that they were shown on national television although exact dates of their screening are not provided nor are any viewing figures provided. Neither has the opponent filed any evidence from third parties to show that he is well known. The opponent claims to have been active in the field for twenty two years yet has provided scant evidence of any activity during the course of his career. In my opinion, the opponent has not shown goodwill under the name Indigo Music and so the opposition under Section 5(4)(a) must fail.

COSTS

20) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £500. 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 26th day of October 2007

**George W Salthouse
For the Registrar,
the Comptroller-General**