

O/069/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION 2412318  
IN THE NAME OF GERALD JAMES RICKMAN  
IN RESPECT OF THE TRADE MARK:**

**NEW FOREST PLONKERS**

**AND**

**AN APPLICATION (NO 83793) FOR A DECLARATION OF INVALIDITY BY  
GORDON BROWNEN**

## **THE BACKGROUND AND THE PLEADINGS**

1) This dispute relates to the use of the word PLONKERS in the registered trade mark the subject of these proceedings. The dispute is between the registered proprietor of the mark, Mr Gerald James Rickman, and the applicant for invalidation, Mr Gordon Brownen. It is not in dispute that both Mr Rickman and Mr Brownen once performed together (along with other people) in a music group that had the word PLONKERS in its name. Mr Brownen makes various claims in his application, including (i) that there is a likelihood of confusion with his earlier trade mark for the words THE PLONKERS, (ii) that he owns the goodwill associated with the words THE PLONKERS such that the use of Mr Rickman's mark is liable to be prevented under the law of passing-off, (iii) that Mr Rickman made his application in bad faith due to him knowing of Mr Brownen's rights and, also, that (implied) contractual duties and obligations existed between them, and (iv) that due to such (implied) contractual duties and obligations, Mr Rickman has breached the law of contract. The grounds pleaded are under sections 5(2)(b), 5(4)(a), 3(6) and 5(4)(b) of the Trade Marks Act 1994 ("the Act") respectively which are relevant in invalidation proceedings due to sections 47(1) & (2) of the Act.

2) Mr Rickman filed a counterstatement. Both sides filed evidence. Both sides attended a hearing before me on 16 December 2011 at which Mr Rickman was represented by Alan Fiddes of Urquhart-Dykes & Lord LLP and Mr Brownen was represented by Daniel Wallens of Lester Aldridge LLP.

3) At the hearing, Mr Wallens identified the section 5(2)(b) ground as the strongest and simplest claim. I will, therefore, begin with an assessment of this ground.

### **SECTION 5(2)(b)**

#### **The law**

4) Section 5(2)(b) of the Act reads:

"5.-(2) A trade mark shall not be registered if because –

(a) .....

(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."

5) When determining matters under this ground, I will take into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."
- 6) To set matters in context, Mr Rickman's mark, which is registered in respect of entertainment services in class 41, consists of the following stylised word mark:



The image shows a stylized word mark for 'NEW FOREST PLONKERS'. The text is arranged in a slight upward curve, with 'NEW' on the left, 'FOREST' in the middle, and 'PLONKERS' on the right. The letters are bold and have a slightly irregular, hand-drawn appearance. The color is a dark green or olive.

- 7) Mr Brownen's mark consists of the words THE PLONKERS and is registered under no. 2393125 in respect of the following services in class 41:

Musical entertainment services, musical group entertainment services, entertainment in the form of live musical performances, entertainment services in the form of concert performances, entertainment services performed by musicians and singers, entertainment services provided by a musical vocal group.

- 8) Mr Brownen's mark was filed on 28 May 2005 whereas Mr Rickman's mark was filed on 28 January 2006; Mr Brownen's mark, therefore, constitutes an earlier trade mark as defined by section 6 of the Act. Mr Brownen's mark completed its registration procedure on 23 December 2005 and he filed his application for the invalidation of Mr Rickman's mark on 17 June 2010; this means that when Mr Brownen filed his application for invalidation, the earlier mark had been registered for less than 5 years, with the consequence that it is not subject to the requirement to meet the use conditions<sup>1</sup>.

- 9) The following is noted from Mr Rickman's counterstatement in relation to the section 5(2)(b) ground:

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<sup>1</sup> See section 47(2A).

“While Mr Brownen is recorded as the registered proprietor of UK trade mark registration 2393125, I do not admit that he is entitled to the registration or that it is validly registered.

In any event, this mark is not confusingly similar with my registered mark, as the Registry has already considered the position and accepted the registration on the basis of “honest concurrent use”.

10) This gives rise to two issues upon which I need to comment, namely: i) validity and ii) honest concurrent use.

### **Validity**

11) Section 72 of the Act states that:

“72. In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

12) Although Mr Rickman does not admit that the earlier mark is validly registered or that Mr Brownen is entitled to it, no proceedings have been instigated against it. Therefore, Mr Brownen’s mark it to be presumed as validly registered in accordance with section 72 of the Act. There is no onus on Mr Brownen in these proceedings to prove that his mark is validly registered to him. I need say no more about Mr Rickman’s comments in relation to this.

### **Honest concurrent use**

13) When Mr Rickman’s trade mark was filed and accepted, section 7 of the Act read:

“7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied, but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade mark or other earlier right unless objection on that ground

is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) For the purposes of this section “honest concurrent use” means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.

(4) Nothing in this section affects-

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal), 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).

(5) This section does not apply when there is an order in force under section 8 below.”

14) I say “read” because there is now an order<sup>2</sup> in force under section 8 of the Act which means that section 7 is no longer in force. Regardless of this, section 7 was in force when Mr Rickman’s trade mark was filed. Upon examination of Mr Rickman’s trade mark application, Mr Brownen’s earlier mark was cited against it<sup>3</sup>. Mr Rickman then filed evidence which was considered at a hearing following which a Hearing Officer, Mr Fowler, allowed the application to proceed on the basis of honest concurrent use.

15) At the hearing before me, Mr Fiddes highlighted the above events. His primary argument was that unless Mr Fowler’s decision to accept the mark on the basis of honest concurrent use can be shown to have been in error, then the ground of invalidation must fail. Mr Fiddes submitted that the only challenge (a challenge which he argued was without merit) to Mr Rickman’s evidence was to the honesty of the evidence presented to Mr Fowler (therefore, an attempt to defeat the “honest” part of honest concurrent use). Whilst I will come back to some of the evidence shortly, I must observe that, in my consideration, the point argued by Mr Fiddes is not correct. As Mr Wallens highlighted, section 7(4)(b) states that the honest concurrent use provisions do not affect the provisions for the making of an application for a declaration of invalidity. This is, in effect, the post registration mirror of section 7(2) which allows for a mark to proceed on the

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<sup>2</sup> The Trade Marks (Relative Grounds) Order 2007, which came into force on 1 October 2007.

<sup>3</sup> Prior to the above Order coming into force, the Registrar would search for earlier marks that gave rise to a likelihood of confusion and would “cite” them as a ground for refusal. The citations would therefore block the progress of the new application unless they could be overcome in some way; using the “honest concurrent use” provisions was one way in which the Registrar would permit a later application to proceed in the face of a citation.

basis of honest concurrent use “unless objection on that ground is raised in opposition proceedings”. Therefore, the legislation permitted the acceptance of an application on the basis of honest concurrent use unless opposition was made and that, even if no opposition is made, then such acceptance has no affect on the making of an application for invalidation. In view of this, the honest concurrent use provisions have no part to play in my decision. The question before me is simply whether, at the time when Mr Rickman filed his trade mark application, there was a likelihood of confusion with Mr Brownen’s mark. This is my own clear view, after listening to the submissions made, of the relevance of section 7 acceptances when it comes to opposition and invalidation proceedings, a view which has some support from an appellate body as can be seen in the decision of Anna Carboni (sitting as the Appointed Person) in *Muddies* (BL O/211/09) where she stated:

“51. Finally, I should mention that the Applicant did not pursue an argument on appeal that section 7 of the Act supported the case for registration based on honest concurrent use. As is clear from the section, honest concurrent use only assists an applicant until the point at which the owner of the conflicting right that had been provisionally overcome in the examination process (as it stood prior to the changes referred to above) opposes the application. At that point, section 7 is of no further assistance and the question of relative rights has to be assessed by reference to the relevant part of section 5. Mr Groom accepted this position, but made a general submission that the fact of honest concurrent use was something that could be taken into account in applying the global appreciation test to determine the likelihood of confusion.

52. As the hearing officer said (at paragraph 39), for honest concurrent use to be of assistance to an applicant, it must be possible for the tribunal to be satisfied that the effect of concurrent trading is such as to suggest that the relevant public has shown itself able to distinguish between goods bearing the marks in question without any confusion as to trade origin. That sort of evidence was not presented and the argument therefore did not assist.”

16) Whilst the above rules out honest concurrent use (in the legislative sense) being relevant in these proceedings, a further argument is that the honest concurrent use the parties have made of their respective marks demonstrates that there will be no confusion. I will deal with this issue next.

### **Parallel trading**

17) Mr Brownen and Mr Rickman have made various statements in their evidence. Mr Rickman has also provided evidence from other musicians. Although much more was said, the basic positions that flow from the evidence are as follows:

Mr Brownen:

That he founded a band called PLONKERS AGRICULTURAL ORCHESTRA in 1979 which always contained him, together with a variety of other people coming into and out of the band over the years;

That the band is often referred to as THE PLONKERS;

That Mr Rickman joined in 1999 but Mr Brownen asked him to leave in late 2001 due to them falling out;

That Mr Rickman then set up, in early 2002, his own band called NEW FOREST PLONKERS (for the first two of its gigs it was called THE NEW PLONKERS);

That NEW FOREST PLONKERS have continued to trade since then (as has Mr Brownen's band) and that he has lost bookings to them as a result of the similarity between the names;

That at various times he has asked Mr Rickman not to use the name.

Mr Rickman:

That Mr Brownen was one of the founding members of PLONKERS AGRICULTURAL ORCHESTRA and he became the main organiser for the band;

That in late 2001 Mr Brownen announced that he was disbanding the band;

That in early 2002 he (Mr Rickman) reformed the band under the name NEW FOREST PLONKERS; a different name (to PLONKERS AGRICULTURAL ORCHESTRA) was chosen to differentiate them from the previous incarnation which he claims was not well organised;

That Mr Brownen has done little to ask him not to use the name other than a serious of communications in 2006 and, of course, the filing of the application for invalidation.

18) There is a dispute between the parties as to whether the parallel trade of the parties since NEW FOREST PLONKERS began to trade has led to confusion or not. There is a tranche of case-law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in*



*the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P.* In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

19) In *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

20) There are a number of reasons why the evidence filed is not particularly helpful in relation to this ground. Firstly, the name of the band which Mr Brownen says he founded was PLONKERS AGRICULTURAL ORCHESTRA and not THE PLONKERS per se. Whilst Mr Brownen states that they were known as THE PLONKERS, the differences between the two actual band names does not match the notional assessment I need to make between the two marks at issue before the tribunal. Secondly, whilst Mr Brownen says that he continued to trade after Mr Rickman left (be it through Mr Rickman being asked to leave or through him disbanding the group) it is not clear as to the extent of such trade or the signs used – therefore, the extent to which parallel trade has taken place is not clear. Any confusion (or lack of confusion) is, therefore, primarily between the old band and the new band rather than strict parallel trade. The third reason is that the evidence comes from a limited geographical area (in and around the New Forest area) and the examples of confusion/non confusion are primarily from those

involved in the booking of bands for local festivals etc or reporting on events. Even if such people have not been confused, they may know or have been educated to know of the dispute between the parties. This can hardly represent the likely reaction of the UK average consumer through whose eyes a likelihood of confusion must be judged. In terms of the average consumer, members of the general public “consume” entertainment services; the cost and nature can vary but, in general terms, they are unlikely to be highly considered decisions, the degree of consideration is therefore no higher or lower than the norm. For all these reasons, the evidence presented has little bearing on the notional assessment I am required to make of the likelihood of confusion on the part of the average consumer.

### **Likelihood of confusion**

21) The factors to be assessed and borne in mind are set out in paragraph 5. In terms of the services, these are considered identical because the services of Mr Brownen’s mark cover various musical entertainment services which fall within the ambit of the entertainment services covered by Mr Rickman’s mark<sup>4</sup>. Mr Rickman’s services may, notionally speaking, also contain non musical entertainment services, but he has provided no fall back specification for consideration and it is clear, in any event, that the entertainment services to be provided are musical in nature. In terms of the distinctiveness of the earlier mark, the comments I made earlier about the nature, scale, degree and geographical origin of the use presented by Mr Brownen means that any distinctiveness his mark possesses is not enhanced through its use. However, in terms of its inherent qualities then the words THE PLONKERS have no real allusive or suggestive qualities to the services provided (no evidence has been presented to the contrary) and, so, it is considered to be a mark with a reasonable degree of inherent distinctive character.

22) In terms of the marks at issue, it is clear that the word PLONKERS is the dominant and distinctive element of both marks. Although Mr Rickman’s mark also has the words NEW FOREST in them, such words are likely to be perceived as having geographical significance, merely suggesting where the band is based. There is also the stylization present in Mr Rickman’s mark to bear in mind, however, whilst it adds further distance, it is not the sort of difference that should be overplayed. I come to the view that despite the identified differences, there is still a reasonable amount of similarity between the marks on a visual and aural perspective. There is also a good deal of conceptual similarity as the primary concept is of plonkers, which will be perceived as a reference to a group of foolish people. The addition of NEW FOREST merely indicates where such a group of people is based.

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<sup>4</sup> See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)*(OHIM) Case T-133/05.

23) I asked Mr Fiddes at the hearing whether, in the absence of his reliance on honest concurrent use, the factors assessed in the previous two paragraphs are ones which would ordinarily lead to a finding of there being a likelihood of confusion. He did not concede that this was the case, although, it is fair to say that he provided little by way of submission against such a view. Mr Wallens strongly argued that the factors assessed would result in a likelihood of confusion. I agree with Mr Wallens. The identity of the services, the reasonable degree of similarity between the marks, and the reasonable degree of inherent distinctive character of the earlier mark will, when the services are considered by a reasonably observant and circumspect average consumer, lead to a likelihood of confusion. **The ground of invalidation under section 5(2)(b) succeeds.**

### **OTHER GROUNDS OF OPPOSITION**

24) I agree with Mr Wallens that section 5(2)(b) is the clearest and simplest ground of invalidation. In view of this I do not consider Mr Brownen to be in any better position under the other grounds and, therefore, I do not intend to discuss them. The application for invalidation succeeds and Mr Rickman's trade mark registration is deemed never to have been made.

### **COSTS**

25) Mr Brownen has been successful and is entitled to a contribution towards his costs<sup>5</sup>. I hereby order Mr Rickman to pay Mr Brownen the sum of £2100.

Official fee for filing application – £200  
Preparing a statement and considering the other side's statement - £400  
Considering and filing evidence - £800  
Attending the hearing - £700  
Total - £2100

26) The above sum should 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 17<sup>th</sup> day of February 2012**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

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<sup>5</sup> Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.