

O-196-13

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2583742

OF THE TRADE MARKS:



IN THE NAME OF

DEAN WOODWARD

AND

THE APPLICATION FOR INVALIDATION THEREOF

UNDER NO 84398

BY

REACTORPANEL SADDLE COMPANY LLC

1) On 3 February 2012 the trade marks shown on the front page of this decision were registered in the name of Dean Woodward. On 26 January 2012 an application to declare the registration invalid was made by Carmi Weininger. This application was later given an effective date of 10 April 2012 (the application having been made prior to the completion of the registration procedure). The statement of grounds was subject to amendment and the name of the applicant was changed to ReactorPanel Saddle Company LLC (RPC). The original statement of grounds was completed by Ms Weininger; although, she gave Singleton's Solicitors as her representatives in the United Kingdom. Subsequent correspondence and the amendment to the statement of grounds emanated from Singleton's Solicitors.

2) In an eight page letter accompanying the application form Ms Weininger wrote:

“Soon after I purchased the business, I engaged LL Prindle Designs of Berthoud, Colorado to create an original graphical identity for my business, and it is this logo for the ReactorPanel Saddle Company that is at the heart of this objection; this logo is mine, and has been used by me in the U.S. and in the U.K. for many years and I own 100% rights in it.”

Despite this claim, the application was not made under section 5(4)(b) of the Trade Marks Act 1994 (the Act) which deals with claims based on copyright. The application was brought under sections 3(6) and 5(4)(a) of the Act.

3) Mr Woodward filed a counterstatement on 3 July 2012. In the counterstatement Mr Woodward requests that the identity of the applicant be clarified; is it Ms Weininger or RPC? Mr Woodward points out that an applicant relying on relative grounds has to be the owner of the earlier right upon which there is reliance. Mr Woodward notes that RPC has not particularised the particular sign or right upon which it is relying, there being reference to a number of potential signs in the statement of grounds. In so far as Ms Weininger or RPC is relying upon copyright in the logo the subject of the application, Mr Woodward accepts that the invalidity should succeed on this ground alone. Mr Woodward denies the grounds under section 5(4)(a) and 3(6) of the Act. Mr Woodward accepts that the invalidation should succeed on the basis of Ms Weininger or RPC having an earlier right in copyright. He states that in so far as the invalidation is considered outside of the above, he requests his costs and that the invalidation be dismissed in relation to these grounds.

4) RPC submitted an amended statement of grounds on 7 August 2012. In this statement of grounds it was clarified as to whom was the applicant for invalidation. This statement of grounds gave further detail, inter alia of the claim to copyright; including the earlier work upon which there is reliance.

5) Mr Woodward agreed that summary judgment could be entered in relation to the application on the basis of section 5(4)(b) of the Act.

6) On the basis of the admission by Mr Woodward, RPC succeeds in its claim under section 5(4)(b) of the Act. In accordance with section 47(6) of the Act, the registration is deemed never to have been made.

7) The parties have been involved in a lengthy correspondence in relation to costs. RPC claims £600 plus the fee for the application, £200. RPC states that the £600 represents the scale fee. The guidance in TPN 4/2007 in relation to costs is as follows:

“Preparing a statement and considering the other side’s statement: From £200 to £600 depending on the nature of the statements, for example their complexity and relevance.”

8) Mr Woodward states that it would be equitable not to make an award of costs. He comments that the grounds of RPC were poorly particularised and pleaded; the grounds did not even originally rely upon the ground upon which the invalidation succeeds. Mr Woodward comments upon the numerous deficiencies in the original grounds of invalidation. He notes that it was he, of his own accord, who identified and acknowledged the ground under section 5(4)(b) of the Act; which is still not specifically pleaded.

9) RPC commented upon the expenses that it had occurred with Singleton’s Solicitors. It also commented upon the substance of the case, the copyright. RPC also commented upon the work that it had undertaken since the filing of the application by Ms Weininger. This work was essentially to amend the deficiencies and irregularities of the original statement of grounds. It is difficult to see, therefore, that a contribution in costs should be made in respect of this. It is also the case that, taking into account the admission of Mr Woodward, all that RPC had to do was identify the party filing the application and confirming that it was basing part of its claim on the law of copyright. The amended pleadings run, unnecessarily, to 11 pages.

10) Both parties made further submissions in relation to costs. Mr Woodward commented upon the costs involved in dealing with the original application which “as filed was confusing and deficient”.

11) This is an unusual case in that the registered proprietor not only identified a basis for the claim by RPC but also accepted that the application should succeed upon this basis. As identified by Mr Woodward, the original grounds of invalidation were confused and lacked particularisation. They did not even identify who had the locus standi in relation to the proceedings. It was Mr Woodward who put it to Ms Weininger/RPC that it was necessary for the party with the locus standi to identify itself. As effectively indicated by Mr Woodward, it is his legal representatives who have put the case of the applicant in to some

form of order. The confusion in relation to the statement of grounds would have put Mr Woodward to unnecessary costs in relation to sorting them out.

12) Taking into account the nature of the original pleadings and the requirements of the registered proprietor to sort through them and the admission at the outset, that the application should be successful in relation to a claim under copyright (and the identification of this by the registered proprietor), an award of costs should not be made to RPC in relation to the statements of ground.

13) All that RPC should receive is the fee for filing of the application for invalidation. Dean Woodward is ordered to pay ReactorPanel Saddle Company LLC the sum of £200. 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 14th day of May 2013

**David Landau
For the Registrar
the Comptroller-General**