

O-287-03

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2304578
IN THE NAME OF CHRISTOPHER JOHN CROOK (MR)**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81218
THERE TO BY ALPHAMAGIC LIMITED**

IN THE MATTER OF trade mark registration No. 2304578
in the name of Christopher John Crook (Mr)

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 81218 thereto by Alphamagic Limited

BACKGROUND



1. The trade mark has been registered since 27 December 2002 under number 2304578 and stands in the name of Christopher John Crook (Mr). It is registered in respect of:

Class 09:

Audio and/or digital recordings and reproductions; discs (including DVD, CD, mini disc, vinyl), tapes, cassettes, wires and computer software; parts and fittings for all aforesaid goods; all included in Class 9.

2. On 18 February 2002, Alphamagic Limited filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of grounds accompanying the application set out the grounds of action, which are as follows:

“It is submitted that the registration should be removed from the Trade Marks Register under Section 47(1) of the 1994 Trade Marks Act, as it is considered that it is in breach of Section 3(6) of the Act, having been filed in bad faith, as it is submitted that the Registrant had no entitlement to use the Registration on or in relation to any of the goods covered by the Registration.”

3. The registered proprietor did not file a counter-statement to defend his registration.

4. The applicants for invalidity provided, as their statement of grounds, a witness statement detailing the case against the registered proprietor.

5. Acting on behalf of the Registrar and after a careful study of the papers before me I give this decision.

DECISION

6. Despite having been notified of the application for invalidity the action is uncontested by the registered proprietor. It does not however follow that the uncontested nature of this action will automatically mean success for the applicants for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicants for invalidity to prove why it is that the registration should be declared invalid.

7. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

8. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....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.”

9. With this in mind, I now turn to consider whether the witness statement, provided as the statement of grounds by the applicants, is sufficient, prima facie, to allow the application for invalidity.

10. The applicants claim that the registration should be declared invalid as per Section 47 of the Act on the basis of the provisions of Section 3(6). The relevant parts of the Act are as follows:

“47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).”

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

11. Recent case law has indicated that bad faith is a serious allegation. In *Royal Enfield* BL 0/363/01 Mr Simon Thorley QC, sitting as the Appointed Person, held:

“An allegation that a trade mark has been applied for in bad faith is a serious allegation. It is an allegation of a form of commercial fraud. A plea of fraud

should not be lightly made (see Lord Denning M.R. in *Associated Newspapers* (1970) 2 QB 450 at 456) and if made should be distinctly alleged and distinctly proved. It is not permissible to leave fraud to be inferred from the facts (see *Davy v. Garrett* (1878) 7 Ch. D. 473 at 489). In my judgement precisely the same considerations apply to an allegation of lack of bad faith made under section 3(6). It should not be made unless it can be fully and properly pleaded and should not be upheld unless it is distinctively proved and this will rarely be possible by a process of inference.”

12. In the witness statement Christopher Gilbert, Company Secretary of Alphamagic Limited, details the business relationship between Alphamagic Limited and Christopher John Crook. That Christopher John Crook developed for Alphamagic Limited four record labels, these being Mohawk Records, Nile Records, Aztec Records and Mind Over Matter Records (MOM). However, these record labels were the property of Alphamagic Limited until the contract with Christopher John Crook was terminated when, as part of the termination agreement he acquired two of the labels, namely Aztec Records and Mind Over Matter Records (MOM). Subsequent to the termination of his agreement with Alphamagic Limited he was informed in writing on at least two occasions that he had no rights in the name Mohawk Records, and both he and his solicitor failed to respond.

13. The facts set out in the witness statement, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case of bad faith has been made out in that, at the date of the application, Mr Christopher John Crook was not entitled to claim proprietorship of the trade mark the subject of the application for invalidation. The application for a declaration of invalidity made under section 47(1) of the Act therefore succeeds.

14. The applicants for invalidation have made no claim for costs and therefore I make no award in this case.

Dated this 19th day of September 2003

**Graham Attfield
For the Registrar
the Comptroller General**