

O-279-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS NO 81684  
BY JIMMY OSMAN FOR REVOCATION OF  
REGISTRATION NO 1494192 STANDING IN THE  
NAME OF MOTOWN RECORD COMPANY LP**

## **TRADE MARKS ACT 1994**

**IN THE NAME OF Application No 81684 by  
Jimmy Osman for revocation of registration  
No 1494192 standing in the name of Motown  
Record Company LP**

### **BACKGROUND**

1. Trade Mark No 1494192, MOTOWN, is registered in respect of:-

“Entertainment information; rental of cine-films; discotheque services; organisation of exhibitions; presentation of live performances; orchestra services; production of radio and television programmes and of shows; radio and television entertainment; audio and video recording studio services; rental of stage and show scenery, radio and television sets, sound recordings and of stadium facilities; video tape film production; all included in Class 41.”

2. It was applied for on 13 March 1992 and was registered on 17 September 1993.

3. On 25 March 2004 Jimmy Osman applied for revocation of this registration claiming that it had not been put to genuine use by the proprietor or with its consent within the period of five years following the date of completion of the registration procedure in respect of “discotheque services; presentation of live performances and orchestra services.” Furthermore, it is said that there are no proper reasons for non-use.

4. Additionally or alternatively, the applicant contends that genuine use has been suspended for an uninterrupted period of five years with no proper reasons for non-use. Again, the request is for partial revocation in respect of the services mentioned above.

5. The registered proprietor filed a counterstatement denying the above claims. It is said that, so far as discotheque and orchestra services are concerned, the use has been by the proprietor itself. Use in relation to live performances is said to have been “by authority of Universal-Island Records Ltd, with the consent of Motown Record Company LP”. The registered proprietor thus requests denial of the application in its entirety. Alternatively, it asks that the position in relation to the services concerned be considered separately to the extent that use is not found to be proven in respect of all the services.

6. Only the registered proprietor has filed evidence. Neither party has asked to be heard on the substantive issues. I note from the file that this case has been allowed to proceed in the absence of evidence from the applicant for revocation. This state of affairs came about following an interlocutory hearing and a direction from the hearing officer that the applicant file written submissions in support of its case. The applicant has met the obligation thus placed upon it by filing written submissions under cover of a letter dated 29 June 2006 from Lloyd Wise, its professional advisers. For the sake of completeness I should add that the hearing officer’s decision on the future

conduct of the case was upheld on appeal to the Appointed Person (decision of David Kitchen QC dated 15 September 2005).

## **DECISION**

### **The law**

7. Section 46 reads:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds –

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that –

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

8. Section 100 is also relevant and reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

### **Guiding principles**

9. These can be found in the ECJ's judgment in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40. I will record the relevant paragraphs in full:

“36 “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37 It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Art.10(3) of the Directive, by a third party with authority to use the mark.

38 Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.”

### **Registered proprietor’s evidence**

10. Claire Sugrue has filed a witness statement. She is Director, Legal and Business Affairs, to the Island Records group of UK companies. This group of companies is under the control of the Universal Music group of companies of which Motown Record LP also forms a part. Ms Sugrue’s responsibilities include the interests of Motown Record Company LP in the UK.

11. Her evidence addresses in turn the three sets of services that are the subject of this action. I propose to approach my decision in the same way.

### **Discotheque Services**

12. Ms Sugrue’s evidence is as follows:

5. The primary use of the trade mark MOTOWN is, and has for many years been as a record label on which recordings of very many very well known and popular musical artists have been, and continue to be sold. These artists include:

Stevie Wonder	The Jackson 5
Smokey Robinson	The Four Tops
Diana Ross	Martha Reeves
Marvin Gaye	Tammi Terrell
The Temptations	Mary Wilson
The Supremes	Edwin Star

and many others of all whom have been, and in some cases still are, contracted to Motown Record Company LP or its legal predecessors in trade.

6. The records (that is to say audio recordings in vinyl, tape, and CD form) of these artists have been, and continue to be, sold in substantial numbers throughout the United Kingdom under the label/trade mark MOTOWN for private domestic use and for commercial use in clubs, bars, discotheques and other forms of public entertainment at which they are played.
7. Commercial discotheques take place every week throughout the year in huge numbers around the length and breadth of the United Kingdom. These take a variety forms in public venues such as clubs, bars, pubs and dance halls for which there will usually be an entrance charge to

cover the cost of the discotheque operator, or in private locations for parties and celebrations for which the host will usually pay cost of the discotheque operator. Both are commercial operations involving payment to the discotheque operator, either to the club etc which provides the equipment (including the records to play) or to an employed “DJ” or to a free-lance DJ who provides his own equipment and purchased records for the event.

8. As commercial public uses of copyright recordings the use of MOTOWN (and other) label records at such discotheques is subject to license payment through the Phonographic Performance Limited (PPL), the centralised UK copyright licensing agency for musical recordings. MOTOWN records do generate receipts of substantial license revenue to Universal-Island Records Ltd as authorised agent for Motown Record Company LP, and the reports we receive from PPL make clear that significant amounts of license payments attributable to commercial discotheque use of MOTOWN records are included.
9. Many commercial discotheques routinely advertise and promote on the basis of the music they play, often by reference to the record label(s) concerned. References by discotheque operators to the trade mark MOTOWN, as the label on which the music of a number of well known and popular artists appears (see above), are widespread and implicitly made with the consent of the registered proprietor as owner of the registered trade mark MOTOWN in respect of such recordings. I exhibit hereto as Exhibit CS1 a copy of a poster advertising an event including a discotheque which took place in Yorkshire in July 2003 showing the trade mark MOTOWN prominently in respect of discotheque and related services. This event had the consent of Motown Record Company LP. I also exhibit hereto as Exhibit CS2 a print of a photograph of a typical banner and speaker covers used, with the consent of Motown Record Company LP, at a number of commercial discotheques held in the North of England within the five years up to 26th March 2004.”

13. The applicant’s written submissions made the following main points in relation to this evidence:

- the mere fact that Motown records are played at a discotheque is irrelevant. It is simply promoting a characteristic of the discotheque. It is not use of Motown in relation to discotheque services. An analogy is made in relation to a beer brand being promoted in a pub. That, it is said, would not be use of the beer brand in relation to pub services.
- Exhibit CS1 shows that the mark being used in relation to discotheque services was ‘North West Social Club’ and not Motown.

- Exhibit CS2 fails as evidence because it fails to identify where or when the photograph was taken or the frequency with which the banner was used.
- the evidence generally is not effective or sufficient to establish genuine use.

14. There are just two exhibits in support of the generality of the registered proprietor's claim. Like the applicant I have been unable to date exhibit CS2 or to establish where it was used. It is said to be a 'typical banner' and to have been used with the proprietor's consent. However, there is no indication as to how many times it or similar banners were used, how the claimed consent by Motown was given or what the nature of that consent was.

15. Exhibit CS1 is clearly dated. It relates to an event held on 20 July 2003 at the Hebden Bridge Picture House. It is billed as 'A day of magical Motown soul' and consisted of a 'Motown Connoisseurs Disco', a Motown film and a Sixties soul special. The advertisement says "North West Soul Club Presents".

16. Quite clearly interested members of the public, would have been attracted to the events taking place that day on the basis of their interest in the history and music of the Motown record label and the stars associated with that label. Like the applicant I have difficulty in accepting that these consumers (from the public at large) would think that the proprietor was making itself responsible for the provision of the discotheque services element of the day's entertainment package (see paragraph 36 of *Ansul* above).

17. The Court of Appeal in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*, [2003] RPC 32, has held that the appropriate test is how the notional consumer would describe the use in question (paragraph 31). That was in the context of limitation of specifications but it is equally appropriate to consider how the notional consumer would see the nature of the use of a mark. In this case Motown clearly describes the subject matter of the day's event but, on the evidence before me, the average consumer would not think that Motown was being used in relation to the provision of discotheque services. The point can be demonstrated another way. If there were to be complaints about the discotheque in terms, say, of its organisation or the quality of the sound system, would consumers direct those complaints to Motown. Clearly they would not – they would approach the event organisers and/or the venue concerned. The event organiser might in those circumstances pass the complaint on to whoever had supplied the discotheque services but I cannot see from the evidence that Motown would be considered to be that provider.

18. The same point can be made on the strength of the limited information available in Exhibit CS2. The banner that is illustrated is headed 'Bob McClure presents 'The Motown Show' along with the words 'Lost and Found'. I infer that Bob McClure is either the organiser or more likely the DJ for the event. Either way Motown is likely to be taken as indicative of the content of the entertainment but not the discotheque service itself. On that basis the proprietor has not demonstrated use of Motown in relation to discotheque services.

## **Presentation of live performances**

19. Ms Sugrue's evidence in relation to these services is as follows:-

“11. Artists who are or have been contracted to the MOTOWN recording label of Motown Record Company LP, for example those listed above in paragraph 5, from time to time give live performances in the United Kingdom. Such performances given during an artist's contract with Motown Record Company LP are routinely presented and promoted with reference to the trade mark MOTOWN in promotional posters, other advertising materials and in performance programmes with the implicit, and sometimes explicit, a consent of Motown Record Company LP. I exhibit hereto as Exhibit CS3 a copy of a programme for the “Dancing in the Street” UK tour in 2000 of May Wilson, Martha Reeves and Edwin Star (see paragraph 5 above). This tour was itself made with the consent of Motown Record Company LP as was the use within the programme, and elsewhere, of the trade mark MOTOWN. Finally in this regard a live musical performance called MOTOWN MANIA was staged in late 2000 which was filmed before an audience and later broadcast by London Weekend Television. The trade mark MOTOWN has therefore been used by authority of Universal-Island Records Ltd, with the consent of Motown Record Company LP, in the United Kingdom within and throughout the five years up to 26 March 2004 in respect of “live performances”.”

20. The applicant submits that the evidence does not show that Motown is being used in relation to live performances merely that Motown is being used to promote the fact that the artist is singing music which is recorded under the Motown label. The submissions go on to say that in the UK a recording label does not organise the concerts of its artists. These are organised by separate promoters. In this case Exhibit CS3 it is ‘Paul Walden and Derek Nicol for Flying Music’ who presented the performance in question. The word MOTOWN is used simply to provide information on content, that is to say it describes the type of music that is to be performed. Finally, in relation to the reference to the Motown Mania event referred to by Ms Sugrue, it is said there is no evidence at all to support the claim.

21. Before considering the single exhibit relied on in support of the claim that genuine use has been made of the mark I should indicate how I approach the registered proprietor's specification and the applicant's submissions in relation thereto.

22. The services in question are described as “presentation of live performances”. What does that cover? Plainly it covers the live performance itself but in my view it is also wide enough to include the process of putting on such performances. It is after all quite normal for live performances by groups or individuals to have an organisation working for them behind the scenes (a promoter or such like) which is responsible for the staging of the performance.

23. Exhibit CS3 is a souvenir programme for a Motown's Greatest Hits show that demonstrates the above point. The front cover of the programme has the following:



Paul Walden & Derek Nicol for Flying Music present  
Dancing in the Streets  
Motown's Greatest Hits Starring  
Mary Wilson            Matha Reeves            Edwin Starr

On that basis the average consumer would understand that the three named stars are giving the live performance and that the presentation of the live performance was the responsibility of Messrs Walden and Nicol for Flying Music.

24. The souvenir programme appears to relate to a show that was being performed throughout the UK in 2000. Tour dates are given for February, March and April. Above the tour dates panel is a message of welcome associated with the name Tamla Motown. I note that Ms Sugrue says that the tour was made with the consent of Motown Record Company LP. There is no documentary support for this claim or explanation of the nature of the consent. Nor is it clear whether the artists concerned were under contract to Motown Records at the time.

25. There are further acknowledgements on the inside front cover of the programme document. Thus, for instance, the names of the three stars' managers and agents are given, and there is acknowledgement of various peoples' involvement in the musical direction and band line-up. There is also a listing of those involved on behalf of Flying Music, press and PR teams etc. Anyone interested in further copies of the programme is directed to Flying Music Co Ltd and a copyright notice in the small print at the foot of the page also points to Flying Music Company Ltd.

26. The bulk of the souvenir programme is taken up with profiles of the three stars. The final pages deal with direction and musical supervision by Keith Strachan and Angelo Starr followed by a Forthcoming Attractions entry which, in so far as a legible, appears to relate to other Flying Music presentations. The back cover is an advertisement/promotional piece for Spectrum Music which has put out various recordings by Tamla Motown stars .

27. I find nothing in this document suggesting that the presentation of the live performances was under the mark Motown. Motown Records or Tamla Motown may well have had some association with the event though the nature of that involvement is not clear. In my view the evidence does no more than show that the artists concerned were performing songs which had been recorded under the Motown label or that the music was of a kind that the relevant public would associate with the Motown label (in this respect Collins English Dictionary has an entry for Motown that acknowledges the trade mark significance of the word but also describes it as "music combining rhythm and blues and pop or gospel rhythms and modern ballad harmony").

28. The applicant's written submissions suggest that recording labels do not usually organise the concerts of their artists. That may be the case in general but it may not be an immutable rule. I bear in mind that Motown is unusual in this respect as being associated with a particular style of music. However, on the limited evidence available it is not possible to conclude that the name Motown has been used in

relation to the presentation of the live performance covered by the souvenir programme.

## **Orchestra Services**

29. Ms Sugrue says:

- “12. The term “orchestra” appears in the Shorter Oxford English dictionary (5<sup>th</sup> Edition 2002) as

“a usu.large group of assorted instrumentalists, *esp*, one combining string, woodwind, brass and percussion sections.”

The term “orchestrate” appears in the same volume as

“combine harmoniously, like instruments in an orchestra; carefully direct or co-ordinate elements of (a plan, situation etc).

The word “orchestra” refers essentially to a group of musical artists an example of which it is commonplace to use as a part of live performances of artists contracted to the MOTOWN record label. The equivalent word “band” is often used – see Exhibit CS3 above. The Shorter Oxford English Dictionary (5<sup>th</sup> Edition 2002) defines “band” as:

“A body of musicians, now *esp*. those playing brass or wind instruments; (a section of) an orchestra; Now also a rock or pop group”.

The equivalence of meaning in this context of “orchestra” and “band” is evident. Performances by bands or orchestras are an important part of the performances of these MOTOWN label artists and take place frequently throughout the United Kingdom making references to MOTOWN as a trade mark/label of the contracted artist. The trade mark MOTOWN has evidently been used, with the consent of Motown Record Company LP, in the United Kingdom within and throughout the five years up to 26 March 2004 in respect of “orchestral services”.

30. The applicant’s written submission dispute that the average consumer would describe a band as an orchestra. It is submitted that “even if bands signed to the Motown record label perform in the United Kingdom, this does not mean that the mark MOTOWN is used in relation to the services of performing.” I take these last three words as referring to orchestral performing.

31. The only exhibit relied on by the registered proprietor in defence of orchestra services is CS3. On the face of it this exhibit is against it. Setting aside for the moment the band/orchestra debate, there is a band mentioned in CS3. It is referred to as The “Dancing in the Streets” Band. I assume it is a band that travelled with the show for the duration of the tour. How the band was put together, whether it existed

for the sole purpose of the tour or whether it was a Motown house band is unexplained. The question is whether on the basis of the use shown the average consumer would consider that orchestra services were being offered under the mark Motown. In my view the answer is that that has not been shown to be the case. In the circumstances it is not necessary for me to engage in the debate as to what consumer perception of the terms band and orchestra is likely to be.

32. The case for revocation has been made out. Pursuant to Section 46(5) revocation will relate to “discotheque services”, “presentation of live performances” and “orchestra services”.

33. The application has been made under Section 46(1)(a) and (b) but the applicant has not specifically raised a claim for revocation from a date earlier than the date of the application for revocation. That, therefore, appears to be the relevant date for revocation purposes – see *Datasphere Trade Mark* BL O/018/06 where the Appointed Person considered the question and followed *Omega SA v Omega Engineering Inc*, 2003 FSR 49, where Jacob J (as he was then) indicated that “the mere reference to Section 46(1)(a), to my mind, does not fairly put in play the use going back beyond the five year period immediately before the application for revocation”. Revocation to the extent indicated above will, therefore, take effect from 26 March 2004.

## **COSTS**

34. The applicant for revocation has been entirely successful in relation to the services that were the subject of the partial revocation request. Based on the standard scale the applicant would be entitled to a sum of **£1300**.

35. I referred earlier to an interlocutory hearing held on 13 December 2004 following which the hearing officer exercised her discretion to allow the proceedings to continue absent evidence from the applicant. Her decision indicated that the question of costs for the interlocutory hearing would be considered as part of the final determination of these proceedings.

36. That decision was upheld on appeal. The Appointed Person awarded **£750** to the applicant as a contribution to the costs of the appeal. There remains the costs of the original hearing before the Registry’s Hearing Officer. The applicant was represented by Counsel on both occasions. I propose, therefore, to order the registered proprietor to pay the same sum as awarded by the Appointed Person in respect of the interlocutory hearing in the Registry. In total, therefore, I order the registered proprietor to pay the applicant the sum of **£2050**. 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 27th day of September 2006**

**M REYNOLDS**  
**For the Registrar**  
**The Comptroller General**

