O-252-14

TRADE MARKS ACT 1994

APPLICATION No. 3005549 BY MICHAEL MILINGTON

TO REGISTER A FIGURATIVE MARK IN CLASS 25

AND

OPPOSITION No. 400643 BY THOMAS ERVAY

Background

On 11 May 2013, Michael Millington applied to register the mark shown below.

2. The application covers:

> Sport shirts; clothing, footwear, headgear; casual clothing; footwear for sport; body warmers [clothing]; athletics wear; babies' clothing; baseball caps and hats; bikinis.

3. On 5 August 2013 the application was opposed by Thomas Ervay, who is an US citizen living in Florida. The opposition is based on section 5(4)(b) of the Trade Marks Act 1994 ("the Act"), which states that:

> (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) -
> (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.
>
> 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.

4. The opponent relies on his ownership of USA trade mark 3973659 and on the copyright registered in the USA in this sign on 24 August 2011 under VAu-1-076-970. The opponent provided certificates of registration in the USA of the trade mark and of the copyright in the work.

5. The sign looks like this.

6. Mr Millington filed a counterstatement denying the ground of opposition. Mr Millington claims that he has been working with someone called Jerry Beck since 2010 and makes a number of claims, which he attributes to Mr Beck. These are that:

- Mr Beck is the 'creator' of IRON ASYLUM and the art work, which was registered in the State of Ohio in 1998.

- Mr Beck attempted to form a partnership with Thomas Ervay in 2010, but no agreement was reached.

- Mr Millington has Mr Beck's permission to obtain the IRON ASYLUM trade mark and to distribute products under it.

The evidence

7. Only the opponent filed evidence. This consists of a witness statement by Thomas Ervay in which he states:

- The truth of the documents filed with the notice of opposition showing that he registered the sign shown in paragraph 5 above at the US Federal Trade Mark and Copyright Offices.

- That he is the "beneficial owner" of the US copyright in this artwork and of US trade mark 3973659.

- The sign shown at paragraph 5 above was first used by him in collaboration with Jerry Beck, but they fell out and decided to continue their businesses separately.

- On 13 July 2012, a licence agreement was entered into between Mr Ervay and Mr Beck through which Mr Beck acquired a fixed term non-transferable licence to use the trade mark, which excluded sub-licensing.

- In that agreement, Mr Beck acknowledges Mr Ervay's ownership of the trade mark.

Decision

8. The US trade mark is territorially limited to the USA. It provides to rights in the UK. It is not therefore an earlier right for the purposes of s.5(4) of the Act.

9. Original artistic works created in the USA are protected under UK copyright law[1]. The sign relied on by the opponent is a graphic work and thus capable of qualifying for protection as an artistic work by virtue of s.1(1) of the Copyright, Designs and Patents Act 1988. The artistic work must also be original[2]. This appears to mean that it must be the authors' own intellectual creation. According to the CJEU in *Painer v Standard Verlags GmbH*[3]*,"* that is the case if the author was able to express his creative abilities in the production of the work by making free and creative choices". The artwork shown at paragraph 5 above has is plainly the result of the authors creativity and, unless copied from some other work(s), appears to qualify as an original work.

10. Mr Ervay claims that he is the "beneficial owner" of the copyright, but according to the certificate he filed from the US Copyright Office, he is recorded as both the author and the legal owner of the work.

11. There is another inconsistency in that the copyright certificate shows that the work was completed or published in 2010, but the trade mark certificate shows that the trade mark (which is identical to the copyright work) was created in 1998 and first used in commerce in 2005.

12. In different circumstances these inconsistencies may have been sufficient to call into question Mr Ervay's claim to be the owner of an original copyright work corresponding to the sign shown at paragraph 5 above. However, Mr Millington's case is not that the work on which Mr Ervay relies is not original, but rather that Mr Beck is the creator of the artwork and the mark which he has applied to register. The difficulty with this is that Mr Beck has filed no evidence to challenge Mr Ervay's claim that he created the work shown at paragraph 5 above. Mr Millington does not appear

[1] The latest list of the countries in which such protection is granted is contained in the Copyright and Performances (Application to Other Countries) Order 2008, S.I. 2008/677, but this has long been the case for the USA.
[2] *SAS Institute Inc. v World Programming Limited* [2013] EWCA Civ 1482
[3] Case C-145/10 [2012] ECDR 6

to have any firsthand knowledge of the matter. In his counterstatement he purports to make statements on behalf of Mr Beck, but as these statements are not covered by a witness statement, affidavit or statutory declaration from Mr Millington (let alone one from Mr Beck himself), they do not even have the status of hearsay evidence. This is because there is no statement of truth (or equivalent) that Mr Beck made these statements to Mr Millington.

13. In these circumstances I accept the unchallenged evidence of Mr Ervay that he is the author of the work shown at paragraph 5 above. I also accept that it is an original work created in the USA. And as Mr Ervay is still very much alive, the work must still be within the term of copyright protection, irrespective whether it was created in 2010 or 2005 or 1998.

14. The artwork in the mark applied is very similar to the artwork shown at paragraph 5 above that it is inconceivable that it was created independently by Mr Beck. I find that it has been copied from Mr Ervay's work. The use of the opposed mark in the UK would therefore be contrary to, inter alia, s.18 of the Copyright, Designs and Patents Act 1988, which prohibits the act of putting into circulation in the EEA copies not previously put into circulation in the EEA by or with the consent of the copyright owner.

15. As use of the opposed mark would be contrary to copyright law in the UK, registration of the mark is contrary to s.5(4)(b) of the Act.

Outcome

16. The opposition succeeds. The application will be refused.

Costs

17. As the opposition has succeeded, the opponent is entitled to a contribution towards his costs. I order Michael Millington to pay Thomas Ervay the sum of £900 made up of:

> £600 for filing a notice of opposition (including the official fee of £200) and considering the counterstatement;
> £250 for filing evidence in support of the opposition;
> £50 for filing written submissions.

18. This sum to be paid within 7 days of the end of the period allowed for appeal.

Dated this 9th Day of June 2014

Allan James
Hearing Officer

Thomas Ervay was represented by Trade Mark Consultants Co.

Michael Millington filed the counterstatement himself, but was otherwise unrepresented.