O/0596/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK NO. UK00003784589
IN THE NAME OF TIMOTHY OLDROYD
FOR THE FOLLOWING TRADE MARK:

IN CLASS 15

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY
UNDER NO. 505812 BY
GENEVA BRASSWIND LIMITED

BACKGROUND AND PLEADINGS

1. Timothy Oldroyd ("the proprietor") is the owner of the UK trade mark shown on the cover of this decision ("the proprietor's mark"). The proprietor's mark was filed on 5 May 2022 and entered onto the trade mark register on 5 August 2022. It stands registered for the following goods:

   Class 15: Brass instruments.

2. On 9 February 2023, Geneva Brasswind Limited ("the applicant") applied for a declaration of invalidity against the proprietor's mark. The application is brought under section 47 of the Trade Marks Act 1994 ("the Act") and is reliant upon section 5(4)(a) of the Act. In bringing this claim, the applicant relies on two earlier unregistered signs and alleges that it has been using both of them throughout the UK since 2011. The signs relied upon are 'GENEVA INSTRUMENTS' ("the applicant's word sign") and:

("the applicant's figurative sign")

3. The applicant claims to have used both signs in relation to "brass musical instruments". The basis of the claim is that the applicant has developed significant goodwill in the signs relied upon in the UK. As a result, use of the proprietor's highly similar or identical mark for identical goods will result in a misrepresentation in the mind of the public who will believe that the goods of the proprietor originate from the applicant, or are economically linked to it. This, the applicant pleads, will result in damage to the applicant either through lost sales or dilution and/or tarnishment of the goodwill and reputation in its signs.

4. The proprietor filed a counterstatement wherein he denied the claims against him. The basis of the proprietor's defence is that he founded Geneva Instruments in 2000, designed the logo and ran the business for many years on his own. In 2019, he entered into an agreement with a Mr Vincent Eckerman[1] regarding the transfer of the Geneva Instruments trade marks to Mr Eckerman. It is pleaded that part of the agreement was for the proprietor to transfer the trade marks to Mr Eckerman but this was not done. The proprietor explains that the reason for not making the transfer was because Mr Eckerman failed to comply with the terms of the agreement. Lastly, the proprietor claims that Mr Eckerman has sought to take the Geneva Instruments brand from him by entering into false promises.

5. The applicant is represented by Dollymores and the proprietor is unrepresented. Both parties filed evidence in chief with the applicant also filing both evidence and submissions in reply to the proprietor's evidence. No hearing was requested and both parties filed written submissions in lieu of the same. This decision is taken after a careful consideration of the papers before me.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE

7. The applicant's evidence in chief came in the form of the witness statement of Mr Vincent Francis Eckerman dated 17 July 2023. Mr Eckerman is the director of the applicant, a position he has held since December 2020. Mr Eckerman's statement is accompanied by 11 exhibits, being those labelled VFE1 to VFE11. The purpose of Mr Eckerman's statement is to not only prove the existence of goodwill in the

[1] It is not stated in the counterstatement who Mr Eckerman is but later in these proceedings, he is confirmed as being a director of the applicant.

applicant's business but also to rebut the allegations of the proprietor in his counterstatement.

8. The proprietor's evidence in chief came in the form of a witness statement in his own name. The statement is not dated but I note that it was filed on 27 September 2023 and is accompanied by a sworn statement of truth. The proprietor's evidence does not come with any supporting exhibits. His evidence goes into further detail regarding the complaints raised in his counterstatement.

9. The applicant's evidence in reply came in the form of the second witness statement of Mr Eckerman dated 6 November 2023. It does not contain any further exhibits but seeks to respond to the claims made by the proprietor in his own witness evidence.

10. I do not intend to summarise the evidence or submissions of the parties in full here but will refer to them below, where necessary.

PRELIMINARY ISSUES

The proprietor's claims

11. The proprietor's evidence was stated as being submitted to clarify the circumstances surrounding the intended transfer of intellectual property from himself to the applicant. Throughout these proceedings, the proprietor has claimed to have started the GENEVA INSTRUMENTS brand in the year 2000. It appears that the proprietor claims to have run the branding for some time before seeking to sell the brand to the applicant (a process seemingly headed up by Mr Eckerman) in 2019. As part of this process, the proprietor claims that Mr Eckerman was entrusted to fulfil several requirements to ensure the smooth and legitimate transition of the intellectual property. While the proprietor does not set out what these requirements were, he claims that Mr Eckerman failed to fulfil them. In direct response of Mr Eckerman's claimed non-compliance with the agreed upon terms, the proprietor made the decision to withhold the transfer of intellectual property to the applicant.

12. Despite the several claims made and multiple references to the terms that Mr Eckerman agreed to (and subsequently failed to comply with), the proprietor's evidence does not contain any supporting evidence. Even though the applicant expressly referred to the proprietor's lack of supporting evidence, it has sought to dispute the claims made. In doing so, the applicant has provided a copy of the deed of assignment between the proprietor, Mr Eckerman, Mr David Walker (together referred to as the 'Assignors') and the applicant (referred to as the 'Assignee') dated 5 October 2021.[2] This document is duly authorised by the relevant parties and sets out at clause 2 that any and all goodwill attaching to the 'Assigned Rights' are assigned to the applicant absolutely with full title guarantee. Those 'Assigned Rights' referred to are listed in a schedule to the document and, amongst others, include a sign identical to the proprietor's mark as well as signs identical or very highly similar to the signs relied upon by the applicant. Despite vague allegations as to Mr Eckerman failing to comply with the unidentified requirements imposed on him, the proprietor has filed no evidence as to why this document is not valid and his reference to his reasons for refusing to assign the rights are vague and unsupported.[3] As such, I am of the view that, in the absence of anything sufficiently solid to the contrary, any goodwill that stems from use of the 'GENEVA INSTRUMENTS' relied upon by the applicant duly vests in the applicant.

13. Even if it were not the case that this agreement were before me, I note that the proprietor has filed no actual evidence of his own use of the 'GENEVA INSTRUMENT' branding so as to support any claim to be the senior user of the same (being a potentially valid defence in passing off claims). In short, the evidence of the proprietor is vague and imprecise and I fail to see how it forms any form of valid defence to the claims brought against him. Having said that, by relying on the section 5(4)(a) ground, the burden still vests in the applicant to prove the existence of a protectable level of goodwill in its business and that the signs relied upon are distinctive and/or associated with that goodwill. I will, therefore, proceed to consider the issue of goodwill in the ordinary way.

[2] VFE3

[3] On this point, there is no reference to previously registered trade marks that would require formal assignment via a Form TM16. The assignment of goodwill is not something that the proprietor needed to have formally assigned in the same way as a registered right. Therefore, the document provided is sufficient evidence of where any goodwill vests.

DECISION

14. Section 5(4)(a) of the Act has application in invalidation proceedings because of the provisions of section 47 of the Act, which states as follows:

> "47. -
>
> (2) Subject to subsections (2A) and (2G),[4] the registration of a trade mark may be declared invalid on the ground-
>
> (a) […]
>
> (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,
>
> unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
>
> […]
>
> (5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.
>
> (5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.
>
> (6)Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

[4] Sub-sections (2A) and (2G) relate to earlier marks, as opposed to earlier rights under 5(4)(a) so these provisions have not been reproduced here.

Section 5(4)(a)

15. Section 5(4)(a) of the Act reads as follows:

> "(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) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
> >
> > (aa) […]
> >
> > (b) […]
>
> 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."

16. Subsection (4A) of Section 5 states:

> "(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

17. In *Discount Outlet v Feel Good UK,* [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

> "55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether *"a substantial number"* of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)."

18. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

19. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.' "

20. The proprietor's mark does not have a priority date. I note that the proprietor's defence is based on the fact that it was he who created and used the brand, however as I have discussed above, the deed of assignment duly shows that any goodwill stemming from this use now vests in the applicant. Further, there is no evidence from the proprietor setting out any competing use to the applicant's use that would be capable of being considered the start of the behaviour complained about. Therefore, the relevant date for the assessment of the applicant's claim under section 5(4)(a) of the Act is the filing date of the proprietor's mark, being 5 May 2022.

Goodwill

21. The first hurdle for the applicant is that it needs to show that it had the necessary goodwill in the signs relied upon at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

22. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends

to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

23. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

24. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an

unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

25. Goodwill arises as a result of trading activities. I remind myself that the applicant claims to have accrued goodwill in its unregistered signs of 'GENEVA INSTRUMENTS' ("the applicant's word sign") and the sign set out below. Further, the applicant claims to have used its signs throughout the UK since 2011 for "brass musical instruments".

("the applicant's figurative sign")

Evidence as to goodwill

26. The applicant's evidence sets out that its goods have been advertised via the websites 'genevainstruments.co.uk', 'genevainstruments.com' and 'genevabandroom.co.uk'. Printouts of these websites are provided in evidence that show the range of brass musical instruments that the applicant offers for sale.[5] The printouts have been obtained from the internet archive facility, the Wayback Machine, and are dated between 2011 and 2022. It is noted that the narrative

[5] VFE4 to VFE6

evidence sets out that the 'genevabandroom' website has been the primary website of the applicant since 2021. Further, it appears from the narrative evidence and the exhibits themselves that the goods shown are not available for sale on the 'genevainstruments' websites. Despite this, I note that the websites provide a list of the applicant's UK dealers. It does not appear that the applicant began selling its goods online via its website until the 'genevabandroom' website opened in 2021. Having considered the websites, I note that the earlier dated printouts make reference to the proprietor (seemingly via reference to product models under the name 'OLDROYD', being the proprietor's surname),[6] however, they all feature the signs relied on prominently. The goods shown on the websites appear to be brass musical instruments such as trumpets, French horns, tubas and tenor horns.

27. Social media evidence is then discussed and I note that copies of undated printouts from the applicant's Facebook, Instagram and Twitter accounts are provided.[7] The narrative evidence explains that this demonstrates how the applicant markets and advertises its goods under its signs. While a number of posts from prior to the relevant date are included on these printouts (along with posts from after), the level of engagement is either not shown or very limited. As for follower counts for these accounts, these are also limited but, more importantly, the printouts are undated meaning that it could very well be the case that they were obtained as at the date the statement was compiled, being 17 July 2023. This is over one year after the relevant date so it is not, therefore, possible to determine whether these figures are reflective of the position at that time.

28. A number of printouts from third party retail websites are provided that show a range of the applicant's goods listed for sale. As was the case with the applicant's own website evidence, these printouts were obtained from the Wayback Machine. They show printouts taken from 2021, which is prior to the relevant date. No level of sales associated with these websites are provided, however, the evidence does go on to discuss actual turnover figures associated with the sale of goods. Between 2017 and 2022, the applicant's sales figures are broken down as follows:

[6] See, for example, page 42 at VFE4
[7] VFE7

Time period[8]	Sales figures (£)
December 2017	1,888,861
June 2019	2,722,342[9]
June 2020	1,481,381
June 2021	176,653
June 2022	610,447
Total:	6,879,684

29. Given that the relevant date sits just prior to the date given for the recent most figure, it is likely that some of the figures covered are from after the relevant date. Having said that, the relevant date sits in May 2022 so it is likely that the majority of the sales provided does cover those from prior to the relevant date. I have no way to accurately determine how much but this is a point I will bear in mind going forward. In addition to the narrative evidence confirming the turnover figures, I note that one invoice in support of the same is provided.[10] This shows the sale of an Oldroyd Cardinal Tenor Horn for a value of £2,916.67 on 4 April 2022. The invoice includes reference to the 'GENEVA GROUP'. The invoice also makes reference to a contact email address with the domain 'genevainstruments.com' and reference to the applicant's website under that same domain.

30. On the point of the level of sales shown in the evidence, I am of the view that based on the evidence as a whole, it is reasonable to infer that it relates to a range of different brass instruments. Such a finding is supported by the presence of the various websites from prior to the relevant date that suitably show a range of various brass instruments.

31. Online press coverage wherein the GENEVA INSTRUMENT brand is provided in evidence.[11] One of the articles provided is taken from a regional publication called 'TeessideLive' which is dated May 2013 and discusses the brand. While noted, this

[8] While it is not specified as to what period these cover (i.e. there is no beginning date for the December 2017 figure), I consider it reasonable to infer that, save for the figures for June 2019, each time period is one year.
[9] This figure is referred to as covering an 'extended period', presumably covering sales from January 2018 to June 2019.
[10] VFE11
[11] VFE9

is a regional publication and not only do I have no readership figures for the same but I have nothing to suggest its level of reach across the entirety of the UK. In addition to this article, there is one article and two reviews, all of which taken from the website '4barsrest.com'. These articles/reviews are dated between December 2013 and August 2019 and relate to the GENEVA INSTRUMENTS brand. While I have nothing to suggest the actual level of readership associated with these articles/reviews, I note that the narrative evidence sets out that '4barsrest' is one of the most prominent brass instrument websites in the UK. Given that this evidence is unchallenged, I have no reason to doubt that this is a prominent website in the brass instrument industry. As such, I am of the view that these articles/reviews offer some assistance to the applicant.

Conclusions on goodwill

32. The applicant's evidence makes no reference to advertising spend and neither does it provided any evidence as to marketing activities undertaken prior to the relevant date. On this point, I do not consider the presence of social media evidence as sufficient evidence pointing to advertising efforts and, even if it was, the evidence before me is very limited in scope. While that may be the case, this does not mean that I am unwilling to find a protectable level of goodwill exists as a result of the use of the 'GENEVA INSTRUMENTS' brand. In considering what the evidence does actually show, I am of the view that the level of sales shown is a factor in favour of the applicant. While I have no evidence as to the size of the UK market for brass instruments, I am of the view that it is a fairly niche market that is unlikely to be an overly significant one. As such, I consider it reasonable to suggest that the turnover figures provided (being sales of £6.8 million over approximately six years) are likely to be respectable in comparison to that market. This evidence represents a respectable level of use over a fairly longstanding period of time (though I appreciate it is not overly longstanding) and is, in my view, sufficient to warrant a finding that there exists a level of protectable goodwill. That being said, the use is not overly significant and, as alluded to above, the lack of supporting evidence pointing to advertising/marketing efforts prevents me from concluding that the applicant enjoys a high level of goodwill. As a result, I am of the view that it is reasonable to find that that the goodwill is at a moderate level. To confirm, I

consider that both signs relied upon are distinctive of and/or associated with this level of goodwill (on the basis that both signs are shown repeatedly and prominently in the evidence) and that it vests in the goods relied upon, being "brass musical instruments". I make the latter finding on the basis that the evidence covers various instruments such as trumpets, tubas and French horns, all of which will, in my view, be fairly categorised as being "brass musical instruments".

33. In terms of ownership of said goodwill, I remind myself that I have discussed this as a preliminary issue above. While I do not intend to repeat this discussion here, I wish to confirm that, regardless of who the actual owner of the goodwill was in the years leading up to the relevant date,[12] I am of the view that the assignment document provided in evidence (being that already discussed at paragraph 12 above) suitably confirms that, as at the relevant date, the goodwill vested in the applicant. As a result, I am satisfied that the applicant is the owner of the aforementioned goodwill. Therefore, the applicant's claim in reliance upon the section 5(4)(a) ground may proceed.

Misrepresentation

34. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"

[12] I say this because the evidence does make reference to the proprietor himself and I note that the applicant company was not actually incorporated until 20 January 2016, being six years after the claimed use began (on this point see paragraph 3 of Mr Eckerman's first witness statement which sets out that the proprietor began selling instruments under the GENEVA branding in 2010).

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

"…. for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

35. I have found that the applicant enjoys a protectable level of goodwill for the signs relied upon in respect of "brass musical instruments". The mark/signs I must now compare are as follow:

The applicant's signs	The proprietor's mark
GENEVA INSTRUMENTS ("the applicant's word sign")  ("the applicant's figurative sign")	

36. The proprietor's mark is dominated by the words 'GENEVA INSTRUMENTS' and while the figurative elements will not be overlooked outright, they will have a very

limited impact on the mark itself. As a result, I consider that the fact it shares an identical word element to the applicant's word sign results in a finding that the proprietor's mark and the applicant's word sign are highly similar. As for the applicant's figurative sign, I am of the view that this is nigh on identical with the proprietor's mark. I say this because both marks feature identical word and figurative elements. If I am wrong to make this finding on the basis that the marks are incapable of being identical due to the proprietor's mark consisting of two additional black shapes and features a contrived colour split, then they are still very highly similar. The goods for which the proprietor's mark is registered, being "brass instruments" are, by virtue of being in class 15, musical instruments and, therefore, plainly identical to those for which the applicant enjoys goodwill. Clearly, it follows that the parties operate in the same field of business.

37. In light of the above findings, it is my view that a consumer who is aware of the applicant's brand of brass musical instruments would be deceived into believing that any brass musical instruments produced by the proprietor and sold under the identical brand of 'GENEVA INSTRUMENTS' (regardless of how said branding is stylised) would originate from the applicant. Overall, I find that use of the proprietor's mark for the goods covered by its specification would, at the relevant date, have constituted a misrepresentation to a substantial number of consumers.

Damage

38. Having found the existence of goodwill and misrepresentation, I consider that damage through diversion of sales is easily foreseeable. The application based upon section 5(4)(a) is, therefore, successful.

CONCLUSION

39. The application for invalidity against the proprietor's mark has succeeded in full. As a result, the proprietor's mark is, subject to any successful appeal, hereby declared invalid and deemed as if it had never been registered for any of the goods covered by its specification.

COSTS

40. As the successful party, the applicant is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,550 as a contribution towards the costs of proceedings.

Preparing an application for invalidity and considering the proprietor's counterstatement:	£300
Filing evidence, considering the proprietor's evidence and responding to the same:	£700
Filing written submissions in lieu:	£350
Official fees:	£200
Total:	**£1,550**

41. I therefore order Timothy Oldroyd to pay Geneva Brasswind Limited the sum of £1,550. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 25th day of June 2024

A COOPER
For the Registrar