

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION No. 81629**

**IN THE NAME OF INTELLIQ LTD**

**FOR REVOCATION OF TRADE MARK No. 1349402**

**IN THE NAME OF DATASPHERE SA**

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**DECISION**

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1. On 20 February 2004 Intelliq Ltd (*‘the Applicant’*) applied under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 for revocation of the registration of trade mark number 1349402. The trade mark was registered on 1 February 1991 with effect from 18 January 1988. It was registered in the name of Datasphere SA (*‘the Proprietor’*). The registration protected the following sign:



*for ‘computer software and computer programmes; materials for the recordal of computer programmes; magnetic and optical tapes, discs, cassettes and cartridges, all for the recordal of computer programmes; all included in Class 9’.*

2. The application for revocation under section 46(1)(a) contemplated that there had been no genuine use of the trade mark in the United Kingdom, by the Proprietor or with its consent, in relation to any goods of the kind for which the mark was registered, during the period of 5 years beginning on 2 February 1991 and ending on 1 February 1996.

3. The application for revocation under section 46(1)(b) contemplated that there had been no genuine use of the trade mark in the United Kingdom, by the Proprietor or with its consent, in relation to any goods of the kind for which the mark was registered, during the period of 5 years beginning on 20 February 1999 and ending on 19 February 2004.

4. There was no direct allegation of non-use in respect of the period 2 February 1996 to 19 February 1999. The Applicant also made no request for revocation to take effect from any date earlier than the date envisaged by section 46(6)(a) i.e. *'the date of the application for revocation'* (20 February 2004).

5. The Proprietor was required by Rule 31(3) of the Trade Marks Rules 2000 to file a Form TM 8 *'which shall include a counter-statement and be accompanied by - (a) two copies of evidence of use of the mark; or (b) reasons for non-use of the mark'*. In accordance with Rule 31(4), it was necessary for any evidence of use filed under Rule 31(3) to:

(a) cover the period of non-use alleged by the applicant ..., or

(b) where the proprietor intends to rely on section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.

6. On 25 May 2004 the Proprietor filed a Form TM 8 accompanied by a Witness Statement of Stuart Nield with 14 exhibits. In Box 7 of the Form TM 8 in the space for the Counterstatement required by Rule 31(3) the Proprietor inserted the words '*Please see attached*'. This was evidently a reference to the accompanying witness statement.

7. It is acceptable for a document which performs the function of a counterstatement to be incorporated by reference into the Form TM 8 by the use of words such as '*Please see attached*'. It is also acceptable for the document incorporated by reference to set out the defence to the claim in narrative form. However, the incorporated document will be open to the objection that it functions inadequately as a counterstatement if it does not provide a focused statement of the grounds on which it is contended that the tribunal should or should not do what it has been asked to do. The statement should not be prolix. It should however be full in the sense indicated by Mr. Simon Thorley Q.C. in COFFEEMIX Trade Mark [1998] RPC 717 at 722:

It must be full in the sense that it must outline each of the grounds ... relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible, but it must be complete.

8. The attempt in the present case to file a single counterstatement-cum-witness statement was misconceived. It was not appropriate to expect the Applicant or the Registrar to construe the witness statement for the purpose of identifying the Proprietor's defence(s) to the application for revocation. The wording in Box 7 of the Form TM 8 '*Please see attached*' succeeded in tendering for consideration as a counterstatement, a document in the form of a witness statement which did not adequately perform the

function that a counterstatement is required to perform. This informality should have been promptly remedied by a direction under Rule 57 of the Trade Marks Rules 2000 requiring the Proprietor to clarify the statement *'Please see attached'* by providing a summary in which the defence to be discerned in the attached witness statement was articulated to the standard I have noted above. However, that did not happen. The Applicant and the Registrar allowed the proceedings to go forward on the basis of the Form TM 8 as filed. The informality in the presentation of the Counterstatement required by Rule 31(3) was thereby waived.

9. The Witness Statement of Stuart Nield set out to:

.... provide evidence to show that there is on-going use of the DATASPHERE mark, and that therefore the claims under section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 ("the Act") must fail. Under Section 46(3) of the Act, provided that use is being made, the registration shall not be revoked.

It did so on the basis that the Proprietor:

.... intends to defend the full range of goods covered by registration no. 1349402, but I have not been able to obtain full evidence within the short and non-extendible deadline. Nevertheless, as the Registry's letter of 25 February 2004 advises, evidence at this stage need not be extensive.

10. Mr. Nield's Exhibit SRN 5 included a table of search results for the period 1 January 1996 to 20 May 2004 downloaded from the Wayback Machine at [www.archive.org](http://www.archive.org). This merely indicated that the Proprietor had a website accessible at [www.datasphere.ch](http://www.datasphere.ch) in 1998 and later years. Save as to that, his evidence and exhibits

were directed to the proposition that there had been use of the trade mark in issue (or at least use of the mark in a form not materially different from the form in which it was registered) in and after the year 2000.

11. The Applicant took the view that the evidence provided by Mr. Nield was not sufficient to satisfy the requirements of Rule 31(3). In correspondence with the Registry it endeavoured to persuade the Registrar that the application for revocation should therefore be treated as undefended under that Rule. The Registrar declined to proceed on that basis. The refusal to do so involved nothing more than a determination that the evidence filed on behalf of the Proprietor showed an arguable or viable defence: MOO JUICE Trade Mark [2005] EWHC 2584 (Ch) Kitchin J., 18 November 2005; YORK Trade Mark (BL O-191-05, 1 July 2005). However, the Proprietor appears to have regarded it as a finding of use sufficient to defeat the application for revocation and decided on that view of the matter to file no further evidence in defence of its registration. For its part, the Applicant continued to maintain that the evidence filed on behalf of the Proprietor was insufficient to defeat the application for revocation. It filed no evidence: none was needed in order to support that proposition.

12. The parties were content to have the application for revocation determined on its merits without recourse to a hearing. Both sides filed written submissions in support of their positions. The determination was made on the basis of the papers on file by Mr. George Salthouse acting on behalf of the Registrar. He determined in a written decision issued on 5 July 2005 (BL O-193-05) that the specification of the registration in suit should be restricted to '*computer software and computer programmes*' under section

46(5) of the Act with effect from the date of the application for revocation (20 February 2004). He directed the Proprietor to pay the Applicant £1,000 as a contribution towards its costs of the Registry proceedings.

13. In his decision he dealt with the defence of the registration in the following terms:

13) Of the evidence filed only two parts are relevant, as the others are either dated after the relevant date, do not refer to use in the UK, or are so generalised that they invite supposition rather than offering evidence. The two relevant exhibits are:

- a) the invoices at exhibit SRN1 which are dated from 27.04.00-13.03.03 and relate to payments for software maintenance or software licence. The invoices refer to the software by way of codes and not the mark in suit. However, the top of the invoice does have the mark in suit upon it and must be considered as part of an after sales service; and
- b) the two letters to banks in London at exhibits SRN 12 & 13, dated June 2000 and January 2001, providing information in the form of a brochure (not supplied) on the “Bali” software system and identifying the manufacturer as Datasphere (the name being in plain font and not with the “ghosting” used in the mark in suit). To my mind this shows that the registered proprietor, via its agent, is seeking sales of its computer software and programmes in the UK.

14) I have to consider whether the use of the plain font version of the trade mark can be considered use of the registered mark. In considering this issue I look to the judgement of the Court of Appeal in *BUD/BUDWEISER BUDBRAU* [2003] RPC 24. ...

15) ...

16) To my mind the use of the name of the company in plain font equates to use of the mark in suit as the “ghosting” effect, whilst a recognisable element, is insignificant compared to the dominant feature of the mark “Datasphere”.

17) In the light of this evidence I believe that the registered proprietor has shown genuine use of the mark in suit upon “computer software and computer programmes”.

18) I do not accept that the evidence shows use upon the remainder of the specification namely, “materials for the recordal of computer programmes; magnetic and optical tapes, discs, cassettes and cartridges, all for the recordal of computer programmes; all included in Class 9”. I therefore order that this part of the specification be revoked with effect from 20 February 2004.

14. The Applicant appealed to an Appointed Person under section 76 of the Act contending, in substance, that:

- (1) the evidence filed on behalf of the Proprietor was insufficient to establish genuine use of the relevant trade mark for any of the goods in Class 9 for which it was registered;
- (2) alternatively the evidence filed on behalf of the Proprietor was insufficient to justify retention of the registration in suit for all forms of ‘*computer software and computer programmes*’ in Class 9;
- (3) in any event the effective date of revocation ought to have been 2 February 1996 pursuant to the claim under section 46(1)(a) of the Act.

These contentions were developed in argument at the hearing before me.

15. In addition the Applicant applied for permission to amend its Notice and Grounds of Appeal so as to contend that the Proprietor had filed nothing amounting to a counterstatement within the unextendable period of 3 months prescribed by Rule 31(3) and that there should accordingly have been an order for revocation in default of defence under that Rule. I rejected this application on the ground that no useful purpose would be

served by allowing the contention to be pursued. The attempt to file a single counterstatement-cum-witness statement was, as I have already said, misconceived. However, it was not a nullity. It resulted in the filing of a counterstatement that was deficient for lack of specificity. That was curable. The failure to cure it was not fatal. The parties joined issue on the deficient counterstatement notwithstanding the deficiencies. That, to my mind, was the end of the matter.

16. I now turn to the points raised by the Notice and Grounds of Appeal.

### **Point 1**

17. This point rested on the proposition that the evidence filed on behalf of the Proprietor showed use of the relevant trade mark in relation to services, not goods. There was no challenge to the hearing officer's finding that use of the name **DATASPHERE** in plain font could be equated with use of the mark as registered. It was submitted that the evidence failed to show use of the mark relative to goods in respect of which it was then being or had previously been used.

18. I agree that the evidence is thin. However, I consider that the hearing officer was required to assess it as a whole and entitled in doing so to regard Exhibits SRN 12 and SRN 13 (in the context of Exhibits SRN 1, SRN 7, SRN 8 and SRN 14) as indicative of a course or pattern of dealing in which the trade mark (or its near equivalent) was used in the United Kingdom during the period of 5 years preceding the date of the application for revocation (20 February 2004) in relation to Class 9 goods within the specification of the

registration in suit. There is no reason to suspect or suppose that such use was not genuine. I therefore reject point 1 of the argument advanced on appeal.

## **Point 2**

19. With what degree of particularity should an order reducing the scope of a specification of goods under section 46(5) of the Act identify and define the goods for which the trade mark is to remain registered? I believe that this should be determined in accordance with the considerations noted in paragraphs 11 to 19 of my decision in WISI Trade Mark (BL O-251-05, 12 September 2005). Fair protection should be achieved by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify.

20. In relation to '*computer software and computer programmes*', that requires evaluation of the evidence of use in the light of the observations of Laddie J. in Mercury Communications Ltd v. Mercury Interactive (UK) Ltd [1995] FSR 850 at 864, 865 where he said:

At the beginning of this judgment I set out the specification of goods in respect of which the plaintiff's mark is registered. In fact the plaintiff only uses it and, I understand, only ever intended to use it in relation to its telecommunications business. The defendant argues that the registration, in so far as it covers computer software, should be restricted as follows: "All for use in or with telecommunications systems."

The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and

enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to Mr Silverleaf that the registration of a mark for “computer software” would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff’s type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable.

In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.

21. This approach appears to me to be consonant with the approach recently adopted by the ECJ in Case C-418/02 Praktiker Bau-und Heimwerkermärkte AG (7 July 2005) in relation to the registration of trade marks for retail services. The Court considered the

degree of particularity which the services of interest to the proprietor should be specified for the purposes of protection by registration:

11. Praktiker Märkte filed for registration with the Deutsches Patent – und Markenamt the mark **Praktiker** in relation to, inter alia, the service described as ‘retail trade in building, home improvement and gardening goods for the do-it-yourself sector’.

...

17. .... in the opinion of the Bundespatentgericht, for the function of the trade mark as an indication of origin to be fulfilled, the subject-matter of the protection conferred must be determined with sufficient precision. General concepts such as ‘retail services’ do not satisfy the requirement of certainty in relation to exclusive rights. Restrictions confining such protection only to the goods distributed do not overcome the indeterminate nature of the words ‘retail trade’ in the individual sector concerned. They leave open the question of what services are covered, apart from the mere sale of those goods. Similar objections can be raised with regard to the provision of details relating to the type of sales location, such as ‘department store’ or ‘supermarket’, for example.

18. The need for a restriction, when registering trade marks, of the content of ‘services provided by a retailer’ applies to an even greater extent to the interpretation of ‘likelihood of confusion’ in Article 4 (1)(b) and Article 5(1)(b) of the directive. Even a reasonable specification, at the time of the registration procedure, of the content of ‘services provided by a retailer’ would ultimately prove insufficient if the service trade mark registered were to be granted a scope of protection which was not capable of review as a result of a wide interpretation of ‘similarity of [the] goods or services’

Reply of the Court

...

32. If the concept of ‘services’ were a matter for the Member States, conditions for the registration of service trade marks could vary according to the national legislation concerned. The objective that acquisition of the right in the trade mark should be subject to

‘conditions . . . identical’ in all Member States would not be attained.

33. It therefore falls to the Court to supply a uniform interpretation of the concept of ‘services’ within the meaning of the directive (see, by analogy, Joined Cases C-414/99 to C-416/99 *Zino Davidoff and Levi Strauss* [2001] ECR I-8691, paragraphs 42 and 43).

34. In that regard, it should be noted that the objective of retail trade is the sale of goods to consumers. That trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, inter alia, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor.

....

40. The question arises as to whether, in the particular case of the retail trade, the concept of ‘services’ within the meaning of the directive needs further specification.

41. In that regard, in the observations submitted to the Court, it was maintained that the services eligible for protection as retail services should be identified in a way which distinguishes them from services which, being closely connected with the sale of goods, could not give rise to registration of a trade mark. It was pointed out, moreover, that the application for registration of the trade mark should specify in detail the service(s) for which the applicant seeks protection.

42. It is argued that such details are necessary, in particular, to safeguard the essential function of the trade mark, namely, as the guarantee of the identity of the origin of the goods or services covered by the trade mark, and to prevent trade marks for retail services from being afforded over-wide and indeterminate protection.

43. The difficulty of the questions thus raised is illustrated by the different answers proposed by the parties which submitted observations and by the information available to the Court regarding the current practices of the Member States.

44. For the reasons set out below, there is no need to rely on a definition of 'retail services' for the purposes of the directive which is more restrictive than that which follows from the description contained in paragraph 34 of this judgment.
45. It must first be stated that any distinction between the various categories of services provided with the sale of goods which involved a more restrictive definition of 'retail services' would prove artificial in the light of the reality of the important economic sector represented by retail trade. It would inevitably raise difficulties both as regards the general definition of the criteria to be adopted and as regards the application of those criteria in practice.
46. Admittedly, a more restrictive definition of 'retail services' would reduce the protection afforded to the proprietor of the trade mark, so that questions concerning the application of Articles 4(1) and 5(1) of the directive would arise less often.
47. However, that is not sufficient to justify a restrictive interpretation.
48. There is nothing to indicate that any problems resulting from the registration of trade marks for retail services could not be resolved on the basis of the two relevant provisions of the directive, as they have been interpreted by the Court. In that regard, it should be recalled that, according to the Court's case-law, the likelihood of confusion must be assessed globally, taking into account all the factors relevant to the circumstances of the case (see Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 22, and Case C-39/97 *Canon* [1998] ECR, I-5507, paragraph 16). In the context of that global assessment, it is possible to take into consideration, if need be, the particular features of the concept of 'retail services' that are connected with its wide scope, having due regard to the legitimate interests of all interested parties.
49. In those circumstances, for the purposes of registration of a trade mark covering services provided in connection with retail trade, it is not necessary to specify in detail the service(s) for which that registration is sought. To identify those services, it is sufficient to use general wording such as 'bringing together of a variety of goods, enabling customers to conveniently view and purchase those goods'.
50. However, the applicant must be required to specify the goods or types of goods to which those services relate by means, for example, of particulars such as those contained in the application for

registration filed in the main proceedings (see paragraph 11 of this judgment).

51. Such details will make it easier to apply Articles 4(1) and 5(1) of the directive without appreciably limiting the protection afforded to the trade mark. They will also make it easier to apply Article 12(1) of the directive, which states that '[a] trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the . . . services in respect of which it is registered, and there are no proper reasons for non-use'.
52. The answer to the first two questions referred for a preliminary ruling must therefore be that the concept of 'services' referred to by the directive, in particular in Article 2, covers services provided in connection with retail trade in goods.

For the purposes of registration of a trade mark for such services, it is not necessary to specify the actual service(s) in question. However, details must be provided with regard to the goods or types of goods to which those services relate.

In the passages I have underlined, the requirement for retail services to be further specified by reference to the types of goods that are or will be made available by the service provider under the relevant trade mark is related to the need for legal certainty as to the area(s) of retail trading activity for which registration has been sought or obtained. The need for legal certainty is clearly not confined to cases involving the registration of trade marks for retail services: see paragraph 12 of the decision of the First Board of Appeal of the Community Trade Marks Office in Case R 167/1998-1 San Francisco Challenge (24 March 1999). The force of the point made by Laddie J. in Mercury Communications that '*the defining characteristic of a piece of computer software is not the medium on which it is recorded . . . but the function it performs*' is evident in that connection.

22. On behalf of the Proprietor it was pointed out that specifications for '*computer software and computer programmes*' are routinely regarded as acceptable without further qualification. I am aware that such specifications are generally accepted without qualification by registries around the world. I am not aware of the United Kingdom Registry or the Community Trade Marks Office seeking to apply any significantly stricter criteria to applications for registration within their spheres of operation. It nevertheless remains the case that the approach envisaged by Laddie J. in the Mercury case has been referred to with approval in later cases: MINERVA Trade Mark [2000] FSR 734 (Jacob J.); Decon Laboratories Ltd v. Fred Baker Scientific Ltd [2001] RPC 17, p. 293 at paragraph 21 (Pumfrey J.); DaimlerChrysler AG v. Alavi [2001] RPC 42, p. 813 at paragraph 70 (Pumfrey J.); and indirectly by approval of MINERVA in Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd [2003] RPC 32, p. 586 at paragraphs 26 to 29 (per Aldous LJ). It has a parallel in the approach adopted by the ECJ in Case C-418/02 Praktiker Bau. And in any event the task of determining fair protection relative to the use which has been made of a mark necessarily requires consideration of the particular area(s) of trading activity in which the mark has actually been used.

23. The evidence in the present case certainly does not show use of the relevant trade mark in relation to '*computer software and computer programmes*' in general. It indicates that use of the trade mark (or its near equivalent) was limited during the period of 5 years preceding the date of the application for revocation to items embodying '*computer software and computer programmes*' which:

fully automate the flow of messages between banking applications and the SWIFT (Society for Worldwide

Interbank Financial Telecommunications) network and interface with main back office applications on the international market and with external (non IBM AS/400) platforms using NFS-IFS or MQ Series

(Exhibit SRN2)

- connect IBM AS/400 platforms to the SWIFT network without any additional hardware;
- manage the flow of messages generated by banking applications and direct them to the SWIFT or the Telex network;
- receive and dispatch incoming messages in real time or in batch;
- provide easy-to-use functions for system configuration, administration and security management;
- allow authorised users to create SWIFT messages from a 5250 terminal

(Exhibit SRN4)

24. The role of the Proprietor as a specialist provider of niche '*computer software and computer programmes*' is clearly confirmed:

Our company, founded in 1983, is specialised in banking telecommunications. We have developed interfaces with financial information suppliers (REUTERS, TELEKURS) as well as with national clearing and settlement institutions (SWISS INTERBANK CLEARING, SEGA/INTERSETTLE)

(Exhibit SRN4)

DATASPHERE is a software editor

The goal of our software edition (sic) activity is to provide for banking and financial institutions 'the missing link' between the banking application software and the service provider in the area of

- Financial information.

- Clearing.
- Settlement

Our software operates mainly in a banking environment with a strong specialisation in telecommunication, primarily on IBM platforms.

Software development is generally based on requests made by a group of banks or by a service provider.

DATASPHERE is a consulting firm

As a consulting firm, we help banks to plan their communication and information system strategies for the future, choosing options for the next 5-10 years, and managing projects.

DATASPHERE is a SWIFT registered partner and vendor

It develops connection links between the SWIFT Alliance platform and IBM hosts (mainframe and AS/400) and direct connections to SWIFT (AS/400).

(Exhibit SRN9).

25. I am unable to accept that the evidence on file is sufficient to justify retention of the registration in suit for all types of '*computer software and computer programmes*' in Class 9. The Proprietor defended the proceedings before the Registrar and before me on the basis that use within the language of the specification of goods, however broadly described, would be sufficient pro tanto to defeat the application for revocation. It did not elaborate on what a fair specification would be in the light of the evidence on file if that approach was (as I think it should be) rejected. Giving effect to the considerations noted in paragraphs 11 to 19 of WISI Trade Mark (above) and the further considerations noted in paragraphs 20 to 22 above, I take the view that the specification of goods for which the Proprietor's trade mark is to remain registered under section 46(5) of the Act should be qualified so as to reduce it to:

computer software and computer programmes, all for use in or with banking or financial telecommunications systems.

Point 2 of the argument advanced on appeal is accepted to that extent.

Point 3.

26. So far as I can tell from the decision under appeal, the hearing officer did not separately consider the request for revocation under section 46(1)(a) of the Act. The Applicant maintains that he should have done so and upon doing so should have made the order for part cancellation effective as of 2 February 1996.

27. I do not agree. Under section 46(6)(b) of the Act the power to order revocation from a date earlier than the date of the application for revocation is conditional upon the decision taker being satisfied that the grounds for revocation existed at that earlier date. If the application for revocation is made on the basis of non-use, the decision taker must also be in a position to say that the grounds for revocation existed in relation to the excluded goods or services at all material times after the earlier date. That is because an order for revocation on the basis of non-use cannot be made with effect from the earlier date in relation to goods or services for which the trade mark has been used at any material time thereafter: section 46(3) of the Act. In reaching a decision it is undoubtedly necessary to apply the provisions of section 100 of the Act:

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.

However, it is only necessary for the proprietor to carry that burden to the extent that such a question has indeed arisen for determination. The extent to which such a question has arisen for determination depends primarily on the pleadings. It is appropriate to consider whether they fairly and squarely raise a claim for revocation from a date earlier than the date of the application for revocation: Omega SA v. Omega Engineering Inc. [2003] FSR 49, p. 893 (Jacob J.). It may also be appropriate to consider whether the parties have none the less joined issue on the basis that revocation has effectively been claimed from an earlier date: WISI Trade Mark (above) at paragraphs 25 to 29.

28. The pleadings in Omega referred to the provisions of sections 46(1)(a) and 46(1)(b) of the Act, but did not specifically raise a claim for revocation from a date earlier than the date of the application for revocation. Jacob J. held (at p.896) that *'the mere reference to s.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'*. That observation applies to the pleadings in the present case. They were silent as to making of any claim for revocation from a date earlier than the date of the application for revocation (20 February 2004). In order to have raised such a claim pursuant to section 46(1)(a), the Applicant should have requested revocation with effect from 2 February 1996 (the day following the 5<sup>th</sup> anniversary of the date on which the trade mark was registered on completion of the procedure for registration). In order to have raised such a claim pursuant to section 46(1)(b) the Applicant should have requested revocation with effect from a date between 2 February 1996 and 19 February 2004. It actually made no request for revocation from any date earlier than 20 February 2004. I see no reason to think that

the parties joined issue on the basis that revocation had been requested with effect from 2 February 1996 or any other date prior to 20 February 2004. I consider that the hearing officer was entitled, if not bound, to regard 20 February as the relevant date for the purposes of the order under section 46(5). I therefore reject point 3 of the argument advanced on appeal.

### **Conclusion**

29. The appeal succeeds to the extent that I have indicated above. It appears to me that the costs of and relating to points 1 and 3 on which the Proprietor has succeeded and the costs of and relating to point 2 on which the Applicant has succeeded are more or less evenly balanced. I therefore make no order as to costs in respect of the appeal. The hearing officer's order for costs will remain undisturbed. I consider that the Applicant should receive the sum awarded in respect of the Registry proceedings on the basis that it covers costs which could have been avoided if the Proprietor had fully accepted the need for part cancellation and made detailed submissions as to what a fair specification would be in the light of the evidence on file.

Geoffrey Hobbs Q.C.

16 January 2006

Mr Michael Edenborough instructed by Messrs. Barlin Associates appeared as Counsel on behalf of the Applicant.

Mr Stuart Nield of Mewburn Ellis LLP appeared on behalf of the Proprietor.

The Registrar was not represented.