

O-026-11

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2523346
IN THE NAME OF BO WURTZ

AND

OPPOSITION THERETO UNDER NO 99765
BY TIVO BRANDS LLC

TRADE MARKS ACT 1994

IN THE MATTER OF application
no 2523346 in the name of
Bo Wurtz and opposition thereto
under no 99765 by TiVi Brands LLC

Background

1. Application no 2523346 is for a series of two marks as follows:

Tibo
TIBO

2. The application stands in the name of Bo Wurtz and was applied for on 11 August 2009. Registration is sought in respect of the following goods and services:

Class 9

Apparatus and instruments for recording, transmission and reproducing sound and/or images; television, radio and video apparatus and instruments; DVD players; CD players; clock radios; audio cassette players; loudspeakers; speakers (audio equipment); amplifiers; amplification apparatus and instruments; headphones; telecommunications apparatus and instruments; stands for televisions; docking stations for MP3/MP4 players; parts and fittings for all the aforesaid goods; audio or video recordings; all included in Class 9

Class 35

Retail and wholesale services (including electronic retail and wholesale services provided via the internet) connected with the sale of apparatus and instruments for recording, transmission and reproducing sound and/or images, television, radio and video apparatus and instruments, DVD players, CD players, clock radios, audio cassette players, loudspeakers, speakers (audio equipment), amplifiers, amplification apparatus and instruments, headphones, telecommunications apparatus and instruments, stands for televisions, docking stations for MP3/MP4 players, audio or video recordings, parts and fittings for all the aforesaid goods; advertising services; provision of space on websites for advertising purposes; marketing and promotional services; advisory, consultancy and information relating to the above.

3. Following publication in the *Trade Marks Journal*, Notice of Opposition was filed by TiVo Brands LLC ("Tivo"). There is a single ground of opposition brought under the provisions of section 5(2)(b) of the Act and based on community trade mark No. 1006014 for the mark TiVo. This mark is protected in relation to goods and services in a number of classes but, for the purposes of this opposition Tivo relies on the following goods and services only:

Class 9

Computer hardware, software and peripherals for personalized, interactive television programming; televisions; television peripheral remote controls; communication devices; transmitters; receivers and controls, and software for use therewith.

Class 35

Advertising; business management; business administration; office functions; the promotion and sale of goods and services for others.

4. Mr Wurtz filed a counterstatement in which he admits Tivo is the proprietor of the Community mark it relies on in these proceedings. He further admits that 'some' (but not further specified) goods within the specifications of goods in class 9 are identical or similar but otherwise denies all the claims made by Tivo.

5. Both parties filed evidence and Tivo requested to be heard. The hearing took place before me by telephone on 20 January 2011. Mr Wurtz did not attend nor was he represented though written submissions in lieu of attendance were filed. Tivo was represented by Mr Jeffrey Parker of Jeffrey Parker & Co, its legal representatives in these proceedings.

The objection under section 5(2)(b)

6. This section of the Act reads:

(2) A trade mark shall not be registered if because -

- (a) ...
- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings, Tivo is relying on a Community Trade Mark, No.1006014. This has an application date, based on a priority claim date from the United States, of 13 March 2001. It qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 18 September 2009 and TB’s trade mark was registered on 1 February 2001. As the earlier mark was registered more than five years before the publication date of the mark for which registration has been applied, it is subject to the provisions of The Trade Marks (Proof of Use, etc) Regulations 2004, the relevant sections of which read as follows:

“6A (1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) 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

(b) 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.

(5)

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7)....”

9. Also of relevance is section 100 of the Act which states:

“**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.”

10. I therefore go on to consider whether genuine use has been shown of the mark relied on by Tivo. In doing so, I take into account that the relevant period is the five year period ending with the date of publication of Mr Wurtz’s application, i.e. 19 September 2004 to 18 September 2009.

11. At the hearing, Mr Parker conceded that Tivo had not proved use of its earlier mark in relation to some of the goods and services it relied on originally in these proceedings and as set out in paragraph 3 above. As a result of this concession, Tivo relies on the following goods only:

Computer hardware, software and peripherals for personalized, interactive television programming; television peripheral remote controls.

12. Tivo’s evidence comes from Mr Joe Miller, Senior Vice President, Retail Sales and Marketing for TiVo Inc. and from Ms Elizabeth Ortiz of Cooley LLP, who describes herself as counsel for Tivo.

13. Mr Miller’s evidence shows Tivo is the subsidiary company of TiVo Inc, an American company incorporated in 1997. The company developed a digital video recorder for use with televisions. It takes the form of a remote controlled set-top box which enables movie and television downloads, search facilities, personal photo viewing, music and online scheduling. In the autumn of 2000, Tivo entered into an agreement with “a local partner”, British Sky Broadcasting (“BSB”) to deliver its products and services in the UK. These are delivered through BSB who provides the customer with access to its services, through a set-top box and for which the customer pays a subscription. The trade mark TIVO is said to appear on screen when the box is being used.

14. The agreement with BSB came to an end in 2003 (before the relevant period) since when no further set-top boxes have been sold in the UK. Mr Miller says that some 22,000 set-top boxes were supplied in the UK when the agreement was in

force. He states that “almost 13,000 of those boxes are still being used and are actively subscribed to the Tivo service”. Mr Miller gives no further details of this use and does not explain how this service is delivered given the agreement with BSB ended in 2003. At LP 1 Mr Miller exhibits photographs of remote controls and manuals which were supplied with the devices. The remote control shown bears the name Thomson at its lower end. At the top of the device is what appears to be a cartoon-type character in the form of a television set which has two antennae sprouting from its ‘head’ and with humanoid legs and a smile. The letters TiVo (in a variety of colours) are presented in a way that is suggestive of the character having eyes and a nose. The exhibit also contains pages downloaded from the TiVoPortal website and is entitled ‘What is TiVo?’. None of the material is dated.

15. Mr Miller states that since the agreement with BSB ended, Tivo has “set about finding another partner”. It has been in talks with other service providers with a view to re-launching its Tivo branded DVR and set-top boxes. An agreement is said to have been reached with Virgin in November 2009 (after the relevant period), though no further detail of that agreement has been provided.

16. Mr Miller says that Tivo has kept an active presence in the UK since 2000. Staff regularly travel to the UK to present at industry events (though he gives no details of these), there are regular mentions of products and services in local trade publications (though again no further details are given) and market research has been carried out (once again, no further details are given). Mr Miller says that a subsidiary company set up in the UK in 2000 is still in existence. It opened an office in the UK in 2001 and employed some 5-10 employees before closing sometime in 2006 or 2007. No further details are given of this office or its function. Mr Miller says that “earlier this year” (his statement is dated 13 September 2010) Tivo retained “full-time contractors in the UK and opened a testing lab devoted to its upcoming product re-launch”. Again, no further details are given.

17. Mr Miller states that Tivo has spent “hundreds of thousands of dollars to advertise, market and promote its products in the United Kingdom”. At LP 2 he exhibits copies of invoices relating to such advertising in the UK. The invoices have been redacted in such a way that no advertising expenditure can be identified. Each of the eight invoices is dated 30 November 2001 (before the relevant period) with four of them referring to the Sky/Tivo launch and four to the “2001/2002 campaign”.

18. Mr Miller states the company has received numerous awards and, at LP3, exhibits a list of these. The details listed are very limited but it is possible to identify that some of the entries show that they relate to awards given to individuals, others show the company to have been entered for an award (which they did not get) and still others relate to unidentified products. And, as Mr Wurtz points out in his written submissions, none appear to relate to the UK.

19. Mr Miller states that Tivo products and services have been “the subject of thousands of unsolicited stories and references in television, radio, and print media” and at LP4 exhibits a number of articles. They date from between 10 March 2000 and 8 April 2002 (before the relevant period). At LP5 is what is described as a listing of press references in the UK. The report is said to consist of 501 pages. Only the first and last fifteen are included in the exhibit. The listing is headed “clip report

August 2006 to April 2010” and provides details of the partial headline of various articles. The detail is scant but close inspection shows that very few of the partial headlines make any reference to Tivo. Those that do include ‘TiVO launches Research Unit’, ‘Tivo Inc Tivo names Steve Sordello as’, ‘TiVo Order to shut down DISH DVR’s blo...’ and ‘Court puts halt on TiVo patent case...’. None of the articles listed have been provided and I am therefore unable to determine what they may have shown.

20. At LP 6, Mr Miller exhibits a listing of worldwide website traffic to the Tivo website between 2002 and 2008. He says the website is widely visited by “hundreds of thousands of visitors from the UK”. The listing indicates that “this data is derived from a sample of traffic for the relevant period. These numbers do not represent a complete count of traffic from each country”. I do not know how these figures were compiled but in any event the listing gives no indication of how or why the visitor may have arrived at the website nor does it provide any detail of what pages they may have seen when they got there.

21. At the hearing, Mr Parker accepted that the evidence of use was not focussed as it could have been. He admitted that no goods had been sold during the relevant period but did not base any claim under section 6A(3)(b) that there were genuine reasons for non use. Instead, he submitted that the mark had been ‘kept alive’ by the continued use of set-top boxes which were provided between 2001 and 2003 and that this was sufficient to show genuine use of the mark within the relevant period. He also submitted that the continued use did provide a guarantee of the origin of the products. He submitted that the Act did not define “genuine use” but referred me to section 10 of the Act which sets out some guidance for the purposes of determining whether infringement has taken place.

22. I reminded Mr Parker of the long-established guiding principles to be applied in determining whether there has been genuine use of a mark. These are set out in *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 and *Laboratoire de la Mer Trade Mark* [2006] FSR 5. From these cases it is clear that:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

23. Tivo claims to have made genuine use of the earlier mark in the UK in relation to *computer hardware, software and peripherals for personalized, interactive television programming; and television peripheral remote controls* within the relevant period but also admits that it has not sold any such goods within that period (or since). There is no evidence of any advertising or promotional activity having taken place within the relevant period (or since). Whilst it is said that some of the goods sold before the relevant period have continued to be used to enable the users to receive Tivo's services, the details of such use in scant. In any event, the issue before me is not whether or not genuine use has been made of the mark in relation to the services for which it is registered but rather whether there is genuine use in relation to the goods themselves. As shown in the evidence these goods are what could be described as high-tech products, the nature of which means they are ever-changing and rapidly developing in terms of their function, capability and ease of use. It has not supplied goods since sometime in 2003 and thus, in my view has not preserved, or shown it has been creating, a market share. In effect, Tivo is relying on legacy use rather than actual use. Many products will be used after they are no longer marketed but that does not maintain or create a market in those products. The fact that Tivo has recently entered into an (unspecified) agreement with a new local partner does not assist. **In short, taking all facts and circumstances before me into account, I do not consider, on the evidence, that Tivo has shown genuine use of its earlier mark in relation to the goods it relies upon within the relevant period.**

24. In view of my decision, Tivo is not entitled to rely on its earlier mark in support of its objection to Mr Wurtz's application. That being the case, the opposition based on

section 5(2)(b) of the Act fails in its entirety and Mr Wurtz's application is free to proceed to registration.

Costs

25. The opposition having failed Mr Wurtz is entitled to an award of costs in his favour. I make the award on the following basis:

For reviewing Notice of Opposition and filing counterstatement:	£300
For filing and reviewing evidence:	£500
For preparation of written submissions:	£200
Total:	£1,000

26. I order TiVo Brands LLC to pay Bo Wurtz the sum of £1,000. 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 the case should any appeal against this decision be unsuccessful.

Dated this 28 day of January 2011

**Ann Corbett
For the Registrar
The Comptroller-General**