

O-029-11

TRADE MARKS ACT 1994

**IN THE MATTER OF
REGISTRATION NO 2453920**

**IN THE NAME OF
PLENTY MORE LLP
OF THE TRADE MARK:**

PlentyMoreFish



IN CLASS 45

AND

THE APPLICATION FOR A DECLARATION

OF INVALIDITY THERETO

UNDER NO 83364

BY

PLENTYOFFISH MEDIA INC

Trade Marks Act 1994

**In the matter of registration no 2453920
in the name of Plenty More LLP
of the trade mark:**

PlentyMoreFish



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thereto under no 83364
by Plentyoffish Media Inc**

INTRODUCTION

1) On 27 April 2007 AT New Media Ltd applied to register the above trade mark. The registration process was completed on 12 October 2007. The trade mark is registered for:

agency services (Dating -); computer dating services; dating agency services; dating services.

The above services are in class 45 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The trade mark has since been assigned twice. It is currently registered in the name of Plenty More LLP (LLP).

2) On 27 October 2008 Plentyoffish Media Inc (Inc) filed an application for a declaration of invalidation of all of the services of the registration under section 47 of the Trade Marks Act 1994¹ (the Act). Inc relies upon section 5(4)(a) of the Act, which states:

“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”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

3) Inc claims to have used the signs **Plenty of Fish**, **Plentyoffish**, **Plentyoffish.com** in the United Kingdom in relation to online dating services since 2001.

4) Inc states that it is one of the largest online dating services in the world and that it has operated an online dating service under the name PLENTYOFFISH at the website located at plentyoffish.com since 2001. Inc states that its website is the second most viewed dating website in the United Kingdom, according to web tracking service Comscore. Inc states that, according to Alexa.com, its website is one of the 150 most visited websites in the United Kingdom. Inc states that traffic statistics for April 2007 show that plentyoffish.com received 4,439,563 new or repeat visitors from the United Kingdom.

5) Inc claims that the services of LLP's registration are identical to the services for which it has a reputation.

6) Inc states that LLP has, since about September 2006, operated an online dating agency under or by reference to the name PLENTYMOREFISH at a website located at plentymorefish.com.

7) Inc states that its online dating service is free for consumers to use, being funded by online advertising. It states that the online dating services operated by LLP are funded wholly or partly by consumer payments collected from customers' credit cards. Inc states that it relies upon instances of confusion arising from customers who registered with the service operated by LLP, in the belief that it was a free service operated by Inc, and who complained to Inc when sums of money were debited by LLP from their credit or debit cards.

8) Inc claims that at the date of the application for registration, use of LLP's trade mark was liable to be prevented by virtue of the law of passing-off and, consequently, the trade mark should be declared invalid under the provisions of section 47(2)(b) of the Act "on the grounds that at the date the Registered Trade Mark was registered, alternatively the date hereof, an earlier right existed in relation to which the conditions set out in section 5(4)(a) of the Act are satisfied".

9) LLP filed a counterstatement in which it denied and/or put to proof the claims of Inc, with the exception that LLP agrees that it operates an online dating agency at plentymorefish.com.

10) Both parties filed evidence. A hearing was held on 21 January 2011. LLP was represented by Ms Fiona Clark of counsel, instructed by Ladas & Parry LLP. Inc was represented by Mr Michael Edenborough QC, instructed by Alexander Ramage Associates LLP.

Goodwill

11) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20, 1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07, in which the GC stated:

"50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-

registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is followed in relation to the Act; so Inc must establish a protectable goodwill as of the date of application for registration, 27 April 2007, if it does not establish this its case will fail.

12) Goodwill was described by Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217 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. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

13) A name does not enjoy goodwill, it does not engender rights other than in relation to goodwill. Parker J in *Burberrys v J C Cording & Co Ltd* [1909] 26 RPC 693 said:

"The principles of law applicable to a case of this sort are well known. On the one hand, apart from the law as to trade marks, no one can claim monopoly rights in the use of a word or name. On the other hand, no one is entitled by the use of any word or name, or indeed in any other way, to represent his goods as being the goods of another to that other's injury. If an injunction be granted restraining the use of a word or name, it is no doubt granted to protect property, but the property, to protect which it is granted, is not property in the word or name, but the property in the trade or good-will which will be injured by its use. If the use of a word or a name

be restrained, it can only be on the ground that such use involves a misrepresentation, and that such misrepresentation has injured, or is calculated to injure another in his trade or business.”

Millett LJ in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 stated:

“It is well settled that (unless registered as a trade mark) no one has a monopoly in his brand name or get up, however familiar these may be. Passing off is a wrongful invasion of a right of property vested in the plaintiff; but the property which is protected by an action for passing off is not the plaintiff's proprietary right in the name or get up which the defendant has misappropriated but the goodwill and reputation of his business which is likely to be harmed by the defendant's misrepresentation: see *Reddaway v. Banham* [1896] A.C. 199 per Lord Herschell; *Spalding v. Gamage* (1915) 32 R.P.C. 273 at page 284 per Lord Parker; *H.P. Bulmer Ltd. and Showerings Ltd. v. J. Bollinger SA and Champagne Lanson Pere et Fils* (the Bollinger case) [1978] R.P.C. 79 at page 93-4 per Buckley L.J.”

14) Goodwill requires a business. To have a business it is necessary to have persons or undertakings with whom the business trades. Ms Clark submitted that as Inc made no charges for membership of its dating services, the customers of the website are the advertisers from whom Inc receives revenue. Mr Edenborough argued that the customers were the members of the website. Inc needs to establish a business in relation to one of these sets of customers; if it does not, there is no need to decide if Ms Clark or Mr Edenborough is correct or if both of them are.

15) In *Pete Waterman Ltd v CBS United Kingdom Ltd* [1993] EMLR 27 Sir Nicolas Browne-Wilkinson VC stated:

“A. As a matter of principle, the existence of a severable English goodwill attached to a place of business in this country is not the basis of a right to complain of passing-off in this country. What is necessary is for the plaintiffs to show they have a trade connection here which will normally consist of customers forming part of their goodwill, wherever that goodwill is situate, which goodwill is being invaded by the acts of the defendant in this country;

B. The approach which I have set out at A above is not open to me as there is binding authority to the effect that the basis of [the] plaintiff's claim must be a goodwill locally situate in England; but

C. The presence of customers in this country is sufficient to constitute the carrying on of business here whether or not there is otherwise a place of business here and whether or not the services are provided here. Once it

is found that there are customers, it is open to find that there is business here to which the local goodwill is attached;

D To the extent that the *Crazy Horse* case is authority to the contrary, I prefer not to follow it.”

The judgment of the Vice-Chancellor makes it clear that it is necessary to have customers in the jurisdictionⁱⁱ.

16) In *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* Arnold J [2008] EWHC 3032(Ch).

“215.Fourthly, in order to found a passing off claim in the United Kingdom, the claimant must own goodwill in the United Kingdom. It is not enough to have a reputation here: see *Anheuser-Busch Inc v Budejovicky Budvar NP* [1984] FSR 413.

216.Fifthly, it is sufficient for goodwill to exist in the United Kingdom that the claimant has customers or ultimate consumers for his goods here, and for this purpose it is immaterial whether the claimant (a) has some branch here or (b) trades directly with customers here without having any physical presence in the jurisdiction (for example, by mail order) or (c) trades through intermediaries such as importers and distributors (provided that the circumstances are not such that the goodwill is owned by the intermediary): see e.g. *SA des Anciens Etablissements Panhard et Levassor v Panhard Levassor Motor Co* [1901] 2 Ch 513, *Manus v Fullwood & Bland* (1949) 66 RPC 71, *Nishika Corp v Goodchild* [1990] FSR 371, and *Jian Tools for Sales v Roderick Manhattan Group* [1995] FSR 924.”

Mr Edenborough interpreted “ultimate consumers” as encompassing visitors to Inc’s website from the United Kingdom. Ultimate in the context means final customers. Mr Edenborough is relying on visitors to a website, a visitor to a website is not the same as a customer; visiting a website neither creates a business relationship nor a business in the jurisdiction. Such an interpretation cannot be squared with paragraph 215 or with the judgment of the Vice-Chancellor, customers are required. The customer relationship may be created, if Mr Edenborough is correct in his definition, by becoming a member of the website in order to use its services to find a partner; that member will need to be within the United Kingdom.

17) Much of the evidence, from both parties, relates to LLP’s claimed use of its trade mark. This evidence only becomes pertinent if Inc establishes a goodwill before 27 April 2007. So the evidence summarised herein relates to this issue. The evidence considered in relation to this consists of parts of two witness

statements of Mr Markus Frind and a small part of the evidence of Mr Stephen Moylan.

Evidence of Markus Frind

18) Mr Frind is a resident of Vancouver, Canada; where Inc is based. Mr Frind is the founder and Chief Executive Office of Inc.

19) Mr Frind registered the domain name plentyoffish.com on 1 June 2001. He states that either he or Inc have operated a website under that domain name since about June 2001. At exhibits 1 and 2 are screenshots taken from the website archive.org. They both come from the website plentyoffish.com. Mr Frind states that the urls for the exhibits show that the pages were archived on 19 January 2002 and 30 January 2003. On the screenshot at exhibit 1 England can be seen on a drop down menu headed "from". Mr Edenborough considered that this was of significance. It is necessary to agree with Ms Clark that this on its own does not have significance. Drop down menus are standard parts of software and cover a standard list of countries; the appearance of a country name on a drop down menu does not show that any business is or can be conducted in the jurisdiction shown. In exhibit 2 a list of users can be seen and they are identified by location, all of the locations are in Canada or the United States of America. As the locations are readily available and accessible on the website, the question is immediately raised as to why no evidence has been shown of any members/customers in the United Kingdom before 27 April 2007.

20) Mr Frind states that the plentyoffish.com website "grew" quickly in Canada and then spread, promoted by word-of-mouth, into the United Kingdom, Australia and the United States. People are not charged to join the website or use the facilities; revenue is generated by advertising on the website. Despite this rapid growth Mr Frind does not exhibit any evidence of either persons looking for partners from the United Kingdom or advertisers based in the United Kingdom. The very nature of a website allows data to be readily accessible, however, Mr Frind furnishes no data as to persons from the United Kingdom joining the website or when the first person from the United Kingdom joined the website. No indication is given as to any United Kingdom undertakings placing advertisements upon the website.

21) Mr Frind states that in 2004 plentyoffish.com became his full-time business. He states that revenue is generated in three ways: banner advertising, affiliate marketing and Google's® adsense programme. He states that a revenue of between US\$5 million and US\$10 million is generated. Mr Frind states that according to the web traffic tracking service Comscore, plentyoffish.com is the second most viewed dating site in the United Kingdom. At exhibit 3 is a page entitled "Key Measures Report Directories/Resources – Personals [Undup]". The page states that it was generated on 3 February 2008 and that the time period was March 2007. The page advises that the "geography" is the United Kingdom and that the location is "all locations", no explanation is given as to the meaning

of these terms. In a list of websites plentyoffish.com appears second. The page advises that 114 pages were viewed and that total visits were 4,181,000. Mr Frind states that Comscore claims to be the largest continuously measured consumer panel providing one of the most comprehensive views of Internet viewing, buying and other activity. He states that it has more than 2 million participants under continuous measurement from which it prepares projections to the total Internet viewing population. Consequently, these figures are extrapolations. No one from Comscore gives evidence as to the number and demographic basis of the members of the consumer panel in the United Kingdom. No evidence is given as to the methodology that is used in arriving at the data or the core data that is used. No data is given as to what is meant by visits; if this relates to unique visitors, if the figure is generated by hits on a page. More importantly, this does not give any evidence of any members in the United Kingdom. Visits to a website are generated by a wide variety of tools eg by the use of keywords and metatags. A visitor may arrive at the website through a search engine, for whatever reason, and then leave as it is not relevant to his or her interest or the jurisdiction in which he or she lives. The visitor may look at the website through curiosity but that does not make the visitor a customer, or indicate that the visitor could even be a customer.

22) Mr Frind states that according to alexa.com, which he states is a web search and website information provider, approximately 13.9% of users of plentyoffish.com come from the United Kingdom. He states that the plentyoffish.com traffic rank in the United Kingdom is number 117, which places the website as one of the 150 most visited websites of any type in the United Kingdom. At exhibit 5 are pages downloaded from alexa.com in support of this statement. It is difficult to clearly identify to what date/period the information relates. A graph appears on the page for September to February and the year 2006 appears twice in proximity to the graph. On one occasion it is as a copyright notice on the other there is no indication as to what it relates. On the second page of the exhibit figures are given for, inter alia, "yesterday" which indicates that the figures relate to an immediate period; the page bears a copyright date of 1996-2008. There is no clear indication as to how a user is defined. Users, however, defined, cannot be seen as meaning members/customers in the United Kingdom; alexa.com will not know who are members/customers. Mr Frind and Inc will know who its members/customers are and from where they hail but they are silent upon the matter.

23) At exhibit 10 is a printout from compete.com, which Mr Frind states offers analysis of websites. The exhibit, he states, lists the keywords that led Internet browsers to the plentymorefish.com website between 30 November 2007 (after the material date) and 28 February 2008. "plenty of fish" and www.plentyoffish.com are the top keywords that led Internet browsers to the plentymorefish.com website. 8.7% of those ending up at the plentyoffish.com website did so by typing either plentymorefish or plentymorefish.com. Other terms that brought people to the website include: meeting/Alabama/personals, women seeking marriage and dating, gang bang personals, totally free dating

perso..., dating, okie singles adult, Microsoft personals, fee intimate encounters..., women seeking marriage and “grand rapids” plenty off... These keywords demonstrate how traffic can be generated to websites, showing that a variety of terms can lead to a website. Consequently, the Internet user can arrive at a site which if of no interest to him or her owing to the use of keywords. There is, of course, also the use of metatags to generate traffic to websites.

24) Mr Frind states that Google® provides a number of online tools for use in optimising advertising revenue online. He states that one of these is called “Google Insights for Search”. Mr Frind states that it can be used to search for words or expressions that Internet users might use when searching the Internet. He states that it enables searches to be conducted covering 2004 to the present day. At exhibit 12 is a screen print of the search term plentyoffish using the Insights system. The search has been conducted on a worldwide basis ie does not relate to the United Kingdom specifically. The result is in the form of a graph, which shows, with a few slight dips, an increase in hits from 2004 to 2008. 4 points are marked on the graph, these are from late 2007 to 2008:

- “comScore Media Matrix Ranks Plentyoffish.com #1 Dating Site in North America and UK by Total Visits” – from 2008. A printout of the web pages relating to this are to be found at exhibit 14. This is in the form of a press release from Inc. A list of the top 10 United Kingdom dating sites is printed, with Plentyoffish at the top as of June 2008. The figure of 8,052,000 visits is given. The press release advises that on 14 July (presumably in 2008) Mr Frind opened his office in Vancouver and Inc hired its first six employees. So according to the press release, until July 2008 Inc had no employees. The press release relates to visits, there is no mention of the number of members/customers in the United Kingdom. The press release quotes a comment from Mark Brooks, who is described as an analyst and dating industry consultant. At the end of the press release the reader is advised that media relations of Inc are dealt with by Mark Brooks.
- “Worth Keeping Test From Plentyoffish.com” – from 2008. The article to which this relates is to be found at exhibit 13, it is in the form of a press release from Inc. It is dated 7 July 2008, after the material date.
- “Jangl Partners with Plentyoffish.com to Connect Daters and Mobile Phones” – from 2008.
- “Plentyoffish.com Ranked #1 Online Dating Site in the United Kingdom By comScore World Matrix” – from 2007.

25) Mr Frind states that exhibit 15 is a printout of a search from Google® Insights. A graph appears on the page for 2004 to 2008. Mr Frind states that the graph line for plentyoffish is at the top in blue and peaks below 100 and that of plentymorefish is a flat red line below 0. On the copy supplied no red line

appears. At the top of the page the number 43 appears against plentyoffish and 0 against plentymorefish. Mr Frind states that the figures do not represent absolute search volume numbers but reflect how many searches have been done for a particular term relative to the number of searches done on Google® over the period. On the page there is a heading for regional interest which gives a geographical breakdown. In relation to the United Kingdom plentyoffish has a score of 36 and plentymorefish has a score of 1. These figures indicate what terms are being used as search terms, it does not show the intention of the user. Searchers do not necessarily use full terms. Again there is nothing to indicate that Inc had any members/customers prior to 27 April 2007. At exhibit 16 are pages relating to Google® Insights. Ms Clark queried the validity of the data owing to the normalisation that is applied to the data. An explanation of the normalisation is given:

“All the results in Google Insights for Search are normalized, which means that we’ve divided the sets of data by a common variable to cancel out the variable’s effect on the data. Doing so allows the underlying characteristics of the data sets to be compared. If we don’t normalize the results and displayed the absolute rankings instead, data from regions generating the most search volume would always be ranked high.”

It is not considered that the normalisation of the data affects its validity, in so far as it has any validity in the context of these proceedings.

26) Mr Frind states that figures obtained from the website of Experian Hitwise show that plentyoffish.com was the 7th most popular dating site by traffic in United Kingdom in October 2006 and in December 2006 plentyoffish.com was the 6th most popular dating site in the United Kingdom by traffic. No copy of these details is exhibited. It is noted that the “popularity” is related to traffic ie hits upon the website. Again there is nothing in the statement that relates to members/customers of the website prior to 27 April 2007. Mr Frind states that data from Hitwise.co.uk is capable of showing the website to which Internet users go after leaving a particular site, downstream statistics. Mr Frind gives downstream percentage figures for the months of October 2006, January 2007, February 2007, April 2007, May 2007, December 2007, April 2008 and May 2008. No explanation is given as to how or why these particular months have been chosen. Again this information does not show any members/customers in the United Kingdom.

Witness statement of Stephen Moylan

27) Mr Moylan is a member of LLP. He states that LLP became aware of Inc’s website in late 2006/early 2007. There is no indication from Mr Moylan that at that time Inc had any members/customers in the United Kingdom. Included in exhibit SM8 is a screenshot of a page from plentyoffish.com. This shows a person from Stoke-on-Trent seeking a partner. However, this appears to be contemporaneous with the witness statement of Mr Moylan, which was signed on

30 September 2009 and so does not have a bearing on the position as of 27 April 2007.

28) There is no need for a business to be based in the United Kingdom to have goodwill in this jurisdiction. There is nothing to stop a website based in Canada having a goodwill in relation to a dating business in the United Kingdom, if it has customers here. In *800-Flowers Trade Mark* [2000] FSR 697 Jacob J stated:

“I questioned this with an example: a fishmonger in Bootle who put his wares and prices on his own website, for instance, for local delivery can hardly be said to be trying to sell the fish to the whole world or even the whole country. And if any web surfer in some other country happens upon the website he will simply say “this is not for me” and move on. For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that the mere fact that websites can be assessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world. It all depends upon the circumstances, particularly the intention of the website owner and what the reader will understand if he assesses the site.”

A dating website is not on a par with a fishmonger in Bootle but the issue of the clientele is still the same. However, there is no evidence that prior to 27 April 2007 that the visitors from the United Kingdom to the website could even be members. The nature of Inc’s business is such that data as to the number and location of its members/customers should be readily available. Mr Frind gives a large amount of detail about hits on his website from the United Kingdom but signally fails to give any details of members/customers and/or revenue from the United Kingdom. He does not identify one member/customer from the United Kingdom prior to 27 April 2007. Inc has to establish a goodwill. Mr Edenborough submitted that it would be perverse to find that there was no goodwill when there were so many hits on Inc’s website from the United Kingdom. He was specifically asked to identify a legal precedent in the United Kingdom which did not require customers/business within the jurisdiction to establish goodwill. He could not. The legal precedents, as rehearsed above, are clear; customers are required, whether they be described as customers or members.

29) A web based business should be able to readily access details of members/customers by reference to location, date and number. Inc gives no details of any members/customers or advertisers from the United Kingdom at all, let alone prior to 27 April 2007. Inc has not established a goodwill prior to 27 April 2007 and so its application must be dismissed.

30) The absence of members/customers from the United Kingdom is startling, taking into account the nature of the claims and the nature of the business. It is not just that Inc has failed to establish goodwill and so its application must fail,

the reasonable inference that can be drawn from the absence of evidence is that Inc did not have any members/customers in the United Kingdom prior to 27 April 2007. It is noted that Inc filed three rounds of evidence and so had plenty of opportunity in relation to this matter. It is also very surprising that rather than supplying data of visits to its website directly, which could identify such things as unique visitors, time spent on the website, pages interrogated and location of the visitor, Inc has relied upon third party calculations.

Costs

31) LLP having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

| | |
|---|--------|
| Preparing statement and considering the statement of Inc: | £300 |
| Preparing evidence and considering the evidence of Inc : | £1,000 |
| Preparing for and attending the hearing: | £1,000 |
| Total: | £2,300 |

Plentyoffish Media Inc is ordered to pay Plenty More LLP the sum of £2,300. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this day 01 of February 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ i “47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(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.

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration, (b) the registration procedure for the earlier trade mark was not completed before that date, or (c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community. (2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exists 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.

(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.”

(The transitional provisions of The Trade marks (Relative Grounds) Order 2007 mean that that Order does not have effect in this case:

“(2) Article 5 shall not apply to an application for a declaration of invalidity which relates to a trade mark the application for the registration of which was published before the coming into force of this Order.”

The order came into force on 1 October 2007.)

ⁱⁱ Also see *Amway Corp v Eurway International Ltd* [1073] FSR 213 and *Athlete's Foot Marketing Associates Inc v Cobra Sports Ltd* [1980] RPC 343.