

O-030-06

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS 365200, 1199776 AND 1384452
IN THE NAME OF GAIL BOURA AND CLIVE BOURA
OF THE TRADE MARK:**

NIRVANA

**AND THE APPLICATIONS FOR REVOCATION THERETO
UNDER NOS 81604, 81605 AND 81606
BY NIRVANA SPA & LEISURE LTD**

Trade Marks Act 1994

**In the matter of registration nos 365200, 1199776 and 1384452
in the name of Gail Boura and Clive Boura
of the trade mark:
NIRVANA
and the applications for revocation
thereto under nos 81604, 81605 and 81606
by Nirvana Spa & Leisure Ltd**

BACKGROUND

1) On 3 February 2004 Nirvana Spa & Leisure Ltd, which I will refer to as NSL, filed applications for the revocation of three trade mark registrations of the word NIRVANA:

Registration no 365200. The date of registration is 24 March 1915. On 16 March 1995, as per section 65 of the Trade Marks Act 1994 (the Act) and rule 40 of the Trade Marks Rules 1994, the specification of the registration was converted from schedule 3 of the Trade Marks Rules 1994 to schedule 4 of the Trade Marks Rules 1994. The current specification of the registration is:

perfumes; perfumed soap; toilet articles; all included in class 3.

Registration no 1199776. The date of registration is 4 September 1985. The specification of the registration is:

deodorants (not for personal use); medicated preparations for the prophylaxis or treatment of diseases or disorders of the skin, scalp, teeth and the mouth; sanitary preparations; disinfectants (other than for laying or absorbing dust).

Registration no 1384452. The date of registration is 2 April 1991. The specification of the registration is:

body sprays; soaps; perfumes; essential oils; cosmetics; non-medicated toilet preparations; preparations for the hair; dentifrices; anti-perspirants; deodorants for use on the person; skin care preparations; all included in Class 3.

The above goods are in classes 3, 5 and 3 respectively 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.

On 12 May 1980 registration no 365200 was assigned from The Boots Company Limited to Unilever Limited. The other two registrations were applied for by Unilever plc. On 11 March 1998 the registrations were assigned from Unilever plc to Gail Boura and Clive Boura. An application to register the change of proprietor was received by the Trade Marks Registry on 8 April 1998. The assignment document describes the assignees as Gail and Clive Boura of Nirvana Natural.

2) NSL states that it has conducted thorough investigations in an effort to establish whether the trade mark is known or in use. As a result of these investigations NSL claims that it has established that there has been no use of the trade mark by the registered proprietors for at least five years and three months prior to the date of the applications. Consequently, the registrations should be revoked as per section 46(1)(b) of the Act.

3) NSL seeks the revocation of the registrations and an award of costs.

4) The Bouras filed counterstatements in which they claimed that the trade mark had been used in respect of all of the goods of the registrations. They seek the maintenance of the registrations in their entirety.

5) Both sides filed evidence.

6) A hearing was held on 18 January 2006. The Bouras were represented by Mr Fernando of counsel, instructed by Murgitroyd & Company. NSL was represented by Ms Lane of counsel, instructed by Marks & Clerk.

7) There is for the most part a triplication of evidence and submission. These cases should have been consolidated at a very early stage. Mr Fernando assumed, very understandably, that this was a consolidated action. Both Ms Lane and Mr Fernando's submissions dealt with the three cases together. I intend dealing with the cases together and this decision will cover all three cases.

EVIDENCE

8) Large parts of the statements filed by both sides are submissions rather than evidence of fact. I will only give a summary of the evidence of fact; although I bear in mind the submission parts of the statements in reaching my decision.

Evidence of Clive Boura

9) Mr Boura states that he is the owner of the trade marks and managing director of Nirvana Natural, which I will refer to as NN. He states that he has been managing director of NN for ten years.

10) Mr Boura states that NN first used the trade mark NIRVANA in the United Kingdom in 1991 and has used it continuously since then. Mr Boura states that because NIRVANA products contain only natural ingredients they can be used all over the body. He states that one of the products can be used as a hair conditioner, shaving lotion, make-up remover or moisturising cream. He states that NN markets the multi-use aspect of its products extensively and mentions this specifically upon the packaging. Mr Boura states that this distinguishes NN's products in a crowded marketplace. He states that this aspect of NN's products has made them very popular and is widely known by consumers, who include "celebrities" such as Victoria Beckham, Nicole Kidman, Hugh Grant, Cameron Diaz and Darcey Bussell.

11) Mr Boura states that the trade mark has been used in relation to shampoos (some of which are medicated), conditioners, hair sprays, holding sprays, shine sprays, body

lotions, foam baths, shower gels, body soaps, shaving lotions, make-up removers and moisturising creams. He states that the trade mark is also used on NN's websites: www.nirvananatural.com and www.nirvananatural.co.uk.

12) Mr Boura exhibits at CB1 a collection of brochures and marketing materials. There is no indication that the material was issued during the five year period prior to the date of the filing of the applications (the material period). On two occasions copyright dates of 1998 appear and handwritten on one exhibit is "original brochure 1990's (sic)".

13) All of the material shows use of NIRVANA NATURAL, rather than NIRVANA on its own with the exception of the following instances:

NIRVANA PRODUCTS ARE NOT TESTED ON ANIMALS

"Active Vitaminization is exclusive to Nirvana and was created and developed by them"

From "Salon Quotations" (a collection of complimentary comments about the products):

"Nirvana Natural is fabulous, our clients love it. Our most widely used shampoo is Nirvana's Rosemary."

"Nirvana is a market leader in its field...."

"The Camomile and Rosemary Shine Sprays have consistently been my favourite Nirvana products. I need gentleness and shine that performs day after day for months on end to improve and protect hair. And all with no product build-up! I always recommend Nirvana to fellow professionals."

"Find your bath-time Nirvana with Nirvana Natural Indulgence's Water Lily and Lavender shampoo."

"The Nirvana of Haircare is here! Much copied, but never successfully, Nirvana Natural has always been ahead of the game".

From the "original brochure": "NIRVANA achieves...", this is followed by a chart listing products and their uses, underneath the table is written "...natural results" (natural is in a different and larger font than results).

14) The goods are identified as being hair care products in the following categories: shampoos, conditioners, shine sprays, holding sprays, hair wax, hair gel.

15) The orange blossom and camomile conditioner is identified as being a "Good hand & body moisturiser, shaving aid" and "makes a wonderful hand and body moisturiser or shaving aid". The camomile conditioner as: "Excellent hand & body moisturiser, shaving aid"; "Excellent as a hand and body moisturiser and make-up remover, leaves skin soft, supple and protected. As a shaving aid, it prevents razor burn." Aloe, almond, walnut intensive treatment conditioners: "Can be used to moisturize hands and body and for shaving." Camomile conditioner: "Makes an

excellent hand and body moisturizer, soothes skin after exposure to sun, and can be used for shaving.”

16) The material includes the following: “Nirvana Natural was designed and created by Gail Austin and Clive M. Boura who stand behind the quality of this unique and effective product range.”

17) Included in the exhibit is a list of stockists of NIRVANA NATURAL products; these are Waitrose, Sainsbury, Fortnum & Mason, John Bell & Croydon, John Lewis, Daniel Field, Moss Chemists and “selected hairdressers”.

18) The part of the exhibit described as the original brochure from the 1990s has, for the most part, NIRVANA in a dominant position with NIRVANA in upper case and natural in lower case, or with NIRVANA in title case and natural in lower case. The other material shows NIRVANA and NATURAL in an equal footing in presentation and also shows use of the ® symbol after the NATURAL of NIRVANA NATURAL.

19) Some of the material identifies Nirvana Natural as a trading division of Linquote Ltd.

20) Mr Boura exhibits at CB2 a collection of labels from NN’s products. There is no indication as to when the labels were used. NIRVANA on its own is not used on any of the labels. Use is always of NIRVANA NATURAL, with the two words being in the same script and font size. The labels are for the following goods: hair conditioner, shampoo, styling mousse, holding spray, shine spray (all being hair products). The labelling indicates that several of the products can be used for other purposes:

Orange blossom & camomile conditioner	“Makes a wonderful hand & body moisturizer or shaving aid.”
White nettle & thyme shampoo	“Add to bath or shower to calm and soothe skin.”
Camomile conditioner	“..... makes a wonderful hand and body moisturizer or shaving aid.”
Nettle & jasmine shampoo	“Add to bath or shower to soothe and clear skin.”

21) Mr Boura states that the turnover figures for goods sold under the trade marks are:

1995	£7,902
1996	£11,188
1997	£8,025
1998	£3,950
1999	£16,525
2000	£32,920
2001	£193,458
2002	£203,109

22) Mr Boura states that NN has advertised NIRVANA products extensively and that this has been done by means of brochures, leaflets, magazine editorials, newspapers

and through magazine give-away offers. He states that its two websites also serve as an effective advertisement and have been running since February 1999.

23) Mr Boura states that NN has spent significant amounts on advertising and promotion since it commenced use of the trade mark and that this expenditure amounts to no less than £500,000 to date. He states that during the previous three years NN has spent an average of £20,000 annually on advertising and promotion.

24) Mr Boura states that the trade mark has appeared or been advertised in numerous publications in the United Kingdom since it was first used. He lists a large number of publications, including some from abroad, but does not ascribe dates to when the trade mark appeared in the publications.

25) Exhibited at CB3 is a collection of magazine and newspaper articles. A good number of the articles either pre-date the material date or have no indication of when they were published. Several of the articles were published after the date of the application for revocation. Certain of the articles emanating from the relevant period are from foreign publications. These in themselves might be considered to show export use. However, where NIRVANA on its own appears in the articles this does not further the case of the Bouras as it is not use in the United Kingdom. Where the actual goods are shown the packaging is for NIRVANA NATURAL and so that may represent use in the United Kingdom for export purposes.

Included in the exhibit are the following:

“Air France Madame” for June – July 2003: detox wash.

“Hairflair” for March/April 2004: NIRVANA NATURAL Indulgence rosemary & jasmine shine spray.

26) Further matter is exhibited at CB4. An advertorial from “Company” for February 1999 is exhibited. This shows three products. The labelling shows the use of NIRVANA and NATURAL together with equal prominence. An advertorial from the “Daily Mail” of 11 March 1999 shows the packaging for shea nut vitamin emulsion. The beginning of the relevant piece of the advertorial reads “NIRVANA Natural’s Shea Nut Vitamin Emulsion. Upon the bottle NIRVANA NECTAR can be read. A piece from “More!” for 25 August to 7 September 1999 advises that NIRVANA NATURAL camomile conditioner can be used to remove make-up and as a shaving lotion. An advertorial from “You” for 10 October 1999 refers to NIRVANA NATURAL shampoos and states that they can be added to bath water to relieve aching muscles. It also refers to a chamomile conditioner which can be used as a moisturiser or make-up remover. An advertorial from “You” for 14 November 1999 refers to NIRVANA NATURAL camomile conditioner and state that it “also works as a hand and body moisturiser”. A piece from “The Daily Telegraph” of 31 January 2004 states that NIRVANA NATURAL nettle and jasmine shampoo can be used in the bath and shower too. An advertorial from “Woman’s JO” for January 2000 includes the following:

“Nirvana Orange & Barley Shampoo (from House of Fraser, Selfridges and Superdrug), £3.50. Nicole Kidman is said to be a big fan of Nirvana’s organic herbal shampoos and conditioners.....”

All of the material from CB4 emanates from the material period. It shows during this period that the labelling for the goods used NIRVANA and NATURAL together, each with equal prominence. The earliest example is from February 1999 which is at the beginning of the material period. It shows the following products: shampoos, hair emulsion, conditioner

27) Mr Boura states that NIRVANA products have appeared as product placements in the television series “Eastenders” and “Inspector Wycliffe”. (In an article reproduced from “Hairdressers Journal International” from June 1995, exhibited at CB3, the following is written: “If you’re an Eastenders fan, you may have already spotted that the salon in Albert Square is stacked high with Nirvana Natural haircare range (tel: 01344 360931). If not, then tune in this September because the products will also be popping up on your screen in An Independent Man, starring George Cole.”

28) Mr Boura states that exhibited at CB5 is a collection of magazine articles relating to the multiple use aspect of NIRVANA products. The articles either show dates outside the material period or do not have an indication or a clear indication of when they were published:

“Time Out” from 1998: “We’re talking shampoos which double as bubble bath, conditioners which quadruple as cleaners, aftersun and shaving cream – in other words perfect products for travelling.”

“Harpers Queen” from February 1995: “Their camomile conditioner can also remove make-up and be used as a body lotion (it has been found to help with some chronic skin complaints).”

“Time Out” for 6-13 January 1999: “The multi-purpose Camomile Conditioner (£4) will not only make your hair glossy but can also be used as a hand and body moisturiser, make-up remover and a shaving aid to prevent razor burn. A good one for taking on hols.”

Article without provenance: “This is a new range which smells really fresh and delicious. You can even put it in the bath.”

“The Express Saturday” for 6-12 June 1999: “It soothes hands as well as locks”.

“New Woman” – date unknown: “A mild shampoo like this is also good for cleaning your body. Pop a bit on a sponge and scrub away.”

“Marie Claire” – date unknown: “..... and the luxurious Orange Blossom and Camomile Conditioner (both £4.45 each) which also doubles up as a hand and body moisturiser or shaving aid.”

“Looks” from October 1995?: “You can also use it as a moisturiser, a shaving balm and even a make-up remover....”

“Hairdressers Journal International” of 3 September 1993: “Nirvana Natural is a collection of professional, organic hair-care products which contain only natural ingredients. With eight shampoos, two conditioners and five sprays – including gels, waxes and shining products – the range is suited to specific hair types and treats certain problems, like dandruff or product build-up. In the process of ‘active-vitaminisation’, each bottle contains an actual herb or plant which is claimed to continue dispersing within the product, infusing it further with vital nutrients. The versatility of the products provides another bonus, as they can also be used for moisturising, shaving or aromatherapy benefits. The range is approved by the BUAV and a percentage of profits will be donated to the anti-animal-testing organisation, as well as the Department of Environment which has agreed to match Nirvana pound for pound on contributions.”

“Marie Claire” for August 1993: “Nirvana Camomile Conditioner, also acts as a make-up remover and after-sun cream.”

“Marie Claire” – date unknown: “.... and Camomile or Aloe Almond and Walnut Conditioners each, act as body moisturisers.”

“The Express Saturday” for 24-30 May 1997: “The Camomile Conditioner is a great multi-purpose product, which can also be used as a shaving cream and aftersun lotion.”

“9 to 5 Midweek” of 16 February 2004: “....and the shampoos so gentle they can be used as body washes, while the conditioners double up as moisture balms and shave aids.....All organic and not animal tested.”

“The Express Saturday” for 29 May – 4 June 199?: “It can also be used as a soothing aftersun and an effective pre-shave skin smoother.”

29) Mr Boura states that NIRVANA products are sold through retail outlets, through mail order and through hair salons. He states that stockists include Waitrose, Sainsbury, Fortnum & Mason, John Bell & Croydon, John Lewis, Daniel Field and Moss Chemists. Mr Boura states that NN sells its products in the United Arab Emirates, France, the Netherlands, the United States of America and Thailand.

Evidence of Shaun Nicholas Sherlock

30) Mr Sherlock is acting for NSL in this case.

31) Mr Sherlock states that between 3 February 1999 and 3 February 2004 (inclusive) three sets of accounts were filed with Companies House by Nirvana Natural Limited; for the years ending 30 June 1999, 30 June 2000 and 30 June 2001. He exhibits at SNS1 copies of these accounts. Mr Sherlock states that no accounts have been filed for later years. The first two sets of accounts are for Linquote Limited trading as Nirvana Natural. The company registration number is 2829966. The director is a Miss C E Brennan and the secretary S C Mason. The third set of accounts is in the

name of Nirvana Natural Limited. The company registration number is 2829966. The directors are listed as Miss C E Brennan, C Boura and Mrs G Boura. The secretary is S C Mason. The final item of the accounts states:

“At the balance sheet date, due to their majority shareholding, the directors C Boura and Mrs G Boura have control of the company.”

Exhibited at SNS2 is a page downloaded on 2 August 2004 from the Companies House website. It shows that the company is in liquidation.. The detail also show that Linqote Limited changed its name to Nirvana Natural Limited on 28 September 2001 and that the company was incorporated on 24 June 1993. Pages are also exhibited in relation to the insolvency history. They show that the company is in voluntary liquidation, having a winding up date of 3 April 2003.

32) Mr Sherlock states that on 13 July 2004 he wrote to the Bouras' trade mark representatives requesting further information regarding the claimed use of the trade mark. Exhibited at SNS3 is a copy of the letter. In the letter Mr Sherlock requests clarification that the reference to Nirvana Natural in Mr Boura's statement is a reference to Nirvana Natural Limited and confirmation that the company is currently in liquidation. He requests confirmation that references to “we” and “our” throughout Mr Boura's statement are references to the acts of Nirvana Natural Limited. Mr Sherlock goes on to request, if the Bouras are intending to rely on use of the trade mark by any other persons than Nirvana Natural Limited, that full details of such instances of use are given. He requests that in all cases where the Bouras are relying upon use by persons other than themselves, including use by Nirvana Natural Limited, that copies of all licences, consents and permissions relating to such use are supplied. He asks whether the material exhibited at CB1 to Mr Boura's statement was used during the five year period to 3 February 2004. He asks, in relation to the labels exhibited at CB2 for full details of dates on which use of the labels commenced, by whom such use was made, the duration of such use and the number of products sold under the label in the United Kingdom in each of the years 1999, 2000, 2001, 2002, 2003 and 2004 (up to 3 February 2004). Mr Sherlock asks whether the sales figures given by Mr Boura relate solely to sales of NIRVANA NATURAL products in the United Kingdom by Nirvana Natural Limited. He asks for a breakdown in relation to the advertising and promotional expenditure incurred by Nirvana Natural Limited in relation to the NIRVANA NATURAL products in each year in the five year period prior to 3 February 2004. Mr Sherlock also requests that any non United Kingdom promotional expenditure is identified. He asks for the date of publication of each of the articles exhibited at CB3. He also asks that in the case of articles from foreign publications that proof is provided that the publication was available at the relevant time in the United Kingdom. Mr Sherlock requests details of the product placement referred to by Mr Boura. Mr Sherlock requests confirmation that, with the exception of one article published on 16 February 2004, that all of the articles exhibited at CB5 were published prior to 3 February 1999. He requests that if it is contended that any of these articles were published on or after 3 February 1999, and prior to 3 February 2004, that such articles are identified, giving in each case the date of publication. Mr Sherlock states that he has not received any of the further information that he had requested.

33) Mr Sherlock states that the home page of the www.nirvananatural.co.uk website contains two links, one marked “enter u.k. site”, the other “enter international site”. The former connects back to the www.nirvananatural.co.uk website, the latter to the home page of www.nirvananatural.com. He states that the two websites appear very similar in their content. Mr Sherlock exhibits at SNS4 pages downloaded on 2 August 2004 from the co.uk website. The second page that is exhibited states that the website was last updated on 8 January 2004. All use is of NIRVANA NATURAL. The products are described as an “environmentally friendly range of hair care products, including shampoos, conditioners and hair sprays. Ideal for treating dry or damaged hair or skin conditions such as dandruff, eczema or psoriasis. Containing natural ingredients.” The list of goods exhibited are for shampoos, hair sprays (both for holding and shining) and conditioners. Mr Sherlock exhibits at SNS5 pages from the same website downloaded on 5 December 2003, it is indicated that these pages were last updated on 28 October 2003. The pages are fundamentally the same as those exhibited at SNS4, use throughout is of NIRVANA NATURAL. There are two product lines: the NIRVANA NATURAL Indulgence range and the NIRVANA NATURAL range. Further pages downloaded from the website on 3 August 2004 are exhibited at SNS6 and SNS7. A page relating to nettle and jasmine shampoo states that the product can be added to the bath or shower to reduce inflammation and itching. A page relating to rosemary shampoo states that the product can be added to bath water to relieve headaches, migraine, sprains, aching muscles and PMT. A page relating to camomile conditioner states that the product can be used as a hand and body moisturiser and make-up remover. It states that it can also be used to prevent razor burn. A page relating to white nettle and thyme shampoo states that if added to the bath or shower it will calm and soothe the skin. A page relating to orange blossom and camomile conditioner states that can be used as a hand and body moisturiser or shaving aid. Further pages from the website, downloaded on 2 August 2004, are exhibited at SNS8. Included in this are pages headed “What The Media Say”. These include the following quotations:

“Nirvana is a market leader in its field.....”

“The Nirvana of Haircare is here! Much copied, but never successfully, Nirvana Natural has always been ahead of the game.”

34) At the end of his statement Mr Sherlock states that he considers that “hair care products” would be a fair specification of the goods. He also states that the Bouras have not demonstrated use of the trade mark by itself or in a form which does not alter its distinctive character.

35) In relation to registration no 365200 Mr Sherlock exhibits at SNS9 a printout from the Registry’s classification data base showing use of the term toiletries. This shows use of the term inter alia in class 3 in respect of antiperspirants, hair mousses, preparations for body care, preparations for application to the body, nails, skin and scalp, rinses, deodorants, swabs, talc, preparations for the eyes, face, feet and skin.

Further evidence of Clive Boura

36) Mr Boura states that the trade mark NIRVANA has been in continuous use by the companies Nirvana Natural Limited and Benbry Limited, trading as Nirvana Natural, in relation to shampoos, conditioners, hair sprays, holding sprays, shine sprays, body

lotions, foam baths, shower gels, body soaps, shaving lotions, make-up removers, moisturising creams and medicated preparations for the prophylaxis or treatment of diseases or disorders of the skin and scalp. He states that Miss Courtney Brennan was a director of Nirvana Natural Limited since its inception. Mr Boura states that he became a director on 1 January 1999. Gail Boura (née Austin) became a director on 1 November 2000. He states that Nirvana Natural Limited used the trade mark NIRVANA until April 2003, when the company went into liquidation. He states that Benbry Limited, trading as Nirvana Natural, was formed on 27 February 2003 and began using the trade mark NIRVANA on goods two months before Nirvana Natural Limited went into liquidation. He states that the directors of Benbry Limited are Gail Boura, Courtney Brennan and himself. He states that NN purchased the registrations in 1998. He states that the trade mark has been in continuous use since 1993¹ for the goods and in continuous use by the Bouras, and with their consent, since 1999. Mr Boura exhibits at CB1 a page from the co.uk website downloaded on 5 November 2004. This is headed “About Nirvana Natural”. It states, inter alia, “Nirvana Natural was designed and created by Gail Austin and Clive M. Boura who stand behind the quality of this unique and effective product range.”

37) Mr Boura exhibits at CB2 the results of a Google search for the terms hair care products + natural. It shows that there were 1,860,000 hits. This exhibit shows the summaries of the first ten hits. There are references to natural hair care products, natural products for the hair and natural hair care recipes. He states that the word natural is descriptive and entirely non-distinctive in relation to hair care products. Mr Boura states that dual use of the products is a particular feature of NIRVANA products. He states that the public is aware of such dual use products. He exhibits at CB3 a website printout showing details of a Radox product that can be used as a both a shower gel and a shampoo. The product is described as “Radox Active Shower Gel & Shampoo”.

38) Mr Boura states that the “Oxford English Dictionary” definition of soap is “a substance used with water for washing and cleaning, made of natural oils or fats combined with an alkali, and typically perfumed”. Its definition of toiletries is: “articles used in washing and taking care of one’s body, such as soap and shampoo”. Mr Boura refers to the description of nettle and jasmine shampoo on the NN website. He states that owing to the use of this product it would cover medicated preparations for the prophylaxis or treatment of diseases or disorders of the skin and scalp.

Further evidence of Shaun Nicholas Sherlock

39) Mr Sherlock states that despite his request no document has been provided to establish that the proprietors have provided “positive” consent to Nirvana Natural Limited or any other person to use the trade mark. Mr Sherlock exhibits a dictionary definition of nirvana.

DECISION

40) Section 46 of the Act reads as follows:

¹ In his first statement Mr Boura states that use commenced in 1991.

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not 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, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) 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 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.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation 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.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

Consideration has to be taken, also, of 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.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

41) Mr Fernando submitted that there was oral use of NIRVANA on its own and this should be taken into consideration. There is no evidence to this point. Mr Boura does not state that NIRVANA rather than NIRVANA NATURAL is used orally. There is no evidence to support this claim. There is nothing to suggest that oral use of a trade mark cannot constitute use for the purposes of section 46 (1)(b) of the Act. However, it is not a matter for mere supposition. If the Bouras want to rely on oral use of NIRVANA without NATURAL they should have put in evidence to this effect. Mr Boura could have included this in his statements and furnished supporting exhibits from customers to show that the proprietors or those using the trade mark with the consent of the proprietors use NIRVANA in relation to the goods without following it with NATURAL. In the absence of any such evidence I reject Mr Fernando’s claim to oral use.

42) Mr Fernando submitted that as Mr Boura had not been the subject of cross-examination his evidence has to be accepted at face value. He relied upon *Markem v Zipher* [2005] RPC 31 in support of this. I do not consider that this case supports his submission. It is a case in which there was cross-examination and an allegation that a witness had lied. There will be parts of Mr Boura’s statements that not being challenged have to be accepted eg turnover figures. Section 100 of the Act requires the proprietor to **show** use of the trade mark. The very nature of a revocation for non-use case demands that use is shown ie that primary documentary evidence is put forward. If this was not the case it would leave the relevant authority having to rely upon a witness’s perception of the use. The registered proprietor could make a statement with no exhibits and if not cross-examined it would have to be accepted. To effect an effective cross-examination the applicant would have to put in evidence to show the nature of the use or the absence of the use, the difficult task of proving a negative. Effectively the onus would shift from the proprietor to the applicant, turning section 100 upon its head. In the case of Mr Boura’s first statement at paragraph 11 he comments upon the material exhibited at CB4. He refers throughout to the use of NIRVANA, when I look at the material I see use of NIRVANA NATURAL. On the basis of Mr Fernando’s submissions I would be deprived of

exercising my judgment as to what the material exhibited shows. In *Kabushiki Kaisha Fernandes v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01* [2003] ETMR 98 the Court of First Instance (CFI) stated:

“47 In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

The acceptance of a statement rather than an analysis of the use would make this position redundant, and that of Jacob J in *Laboratoire De La Mer Trade Marks* [2002] FSR 51:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

It seems that Mr Fernando's submission is that use can be proved without material showing such use. This would deprive the relevant authority from using its judgment on what the nature of the use shows; it could put the registered proprietor in the position of deciding what the nature of the use was, whether it was use of the trade mark in the form registered or in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. The registered proprietor would also be deciding upon what goods or services the trade mark had been used and the appropriate description of such goods or services. Mr Fernando seemed to seek succour from recent decisions and judgments in relation to the nature of evidence in revocation cases eg *York Trailers Ltd* BL O/191/05 and *Almighty Marketing Ltd v Milk Link Ltd* [2005] EWHC 2584. In the latter judgment Kitchen J stated:

“15 Against this background, counsel for the appellant submitted that rule 31(3) lays down no more than a procedural requirement which is satisfied by the filing of any evidence of use at all. It would be enough, he submitted, for the proprietor to say "I have made genuine commercial use of the trade mark".

16 I am unable to accept this submission. It goes too far and pays no regard to the purpose of the provisions in issue. Section 100 and rules 31 and 31A address the difficulty facing anyone who wishes to establish a trade mark has not been used. As explained in the White Paper: Reform of Trade Marks Law, September 1990 at paragraph 4.30:

"It is however difficult and time consuming to have to prove a negative, whereas if a trade mark is in fact being used it is a straightforward matter for the proprietor to demonstrate this. The law will therefore provide for a person who is affected by the presence of a mark on the register ... to call upon the proprietor to produce evidence of use; failure to produce such evidence will be treated as an admission of non-use."

To my mind the requirement laid down by rule 31(3) is not therefore satisfied by a proprietor who simply asserts, through a relevant witness, that the trade mark has been used. Such a bare assertion would provide no evidence as to the actual use made by the proprietor. The evidence must provide a sufficient explanation of how the mark has been used for the tribunal to conclude that the proprietor has an arguable defence to the application. I respectfully concur with Mr. Geoffrey Hobbs QC, sitting as the appointed person, in *York Trade Mark* [decision 0-191-05 of 1 July 2005] when he said, at paragraph 10 :

"The purpose of rule 31(3) is to allow the Registrar to make an order for revocation if it does not appear from information provided in the manner prescribed by rule 31(2) that the proprietor has a viable defence to the pleaded allegation(s) of non-use."

Conversely, however, the evidence does not have to be so persuasive that, if unanswered, it would necessarily discharge the burden of proof lying upon the proprietor. The scheme which I have summarised clearly contemplates that the proprietor should have an opportunity to supplement its evidence even if the applicant for revocation chooses to file no evidence. The purpose of the evidence under rule 31(3) is to establish that the proprietor has an arguable or viable defence to the attack mounted upon the registration and to provide the applicant for revocation with sufficient information to enable him to investigate the use of the mark upon which the proprietor proposes to rely.

17 In *Carte Bleue Trade Marks* [2002] RPC 31 Mr. Knight, the principal hearing officer acting for the registrar, observed at paragraph 35:

"Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used."

If, in using the expression "proper defence", the hearing officer meant an arguable defence then I respectfully agree with him. After referring to another decision by one of the registrar's hearing officers in *Adrenalin* [BL O/336/99] he continued, at paragraph 37:

"From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question together with some indication of the sales of goods, or the provision of services during the relevant periods. Clearly this cannot be an exhaustive list and is merely an example of documents which might be sent in." I agree with the hearing officer that evidence of this kind is highly desirable. If the proprietor files such evidence it will assist in clarifying the issues at an early stage and may even serve to shorten the proceedings. It is not, however, a requirement of rule 31(3). If the

proprietor is able to establish that it has an arguable defence to the application without filing such evidence then, in my judgment, it is not obliged to do so.

18 With these principles in mind I turn to consider the evidence in the present case. Mr Cooper is plainly a person who is qualified to give evidence of use. He was the person responsible for using the Trade Mark at the relevant time in the course of his farming business. He explains that the mark was used on a daily basis in relation to milk up until 31 March 2001. He demonstrates how the mark was used by exhibiting labels used on the packaging of the cartons of milk sold under the Trade Mark. Those labels bear the words MOO JUICE prominently upon them together with the source of the milk as Matts Hill Farm, Hartlip. He also provides certain corroborative evidence of the use of the mark by exhibiting a letter from his accountants. I have reached the conclusion that this evidence does, just, satisfy the requirements of rule 31(3). Albeit very short, the evidence shows when the mark was used, by whom it was used, how it was used and in relation to which product it was used. In my judgment Mr Cooper has shown an arguable case that he made genuine use of the Trade Mark in the course of his business up to 31 March 2001.

19 It was contended on behalf of the respondent that the evidence relied upon by the appellant consisted of assertion rather than evidence of actual use. First of all it was pointed out that the labels which Mr. Cooper exhibits are not labels which actually appeared on milk cartons within the relevant five year period. Notably, it was said, the "use by" dates had not been completed. I accept this is the case but it is hardly surprising that Mr. Cooper has not retained old cartons of milk so long after their sell by date. The substance of his evidence is, however, that the labels he has exhibited are the same as those which he used prior to 31 March 2001.

20 It was also submitted that the evidence does not explain how the Trade Mark was used or explain in relation to which goods it was used. Further, it fails to give details of any quantities, turnover, profit or marketing costs associated with the Trade Mark. I do not accept that the evidence does not explain how the Trade Mark was used or in relation to which goods it was used. For the reasons that I have given the evidence shows the Trade Mark was used in relation to milk and it shows the way it was used on the milk cartons. I accept, however, that the evidence does not give details of the quantities of milk sold, the turnover achieved or the profits made. These are deficiencies in the evidence. However Mr. Cooper has given evidence that he used the mark in the course of his business every day and in the light of the nature of the use which he has shown and the nature of the business in relation to which he used it I believe he has done enough to show that he has an arguable or viable defence to the allegation of non-use."

In my view Kitchen J's judgment is against Mr Fernando. The judgment deals with what is necessary to establish a defence, not to retain a trade mark, and even in these circumstances mere assertion is not enough. If Mr Fernando's argument is correct there would be no need for a registered proprietor to furnish evidence of the actual use made.

43) The outcome of this is that when considering the nature of the trade mark used and the goods upon which it is used, my judgment will be rooted in what is shown by the exhibited material, that which shows how the trade mark has been used and upon what it has been used.

44) Mr Fernando raised the issue of what trade mark has been used. He considered this the first issue. Ms Lane also raised this issue; Mr Fernando approached this from the basis of the judgment of the European Court of Justice (ECJ) in *SA Société LTJ Diffusion v Sadas Vertbaudet SA* (Case C-291/00) [2003] FSR 34, Ms Lane from *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40.

In the former case the ECJ stated:

“53 Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.

54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the Directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

In the latter case Jacob LJ discussed the above judgment of the ECJ and the opinion of the advocate general. At the end of his discussion he came to the following conclusion:

“39 Putting it another way, I do not think the additional words "Business Information" would "go unnoticed by the average consumer." In all uses of the phrase complained of they are as prominent as the word "Reed".

40 In so holding I am not saying that in some circumstances the average consumer could not assume that "Reed Business Information" is connected with Reed Employment or an organisation called "Reed." But these would be cases of similarity of mark and sign, not identity.”

It was Mr Fernando’s submission that the trade mark upon which use had been shown was NIRVANA on its own. If Mr Fernando is correct then the issue of 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” is headed off at the pass; there is no question to be considered as the use of the trade mark is as registered. Ms Lane referred to Jacob LJ’s example of Palmolive soap, if in a slightly different context. I was surprised by Mr Fernando’s submission. Having considered all the evidence I considered that, with a few exceptions, it was a given that the use was of NIRVANA NATURAL. The NATURAL element might or might not alter the distinctive character of the trade mark as registered, however, it is not something that would be subsumed in the consciousness of an average consumer. It is certainly not soap as in Palmolive soap,

in the context of this case that sort of use comes in the use of terms such as rosemary shampoo and orange and barley shampoo. I am also influenced in this in the way that NATURAL is used in relation to NIRVANA. The NATURAL element of NIRVANA NATURAL has to be considered. There are a few examples of NIRVANA on its own and I will consider these in the context of considering use of NIRVANA NATURAL.

45) Both the cases relied upon by counsel relate to the issue of identity of conflicting trade marks. I am not certain that it is necessary or helpful to import considerations relating to this issue in a non-use case. It is necessary for me to decide what trade mark has been used from the evidence and then, if there is a variation from the form in which it is registered, to apply the criteria set out by Walker LJ in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25.

46) Both counsel accepted the material period to be from 3 February 1999 to 3 February 2004. A good deal of the evidence emanates from prior to the material date, some of it does not bear a date and some of it emanates from after the material date. Of course the period of use is confined to the material period. However, other material can be helpful in putting the business into a context and the rôle of the Bouras in it. The material prior to the beginning of the material period shows that in the beginning the use of NATURAL was subservient to NIRVANA. By the time of the beginning of the material period the nature of the use had changed; as can be seen from the extract from “Company” of February 1999 exhibited at CB4. It should be noted also that there is no indication that the use by the Bouras prior to 11 March 1998, when the trade mark registrations were assigned, was with the consent of the then proprietors, Unilever plc.

There are three main areas of the case to be considered:

- Whether the trade mark was used with the consent of the proprietors.
- Whether there has been use of NIRVANA on its own and whether use of NIRVANA NATURAL is use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.
- What the proper specifications of the registrations should be.

Consent of the proprietors

47) It has been the argument of NSL throughout that it has not been established that use of the trade mark, if there has been use, has been use with the consent of the Bouras. The goods are clearly identified as emanating from NN. The abbreviated company accounts for years ending 30 June 1999 and 30 June 2000 are for Linquote Limited which is identified as trading as NN; this is also shown in some of the material exhibited at CB1. On 28 September 2001 Linquote Limited changed its name to Nirvana Natural Limited. The accounts for the year ending 30 June 2001 state that due to their majority shareholding the Bouras had control of the company. Mr Boura states that following the liquidation of Nirvana Natural Limited in April 2003 the business was taken over by Benbry Limited who continued to trade as NN. Mr Boura states that the directors of Benbry Limited are the Bouras and Courtney Brennan, who were previously the directors of Nirvana Natural Limited. The

evidence shows constant use of the trading name Nirvana Natural. So the companies behind the trading name have included the Bouras as directors. From the outset the goods have been identified with the Bouras.

48) Mr Boura states that he became a director of Nirvana Natural Limited on 1 January 1999 and that Mrs Boura became a director on 1 November 2000. I presume he means Linquote Limited. The relevant accounts covering these dates list only one director Miss Brennan. There is no mention of the Bouras until the accounts for the year ending 30 June 2001. I note that in the accounts for years ending 30 June 1999 and 2000 there is a reference to intangible fixed assets:

“Company trade mark costs have been capitalised, and are being written off evenly over their estimated useful life of twenty years.”

In the accounts for the year ending 30 June 2001 the reference to the intangible fixed assets has changed:

“Company patents, licences and design costs have been capitalised, and are being written off evenly over their estimated useful life of twenty years.”

There is no indication in the evidence as to the nature of these intangible fixed assets. The presence of these notes in the accounts could give rise to speculation as to what they exactly relate. I cannot see that an explanation would necessarily be to the detriment to the case of the Bouras, the very opposite could well be the case. However, in the absence of explanation I can make nothing of the notes. NSL sought no explanation of these notes in the extensive list of queries it sent to the representatives of the Bouras; it was NSL that exhibited the accounts.

49) NSL sought clarification on the position of NN and of any licence agreements that had been issued by the Bouras in relation to their trade mark. The Bouras did not give specific responses to the queries. However, Mr Boura in his second statement commented on NN and the companies that used this trading name. He also states that the use by NN was with the consent of the Bouras since 1999; there is no explanation as to why 1999 rather than 1998 when the Bouras bought the trade marks from Unilever.

50) There is a certain lack of clarity and precision in some of the information furnished by Mr Boura. However, that is not damning in itself.

51) The Bouras began using the trading name NN from the beginning of their business using the trade mark NIRVANA or NIRVANA NATURAL. In various exhibited material they are clearly identified with the goods. The Nirvana Natural Limited accounts show that at least in one period during the material period the Bouras controlled the company. The Bouras clearly had an awareness of use of NIRVANA or NIRVANA NATURAL by the companies using the trading name NN. Mr Boura has stated that he has been managing director of NN for ten years. One might ask how it is possible to be the managing director of a trading name. However, I read this as meaning that Mr Boura was in charge of the business which used the trading name Nirvana Natural. The trading name brings together the trade marks rights of the Bouras and the legal entity of a registered company. In March 1998 the

Bouras purchased the trade marks from Unilever; so at the time of the purchase the Bouras would have been aware of the use of NIRVANA or NIRVANA NATURAL by NN. The purchase of the trade mark registrations in their joint names rather than in a company name is not unusual. Taking into account that the Bouras have very much identified themselves with the brand it is unsurprising that they would wish to control the trade mark rights associated with it. Mr Boura states, and he is unchallenged in this, that the trade mark has been used by NN with his consent.

52) Ms Lane argued that the evidence showed mere acquiescence and that as per *Anastase* BL O/145/01 mere acquiescence is not tantamount to consent. I find it difficult to conceive of how the Bouras and particularly Mr Boura in relation to the use by NN, taking into account their relationship with NN, could be said to be merely acquiescing. At least for one period the accounts of Nirvana Natural Limited show that the Bouras were the controlling minds behind the company that used the trading name NN. Ms Lane looks to the absence of a licence. I am hardly surprised by the absence of a licence. This case relates to a small undertaking, in which all the evidence suggests that the Bouras are the dominant figures and controlling minds. Owing to their position in the business it would almost be like them writing a licence for themselves. I would suggest that it is an unlikely scenario for a small business to act in this way.

53) In considering this matter it is also useful to look at Article 19 (2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS):

“2. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.”

TRIPS talks about control. Article 10 (3) of the First Council Directive 89/104 of December 21, 1988 (the Directive) states:

“Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.”

In *Heidelberger Bauchemie GmbH* Case C-49/02 [2004] ETMR 99 the European Court of Justice stated:

“20 Since the Community is a party to the TRIPS Agreement, it is required to interpret its legislation on trade marks so far as possible in the light of the wording and purpose of that Agreement (see, to that effect, Case C-53/96 *Hermès* [1998] ECR I-3603, paragraph 28).”

Consequently, it could be argued that it is necessary to look for control. In this case, owing to the position of the Bouras, for at least part of the period, they had control of the company, using the trading name which was using the trade mark (and of course Mr Boura was running the business as managing director of NN).

54) In *Sanofi-Synthelabo SpA v 3M Healthcare Ltd* [2003] ETMR 45 Laddie J commented on control in the following terms:

“26 It seems to me that the words "effective control" in the supply agreement have much the same meaning. A company can be considered to be in the control of that person or those persons who can make or unmake its officers and dictate their conduct mediately or immediately. This does not mean that the controller will be involved in the day to day running of the company. He may never need to exert his control. His power may remain sheathed because the company is always run to his satisfaction. But he has control if, when necessary, he can directly or indirectly make the company to his bidding. That is the sense in which that word is used in clause 11.2:3. If that is so, then what is added by the word "effective"? It could be said that it adds nothing to "control" since control which is not effective is not control. In my view it adds little, save to emphasise that control may be indirect.”

Most certainly for at least part of the material period the Bouras could make and unmake the officers of Nirvana Natural Limited which was using the trading name NN. The Bouras controlled the company, the Bouras owned the trade mark that the company, using the NN trading name, used. Yet it is argued that the trade mark has not been used with the consent of the proprietors.

55) I have no doubt on the facts of this case that the trade mark, if it has been used, has been used with the consent and for at least part of the time within the control of the Bouras.

Use of the trade mark

56) For the most part the trade mark that has been used with the consent of the proprietors is NIRVANA NATURAL. The only occasion upon which NIRVANA on its own has been used on material that clearly emanates from the material period by NN is very limited. This occurs in the pages downloaded from the NN website exhibited at SNS 8. On that occasion it is in the form of a quotation that is quoted in the section “What The Media Say”:

“Nirvana is a market leader in its field....”

This is attributed to the owner of the Martin Dorcott Hair Salon. The same page does have a quotation referring to the “Nirvana of Haircare” and the homepage exhibited at SNS4 states “you have reached nirvana. prepare to indulge yourself.” I do not consider that these two occurrences can be viewed as trade mark use; they make a pun of the word nirvana. There are various press articles where NIRVANA is referred to rather than NIRVANA NATURAL. Mr Fernando submitted that such use was use with the consent of the proprietors. It is an interesting submission but one that I have difficulty in accepting. Why would there be consent? How would there be consent? Where is the proof of consent? Where is the proof of any involvement of the Bouras or NN? If the press pieces were advertisements in which the copy could be assumed to be controlled by NN or the Bouras, that would be accepted as use by the proprietors; that after all is the normal case in revocation cases. However, there are no conventional advertisements produced. The press coverage is via advertorials and

features; there is no establishment that either NN or the Bouras had control of the copy. I am not prepared to accept that use of NIRVANA on its own in the press material exhibited represents use with the consent of NN or the Bouras.

57) So there is one identifiable use in the material period by the proprietors of NIRVANA on its own and that in the form of a quotation from a third party on a webpage. I do not consider that such use establishes use of NIRVANA on its own, by the proprietors or with their consent, in relation to the creation or preservation of an outlet for the proprietors' goods (borrowing from *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85).

58) In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

“40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal: "... 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." (This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

59) The goods under consideration are used by almost everyone. The use has been at the higher cost end of the market, however, those who encounter the trade mark will not be restricted to those who are willing to pay more than the norm for such products. I consider, therefore, that the average consumer should be taken as the public at large.

60) In considering the issues here it is necessary to keep in mind that the test is the perception of the average consumer. It does not relate to the intention of the proprietor; it is the effect that counts. It is clear that NN has used NIRVANA NATURAL constantly, it is on the products, it is on the website. In the material period there is no indication of the use of NIRVANA on its own originating from NN, any such use originates from the press. In this case the trade mark registrations are not bespoke; they were bought off the rail by the Bouras from Unilever. So it could be that the goods purchased by the Bouras did not fit. I put this to Mr Fernando, who responded that they fitted like a glove. The nature of the use, the purchase of the trade mark registrations, these are the facts. They are, however, not determinative facts. It is again a matter of perception of the average consumer that counts; effect not intention.

61) There are, to my calculations, fifteen English language press or press related references to NIRVANA where it is not followed by NATURAL. The majority of these are outside the material period. Six clearly emanate from the period when the NATURAL element did not have equal billing with NIRVANA. Five originate from after the change in the packaging, where the two elements have equal billing. It is not possible to attribute the other four. (I have excluded the punning use of NIRVANA.) Mr Fernando submitted that the dropping of the NATURAL element in these press references showed the way that the average consumer would perceive the trade mark in use. Ms Lane submitted that the fact that the vast majority showed use of NIRVANA NATURAL was indicative of the way that the average consumer would view the use of the trade mark. I don't think that the instances of use assist me

greatly. All of these emanate from the press, this cannot be considered to represent the average consumer. One does not know what constraints the writers would be under; whether when reproducing NIRVANA NATURAL they were reflecting their own perception or just being punctilious. So the press usage, one way or the other, has not weighed greatly with me.

62) Ms Lane referred to the use of the ® symbol after NIRVANA NATURAL on the packaging; a good deal of the use shown does not show the symbol. I am not convinced that the presence of this symbol will have a great effect upon the average consumer. This symbol and TM are so common that they certainly don't register with me when I am purchasing a product; for persons of failing eyesight, such as me, it would be difficult to even discern. The use of this symbol might indicate the intention of the proprietors but as I have stated above it is effect not intention that has to be considered. However, the intention it might indicate is ambiguous. It could be as Ms Lane submits indicate that NIRVANA NATURAL as an entirety is seen as the trade mark. However, it could also be argued that the Bouras knowing what their trade mark registrations are felt happy for the symbol to appear after NATURAL owing to their belief that NATURAL being completely non-distinctive would not be seen to have any trade mark significance. One wonders if the symbol had followed NIRVANA whether Ms Lane would have accepted that this proved use of NIRVANA in a form which does not alter the distinctive character of the mark in the form in which it was registered

63) NIRVANA NATURAL consists of two words, they are both of seven letters and so balance one another. NIRVANA contains three syllables. NATURAL can be pronounced with two or three syllables; the middle vowel often being lost in speech. There is an alliteration between the two elements. Ms Lane submitted that the addition of NATURAL changed the conceptual meaning of the trade mark. She submitted that in addition to the concept of nirvana or heaven a new and completely different concept is introduced; that of naturalness. According to Ms Lane the two concepts are contrasting, "other worldly with environmental". Ms Lane submitted that this changes the overall conceptual impact of the trade mark completely. The use of NIRVANA NATURAL certainly does not have that effect upon me. Ms Lane's submission does not relate the submission to the goods and the nature of the use; the use of the trade mark has to be considered in relation to the goods. I am not convinced that the conceptual significance of NIRVANA will be considered by the average consumer. In comparing trade marks the average consumer may be made aware of the conceptual associations by the act of comparison, or simply discriminate between them as he or she is used to discriminating between words; which is how language works. I am of the view that the average consumer on seeing NIRVANA upon the goods of NN will just think of it as a trade mark. I doubt that he or she is going to consider the philosophy of Buddhism. If I am working on an Apple Mac I neither think that I am going to eat it or wear it. It will be viewed as a trade mark by me. If NIRVANA was being used in relation to Buddhism or rock music it would have a conceptual significance to me; in relation to the goods of NN its significance is that of a trade mark rather than coming freighted with meaning.

64) The nub of the issue in relation to the presence of NATURAL relates to the nature of the goods and the average consumer's perception in relation to such goods. Proof of use cases are about the realities of actual use and how that use justifies or does not

justify maintenance upon the register. They are not about theoretic notional and fair use. Consequently, I consider that how NN has marketed the goods and the exact nature of the goods has to be taken into account; rather than a consideration of the goods in the specification without reference to the nature of the use. Ms Lane disagreed with this. She considered that the consideration should be against the goods as registered without reference to how the goods had been marketed and the exact nature of the goods. I cannot see how this can be correct because the issue is about the average consumer's perception of the trade mark as used and that cannot be divorced from the nature of the use. Average consumers do not consult the trade marks register; specifications, like disclaimers, do not go into the market place.

65) From the inception the natural nature of the goods has been identified and emphasised. This has been done in the publicity, in the statements of the Bouras and in the nature of the goods. The very titles of the goods speak of the natural eg nettle and jasmine, wheat and honey and wild mint. Mr Sherlock has exhibited pages from the NN website. In SNS4 there is a page headed "Nirvana Natural Hair Product Index". The goods are divided into two ranges; the Indulgence Range and the "Nirvana Natural Range". At SNS5 there are again pages relating to the "Nirvana Natural Range"; at the side of the page there is the heading "Natural Range". If this use was decontextualised it would, in my view, be a knock out blow to NSL's case; simply quoted I do not believe that anyone would see NATURAL as being anything other than a descriptor. However, this use has to be put in the context of the banners that use NIRVANA NATURAL and these words appearing on the products displayed. What this use does show, however, is how easily it is for NATURAL in the context of the goods to be seen as a descriptor.

66) There may be a consumer who has by constant exposure and purchase of the goods of NN come to see NATURAL as an inherent part of the trade mark and expect it to be there. However, there will be many others who are browsers or occasional purchasers who will not be educated thus. Even the consumer who has been educated by use and exposure could still view NATURAL as a descriptor, taking into account the nature of the product. That customer could still effectively perceive a NIRVANA trade mark.

67) I have considered this matter at great length and debated with myself for sometime. The very fact of their being a case to some extent skews the perspective as one is confronted with a tranche of use of NIRVANA NATURAL and there is almost a reflex reaction in favour of the position of NSL. The average consumer is not going to be in that position. Taking into account the nature of the goods and the nature of the use, I have concluded that the average consumer would see NATURAL as no more than indicating the nature of the products, as a descriptor. Ms Lane accepted that NATURAL was lacking in distinctiveness for the goods although she submitted that it wasn't at the furthest end of the scale for unregistrability. I am of the view that NATURAL for the products is at the extreme end. Mr Boura furnished a Google printout for use of NATURAL with hair care products; the frequency of its occurrence is no surprise. Producers of personal care products wish to associate the idea of the natural with their products. In use it is NIRVANA that is striking and memorable, NATURAL becomes an indication of the products.

68) I find that the use shown of NIRVANA NATURAL is use of the trade mark in a form which does not alter the distinctive character of the trade mark as registered.

My decision would have been no different if, as submitted by Ms Lane, I did not take into account the nature of the use of the trade mark and based it purely upon the specifications. The nature of the goods, whether they are “natural” or not, dictates the descriptiveness of the term NATURAL and the consequent effect upon the perception of the average consumer for the goods.

Proper specifications of the registrations

69) Ms Lane in her skeleton argument pointed out that shampoos are in class 3 and, therefore, the basis of the Bouras’ claim to keep medicated preparations for the prophylaxis or treatment of diseases or disorders of the skin and scalp on the basis of use on shampoo must fail. The specification of registration no 1199776 is governed by the 4th edition of the Nice Agreement concerning the International Classification of Goods, coming into effect from 1 June 1983. All shampoos, whether medicated or non-medicated, were in class 3, as they still are. On this basis Mr Fernando conceded that no use in relation to class 5 goods has been shown. I note that the camomile conditioner is also advertised as being for use in relation to psoriasis. All hair conditioners also fall within class 3.

70) The remaining goods upon which it is claimed that there has been use are:

shampoos, conditioners, hair sprays, holding sprays, shine sprays, body lotions, foam baths, shower gels, body soaps, shaving lotions, make-up removers, moisturising creams.

In his evidence Mr Sherlock accepts that if it is decided that there has been use of the trade mark with the consent of the proprietors then there has been use in relation to hair care products.

71) There is now a body of case law as to how to arrive at a fair specification of goods in non-use cases:

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal

cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

Animal Trade Mark [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

72) The specifications must fall within the parameters of the original specifications. Shampoos, conditioners, hair sprays, holding sprays and shine sprays, as used, are all hair care products; a term that would certainly be encompassed by the specification for registration no 1384452 and the general term toilet articles in registration no 365200. The term hair care products would seem a fair description of the aforesaid goods and would satisfy the requirements of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*, *Reckitt Benckiser (España)*, *SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* and *Animal Trade Mark*.

73) This is no evidence of use upon certain specifically identified goods. There is no indication that registration no 365200 has been used in respect of perfumes or perfumed soaps. There is no indication that registration no 1384452 has been used in respect of body sprays; soaps; perfumes; essential oils, dentifrices; anti-perspirants; deodorants for use on the person.

74) One is now left with the multiple use items. I am aware of no authorities that cover this situation and counsel were unable to advise me of any. The claimed multiple use is not a manufactured claim. From an early stage certain of the goods have been promoted as having multiple uses and this has also been identified on labels. In the material period I have been able to identify the following additional uses of the goods:

Camomile conditioner	Make-up remover, shaving lotion, hand and body moisturiser
Various shampoos	“can also be added to bath water to relieve aching muscles”
Nettle and jasmine shampoo	“can be used in the bath and shower, too, if the skin on the body is also inflamed” “Can also be added to bath or shower to reduce inflammation and itching.”
Rosemary shampoo	“Adding Rosemary shampoo to bath water relieves headaches, migraine, sprains, aching muscles and PMT.”
White nettle and thyme shampoo	“...and if added to the bath or shower, will calm and soothe your skin.”
Orange blossom and camomile conditioner	Hand and body moisturiser or shaving aid.

Ms Lane submitted that the goods were described as various hair care products; that was how the average consumer would perceive them; the multiple uses of certain goods does not change this. It is possible, however, that a customer would purchase the goods because of their multiple functions. The extract from “Time Out” from 1998 exhibited at CB5 comments on the multiple functions of the products and states that because of this they are “perfect products for travelling”. This article is before the material date but is indicative of how the goods might be perceived and why they might be purchased eg because they are shampoos and bubble baths. It can be easily envisaged that someone specifically purchases the goods for their multiple purposes. Couples might use the goods for different purposes, one as a conditioner, the other as a moisturiser.

75) In considering this issue of multiple use goods I have found it useful to go back to first principles. The recitals of the Directive state:

“Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation;”

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 deals with the Community Trade Mark Regulation but it is based upon the same fundamental principle:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.”

The purpose of revocation is to remove trade marks or parts of the specifications of trade marks where there has not been use. It is there to serve a purpose in trade; it is the Lipitor that stops the arteries of commerce being blocked with the cholesterol of unused trade marks. The trade mark has certainly been used for multiple purpose

goods. There has been genuine use in relation to such goods and so it would seem contrary to the recitals of the Directive to revoke in respect of such goods. Revocation for non-use is to deal with the facts of use, not to sit neatly in some legal formula. I find, therefore, that the multiple use goods should retain protection for their additional functions.

76) It would seem perverse in the extreme to have decided that there has been no use of goods specifically listed in the specifications and then to give them cover in a portmanteau term. There is no use upon perfumes or perfumed soap but these terms would be covered by toilet articles. The case law dictates against over prescription but also against over generalisation in an amended specification. Toilet articles and non-medicated toilet preparations are very wide terms that could subsume all the other goods in the class 3 specification. They are terms that are certainly open to further sub-division as per *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*. Mr Boura claims use upon body lotions, foam baths, shower gels, body soaps, shaving lotions, make-up removers. I have listed above the additional purposes of the goods. **Taking into account the case law and the purposes for which the goods can be used I consider that a fair specification, that is neither pernicky nor overly broad, and which would reflect the perception of the average consumer would be: moisturisers, shower and bath preparations, shaving lotions and make-up removers. I am of the view that such goods would be encompassed by the terms toilet articles (registration no 365200) and non-medicated toilet preparations (registration no 1384452).**

Conclusion

77) There has been no request to revoke the registrations from a date earlier than that of the date of the applications. I can see no reason that the dates of revocation should be other than the date of the filing of the applications, 3 February 2004.

78) On the basis of the above findings registration no 1199776 is to be revoked in its entirety. The specifications of both registration nos 365200 and 1384452 should read as follows:

Hair care preparations; moisturisers, shower and bath preparations, shaving lotions, make-up removers.

COSTS

79) Ms Lane wanted costs to take into account a request by Mr Boura to give oral evidence, a request that was turned down by the registry. She advised that she took instruction in relation to this matter. I consider that the request was just a normal part of the administrative process of the case and not one that is normally compensated for in costs. If NSL chose to instruct counsel that was its choice, I see no reason it should be compensated for this. Ms Lane also commented on the blanket rebuttal of the claims to non-use by the Bouras. This was the case in the counterstatements. However, Mr Boura set out his stall as to which goods for which he was claiming use upon in the third paragraph of his witness statements; witness statements that came in with the counterstatements. The Bouras have effectively succeeded in maintaining

their registrations in respect of all the goods listed in that paragraph, with the exception of those that they mistakenly believed were in class 5. NSL has succeeded in having the class 5 specification revoked in its entirety and parts of the class 3 specifications as well. I note that the Bouras did not formally give up the class 5 registration and parts of the class 3 specifications until the hearing. Taking into account the overall results and that NSL had to pay application fees, I consider that each side should bear its own costs. (If costs had been awarded they would have reflected that the cases should have been consolidated and that every aspect of the cases was virtually identical, there would have been an award of single rather than triple costs.)

Dated this 26th day of January 2006

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