

O-045-08

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO. 82532
IN THE NAME OF WOODBRIDGE ESTATES LIMITED
FOR REVOCATION OF TRADE MARK NO. 1578364
IN THE NAME OF METRO-GOLDWYN-MAYER STUDIOS INC.**

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**IN THE MATTER OF Application No. 82532
in the name of Woodbridge Estates Limited
for revocation of trade mark No. 1578364
in the name of Metro-Goldwyn-Mayer Studios Inc.**

BACKGROUND

1. Trade mark No. 1578364 is for a series of four trade marks THIRTYSOMETHING, THIRTYSOMETHINGS, 30 SOMETHING and 30 SOMETHINGS. The registration is in respect of the following services in Class 41:

Production of shows; organisation of entertainment competitions; tourist and leisure camp services; entertainment services, all provided by tourist resort establishments; sports camp services; provision of gambling casino facilities; rental of films; providing of cinema facilities; services; discotheque services; rental of sporting equipment; entertainer services; entertainment information; gaming; gymnastic instruction; presentation of live performances; rental of movie projectors and accessories; provision of movie theatre facilities; party planning; production of shows and programmes; radio entertainment; provision of recreation facilities; rental of radio and television sets, sound recordings, video cassette recorders and video tapes; rental of stadium facilities for entertainment; theatre productions; all included in Class 41.

2. The trade mark is registered in the name of Metro-Goldwyn-Mayer Studios Inc. The registration contains the disclaimer "Registration of these marks shall give no right to the exclusive use of the word "Thirty" and the numeral "30"".

3. By an application dated 22 June 2006, Woodbridge Estates Limited applied for the registration to be revoked under the provisions of Sections 46(1)(a) and 46(1)(b) of the Act on the basis that the trade mark has not been put into genuine use following its registration, or in the five years immediately preceding the filing of the action. They request that the date of revocation be taken as either 18 October 2004 or 21 June 2006.

4. In a Counterstatement filed on 28 September 2006, the registered proprietors deny that the trade mark has not been used.

5. Both sides ask that an award of costs be made in their favour.

6. Only the registered proprietors filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. The matter came to be heard on 4 September 2007, when the applicants were represented by Mr Julius Stobbs of Boulton, Wade Tennant. The registered proprietors were represented by Mr Andrew Norris of Counsel, instructed by Forrester Ketley & Co.

Registered proprietor's evidence

7. This consists of a Witness Statement dated 28 September 2006 from Steven John Wake, a Trade Mark Attorney with Forrester Ketley & Co, the registered proprietor's representatives.

8. Mr Wake says that the trade mark THIRTYSOMETHING has been used as the name of a television series, most recently broadcast by Channel 4 on their More4 Channel. Exhibit SJW1 consists of a copy of a License Agreement dated 21 October 2005, between Sony Pictures Television International, the licensing entity being shown as Columbia Pictures Corporation Ltd, and Channel Four Television Corp as the station. The financial information on the agreement has been obliterated. The Agreement relates to the screening of THIRTYSOMETHING, a later page showing the start date as "01 Jan 2006", which corresponds with Mr Wake's statement that the series was to run from 1 January 2006 to 31 December 2006. Mr Wake explains that Columbia/Sony Television were the sales agent/sub distributor for Metro-Goldwyn-Mayer Studios Inc., and that use of THIRTYSOMETHING by Channel 4 Television was with the consent of Metro-Goldwyn-Mayer-Studios Inc. He says the series was produced in four seasons or years, the license with Channel Four covering all four of the seasons. Mr Wake says that Exhibit SJW2 is a listing of the transmissions obtained from Channel Four. The list is headed "Thirty Something Episode Breakdown". It contains two tables headed "Thirtysomething YR 1 (More 4)" and "Thirtysomething YR 2 (More 4)". The rows of the tables have the titles "Episode, Date and Time", the "Episode" column on the first showing "Ep.1 to Ep.21" each with corresponding dates from "21-Aug-06" through to "19-Sep-06", the second showing "Ep.1" to "Ep.17" with dates in the range "20-Sep-06" through to "12-Oct-06".

9. Exhibit SJW3 consists of a TV listings page for Channel 4's "More 4" channel taken from the Internet. This details programmes to be broadcast on 22 September, and 25 to 28 September 2006, showing a scheduled broadcast of "Thirtysomething" on each day. These dates correspond to the listing at SJW2. That concludes my review of the evidence insofar as it is relevant to these proceedings.

DECISION

10. Section 46 reads as follows:

"46.-(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 purpose 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.”

11. Section 100 of the Act is also relevant and reads:

“**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.”

Relevant five year period

12. The application for revocation is based on Sections 46(1)(a) and 46(1)(b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] R.P.C. 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. The date for revocation is the date that the application for revocation was made, and cannot be less than five years from the date the registration procedure was completed. In *WISI Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

13. The subject mark achieved registration on 2 June 1995, so the five year period for the purposes of Section 46(1)(a) runs from 3 June 1995 to 2 June 2000. The application for revocation was made on 22 June 2006 requesting two dates of revocation under Section 46(1)(b). The first is the date of 18 October 2004, which makes the five year period from 18 October 1999 to 17 October 2004, the second date being 21 June 2006, making the relevant period 21 June 2001 to 20 June 2006. The proviso found in Section 46(3) means that whether or not the registered proprietors have used the mark within the five years following registration, if there is genuine use within the 46(1)(b) periods this will be sufficient to overcome the ground under Section 46(1)(a).

The authorities on genuine use

14. Both sides referred to *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5, as being the leading authorities on the principles to be applied in determining whether there has been genuine use of a mark. I derive the following points from these cases:

Genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

The use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

It must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

The use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

All the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

The assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

But the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

An act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

There is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

What matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

The need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

15. Mr Stobbs referred me to Kerly's Law of Trade Marks and Trade Names, (Fourteenth Edition) which, at pages 288 to 292, contrasts the ECJ and UK approach to what genuine use actually means. This is essentially a question of "use that is justified in the economic sector concerned for the purpose of creating or preserving a market share" (ECJ) compared with the UK position which considers genuine use to be "use of the mark on the market" that brings it to the attention of the end consumer. Despite Mr Stobbs invitation to settle the position I do not consider that I need be too concerned whether I look at the registered proprietor's use through the eyes of the ECJ or the UK Courts, the view in my opinion is still the same.

16. Mr Wake says that the trade mark THIRTY SOMETHING has been used as the name of a television series broadcast by Channel 4 on their More4 Channel. Exhibit SJW1 consists of a copy of a License Agreement dated 21 October 2005 by which Channel 4 were to screen THIRTY SOMETHING starting on 1 Jan 2006. All figures relating to amounts paid have been obliterated, but that does not detract from its evidential value. Mr Wake says that the series was due to run from 1 January 2006 to 31 December 2006. Although it is not possible to ascertain this from the Agreement, there is a reference to the first instalment consisting of "50.00% of Total StartOrder Value" being due on 1 January 2006, with the second instalment being payable on 1 July 2006. This would seem to be consistent with Mr Wake's claim.

17. The Agreement is between Sony Pictures Television International, the licensing entity being shown as Columbia Pictures Corporation Ltd, and Channel Four Television Corp as the station. Mr Wake says that Columbia/Sony Television were the sales agent/sub distributor for Metro-Goldwyn-Mayer Studios Inc who consented to the use of THIRTY SOMETHING by

Channel 4 Television. There is no mention of Metro-Goldwyn-Mayer Studios Inc in the Agreement, but there seems no reason to doubt Mr Wake's claims; the applicants have not done so. It is a matter of fact that Metro-Goldwyn-Mayer Studios Inc. is the proprietor of the THIRTYSOMETHING trade mark. It does not seem unlikely that they produce the television series of that name, and it is not implausible that Columbia/Sony Television act as sales agent/sub distributor. It also seems reasonable that part of the licensing arrangements by which the show is broadcast includes consent to the use of the name of the show. Mr Stobbs asserted that the Agreement is not use, but it cannot be viewed in isolation. Even allowing for some of its flaws (not being signed) it is the picture on the jigsaw box of use and helps put the evidential pieces together.

18. Mr Wake says that the series was produced in four seasons or years, the license with Channel Four covering all of the series/seasons. The StartOrder shown as part of Exhibit SJW1 lists four seasons of THIRTYSOMETHING, each showing a start date of 1 January 2006 and an end date of 31 December 2008. It does not say that it relates to the Agreement, but as the StartOrder reference number on this sheet is the same as the one on the Agreement it is reasonable to infer that the documents relate to the same transaction.

19. Mr Wake introduces Exhibit SJW2 as being a listing of the transmissions obtained from Channel Four. It is headed "Thirty Something Episode Breakdown" and contains two tables headed "Thirtysomething YR 1 (More 4)" and "Thirtysomething YR 2 (More 4)". The tables have three columns with the titles "Episode", "Date" and "Time", the rows in the "Episode" column on the first table show "Ep.1" to "Ep.21" each with a corresponding dates from "21-Aug-06" through to "19-Sep-06". The rows in the second table show "Ep.1" to "Ep.17" with dates ranging from "20-Sep-06" through to "12-Oct-06". Exhibit SJW3 consists of a TV listings page for Channel 4's "More 4" channel taken from the Internet. This details programmes to be broadcast on 22 September, and 25 to 28 September 2006, showing a scheduled broadcast of "Thirtysomething" on each day. These dates correspond to the listing at SJW2.

20. The applicants did not file any evidence or seek to challenge Mr Wake's evidence. Mr Stobbs did not go so far as to invite me to disbelieve Mr Wake, but this was the tenor of his submissions in which he pointed out that Mr Wake has no connection with the registered proprietor other than being their trade mark attorney. In *Extreme Trade Mark* (BL O/161/07) Mr Richard Arnold QC sitting as The Appointed Person, considered whether the strict rules of evidence apply to the Registrar's tribunal. The relevant part of his decision is as follows:

"Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

'In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position. This rules [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...’

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness’s evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

21. Much of what Mr Wake says is no more than an introduction to the exhibits he files, and the conclusions that he considers can be drawn from them. He does put some exhibits into context and there is a question as to how Mr Wake knows certain things, for example, the nature of the relationship between the registered proprietors and Sony Pictures Television International/Columbia Pictures Corporation Ltd, and that the registered proprietors had consented to use of THIRTYSOMETHING by Channel 4 Television. Mr Wake does not say that he has had any access to his client's company records. Whilst it would probably have been difficult for the applicant's to challenge this aspect of Mr Wake's statement in formal evidence, they could have sought cross examination. As it happens they did neither, and as the guidance in *Extreme* states, the hearing is not the place to invite me to disbelieve his statement if it is not obviously incredible.

22. On the evidence before me I am satisfied that the registered proprietors have made genuine use of THIRTYSOMETHING in relation to a television series, in the UK in the five years prior to the filing of the application for revocation. This being the case, the application must fail in part. I am conscious that THIRTYSOMETHING is one of the four versions of the mark covered by the registration. The applicants have not raised the form in which the mark has been used as being an issue, which I take to mean that it is not. What is significant is that the use does not cover all of the services for which the mark is registered. The correct approach to reducing a specification to reflect the extent to which a mark has been used has been considered in a number of cases that have been before the High Court and Court of Appeal. Mr Richard Arnold QC, sitting as the Appointed Person, considered the accumulated authorities in *Nirvana*

Trade Marks, BL O/262/06. I adopt the following propositions that he derived from his consideration of the case law:

(1) The tribunal's first task is to find, as a fact, those goods or services for which genuine use has been made, relative to the trade mark, during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

23. As I have already said, the evidence establishes genuine use of the registered mark in relation to a television series, but how should this be reflected in the specification? This is not an industry of which I have a great deal of knowledge, that is apart from as a viewer of the programmes and there is nothing in the evidence that gives me much assistance in this area.

24. I consider that the sale of a television series could be regarded as a trade in recorded media which to my mind would be use in relation to a product that properly falls in Class 9. The registration does not cover this class. It can also be the provision of a "television entertainment" service. This is not a description that is expressly mentioned in the list of services for which the mark is registered, so is it covered by another term? The specification does mention the "production of shows and programmes" which in my view would include the production of a television show, or series of shows. Whilst to qualify as a service it would usually be provided to others, it can also be taken to include the production of television shows on your own account that are sold or licensed to another party. I do not consider that this interpretation would be at odds with the way in which the trade would view the activity. I therefore conclude that this term within the specification of the registration would encompass

the use made by the registered proprietors.

25. There is no use within the relevant five-year period for the ground under Section 46(1)(a). There is use in respect of the “production of television shows” within the relevant periods for the second period of the ground under Section 46(1)(b). Therefore, the application for revocation on its face succeeds under Section 46(1)(a) in respect of all services other than “production of television shows”. Mr Norris argued that the evidence justified maintaining the registration in respect of “Production of shows, production of shows and programmes, theatre productions; all included in Class 41. Mr Wake was more realistic in saying that the mark has been used in relation to a television series, which is the extent to which Mr Stobbs conceded the registered proprietors may have used the mark. It therefore seems to me that the term “Production of television shows” reflects the position of both parties.

26. In summary, the registration shall be revoked under the provisions of Section 46(1)(a) in respect of all services other than the “production of television shows” with effect from 3 June 2000.

27. The applicants sought revocation of the registration in its entirety. In their Counterstatement the registered proprietors did not claim use of the mark other than in relation to a television show or series. To that extent they have been successful although I do appreciate that Mr Norris sought to argue that the use went somewhat wider than this. In these circumstances I do not consider it appropriate to make an award of costs to the applicants beyond the statutory fee incurred for the filing of the application, an amount relating to the work involved in drafting the Statement of Case, and consideration of the Counterstatement.

28. I therefore order that the registered proprietors shall pay the applicants the sum of £700. This sum to be paid within seven days of the expiry of the appeal period, or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th Day of February 2008

**Mike Foley
For the Registrar
The Comptroller-General**