

O-058-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 2101481
IN THE NAME OF RED BULL GMBH
OF THE TRADE MARK:**

BULLIT

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO. 82665
BY SEA, AIR AND LAND FORWARDING LIMITED**

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In the name of Red Bull GmbH
of the trade mark:
BULLIT
and the application for revocation
thereto under no. 82665
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BACKGROUND

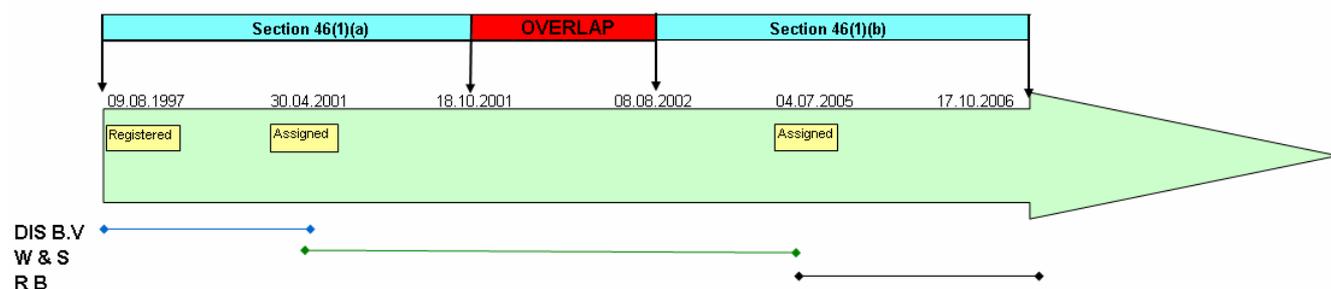
1. On 18 October 2006, Sea, Air and Land Forwarding Limited, which I will refer to as SALF, filed an application for the revocation of registration number 2101481. The registration is for the word BULLIT and is registered for the following goods:

Non-alcoholic beverages and preparations for making non-alcoholic beverages; but not including de-alcoholised, low alcohol or alcohol free beers and lagers.

The above goods are in class 32 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.

2. Completion of the registration procedure for 2101481 took place on 8 August 1997. On 30 April 2001, the registration was assigned from DIS B.V. to W & S Holdings B.V., a company based in the Netherlands, which I will refer to as W & S. The registration was assigned again, on 4 July 2005, from W & S to Red Bull GmbH, which I will refer to as RB.

3. SALF seeks revocation of the registration either in full or in part under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (the Act). It claims that the mark has not been put to genuine use in the United Kingdom by the proprietor or with its consent between 9 August 1997 and 8 August 2002, and between 18 October 2001 to 17 October 2006. Success for SALF would mean revocation taking effect on either 9 August 2002 or 18 October 2006. There is an overlap between both periods of non-use pleaded, when the registration was owned by W & S. For ease of reference, the dates and various ownerships are tabulated below:



4. RB filed a counterstatement, claiming the mark had been used in the UK during the relevant time frames and that the use made was sufficient to maintain the registration for the whole specification.

5. In its application, SALF pleaded section 46(1)(a) and (b); however, in its evidence it refers to use of BULLIT outside the section 46(1)(b) date range as irrelevant. Since SALF has at no time withdrawn its pleading under section 46(1)(a), I do not see how any use shown in the first five years after the completion of registration can be irrelevant. Accordingly, I have based my decision on the requirement to prove genuine use of the mark during both periods of time.

6. Both sides filed evidence and both seek an award of costs. They were advised that they had a right to a hearing and that if one was not requested a decision would be made from the papers and any written submissions received. Neither side requested a hearing and both filed written submissions through their respective professional representatives. RB submits that the registration should be maintained in its entirety but that if the Registrar considered that the specification should be reduced in scope, it should be no narrower than “non-alcoholic beverages namely, energy drinks, sports drinks, caffeinated formulated beverages and soft drinks; but not including de-alcoholised, low alcohol or alcohol free beers and lagers.” After a careful study of all the documentation filed, I give this decision on behalf of the Registrar.

EVIDENCE

7. There have been four rounds of evidence in these proceedings. In order to mount a defence to the revocation attack, RB filed a witness statement and supporting exhibits from Stuart Nield, a trade mark attorney at Mewburn Ellis LLP, in his capacity as RB’s professional representative in this matter. SALF filed a witness statement in reply to RB’s initial evidence and also a report from an investigation SALF had commissioned into the use of BULLIT. In direct response to SALF’s evidence, and challenging the report in particular, Mr Nield filed a further witness statement of his own, together with witness statements from employees of W & S and RB, and RB’s solicitors. SALF countered with further witness statements. Since the nature of this action means that there have been, what are in effect, three sets of ‘evidence-in-reply’, I have integrated the parties’ allegations and responses in my summary of the evidence. Some of what has been filed as evidence may properly be classified as submissions, and where this is the case I have borne them in mind in reaching my decision.

8. Stuart Nield exhibits four sets of evidence of commercial transactions having taken place in the UK in the relevant goods under the mark BULLIT. I use the word ‘transactions’ to cover orders for the goods as well as sales. All four relate to the section 46(1)(b) period, whilst one set also relates to use within the section 46(1)(a) period. The transactions were made whilst W & S owned the mark.

9. Between 22 June 2001 and 21 December 2001, Meridian House, a company in Prescot, Merseyside, ordered “Bullit Energy Drink” from W & S, in the Netherlands, for a total amount of €86,160. Ten invoices are exhibited (SRN1) to show this

activity. All of the invoices fall within the section 46(1)(a) period, of which four also fall within in the section 46(1)(b) period (€34,464). SALF's Managing Director, Raminder Singh Ranger, disputes that these invoices show sales having been effected because four of them include the instruction "release goods after payment" and there is no proof that the goods were ever paid for and thus shipped to the UK. He also says the quantities involved are small – about 8-9 pallets. Mr Nield says "release goods after payment" is normal business practice and cannot be taken to mean no actual sales in the UK took place. Mr Ranger questions the solvency of Meridian House, and therefore its ability to pay the invoices, but the evidence for this is inconclusive and must be disregarded.

10. At SRN2, Mr Nield exhibits a single invoice from W & S to World Wine & Spirits, a company in Watford, dated 4 August 2003 (Section 46(1)(b) date range). This was an order for "Bullit Energy Drink Real Taste" and "Bullit Energy Drink Sugar Free", totalling €9,000. From the information on the invoice, I calculate that this order was for 31,680 25cl cans of drink. Mr Ranger says that this amount represents merely token use of the mark since the quantities are small, but Mr Nield refutes this by pointing out that the effect of each sale is cumulative (I assume he means in conjunction with the Meridian House invoices).

11. The third set of evidence of commercial transactions having taken place in the UK is shown by a combination of exhibits SRN3A and SRN3B. The former comprises seven invoices from W & S, between 16 January 2003 and 27 January 2004, to Kubizz B.V., also in the Netherlands. In conjunction, SRN3B shows seven invoices from Kubizz B.V. to a UK company called Freemans Confectionery Supplies in Bloxwich, West Midlands. These invoices are dated between 19 February 2003 and 28 January 2004, a period corresponding with the dates of the invoices from W & S to Kubizz B.V. I have discerned corresponding amounts of BULLIT energy drink appearing on both sets of invoices. Mr Ranger says this is not evidence of genuine use in the UK of BULLIT by W & S, the (then) registered proprietor. In reply, Mr Nield says that these exhibits are intended to show a chain of sales in the UK; large companies in this trade distribute to small companies and it is seldom that drinks are sold directly from the manufacturer to the final consumer. He states that all sales of BULLIT in the UK accrue to the benefit of RB. Chantál van Eijkelenborg, who is the Managing Director of W & S and has provided her witness statement dated 3 July 2007 at the request of RB, states that "the sale by Kubizz B.V. into the UK was with our consent. We were indeed very pleased with these sales and have since provided some of Kubizz' UK invoices to Red Bull GmbH."

12. The final set of evidence showing BULLIT having been sold in the UK is SRN4: three till receipts from a UK store called Farmfoods itemising "BULLIT NRG". The receipts are dated from 8 July 2004 to 16 September 2004 and are from stores located in Stratford, Walthamstow and Walsall. Mr Ranger, for SALF, attacks these exhibits as showing tiny amounts of sales. Mr Nield explains their existence as stemming from an earlier non-use attack which W & S defended against RB (W & S assigned the mark to RB and the action was withdrawn). The evidence has therefore been inherited from W & S. Ms van Eijkelenborg further adds to the picture by stating that BULLIT was also sold in "Netto" supermarkets in the UK until at least 2002, exhibiting a report from a marketing company called ACNielsen Databases. The report records sales between 2000 and 2002 (but that the exact figures are

unavailable) and “limited sales of ‘Bullit’ in London Foodservice outlets only – 699 actual litres, £3,356 value sales. No further sales have been recorded in the UK since 2004.” The report is undated.

13. Mr Nield and Ms van Eijkelenborg also say that W & S were present in March 2005 at the International Food and Drink Federation exhibition in London. Exhibit SRN5B shows an exhibition preview which states that W & S “will be exhibiting its Bullit energy drinks including the sugar-free and premium varieties”. There is evidence provided to show that the company did attend.

14. Also filed on behalf of RB are a witness statement from Esther Gunaratnam, a solicitor at Laytons Solicitors who had acted for RB, and copies of correspondence between RB and SALF relating to other actions, counter-actions and speculation as to the parties’ motivations for the actions. None of these are relevant to these proceedings. I have also disregarded SALF’s exhibit showing other ‘BULL’ marks as it has no bearing on the question of whether there has been genuine use of BULLIT for the goods for which it is registered in the UK, and at the relevant dates pleaded.

15. There is one more piece of evidence filed by SALF which initiated much of the remaining evidence in reply by RB and more evidence in reply to that by SALF. This is an investigator’s report into use of BULLIT in the UK by Farncombe International Limited, dated 17 October 2006. It is of limited probative value. For example, it places emphasis on the fact that the switchboard operator at RB’s UK office had not heard of BULLIT. The investigator contacted W & S (when W & S no longer owned the mark) and spoke to the ‘managing director’ who was reluctant to give much information, but said “Bullit is popular in the Netherlands but it is not sold in the UK”. Since this is the present tense, the managing director was not referring to a time when W & S held the mark but instead when RB owned it. He could not therefore give an account of RB’s use of the mark with any degree of authority. Chantál van Eijkelenborg says that the employee at W & S was not the managing director but the finance manager and that his name is Mr Velis, not Mr Felis as stated by Farncombe International Limited.

16. RB filed a witness statement, dated 27 June 2007 by Raluca Simiuc, Brand Manager in the International Brand Marketing department of RB, who was approached by the investigator (under pretext). Ms Simiuc says that she had only been assigned the BULLIT brand the previous day so that her answer to the investigator that BULLIT was sold in the Netherlands but not in the UK was ill-informed. To substantiate this, RB also filed a witness statement, dated 28 June 2007, by Jennifer Powers, in-house Intellectual Property Counsel in the Legal Department of RB. Ms Powers says that, having subsequently spoken with Ms Simiuc, she called the investigator to give UK sales information but none of it was included in the report. This point is answered in a witness statement filed on behalf of SALF by Graham Robinson, managing director of Farncombe International Limited. He says that SALF’s trade mark attorney did not think it was necessary to pursue the information provided by Ms Powers as he had “drawn [his] own conclusions from her follow-up”.

17. The report may be said to cast doubt upon genuine use in the UK since RB took over ownership of the trade mark, but nothing more. It does not prove what the

position was when W & S owned it, which is across the overlap between Sections 46(1)(a) & (b) of the Act, as pleaded.

DECISION

18. Section 46 of the Act reads as follows:

“(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.

19. I have to consider whether there was genuine use in the UK of BULLIT, for all or any of the goods for which it is registered, by RB or its predecessors in title between 9 August 1997 and 8 August 2002 and between 18 October 2001 and 17 October 2006.

20. The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is “genuine use” of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark.

The fact that a mark that is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38, the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark.”

In *Laboratoires Goemar S.A. v La Mer Technology Inc* [2005] ETMR 114, Neuberger LJ held that:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially

weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.”

In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-416/04 P the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

21. In the present case, SALF has attacked the use during W & S’s ownership as token use because the quantity is small in the context of the drinks trade. I agree that it may be said to be ‘exiguous’, but it does not follow that the use is token or not genuine merely because it is slender. All surrounding circumstances must be assessed. There is no use in the UK by RB, but the periods pleaded by SALF cover date ranges when W & S owned the mark. RB is at the mercy of W & S’s record-keeping of its trade in the UK. The use that has been filed seems to be in existence because W & S went through the process of proving genuine use in the UK against a previous attack by RB.

22. It has been argued on behalf of RB that it is a feature of this industry that a registered proprietor who wishes his goods to be sold in the UK will not necessarily do the exporting to the UK himself, but may use a third party. If that is the case, the provision of invoices to W & S by Kubizz B.V. of its trade in the UK (to Freemans Confectionery Supplies) helps to support it and to corroborate Ms van Eijkelenborg’s statement that the sales by Kubizz B.V. in the UK were with W & S’s consent. I have taken them into account to the extent that they may indicate the characteristics of the market and so assist in building up a picture of how the goods protected by W & S’s

BULLIT trade mark came to be on the UK market for drinks during the relevant periods.

23. In establishing whether there has been genuine use of the mark in the UK on the goods for which it is registered, it is relevant that I look at the frequency as well as the scale of any use shown. The four sets of evidence of use cannot be said to represent continuous use of the mark, but continuous use is not a requisite of genuine use. In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-234/06 P, the ECJ stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).

74 By stating, at paragraph 35 of the judgment under appeal, that the evidence is very limited with regard to 1994 and non-existent for the period from 1996 to 1999, the Court of First Instance did not in any way require the appellant to establish continuous use of the trade mark THE BRIDGE (No 642952) throughout the whole of the period in question. In accordance with the Court's case-law cited in paragraphs 72 and 73 of the present judgment, the Court of First Instance examined whether that trade mark had been put to genuine use during that period. To that end, the Court of First Instance assessed, at paragraphs 32 to 36 of the judgment under appeal, whether the scale and frequency of use of that mark were capable of demonstrating that it was present on the market in a manner that is effective, consistent over time and stable in terms of the configuration of the sign.”

The sales to Meridian House took place over a six-month period; the Kubizz invoices span a (different) twelvemonth; and the invoices to World Wines and Spirits and the Farmfoods till receipts punctuate those periods at intervals. From the first Meridian House invoice to the last Farmfoods till receipt, the dates range from 22 June 2001 to 16 September 2004. Whilst they in no way show continuous or even regular use, I think it unlikely that they were token sales merely to give the registration some immunity against an allegation of non-use. The exhibition in 2005, of course, does not constitute sales in the UK, but shows a degree of the brand's presence in the UK.

24. If not token use, was it nevertheless enough to create and preserve a market share for the goods protected by the mark? I bear in mind that a low volume of sales can sometimes be compensated for by a burst of trade over a short period or, conversely, modest levels of turnover but over a greater length of time (see the judgment of the Court of First Instance (CFI) in *Charlotte SARL c Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles)* (OHMI) Case T-169/06). I do not consider that applies here, since the levels of sales are both low and sporadic. Commercial success is also not a requisite of genuine use. In *La Mer Technology, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-418/03, the CFI said:

“53 For the interpretation of the notion of genuine use, account must be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a Community trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38).

However, the purpose of that provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (*VITAFRUIT*, cited above at paragraph 51, paragraph 38, and Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 32).”

25. RB has not shown that there has been any use in the UK on drinks since BULLIT was assigned to it on 4 July 2005. No use has been shown in the years immediately after the completion of registration when DIS B.V. owned it. W & S owned BULLIT from 30 April 2001 to 4 July 2005, which spans both the periods pleaded under Sections 46(1)(a) and (b) of the Act. The overlap between these periods of time is from 18 October 2001 to 8 August 2002; the Meridian House sales fall within the overlap, as does the ACNielsen report. The other three sets of invoices and till receipts fall outside of it, but within the 46(1)(b) range. There is therefore use, by W & S, across both the Section 46(1)(a) and (b) periods that the applicant has pleaded. I consider it to be a close call, but my decision is that RB has succeeded in showing its predecessor’s use of BULLIT to be sufficiently tolerable to resist, at least in part, the application. I must now decide upon a fair specification of goods.

26. There is established case law which sets out the ground rules for the tribunal in determining fair specifications. In particular, I refer to *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."

and to *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 pernickety 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."

27. In their written submissions, RB's attorney suggests that if I find that there has not been genuine use across the full width of the specification, that it should be cut down to read "Non-alcoholic beverages namely, energy drinks, sports drinks, caffeinated formulated beverages and soft drinks; but not including de-alcoholised,

low alcohol or alcohol free beers and lagers.” I consider the use made of the mark does not entitle it to maintain the full specification. I bear in mind the guidance provided by the CFI in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03:

“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.”

In my view, the average consumer, and also the drinks trade, would understand the term ‘energy drinks’ as a recognisable sub-category of beverages. Energy drinks are all that RB has shown use of BULLIT upon. Restricting the specification to this does not make for a pernickety description of a recognised category of drink. Framing the specification as the attorney suggests is, I think, over-egging the pudding.

Conclusion

28. The use by W & S partly saves the registration. The registration is to be revoked for all goods save for *energy drinks*. It is to be revoked in respect of all other goods with effect from 9 August 2002. The specification is, therefore, to read:

Energy drinks.

COSTS

28. Each side has achieved a measure of success and so each should bear its own costs.

Dated this 27th day of February 2008

**Judi Pike
For the Registrar
the Comptroller-General**