

O-112-05

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION  
No 81099  
BY IDEAL HOME LIMITED  
FOR REVOCATION OF TRADE MARK No. 2068888  
**IDEAL HOME AND LIFESTYLE**  
STANDING IN THE NAME OF  
IPC MEDIA LIMITED

## **BACKGROUND**

1) The following trade mark was registered as of 7 March 1997 in the name of IPC Media Limited

Mark	Number	Effective Date	Class	Specification
IDEAL HOME AND LIFESTYLE	2068888	16.04.96	16	Printed publications.

2) By an application dated 18 December 2002, Ideal Home Limited applied for the revocation of the registration under the provisions of Section 46(1)(a) & (b). The grounds stated that there has been no use of the trade mark in suit since registration was granted, or in the alternative that use may have been suspended for an uninterrupted period of five years and there are no proper reasons for non-use. Revocation from 7 March 2002 was requested. In the alternative it was requested that the trade mark registration be partially revoked in accordance with Section 46(5) in respect of those goods for which the trade mark has not been used for a continuous period of five years.

3) On 7 July 2003 the registered proprietor filed a counterstatement denying the above grounds.

4) Only the registered proprietor filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 16 February 2005 when the applicant for revocation was represented by Ms Ennison of Ideal Home Ltd, and the registered proprietor by Mr Malynicz of Counsel instructed by Messrs f J Cleveland.

## **REGISTERED PROPRIETOR'S EVIDENCE**

5) The registered proprietor filed a witness statement, dated 4 July 2003, by Yvonne Ramsden the Publishing Director of the IDEAL HOME publication owned by IPC Media Ltd, a position she has held since March 1999. She states that the mark in suit has been used in conjunction with the house mark IDEAL HOME in respect of printed publications within the relevant period. At exhibit YR1 she provides copies of pages from two magazines dated December 1997 and October 1998. They have on the front cover and the interior pages the words "Ideal home" in very large print with in manuscript underneath, in smaller typeface "& lifestyle". The index to the December 1997 magazine shows that in addition to home decoration, topics include issues such as gifts, health, fashion, entertaining, cooking and gardening. There is also a page titled "Travel shop" which covers travel and holidays.

6) Ms Ramsden states that the circulation figures for these two magazines was 225,163 and 180,683 respectively, said to represent 11.9% and 8% of the market share in the relevant sector. She claims that the substitution of the word "AND" with "&" does not alter the distinctive character of the mark. Ms Ramsden contends that the registered proprietor's use of the trade mark IDEAL HOME in respect of printed publications can support the mark in suit. This is based on the view that the distinctive character of the mark in suit lies in the element "Ideal Home" whilst the words "and Lifestyle" are non-distinctive in relation to printed publications. She states that the words "and lifestyle" refer to the specific subject matter of the publications. Thus, she

contends, use of the mark IDEAL HOME is use of the mark in suit in a different form which does not alter the distinctive character of the registered mark.

7) Ms Ramsden states that the IDEAL HOME magazine is the UK's leading "home interest" magazine. She provides figures for the period July 2001-December 2002 which shows an average circulation of 266,012 per month. Ms Ramsden provides a number of examples of use of the IDEAL HOME mark.

8) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

9) The relevant part of 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 and 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)....

(d)....

(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."

10) The applicant specifically seeks revocation from 7 March 2002 alleging that the mark has not been used in the five years since its registration. The period in question is, therefore, 7 March 1997 – 6 March 2002. It was accepted that the alternative period under 46(1)(b) which would give a period of 18 December 1997 – 17 December 2002 would not affect the outcome as the evidence provided fell within both the periods under consideration.

11) The registered proprietor sought at the hearing to have the request for revocation dismissed as, it contended, revocation was being sought from an impermissible date, namely 7 March 2002. The registered proprietor claimed that a trade mark registration only becomes vulnerable to a non-use attack after five years following the date of registration. The registered proprietor contended that as the mark was registered on 7 March 1997 then it was only vulnerable to attack as of the 8 March 2002. They referred me to the Court of Appeal's decision in *Philosophy de Alberta Ferretti Trade Mark* [2003] RPC 15.

12) I do not accept this contention. The Inland Revenue defines the normal tax year as being 1 April -31 March. Using this analogy if the trade mark is placed on the register on 7 March 1997 then the last day of the five year period is 6 March 2002. Therefore, the applicant is entitled to request that the date that be considered is five years following registration i.e. 7 March 2002.

13) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. It 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.”

14) The proprietor has admitted that it has not used the mark in the exact form registered. It is contended that the mark has been used “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”.

15) In considering the usage made I look to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] ETMR 34. This was an appeal against a decision by the Registrar. In that case the question of whether a very limited amount of use in this country can be regarded as sufficient to be “genuine” was considered. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

16) I also take into account the judgement in Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-39:

“35. Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks ‘must actually be used, or, if not used, be subject to revocation’. ‘Genuine use’ therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of origin of goods or services to the consumer or the end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations for by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular 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.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.”

17) On the question of onus of proof I note the comments from the *NODOZ* case [1962] RPC 1, in which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, .....

18) Whilst the actual use shown relates to only two magazines published in December 1997 and October 1998 there has been no suggestion that such use was not genuine.

To my mind the examples of use provided show that the mark has been genuinely used on magazines in the five years since registration and in the five years prior to the application for revocation.

19) With regard to whether the mark used differed in elements which do not alter the fundamental nature of the registered mark I look for guidance on this to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 24. In particular, reference was made to the comments of Lord Walker at paragraphs 43-45 where he stated:

“43. 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 judgement, 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 judgement 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.”

20) The mark as registered is “IDEAL HOME AND LIFESTYLE” the mark as used is “IDEAL HOME & LIFESTYLE” albeit that the font size used for “Lifestyle” is smaller than that used for the initial part of the mark. To my mind the substitution of an ampersand for the word “AND” would hardly be noticed by the average consumer. An ampersand would be recognised by consumers as having the same meaning and sound as the word “AND”. In my opinion, on a global appreciation, the mark used by the proprietor does not possess a different distinctive character from the mark registered.

21) The applicant also sought to reduce the specification down to “magazines relating to interior decorating for the home”. In determining this issue I look to the comments of Jacob J in the case of *Pomaco Ltd v Reed Consumer Books Ltd* [2000] FSR 734 where he said:

“Neuberger J’s attention was not drawn to the decision of Laddie J in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J was concerned with a very wide specification of goods: “computer programs”. In rejecting an application for summary judgement, he took the view that the wide specification could be cut down by a non use attack. In other words, that “computer programs” could be limited to computer programs of a particular part.

I have no doubt that what Laddie J assumed was right and in this respect I differ from Neuberger J. The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, “printed matter” in this case is extremely wide. I think it is inevitable that at times one would have to “dig deeper”. Even taking the specification considered by Neuberger J for a “domestic container”, one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put in the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercially nonsense to maintain the registration for all goods caused by the wide words.

That is not to say the court will cut the registration right down to things like red tea caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the specification.”

22) In a more recent case, Aldous LJ in *Thompson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 stated:

“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 section 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.”

23) It is clear from these cases that there is no need for excessive detail in the description of goods/services and that a reasonable degree of generality can be tolerated. I have to consider how the reasonably well-informed and reasonably observant and circumspect consumer would describe the use that the registered proprietor has shown in its evidence. I must also bear in mind that the European Court of Justice (ECJ) has stressed the need for legal certainty and sound administration on

several occasions , for example in Case C-273/00, *Sieckmann* [2002] ECR I-11737, paragraphs 37 and 46-55 in relation to representations, Case C-363/99, *Koninklijke KPN Nederland NV*, 12 February 2004, paragraphs 114-115, regarding limitations and most recently in the Opinion of A.G. Leger in Case C4-418/02, *Praktiker Bau-und Heimwerkermarkte AG*, 13 January 2005, paragraphs 62-67, concerning specifications of goods and services.

24) Undoubtedly the magazine produced by the registered proprietor is fundamentally concerned with the home. However, from the evidence filed it is clear that the magazine covers a range of topics such as gardening, travel, cookery, fashion and health. In my view restricting the specification to “magazines relating to interior decorating for the home” would not meet the dual requirements of legal certainty and sound administration. The request to limit the specification fails.

25) The application for revocation fails. I have taken into account the fact that this case was one of three where the evidence was very similar and a single hearing took place. I order the applicant to pay the registered proprietor the sum of £1000. 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 25<sup>th</sup> day of April 2005

George W Salthouse  
For the Registrar  
The Comptroller-General