

O-114-05

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION
No 81101
BY IDEAL HOME LIMITED
FOR REVOCATION OF TRADE MARK No. 2121954
IDEAL HOME
STANDING IN THE NAME OF
IPC MEDIA LIMITED

BACKGROUND

1) The following trade mark was registered as of 19 September 1997 in the name of IPC Media Limited.

Mark	Number	Effective Date	Class	Specification
IDEAL HOME	2121954	28.01.97	9	Sound, video and data recordings, cinematographic films prepared for exhibition, CD-Roms.
			41	Entertainment, education and instruction by or relating to television, radio or films; production, presentation and rental of television and radio programmes, of films and of sound and video recordings.

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 had been no use of the trade mark in suit in the five years following registration, 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. In particular revocation was sought from 19 September 2002. Alternatively, 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.

6) At exhibit YR1 Ms Ramsden provides a copy of a cassette tape which was attached to the December 1997 edition of the IDEAL HOME magazine which contained a "Christmas Trivia Quiz". The cassette is marked "Not for resale". It is stated that the magazine for December had a circulation figure of 225,163.

7) At exhibit YR2 she provides a video recording of a television programme produced in association with IDEAL HOME magazine entitled IDEAL HOME COOK. Ms Ramsden states that the programme was made for cable TV and was first shown on the Carlton Food Network Channel in 1997. The programme, lasting twenty-five

minutes, was titled IDEAL HOME COOKS and featured a woman being interviewed by Nanette Newman in the woman's home. In addition there was a feature on kitchen appliances. Apart from the programme title which appeared at the start and either side of the advertisement break there was a credit at the end which stated that the programme was made "In association with Ideal Home Magazine". There was also a tedious feature on kitchen scales featuring a consultant identified as being from Ideal Home Magazine.

8) At exhibit YR3 she provides a copy of a video featuring a promotional film entitled "A Guide to Decorative Effects" this had in its title a page which read "Do It All with Maggie Colvin and Ideal Home Magazine". This video was produced in conjunction with the DIY retail chain Do It All which Ms Ramsden describes as being the UK's fourth largest DIY chain in 1998. This video lasted twenty-four minutes and showed Maggie Colvin explaining how to achieve various decorating effects. Twice during the programme it mentioned that ideas for effects could be obtained from Ideal Home Magazine.

9) At exhibit YR4 Ms Ramsden provides what she describes as:

"(a) Details of a proposal for a joint venture dated 2 November 1990, which was made by the Registered Proprietors to Flextech, the media company who provide entertainment, information and interactive content and services to the multi-channel television and on-line markets. Market research was undertaken with a view to developing branded programmes in conjunction with Flextech.

(b) Proposals for an IDEAL HOME media-neutral community dated 7 December 2000."

10) In fact the document relating to Flextech has a date of November 2000. The Flextech name has been hand written on the top of the initial page, but the main heading simply states "A potential venture between IPC Media and select Media Partners". Later, in the pack there is a page which states "What Flextech brings" there are six bullet points such as "cash", "marketing resource" and "iDTV expertise". Both sets of documents appear to state the position of the registered proprietor at the date of the document and go on to consider the possibility of opening up a web-site with the potential to sell, online, goods featured on the web-site in conjunction with retail stores and web-site distributors. Both sets of documents appear to be print-outs of power point/slide presentations. Both sets of papers are extremely broad and do not contain any detailed proposals although there is a single page relating to project costs and revenues.

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

DECISION

12) 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 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)....

(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.”

13) The applicant alleges that the mark has not been used in the five years following registration of the mark. The period in question is, therefore, 19 September 1997 – 18 September 2002.

14) 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 19 September 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 the 19 September 1997 then it was only vulnerable to attack as of 20 September 2002. They referred me to the Court of Appeal’s decision in *Philosophy de Alberta Ferretti Trade Mark* [2003] RPC 15.

15) 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 19 September 1997 then the last day of the five year period is 18 September 2002. Therefore, the applicant is entitled to request that the date that be considered is five years following registration i.e. 19 September 2002.

16) 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.”

17) 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*.”

18) 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’être*, 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.”

19) 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,

20) The evidence filed shows the following:

- The mark was used on a trivia quiz cassette tape given away free with the magazine on one occasion in December 1997. The magazine is said to have had a circulation of 225,163.
- A television programme was made in 1997 called *Ideal Home Cooks*. The mark *IDEAL HOME* featured in the titles at the start, either side of an advertising break and at the end. A staff member from the magazine also appeared and the magazine name was shown in the subtitle when the person first appeared. No viewing figures are provided nor is it stated whether the programme was ever repeated.
- A video of decorative effects was made in conjunction with the *Do It All DIY* chain. It is inferred but not clearly stated that this was made in 1998. No details of whether it was actually issued, how it was issued and how many copies were given away are provided.
- Two sets of documents which provide an analysis of the registered proprietor’s position in 2000 and the possible expansion into selling by setting up a web-site with the potential to sell, online, goods featured on the web-site in conjunction with retail stores and web-site distributors. These documents are more of a “presentation pitch”. It is not clear if the joint venture that was referred to was ever discussed either internally or with the possible partner. The papers deal with the issues in the broadest sense.

21) The registered proprietor contended that the evidence shows use across the whole of the specification with the exception of CD-roms. But it was argued that tape

cassettes are now a redundant technology which has been replaced by CD-ROMs and so the use on tape cassettes should be regarded as covering CD-ROMs.

22) I do not accept the contention that use on an item can be taken as use on an entirely different type of product simply because technology has moved on.

23) For ease of reference I reproduce the registered proprietor's specification below:

In Class 9: Sound, video and data recordings, cinematographic films prepared for exhibition, CD-ROMs.

In Class 41: Entertainment, education and instruction by or relating to television, radio or films; production, presentation and rental of television and radio programmes, of films and of sound and video recordings.

24) In the instant case, I do not accept that the mark has been used on a cassette tape. The tape was attached to the magazine and given away as a free gift on a single occasion. This is a common marketing tool of magazines as one frequently sees items glued to the front of magazines or included within the overall packaging. The average consumer does not regard the use of a mark on such an item as an indication of origin no more than the use of trade marks on pens pencils and other ephemera handed out with increasing frequency as a method of promoting one's core business.

25) Similarly, I view the sponsoring of the television programme and the home decorating video as falling outside what can be described as genuine use. To regard it otherwise would mean that advertising on television would create rights for the advertiser's mark in broadcasting. In addition the details of the extent of use of both the television programme and video are at best described as sketchy. It is clear from the authorities referred to that the onus is on the registered proprietor to show clearly the use made.

26) Lastly, I consider the documents which were provided at exhibit YR4. These appear to be printouts of a power point presentation. It is claimed that a joint venture was proposed with a company called Flextech. This name has been hand written on the top of the initial page, but the main heading simply states "A potential venture between IPC Media and select Media Partners". Within the body of the document is a single page which lists six simple items that Flextech can bring to the partnership. However, it is not clear if any discussions were ever entered into or whether this was simply an internal idea which was subsequently shelved. If the registered proprietor wished to rely upon such evidence then it should have provided considerably more detail as to what use was made of such material when and with whom.

27) To my mind the registered proprietor has not shown any use of the registered mark on any of the goods or services within the specifications. The trade mark is revoked in regard to the whole of the registration as of 19 September 2002.

28) The application for revocation succeeds. 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 registered proprietor to pay the applicant 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 25th day of April 2005

George W Salthouse
For the Registrar
The Comptroller-General