

O-119-05

TRADE MARKS ACT 1994
IN THE MATTER OF CONSOLIDATED APPLICATIONS
Nos 80888, 80887 & 80889
BY FRATELLI MARTINI SECONDO LUIGI S.P.A.
FOR REVOCATION OF TRADE MARKS Nos
1114411 **CANEI**,
1336613 **PEACHCANEI**
& 1493906



STANDING IN THE NAME OF
DISTILLERIE FRATELLI RAMAZZOTTI S.P.A.

BACKGROUND

1) The following trade marks are registered in the name of Distillerie Fratelli Ramazzotti S.p.A.:

Mark	Number	Effective Date	Class	Specification
CANEI	1114411	16.05.79	33	Wines.
PEACHCANEI	1336613	25.09.87	33	Wine, being peach flavoured or made from peaches; all included in Class 33.
 <p>In use in relation to goods covered by the specification other than sweet sparkling wine the mark will be varied by the substitution of the name and description of such goods for the words "Vino Frizzante Dolce". The Italian words "Vino Frizzante Dolce" appearing in the mark mean "Sweet Sparkling Wine".</p>	1493906	11.03.92	33	Wines, spirits and liqueurs; all included in Class 33.

2) By applications dated 2 July 2002, Fratelli Martini Secondo Luigi S.p.A of Via Statale 6, 12054 Cossano Belbo CN, Italy applied for the revocation of the registrations under the provisions of Section 46(1)(a) & (b). The grounds stated that there has been no use of the trade marks 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. They also request that the trade mark registrations be partially revoked in accordance with Section 46(5) in respect of those goods for which the trade marks have not been used for a continuous period of five years, or in the alternative be revoked from 20 September 2001 or an earlier date on the basis that they were not used in respect of the goods for which they are registered for a period of five years leading up to that date and have not been put to genuine use since that date.

3) On 29 October 2002 the registered proprietor filed a counterstatement denying the above grounds.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 26 January 2005 when the applicant for revocation was represented by Mr Buehrlen of Messrs Beck Greener, and the registered proprietor by Ms Cole of Messrs Urquhart-Dykes & Lord.

REGISTERED PROPRIETOR'S EVIDENCE

5) The registered proprietor filed three witness statements. The first, dated 27 July 2003, is by Ludwig Paillier the Brand Manager for Canei products at Pernod Ricard UK Limited. He states that he has been in the marketing profession for four and a half years and is conversant with the English language.

6) At exhibit LP1 he provides a print out from his company's website dated October 2002 which shows a group of sparkling wines, one of which appears to have a trade mark similar to 1493906 on it. It is not possible to be sure if it is the mark or a similar version.

7) At exhibit LP2 he provides various material relating to the promotion of the brand. Much of this relates to plans for promotions in various years, although it is not clear if these activities were carried out. The only evidence of use appears to be the sponsoring of an "Up for it" night at a London night club. This shows that CANEI (shown in capital letters in a plain font) is one of the sponsors. The year is not shown on the copy of the poster but it does have a date of 2000 added in pen on the top of the photocopied page. There is a copy of a page from a magazine called "Pride" from 1999 which has a competition to win a bottle of Canei and it shows a picture of a bottle with the word CANEI in script. It is similar to trade mark 1493906 but the wording under this name appears to be different, although it is impossible to read precisely what is written due to the poor nature of the photocopy. There is also an undated flyer showing various drinks and their prices, this includes two bottles of Canei neither of which carries any of the trade marks in the exact form that they are registered upon them. The word "Canei" is produced in exactly the script form used in 1493906.

8) At LP3 he provides the results of research carried out by The Redbox Agency into "Canei: Qualitative Research Study Social & Drinking Trends." This offers overviews which state, inter alia, "Canei enjoys strong brand recognition as an established and long standing family name". However, it does not state when or where the research took place, how many people were interviewed, what questions they were asked although it would appear from comments such as "Most of the sample were surprised to learn that they had tested, and highly rated, Canei samples, especially the two popular flavours, during the taste test", that the product was on view.

9) The second statement, dated 17 June 2003, is by Antonio Ghilardi the President and General Manager of the registered proprietor company. He states that wines bearing the three trade marks 1114411, 1336613 & 1493906 have been sold in the UK since 1979, 1988 and 1992 respectively. At exhibit AG1 he provides examples of how the marks are used in the UK. These examples are not dated and whilst they have the name CANEI in script none are identical to the marks registered. It is very similar to the label in mark 1493906 in that the name CANEI is in the same script set against a black label but it does not have the additional words underneath as shown in the mark 1493906. The labels feature an heraldic shield device and also descriptors such as "Vino Rose", "Vino Rosso", "Mellow Wine" and "Vino Blanco". The word CANEI is also underlined in a number of the illustrations of bottles. He also provides the following turnover figures for the UK for the three trade marks:

Year	Cases	Litres	Turnover
1995	32,638	293,000	965 Million Lira
1996	36,389	327,500	1,066 Million Lira
1997	31,844	286,588	1,991 Million Lira
1998	32,589	293,274	1,024 Million Lira
1999	33,623	302,553	1,150 Million Lira
2000	29,814	268,323	572,000 Euros
2001	25,060	225,542	491,000 Euros

10) At exhibit AG2 Mr Ghilardi provides invoices for the period June 96-January 2002 which show sales of goods under the following descriptions: “PEACHCANEI”, “CANEI BIANCO”, “CANEI ROSSO”, “CANEI LAMBRUSCO”, “CANEI ROSE”, and “CANEI PEACH”. The only ones showing “PEACHCANEI” were dated June 1996, October 1996 and July 1997. Although the invoices are in Italian and the printing is not entirely clear it would appear that each invoice relates to 2,860 x 75cl bottles of what is described as “COCKTAIL AROM. BASE PROD. VITIVIN”. I note that the two invoices for “CANEI PEACH, dated September 2000 and February 2001 also carried the same descriptive line “COCKTAIL AROM. BASE PROD. VITIVIN”. Similarly, an earlier invoice, dated March 1998 has an entry for SANGRIA with the line “BEVANDA AROMATIZZATA A BASE VINO” beneath it.

11) Mr Ghilardi states that the products are sold throughout the UK via cash and carry outlets, retail stores, bars and nightclubs. At exhibit AG3 he provides a copy of the statement of Mr Paillier detailed in paragraphs 5-8 above. Mr Ghilardi also provides figures for the advertising and promotion of the three marks in the UK as follows:

Year	Amount
1995	109 Million Lira
1996	99 Million Lira
1997	146 Million Lira
1998	141 Million Lira
1999	200 Million Lira
2000	119,000 Euros
2001	62,000 Euros

12) Mr Ghilardi states his view that his company has a reputation under its trade marks.

13) The third witness statement, dated 29 September 2003, is by Stephen Richard Maly a Director of The Redbox Agency. He describes his company as a marketing and advertising agency and states that they also carry out research as part of the marketing process. He states that his company has been responsible for market research for goods bearing the trade mark CANEI since the 1990s. He states that the first project that his company was involved in was the re-launch of the brand in 1998.

14) Mr Maly states that goods in the alcoholic drinks sector are traditionally split between beer, spirits, wine and, more recently, alcopops. He states that goods bearing the CANEI mark would be “classified as wines and on a par with alcopops”.

15) He states that his company carried out research for the registered proprietor at the beginning of 2001. The research was designed to provide background information about the target market, their drinking patterns and opinions and the different flavours of the brand. The research was also designed to provide information on previous campaigns and the drink itself. From previous work carried out for the registered proprietor Mr Maly states that his company had a good idea of the target audience which in this case is described as being “largely Afro-Caribbean”. Mr Maly states that: “A vast majority of the Afro-Caribbean population of the UK lives in London and as a result, much of the company’s research has been focussed here.”

16) As well as providing a copy of the research at exhibit SRM1 Mr Maly states that the research “established that CANEI is a leading brand in its target market and that the introduction of new flavours would be popular. He states that as a result of the research, posters were devised which were then used in a marketing campaign.

17) Mr Maly also states that “Market research companies hold databases of different types of people, for example according to age, sex, race and earnings. Once the target audience for a specific product has been identified, then a focus group of people belonging to that audience is assembled. Focus groups are made up from people on the street, existing contacts etc.”

18) Exhibit SRM1 is not dated. It states that there were three discussion groups each comprising 7-8 people. The three groups were categorised as follows:

- a) Male and female participants aged 18-24
- b) Female participants aged 25-34
- c) Male participants aged 25-34

19) The questions evoked various responses but the overwhelming attitude from the 20 or so people questioned seemed to suggest that CANEI was seen as a teenagers drink or a drink for girls.

APPLICANT’S EVIDENCE

20) The applicant filed a witness statement, dated 3 March 2004, by Giannienrico Martini the President of the applicant company. Most of his evidence relates to the opposition case between the two parties which is not relevant to these proceedings. Mr Martini states that the products of the two companies are very different with his company selling wine as opposed to the registered proprietor’s alco-pop.

21) At exhibit GM5 he provides a copy of an article said to have been published by the previous proprietor of the registered proprietor’s mark which describes how the registered proprietor’s product was conceived and marketed. According to the article it was once described as “Coca-Cola, Italian-style” and reference is made to the bottle as follows: “In fact, the Canei bottle could not fit in normal wine shelving in stores, and as a result Canei was displayed in supermarkets in different areas than most wines.”

REGISTERED PROPRIETOR'S ADDITIONAL EVIDENCE

22) The registered proprietor filed a witness statement, dated 24 September 2004, by Alison Elizabeth Fraser Simpson the registered proprietor's Trade Mark Attorney. She refutes the allegation made by the applicant that the products of the two parties are displayed in different areas. At exhibit AS1 she provides copies of photographs taken at a cash and carry these show that both parties products are stored with other wines. At exhibit AS2 a receipt is provided showing that both products are available from the same cash and carry outlet.

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

DECISION

24) At the hearing Ms Cole, for the registered proprietor, accepted that use had not been shown of Trade Mark 1493906 with regard to "liqueurs or spirits". Also at the hearing Mr Buehrlen clarified the periods being considered when he stated;

"It requests revocation on grounds of non-use from a date such that the revocation is effective before the date of application or in the alternative from the date when the revocation action itself is being pleaded."

25) The revocation action is intrinsically linked to the filing of an application for registration of a trade mark by the applicant for revocation in the instant case. The application for the trade mark was filed on 21 September 2001, hence the allegation in the pleadings that the registered proprietor had not used the three marks identified in paragraph 1 above in the five years prior to 20 September 2001 or in the alternative the five years preceding the date of the application for revocation. The registered proprietor's representative did not object to this clarification and consequent reduction of the periods being considered.

26) The relevant part of Section 46 of the Trade marks Act 1994 reads as follows:

"46.(1) The registration of a trade mark may be revoked on any of the following grounds-

(a)....

(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."

27) Under Section 46(1)(b) the periods in question are, therefore, 21 September 1996-20 September 2001 and 2 July 1997-1 July 2002.

28) 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.”

29) In considering this matter 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*.”

30) 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.”

31) 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,

32) The relevant facts before me are as follows:

- In 2000 a London nightclub event was sponsored under the CANEI name with the mark appearing in capital letters with a plain font.
- A bottle of CANEI was offered as a prize by a magazine in 1999. The label on the illustration of the bottle shows the name CANEI in the same script as trade mark 1493906, and on a black background label.

- The research carried out by Redbox Agency cannot be taken into account due to the lack of detail surrounding the research such as when it took place, where, how many people were interviewed, how they were chosen, what questions they were asked, what their precise responses were etc. Later evidence from Mr Maly indicates that some research took place in 2001, although he does state that his company had carried out previous research, but he does not provide details of when or link his comments to the earlier evidence.
- The turnover figures provided were said to relate to all three of the marks. A number of invoices were provided for the period June 1996-January 2002 which showed sales of a number of Canei varieties. These included “Canei rosso”, “Canei bianco”, “Canei rose” and “Canei peach”. Amongst these invoices were three dated June 1996, October 1996 and July 1997 relating to sales of “peachcanei”. Although the description provided under this heading was not entirely clear referring to “COCKTAIL AROM. BASE PROD. VITIVIN”. I note that the bottle size was given as 75cl which corresponds with the bottles shown throughout the exhibits.
- At exhibit AG1 the registered proprietor has shown how the script form of the mark CANEI on a black background label appears on the actual product. It is clear that the product is sold in a variety of flavours and the wording under the name CANEI changes to reflect the flavour. These exhibits show an heraldic device also being used on the label and the word CANEI is underlined. None of the exhibits are dated although they do correspond to the descriptions provided on the invoices.

33) The applicant contends that the evidence shows no use of the marks CANEI VINO FRIZZANTE DOLCE (label) or PEACHCANEI. They claim that the label shown in the exhibits is a different shape, features an heraldic device and also has a different descriptor such as sangria, raspberry, peach. The applicant states that “It is submitted that at best the label evidence featured in exhibit AG.1 shows use of the word mark CANEI but not PEACHCANEI or CANEI VINO FRIZZANTE DOLCE (Label).”

34) Regarding the other evidence the applicant contends that there are only three invoices which show sales of PEACHCANEI and these all refer to a cocktail aroma and also are de minimis.

35) Regarding trade mark 1114411 CANEI I note that the applicant for revocation accepts that the mark has been used. Even if this concession had not been given the evidence contained in the invoices at exhibit AG2 would have sufficed to show use of the mark in the two periods in question. The revocation action with regard to this mark therefore fails.

36) Moving onto mark 1336613 PEACHCANEI. The only evidence of use is that provided by the invoices at exhibit AG2. The applicant for revocation has described these as being de minimis. I accept that the evidence of use is scant and it would appear that the registered proprietor has ceased to use the mark. However, in my opinion the invoices must be regarded as genuine use of the mark in suit. Therefore,

even though there are two invoices for the earlier period under consideration and only a single invoice for the later period I take the view that the evidence filed, just, meets the obligation placed upon the registered proprietor to show use of the mark. The use relates to 75cl bottles of what is described as “COCKTAIL AROM. BASE PROD. VITIVIN”. I must now consider what goods the mark has been shown to have been used on. The applicant for revocation contends that the wording on the invoices should be seen as referring to a “cocktail aroma base”. No explanation of this phrase was offered by either side although I note the similarity of wording used on the “Sangria” version of the product. Taking all the circumstances into account I am willing to accept that on the balance of probabilities the mark has been used on peach flavoured wine or wine made from peaches. The revocation action against trade mark 1336613 therefore fails.

37) Lastly, I consider mark 1493906 for the label mark CANEI VINO FRIZZANTE DOLCE. The registered proprietor accepted that no use had been shown of this mark with regard to “spirits” or “liqueurs”. In considering the use shown I must also bear in mind the limit of the mark’s claim which states: “In use in relation to goods covered by the specification other than sweet sparkling wine the mark will be varied by the substitution of the name and description of such goods for the words “Vino Frizzante Dolce”. The Italian words “Vino Frizzante Dolce” appearing in the mark mean “Sweet Sparkling Wine.”

38) The registered proprietor has not shown use of the mark as registered. What it has shown is use of the word CANEI in the exact same script form on a black background or label. The sides of the labels shown are elongated compared to the mark registered. Also on the labels exhibited the word CANEI was underlined and there was also an heraldic device. The registered proprietor 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.

39) In considering this issue I look to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 24. In particular, I refer 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.”

40) I also refer to the comments of Sir Martin Nourse, in the same *Bud* case where, at paragraph 12, he said:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements.”

41) Considering the registered mark I believe that the dominant feature that the average consumer will recall is the name CANEI, that it is written in a script form and that it is on a black background or label. I do not believe that the actual shape of the label will register strongly with most consumers as it is relatively non-descript.

42) The applicant contends that the labels shown in the various exhibits differ to that in the registered trade mark. I accept that the mark as registered has a background which extends beyond the word CANEI but more than half of the label is within the boundaries of the word. The labels shown in the exhibits extend far beyond the word, and whilst the black background is retained immediately surrounding the word CANEI outside this area the label is a different colour, presumably white. The black part of the label in the mark registered is an oblong with rounded corners. In the exhibits the bottom and the two sides of the label are flat whilst the top has a large bulge in which sits the heraldic device.

43) The fact that the black background used on the bottle has three sharp edges instead of rounded ones as in the mark as registered will not, in my opinion, immediately strike the average consumer who will not have both alongside each other to compare. What the average consumer will have is an image of the mark in suit which is subject to the concept of imperfect recollection. If the background had been a particularly striking one such as a starburst then the issue would be different. As it is I do not believe that the difference to the background, including the addition of an extended white area will register in the mind of the average consumer.

44) The applicant also states that the heraldic device is a significant change to the mark as registered. I do not accept this contention. Heraldic devices are common on this type of product and the average consumer would not pay particular attention to this element. In the instant case this is emphatically the case as the device is very obscure. It needs very close scrutiny to pick out any detail at all. The casual observer might discern that there was a device of sorts but would be unable to state what was within the shield outline. After very careful consideration it would appear to consist of an urn in front of a plaque with the head and rear of a lion protruding on either side of the plaque. It also has the name CANEI in plain font underneath. The device offers no clear conceptual image that the average consumer would take away and which could affect their recollection of the overall mark.

45) The only other element which appears on the label as used but not in the mark registered is a line under the main element of the mark, the word CANEI. The fact that the word is underlined would, if it adds anything at all, serve to emphasise the dominant element of the mark, the name CANEI.

46) In my view the additional elements used on the actual product whilst being recognisable elements are not significant enough to be part of its distinctive character, particularly when used on bottles of wine. The main element is the name which has dominance which reduces to insignificance the other recognisable elements.

47) Consequently, my decision is that the mark shown to be used is not in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered. The application for revocation under Section 46(1) of the Act must fail.

48) The applicant also sought, if I found in the registered proprietor's favour regarding actual use of the marks in suit, to have the specifications of all three marks restricted to "sparkling wine" or "fruit flavoured sparkling wine" as it was contended that this more accurately reflected the product produced and sold by the registered proprietor. It was stated that the product was an alco-pop and reference was made to the exhibit which described the product as "Coca-Cola Italian style".

49) In *Premier Brands UK Limited v Typhoon Europe Limited* (Typhoon) [2000] FSR 767 Mr Justice Neuberger stated:

"Mr Arnold raised the question as to how Section 46(5) is to be applied once one concludes, as I have done in relation to the '276 Mark, that it has been used in respect of some of the items for which it is registered, but not in respect of others. It appears to me that one simply looks at the list of items on the register and asks oneself, in relation to each item, whether or not the mark has been used "in relation to" or "in connection with" that item during the past five years. If the answer is in the affirmative, then the mark can remain registered in respect of that item; if the answer is in the negative then, subject to any question of discretion, the registration is revoked in respect of that item. One does not dig deeper and, as it were, narrow a particular category of item to reflect the extent of the goods to which the mark has been used. Thus if the only "domestic ... container" in connection with which the mark had been used

was a red tea caddy, it seems to me that the registration should remain in respect of domestic containers: it should not be cut down to, for instance containers for food, containers for tea, tea caddies or red tea caddies.”

50) I also 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.”

51) 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.”

52) 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. In the instant case the proprietor has shown use of the three marks in suit on forms of wine. The marks 1114411 and 1493906 have been used by the registered

proprietor on versions where the fruit taste has been enhanced, but also on simple red or white versions of the drink. All wine, inevitably, has some form of fruit taste. Therefore, I do not believe that the specification can be restricted to fruit flavoured sparkling wine. 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.

53) The registered proprietor's representative at the hearing pointed out that it was usual for wine producers to offer sparkling and still wines, and that in the combination of both sides evidence it had been shown that the well known brand, "Jacobs Creek", offered both types of wine. The applicant for revocation did not contest this point. Even if it had been contested I would probably have taken judicial note that this is a commonplace occurrence. In my view restricting the specification to "Sparkling Wine" would not meet the dual requirements of legal certainty and sound administration. The request to limit the specification of all three marks fails.

54) At paragraph 24 of this decision I noted that the registered proprietor accepted that it had not shown use of its trade mark 1493906 with regard to "liqueurs or spirits". I therefore order that this part of its specification is revoked with effect from 20 September 2001.

55) The revocation has only been marginally successful with regard to one of the marks and failed totally with regard to the other two marks. The registered proprietor is therefore entitled to a contribution towards costs. I have taken into account the fact that this case was one of three where the evidence was effectively identical and a single hearing took place. I therefore order the applicant for revocation 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 27th day of April 2005

George W Salthouse
For the Registrar
The Comptroller-General