

O-142-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS 2279047A AND 2279047B
FOR THE TRADE MARKS:**

THE LIGHT

AND



**IN THE NAME OF AEGON UK PROPERTY FUND LIMITED
AND THE CONSOLIDATED APPLICATIONS FOR REVOCATION THERETO
UNDER NOS 83599 AND 83600
BY THE LIGHT APARTHOTEL LLP**

TRADE MARKS ACT 1994

**IN THE MATTER OF registration nos. 2279047A and 2279047B
for the trade marks THE LIGHT and a series of two marks THE LIGHT and
device in the name of Aegon UK Property Fund Limited**

and

**the consolidated applications for revocation thereto under no. 83599 and
83600 by The Light Aparthotel LLP**

BACKGROUND

1) On 12 October 2009, The Light Aparthotel LLP (“TLA”) of 3rd Floor, 23 Tavistock Street, London, WC2E 7NX filed applications for the revocation of registration numbers 2279047A and 2279047B. The registrations are in respect of the following marks:

2279047A:

THE LIGHT

2279047B:



2) The registrations both cover the following identical list of services in Classes 19, 35, 36, 37, 39, 41 and 42. However, the applications for revocation are directed only at the following Class 42 services:

*Provision of food and drink; restaurant, cafeteria and bar services;
provision of hotel and other temporary accommodation*

3) Completion of the registration procedures for both registrations took place on 21 March 2003.

4) TLA seeks revocation of the registrations, in respect of the above identified services, 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 22 March 2003 and 21 March 2008 and 10 October 2004 and 9 October 2009. Success for TLA would mean revocation taking effect on 22 March 2008 or 10 October 2009.

5) The proprietor, Aegon UK Property Fund Limited (“Aegon”), of 4th Floor, 77 Gracechurch Street, London, EC3V ODL, filed counterstatements, claiming that it has maintained a commercial interest in the marks and that they have been in continuous use. It therefore denies that there has been no use of the marks in respect of the relevant services during the first possible five year period or during the period between 10 October 2004 and 9 October 2009.

6) Only Aegon filed evidence and both parties seek an award of costs. Both parties requested a hearing and the matter came to be heard on 5 April 2011 when Aegon was represented by Michael Edenborough QC of Counsel instructed by Trowers & Hamlins LLP. TLA was represented by Linda Harland for Reddie & Grose.

Aegon’s Evidence

7) This consists of four witness statements, the first three all dated 14 April 2010 and the fourth dated 16 April 2010. The first of these is by Brian Oakley, General Manager employed by NB Real Estate Limited, a real estate consultant retained by Aegon. He is employed specifically for, and he is located at, The Light Centre being a shopping centre in Leeds. His role is to manage the centre and deliver Aegon’s services and strategy in respect of the centre. He has worked there since February 2002 and has filled his current role since January 2006.

8) He states that, up until March 2008, the name THE LIGHT was used alone in some contexts and THE LIGHT and “starlight” device mark in other contexts. In March 2008, the use of THE LIGHT and “starlight” device mark was put on hold and use of it ceased.

9) Aegon’s mark is displayed throughout the exterior and interior of the centre premises, together with the respective marks of a hotel operator and individual retailers. Aegon’s mark is displayed above the entrance of the hotel and above the hotel operator’s own mark. A photograph of this hotel entrance is provided at Exhibit BO1. The words THE LIGHT can be seen above the entrance arch that incorporates the front door. The word *Radisson* is also visible directly above the door.

10) Mr Oakley also states that the mark appears elsewhere on the exterior of the premises of the centre, appearing in conjunction with the marks of the various

retailers based within the centre. A photograph provided at Exhibit BO2 shows “light boxes” (that appear to be banner-like displays that incorporate back lighting) on the exterior of the centre. One has the words THE LIGHT conjoined, but with the word “light” in a heavier font whilst the second “light box” contains, what appears to be, three marks of business occupiers of the centre within circles above the words THE LIGHT, once again, in the same form as on the first “light box”. These “light boxes” have been in place since March 2008. A second copy of a photograph in the same exhibit illustrates banner advertising on the exterior of the centre featuring THE LIGHT and “starlight” device mark. Mr Oakley states this was how the exterior of the centre looked prior to March 2008.

11) Further copies of photographs are provided illustrating the name THE LIGHT appearing on both the interior and exterior of the centre. The two photographs at Exhibit BO3 illustrate very similar versions of the mark THE LIGHT, the first as it appeared up to “late 2005”, the other showing the mark as displayed from late 2005 to the present. Exhibit BO4 is a series of photographs showing the mark THE LIGHT displayed above the entrances to the centre both on the interior of the entrances and on the exterior. Exhibit BO5 consists of further photographs. These are of the interior of the centre and show THE LIGHT mark being displayed on banners. Six of these photographs illustrate the position since March 2008, and one additional photograph as it appeared directly prior to this time. It shows the mark THE LIGHT and “starlight” device appearing on banners alongside a banner bearing a mark *Maxi’s* that Mr Oakley explains is a restaurant.

12) Mr Oakley provides figures to illustrate the number of visitors to the centre each year. This has been in excess of five million each year between 2003 and 2008.

13) Mr Oakley explains that promotional events “relating to the Centre” are organised and paid for as a combined effort by both the centre itself and individual tenants. Since 2007, the centre has a marketing spend in the region of £260,000 to £310,000 per year. This spend encompasses organisation and promotion of events, operation of THE LIGHT website, all public relations and advertising materials. This spend also covers the operation of a free loyalty scheme called *Elite Club* that has been in operation since November 2001. It entitles members to discounts from retailers.

14) Mr Oakley explains that 45% of the marketing budget is spent on specific events. Examples of these events include:

- “Fun with Sushi at the Light” on 25 June 2009. This consisted of a sushi outlet called *Sesame* visiting the centre and giving demonstrations in sushi making.

- *Taste of Leeds Festival*, 5 – 8 June 2008. The centre ran a series of food and drink events within the centre. In addition, the centre paid for and hosted the VIP hospitality tent at a location elsewhere in Leeds. The launch day of the festival was hosted by the centre. A number of restaurants and the hotel located within the centre co-hosted subsequent days with the centre. The centre also hosted some events in the previous year's festival.
- *A Night of Indulgence* was a pre-Christmas promotional event for Christmas shopping and food and drink. Photographs of this event taken in 2007 or 2008 are provided at Exhibit BO7. THE LIGHT mark is not visible in any of these photographs, but the background suggests that the photographs were taken inside the centre.
- A Christmas Hamper Competition was run in November and December 2008 with prizes provided by occupying businesses of the centre.

15) These events were advertised on the centre's website.

16) At Exhibit BO8, Mr Oakley provides a copy of pages from the current (April 2010) *Lightstyle* magazine (provided to members of the *Elite Club*). This includes advertisements and a number of promotional offers relating to restaurants located within the centre.

17) Since November 2001, the centre has offered conference and exhibition space as well as meeting room accommodation. Hot and cold lunches can be provided for delegates, booked through the centre's event coordinator. The turnover in respect of these services was in the region of £17k in 2007, £25k in 2008 and £11k between January and July 2009.

18) The second witness statement is by Paula Louise Toole, PR Manager with Ledgard Jepson, a company retained by Aegon to promote and manage the publications of THE LIGHT centre. She was formerly employed by HMA, Ledgard Jepson's predecessor in the role (up to October 2005). Ledgard Jepson is retained to design and publish the centre's leaflets, brochures, other literature and its press releases as well as management of the centre's loyalty scheme database, e-mail literature to its members and to design and publish the *Lightstyle* magazine.

19) It is also responsible for designing and hosting the centre's website. At Exhibit PLT1, Ms Toole provides copies of pages from this website. The banner along the top of each page includes a number of themes including "bars", "eat" and "hotel". The pages accessed when clicking on the above themes are also provided. These pages contain advertisements for the hotel and for various bars, restaurants and take-away food outlets. Clicking on these advertisements takes the enquirer to a page providing more detailed information about each outlet. On

all these pages, the mark THE LIGHT (once again, in conjoined form, with the word “light” in bolder text, as in earlier exhibits) appears in a uniform position on the far right border of the page. This website format was adopted in June 2008.

20) At Exhibit PLT2, Ms Toole provides copies of pages from the website as at 4 January 2007. Whilst the layout is somewhat different to the later dated pages, the mark THE LIGHT (still in the conjoined form) appears prominently, this time, at the top of each page. Links are provided to the various food and drink outlets in a similar way to the later web page extracts.

21) Ms Toole states that the web page relating to the hotel received in the region of 500 – 700 visits per month between March and June 2009. The loyalty scheme had over 35,000 members as of the end of June 2009. All members receive a copy of the *Lightstyle* magazine and copies of editions from Spring/Summer 2006 through to Summer 2009 are provided at Exhibit PLT4. The various contents pages list articles relating to food and drink and under the heading of “Giveaways” are offers relating to various food and drink establishments located within the centre. Advertisements or editorials about establishments such as *The Radisson SAS Hotel*, *Bagel Nash*, *Maxi’s Express* and *Tiger Tiger* are included within the magazine as are multi-establishment editorials/advertisements promoting these and other bars and restaurants within the centre.

22) A fortnightly e-mail newsletter is also sent to members of the loyalty scheme providing offers such as discounts off meals at restaurants within the centre. Example copies of these e-mail newsletters are provided at Exhibit PLT5.

23) At Exhibit PLT6, Ms Toole provides copies of a number of press articles about THE LIGHT centre. These confirm that THE LIGHT is a centre that houses retail outlets, a hotel and various food and drink outlets. There is also an extract from the Yorkshire Evening Post from 22 May 2009 that is a report of a cooking demonstration for shoppers at the centre. The first article is an extract from the Daily Mail newspaper. The writer variously says “I’ve stayed at The Light – the address of the brilliantly positioned Radisson SAS hotel, in Leeds”, “Located in the heart of the city, the award winning Radisson SAS ...” and “The Light combines fantastic shopping with a wide variety of cafes, restaurants, bars, a 13-screen multiplex cinema and our home for the weekend, the four star Radisson SAS”. The second article, albeit of unknown origin, follows a similar line. The writer’s statements include “Conveniently placed in The Light, in the heart of the city centre, the award-winning four-star deluxe Radisson SAS Hotel makes an ideal residential base...” and “The Radisson SAS really is something else”.

24) The third witness statement is by Sarah Jean Masoom, Customer Service & Event Coordinator for NB Real Estate who are retained by Aegon. Ms Masoom states that, since October 2008, part of her role involves operating the centre’s

switchboard and she provides comments on the telephone enquiries she receives concerning the hotel and food and drink retailers located in the centre.

25) Ms Masoom explains that she receives approximately two or three calls a week from callers who believe they are calling the Radisson Hotel situated within the centre. She suggests that when speaking to directory enquiries they ask for THE LIGHT rather than "The Radisson". Ms Masoom also receives a couple of calls a day with general enquiries about the restaurants and bars within the centre and on occasions, callers have attempted to make table reservations with her.

26) Ms Masoom is also responsible for bookings of the centre's conference, exhibition and meeting facilities and for arranging refreshments for the delegates. At Exhibit SJM1, Ms Masoom provides a copy of the centre's brochure and website relating to these services. On the subject of refreshments, the brochure states:

"Bored with the usual sandwich platter? At The Light we have an excellent choice of cafes and restaurants and can provide you with a selection of menus. Offering a wide choice of catering from traditional light bites to exquisite four course meals with everything from Chinese, Italian, French and contemporary English dishes to choose from there's sure to be something to suite all tastes!"

27) On the page entitled "Meeting at The Light", the meeting room accommodation is explained and the facilities are listed as including "Tea and coffee service" and "hot and cold lunch options". The web page extracts include a page entitled "Venue Hire" where the above quoted text is repeated.

28) Ms Masoom explains that refreshments served within the conference/exhibition/meeting facilities are either prepared by one of the centre's retailers or, alternatively, the centre offers additional options which are sourced externally. Another alternative is for delegates to dine in one of the centre's restaurants with Ms Masoom booking the table. At Exhibit SJM2 are copies of invoices relating to these services. There are twenty four invoices dated between December 2007 and June 2009 and detail the provision of "tea & coffee", "water & fruit squash", "bagel buffet", "cakes & pastries" "breakfast feast platter" or similar, as well as such items as "Maxi's lunch", "two-course Brown's lunch" and "Chinese buffet... table booked for 12.30". These invoices are for values ranging between £170 and £450.

29) The fourth witness statement is by William John Clements, solicitor and partner in Trowers & Hamblins LLP, Aegon's representative in these proceedings. Mr Clements provides a copy of the Hotel Lease where the tenant hotel operator is required to provide hotel services to meet certain quality and range of services criteria. This lease provides the landlord (currently identified as being Aegon)

with authority to control the quality of the hotel services and can replace the hotel operator or operate the hotel itself. The rent that Aegon receives from the hotel is directly linked to the financial performance of the hotel, including the performance of its restaurant and bar.

30) At Exhibit WJC2, Mr Clements also provides a copy of an equivalent lease for the centre's other restaurants and bars. Once again, the rent received by Aegon is directly related to the financial performance of the outlet concerned.

DECISION

31) 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.”

32) 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 use of the mark in suit, or that there are proper reasons for non-use.

33) The application for revocation is based on Section 46(1)(a) and (b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] RPC 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. In *WISI Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any

subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

34) The applications for revocation were made after the fifth anniversary of completion of the registration of the contested marks, namely 21 March 2008. Therefore, I have to consider whether there was genuine use in the UK of Aegon’s three marks, for all or any of the services, the subject of these proceedings, by the proprietor or with his consent between 22 March 2003 and 21 March 2008 and between 10 October 2004 and 9 October 2009.

35) The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV (ANSUL)*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Anna Carboni, sitting as the Appointed Person in O-371-09 SANT AMBROEUS:

42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

36) Taking account of this guidance it is clear that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all the surrounding circumstances.

37) At the hearing Ms Harland made it clear that TLA are not challenging Aegon's use in respect to activities relating to the running of a shopping centre, but rather, the challenge is based upon the scope of this use and how the evidence should be interpreted. TLA's basic proposition is that the marks have not been used in respect of *provision of food and drink; restaurant, cafeteria and bar services; provision of hotel and other temporary accommodation*, but rather, in respect to such services, THE LIGHT does no more than indicate the location of the providers of these services.

38) On the other hand, Mr Edenborough argued that the evidence clearly illustrates that the activities of the service providers located within THE LIGHT

centre are “co-branded” with both the providers mark and the mark THE LIGHT. He argued that Aegon use the marks in connection with the various services being offered by itself and by its tenants.

39) Mr Edenborough’s arguments relate to the interpretation of Article 12(1) of Council Directive 2008/95/EC (“the Directive”), upon which Section 46(1)(a) of the UK Act is based. This Article reads:

“Article 12

Grounds for revocation

1. A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State *in connection with* the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

However, no person may claim that the proprietor’s rights in a trade mark should be revoked where, during the interval between expiry of the five-year period and filing of the application for revocation, genuine use of the trade mark has been started or resumed.

The commencement or resumption of use within a period of three months preceding the filing of the application for revocation which began at the earliest on expiry of the continuous period of five years of non-use shall be disregarded where preparations for the commencement or resumption occur only after the proprietor becomes aware that the application for revocation may be filed.

40) Mr Edenborough argued that the expression “in connection with the goods and services” used in the first sentence of Article 12 is distinct, and places a lower hurdle, than the phrase “in relation to goods and services” used to delimit the scope of infringement in Article 5.1. He hypothesised that because the different parts of the Directive use different phraseology, then it is intended that the phrases carry different meanings with the latter implying a more direct involvement. Mr Edenborough suggested that support for this proposition can be found in the relevant case law. In particular, he referred to *ANSUL* paragraphs 40 to 43:

“40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

41. That applies, inter alia, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he

makes actual use of the same mark under the conditions described in paragraphs 35 to 39 of this judgment. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

43. In the light of the foregoing considerations the reply to the first question must be that Article 12(1) of the Directive 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 those goods or services, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark 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."

41) Whilst I acknowledge that this extract from *ANSUL* may support the view that "in connection with" may be interpreted more widely than "in relation to", it is still not clear to me that such a proposition would extend to a finding of genuine use in the current circumstances. In *ANSUL* there is a finding that use of a mark was genuine when used in respect of parts and fittings for goods no longer sold and covered by the registration. In such a scenario, there would be a "connection" with the registered goods, in the minds of the consumer. However, in the current proceedings, the mark THE LIGHT has not been used in connection with hotel, restaurant or bar services. These are all provided by other entities who lease space from the proprietor within its centre called THE LIGHT.

42) As Ms Harland pointed out at the hearing, the above extract from *ANSUL* makes it clear that use of the mark must be “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” (see *ANSUL*, para 43 above). The evidence clearly shows that the hotel, bar and restaurant services provided within the centre are identified by the traders’ own marks such as *Radisson SAS*, *Starbucks*, *Nandos*, *Maxi’s* etc etc. It is these marks that guarantee the identity of the origin of their respective services and not Aegon’s mark. Ms Harland criticised the claim that Aegon are involved in co-branding saying that there was no evidence of this. Ms Harland’s concluded that the mark THE LIGHT merely identifies the location where the third party services are provided.

43) Ms Harland’s arguments have some force. The evidence of alleged co-branding, as identified by Mr Edenborough, consists of pages from THE LIGHT website where restaurants such as *Brio Pizza* are promoted. However, this is not co-branding or use of the mark “in connection with the services” of *Brio Pizza*, as Mr Edenborough alleged. It is clear that the location is provided by THE LIGHT but it is equally clear that the services are provided by *Brio Pizza*. As such, there is a clear divide in the minds of the consumer regarding what each of the marks represents. The same can be said for the promotion of other establishments within the centre.

44) The same criticism can be levied at the press articles referred to by Mr Edenborough. These are littered with references to THE LIGHT being the location of a wide variety of cafes, restaurants and bars, as well as a hotel, but none of these references give any impression that the centre is, in anyway, responsible for the services provided by these outlets. The examples identified earlier illustrate clearly that the writers of these press articles clearly recognised a distinction between the centre itself, serving as the location of a hotel and the provider of the hotel services. I have no reason to believe that the consumer’s perception will be any different.

45) In these circumstances, it cannot be said that the mark THE LIGHT performs the essential function of a mark, namely, to guarantee the identity of the origin of the services at issue and for which it is registered. Whilst there may be some merits to Mr Edenborough’s contention that the phrase “in connection with” should be interpreted more widely than “in relation to”, nevertheless, both phrases are bound by a need for the mark at issue to perform this essential function. As this is not the case here, it follows that this line of argument does not take Aegon’s case any further forward.

46) I acknowledge that the copy of the lease provided to *Radisson SAS* by Aegon (in its capacity as the landlord) illustrates that the centre can, if it so wishes, operate the hotel itself. However, there is no evidence that it has ever

done so and therefore, such evidence does not support a claim of genuine use. Also, the mere fact that the lease requires the hotel to be run to a minimum standard as characterised by hotel industry standards, does not, in itself, demonstrate that Aegon has used its mark genuinely in respect to the services of that hotel.

47) Taking account of the above comments, the evidence illustrates that the services provided in respect of the mark THE LIGHT are those of operating a shopping centre. The issue of shopping centre services was considered by the High Court in *Land Securities plc (and others)* (CH2008 APP 0278/0279/0281) and summarised in the Registry's Practice Amendment Notice 01/09. The judgement recognised that such services are those which "make the shopping centre as a whole an attractive place for the consumer to come and spend money". From the evidence before me, there is little to suggest the mark THE LIGHT has been used in any different way. Certainly, there is nothing before me that leads me to conclude that the mark THE LIGHT identifies hotel, bar or restaurant services to the consumer.

48) However, this is not the end of the matter, as Aegon has also provided evidence, in the form of numerous invoices, illustrating that it provides services outside its core "shopping centre services". These invoices relate to the provision of food and drink to delegates using its conference and meeting rooms. Whilst the source of such food and drink is not always clear, where it is not specifically provided at one of the establishments (operated by a third party trader) within the centre, then the purchasers of these services will perceive the food and drink as being provided by THE LIGHT centre. Ms Harland suggested that I should disregard these invoices because such food and drink is only provided as part of the centre's conference and meeting room hire. This context is obvious, but is not a reason for finding that the service of providing food and drink is not being provided, though it does raise an issue of what would be a fair specification to reflect this use.

49) The issue of what is a fair specification has been considered by the courts and I am particularly mindful of the guidance in *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."

50) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

"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 pernicky 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."

51) Finally, I am also mindful of the guidance provided by *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétouinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in

general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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 subcategories 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 subcategory or subcategories 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.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

52) Therefore, I must consider if the evidence, in the form of the invoices and extracts from the centre's brochure, is sufficient to permit Aegon to retain the

term *provision of food and drink* in its specification, but if not, what would be a fair alternative.

53) The term *provision of food and drink* is wide ranging and can include the provision of food and drink in restaurants, in bars, in hotels and at outdoor catering events to name but a few examples. Aegon's evidence demonstrates that THE LIGHT provides food and drink only to delegates who are using its rented meeting rooms. Such a narrowly focussed service leads me to conclude that it would not be appropriate to permit Aegon to retain the broad term *provision of food and drink* as it would unfairly provide a right against providers of restaurant, bar and hotel services etc etc. Having decided this, I must go on to consider how the term should be amended fairly to reflect this genuine use.

54) Taking all of the guidance, cited above, into account and considering how the notional consumer would perceive the services, it is correct and appropriate to limit Aegon's *provision of food and drink* by the addition of the words *in connection with the provision of conference and meeting room hire*.

55) Finally, I will also comment briefly on the remaining issue, namely, whether genuine use has been shown in respect of *other temporary accommodation*. It is clear from my earlier finding that Aegon cannot rely upon any such services provided by *Radisson SAS's* onsite hotel. However, I also need to consider whether the provision of meeting rooms allow Aegon to retain the term. The invoices submitted in support of Aegon providing food and drink also make reference to "meeting room hire" and "boardroom room hire". In considering if such services would be covered by the term *other temporary accommodation*, I am mindful that terms should not be given a wide construction (*Avnet Incorporated v Isoact Ltd* [1998] FSR 16) or an unnaturally narrow meaning (*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267). With this guidance in mind, temporary accommodation will be understood, by the notional consumer, as including overnight accommodation when the user is away from their normal residence. It is also used to describe rooms or buildings that are occupied on a temporary basis when the normal place of occupation is unavailable for some reason. However, generally the term is not understood as referring to the rental of meeting rooms for individual meetings. As such, I find that the provision of *other temporary accommodation* does not include meeting room or board room hire and, therefore, no genuine use has been demonstrated in respect of this term.

56) Taking all of the above into account, the applications for revocation are substantially successful with the evidence failing to demonstrate that the marks have been put to genuine use by Aegon, or with its consent, during either of the relevant five year periods, in respect of all except one description of the contested services. As such, the following contested terms are revoked in their entirety and with effect from the earlier of the two possible dates, namely 22 March 2008:

restaurant, cafeteria and bar services; provision of hotel and other temporary accommodation

57) The term *provision of food and drink* is retained but only with the following limitation:

Provision of food and drink in connection with the provision of conference and meeting room hire

COSTS

58) TLA has been substantially successful in its applications for revocation and is entitled to a contribution towards its costs. I award costs on the following basis:

Preparing and filing a statement & consideration other side' statement	£500
Considering evidence	£500
Preparation for, and attending hearing	£700
TOTAL	£1700
Reduction for partial success	£300
TOTAL	£1400

59) I order Aegon UK Property Fund Limited to pay The Light Aparthotel LLP the sum of £1400. This sum is 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 27 day of April 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**