

O-160-06

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2121384
IN THE NAME OF MUSGRAVE LIMITED
OF THE TRADE MARK:**

SNUGGLES

IN CLASSES 3 AND 16

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 82080**

**BY
SUPERDRUG STORES PLC**

Trade Marks Act 1994

**In the matter of registration no 2121384
in the name of Musgrave Limited
of the trade mark:
SNUGGLES
in classes 3 and 16
and the application for revocation
thereto under no 82080
by Superdrug Stores plc**

BACKGROUND

1) On 17 March 2005 Superdrug Stores plc, which I will refer to as Superdrug, filed an application for revocation of registration no 2121384 for the trade mark:

SNUGGLES

The trade mark is registered for the following goods:

soap; non-medicated toilet preparations; shampoo; cotton wool; dentifrices; all the aforesaid goods for infant and baby care; baby wipes;

paper, cardboard and cardboard goods; printed matter; instructional and teaching material (except apparatus); plastics materials for packaging; nappies, refuse sacks, toilet tissue.

The above goods are in classes 3 and 16 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The registration process was completed on 13 February 1998.

The registration stands in the name of Musgrave Limited, which I will refer to as Musgrave.

2) In its (amended) statements of grounds Superdrug claimed that the trade mark had not been used for any of the goods of the registration from at least 1 December 1998 to 1 December 2003, or in any period since. Superdrug requested that if use of the trade mark was shown for some goods that the registration should be partially revoked as per section 46(5) of the Trade Marks Act 1994 (the Act). However, if no use was demonstrated the registration should be revoked in its entirety as per section 46(1)(b) of the Act. Superdrug sought revocation with effect from 1 December 2003.

3) In response Musgrave filed a counterstatement, witness statement and evidence of use of the trade mark. In the witness statement Eoin Connolly, group legal counsel of Musgrave, stated that the trade mark has been used between 21 December 1999 and 21 December 2004 in relation to *nappies, wipes* and *refuse sacks* and is still in use to date. Mr Connolly also stated that there had been genuine use of the trade mark between the period 1 December 1998 to 1 December 2003.

4) Neither side requested a hearing; both sides filed written submissions.

5) In its written submissions Superdrug accepted that genuine use had been shown in relation to *nappies*, *baby wipes* and *nappy sacks*. It submitted that the registration should be limited to *baby wipes* in class 3 and *nappies* and *nappy sacks* in class 16. Taking into account the specification and the claim to use by Musgrave, it appears to me that the sole issue in this case is what an appropriate specification should be. There is now much guidance as to the approach to be taken: *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03, Animal Trade Mark* [2004] FSR 19 and *Omega SA v Omega Engineering Inc* [2003] FSR 49. The effect of the case law is that it is necessary to give a fair description of the goods upon which use in relation to the trade mark has been shown, taking into account the nature of the trade; such a description should not be overly pernickety nor overly wide.

6) The terms *baby wipes* and *nappies* appear in the specifications and so I cannot see why any other terminology should be used. The terms describe the goods upon which it has been agreed by both sides that the trade mark has been used. Superdrug considers that the only other goods upon which the trade mark has been used should be described as *nappy sacks*. Musgrave refers to *refuse sacks*. The only reference in the evidence to goods that appear to sit with either term is *nappy bags*. On the basis that no other goods for which use has been shown could be described as *refuse sacks*, Musgrave appear to consider that the *nappy bags* are used for the disposal of used nappies. Superdrug wishes to use the term *nappy sacks* and Musgrave *refuse sacks*. “Quadruped. Graminivorous. Forty teeth, namely twenty-four grinders, four eye-teeth, and twelve incisive. Sheds coat in the spring; in marshy countries, sheds hoofs, too. Hoofs hard, but requiring to be shod with iron. Age known by marks in mouth.” That is the Gradgrind description of a horse. However, it is easier to call a horse a horse and a lot more readily comprehensible. I can see no reason not to call what are described in the exhibits as *nappy bags* as *nappy bags*. These seem to be a specific type of product and describing them in this fashion does not seem to be to overly prescriptive or pernickety. Such goods would be encompassed by the portmanteau term *paper goods* and also *refuse sacks*, and so are covered by the specification.

7) The class 3 specification is to be limited to *baby wipes*. The class 16 specification is to be amended to read: *nappies and nappy bags*. As per the claim of Superdrug, the partial revocation is to take place from 1 December 2003.

8) Each side has had a measure of success, therefore, each should bear its own costs.

Dated this 14th day of June 2006

**David Landau
For the Registrar
the Comptroller-General**