

**In the Matter of the Trade Marks Act 1994**

**In the Matter of Trade Mark Application No: 2356356  
in the name of MIP METRO GROUP INTELLECTUAL PROPERTY GmbH & Co KG**

**In the Matter of Opposition No: 96081 thereto by  
ASSOCIATED NEWSPAPERS LTD**

**In the Matter of UK Trade Mark Nos: 1084267 and 1586405 in the  
name of ASSOCIATED NEWSPAPERS LTD**

**In the Matter of Revocation Nos: 83490 and 83491 thereto by  
MIP METRO GROUP INTELLECTUAL PROPERTY GmbH & Co KG**

**In the Matter of an Appeal to the Appointed Person  
from the decision of Mr. Mark Bryant dated 21st July 2011**

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**DECISION**

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1. This is an appeal against a decision of Mr Mark Bryant, the Hearing Officer for the Registrar, dated 21 July 2011, in consolidated proceedings in which (a) Associated Newspapers Ltd ('Associated') opposed the registration of a stylised mark, METRO, by MIP Metro Group Intellectual Property GmbH & Co ('MIP') on the basis of its own METRO marks, and (b) MIP sought revocation of Associated's earlier marks. Mr Bryant considered that the revocation proceedings failed almost (but not quite) in their entirety, and upheld the opposition.
2. MIP appealed. As the trade mark and case numbers on the TM55 show, the appeal was brought only in respect of the decision on the opposition proceedings. Dr Saunders, who appeared on behalf of MIP at the appeal, initially confirmed that there was no appeal in relation to the revocation, but said that MIP would ask me to take into account its arguments and the evidence about the extent of use of Associated's marks to limit the scope of Associated's marks which could be relied upon in the opposition proceedings. However, at the end of his oral submissions to me at the hearing, Dr Saunders indicated that his

instructions had changed, and he invited me to treat the appeal as applying not just to the opposition but also to the revocation proceedings. Mr Speck not unnaturally objected that it was too late to seek to appeal the revocation decision, in particular, he said, because had that part of the decision originally been appealed, his client might have wished to lodge a respondent's notice and cross-appeal, especially on the findings as to the use of Associated's mark on books.

3. MIP was in effect asking me to extend the time for lodging an appeal against the findings in the revocation proceedings until the day of the hearing. No explanation was advanced for MIP's volte-face, which I imagine arose from comments which I made at the outset of the hearing when I sought to clarify the extent of the appeal. Such a late appeal seems to me wholly inappropriate, especially if the respondent may have wished to file a respondent's notice to such an appeal. I am not prepared to permit the appeal to be extended in that way and I shall deal only with the appeal in relation to the opposition.

### **Background**

4. MIP's trade mark application was filed as a Community trade mark application as long ago as 20 March 1998. After some opposition at OHIM, it was converted to a UK national application no. 2356356 which was published in November 2007. The application is in respect of the following goods and services:

#### **Class 16**

*Goods made from paper; printed matter; instructional and teaching materials in form of printed matter.*

#### **Class 41**

*Publication of books, newspapers and periodicals.*

5. On 4 February 2008, Associated filed notice of opposition pursuant to sub-sections 5(1), 5(2)(a) and 5(2)(b) of the Act. Associated's earlier marks are:

UK Mark No. 1084267

#### **METRO**

**Class 16:** *Magazines (publications), but not including magazines relating to city life or travel.*

UK Mark No. 1586405

**METRO**

**Class 16:** *Books, magazines, printed publications and diaries; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.*

6. Both of Associated's marks had been registered for over 5 years. MIP filed a counterstatement putting Associated to proof of use in respect of all of the whole specification, and later filed applications for the complete revocation of both of Associated's marks under sub-sections 46(1) (a) and (b) of the Act. This would have taken effect from a variety of dates which, in the circumstances, I need not consider. It also sought proof of use for the purposes of section 6A. The dates when use needed to be shown to satisfy that section are different from the dates relevant to revocation; to the extent that this was a live point on the appeal, use needed to be shown in the period 3 November 2002 - 2 November 2007. Associated filed counterstatements and evidence of use.
7. Both sides filed written submissions and were professionally represented at a hearing before Mr Bryant on 18 November 2010.

**The Hearing Officer's conclusions**

8. The Hearing Officer started by summarising the issues and the evidence of use of Associated's marks. Use on newspapers was sensibly conceded. Mr Bryant found that there had been use of Associated's marks on magazines too. That finding is not challenged by MIP. However, there was an issue on the appeal about the extent of use which had been made in relation to books. Associated relied upon use in respect of (a) books recommended by the METRO Book Club, (b) travel or event guidebooks published in collaboration with the Rough Guide and (c) a book which was a guide to bars, clubs and pubs, entitled the METRO CrushGuide.
9. After setting out the law in relation to genuineness of use, the Hearing Officer said:  
"27) It has been conceded by MIP that Associated has demonstrated genuine use in respect of newspapers. By extension, it also accepts that goods do not need to be

paid for in order for such use to qualify to illustrate that a mark is used in a way that is consistent with its essential function (see the comments of the CJEU in NASDAQ C-320/07 P, paragraph 29) them to qualify as use of the mark. Further, Associated conceded at the hearing that it has not demonstrated use in respect of diaries. The goods that remain contested and the reasons why, are:

- Books: Here the issue is whether use has been shown on such goods through METRO's business conducted through its book club, its link-up with Rough Guide and through its publication of a book entitled METRO CrushGuide;
- Magazines: Here the issue is whether or not the marks used in respect of these goods are considered as acceptable variant forms of the marks as registered;
- Printed publications: Mr Rundle, for MIP argued at the hearing that even if use has been demonstrated in respect of magazines and books as well as newspapers, this is insufficient to allow Associated to retain such a broad term as printed publications.

Use in respect of books

28) Associated relies upon its activities undertaken under the mark METRO Book Club, books published in collaboration with Rough Guide and also a book entitled METRO CrushGuide. In respect to the first, the evidence illustrates a retail activity delivered in association with the online retailer Amazon. Books were reviewed in the MetroLife section of Associated's newspaper with readers able to purchase that book at a discount. There is nothing in the evidence to suggest that the product being provided to the consumer was anything other than the service of retailing the reviewed books at a discount. As such, it does not support use in respect of the books themselves.

29) The same criticism cannot be applied to the other two uses illustrated. It is clear that the books produced in conjunction with Rough Guide were co-branded with both the METRO mark and the Rough Guide mark appearing prominently on the cover of the books. Evidence is provided that this partnership venture existed between 2004 and 2008 and that after the first of these years, 100,000 copies were produced. I accept this use as clearly demonstrating that the METRO mark was used in respect of these books. The evidence clearly demonstrates that Associated's involvement was not as a sponsor, as contended by MIP. Joint billing of the METRO and Rough Guide marks and evidence of Associated's involvement in the editing and authoring of the book support this as does the name of the book's sponsor being clearly marked elsewhere on the front cover."

10. Associated's specification for Mark 1586405 was for "*books, magazines, printed publications and diaries.*" No relevant use had been made in relation to diaries and to that extent the specification was revoked for non-use. MIP challenged the Hearing Officer's finding that there had been use on "books," saying that there had been use only in relation to a narrow range of books.

11. The main thrust of MIP's appeal, however, related to the manner in which the Hearing Officer applied his findings to the rest of the specification of Mark 1586405. Having found that Associated had shown genuine use in respect of newspapers, magazines and books, the Hearing Officer went on at paragraph 40 to consider whether such use justified the retention

of the broader term "printed publications". He referred to the guidance in *Thomson Holidays Limited v Norwegian Cruise Lines Limited* [2003] RPC 32, and the comments of Jacob J in *Animal Trade Mark* [2004] FSR 19, as well as to the guidance of the General Court in Case T-126/03 "ALADIN." Lastly he quoted the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in case BL O/345/10 *Euro Gida*, in which Mr Hobbs summarised the state of the law as

"fair protection is to be achieved by identifying and defining not the particular *examples* of goods or services for which there has been genuine use but the particular *categories* of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

12. Mr Bryant concluded:

"44) Taking all of the above into account, it is likely that the "average, reasonably informed consumer" would, when asked to collectively describe newspapers, magazines and books, say that they are printed publications. Whilst, the goods in respect of which use has been shown, do not constitute all the goods that may be covered by this term, they all belong to the group described as "printed publications" and that this term "cannot be divided other than in an arbitrary manner". As such, I find that it is appropriate for Associated to retain the term printed publications in the specification of goods of earlier mark 1586405 because of the use demonstrated in respect of newspapers, magazines and books.

45) Taking all of this into account, Associated is entitled to retain the whole of its specification in respect of its earlier mark 1084267 and all except diaries in respect of its earlier mark 1586405. Therefore, MIP's revocation action against Associated's earlier mark 1084267 fails and its revocation action against Associated's earlier mark 1586405 is successful, but only in respect of diaries.

46) In respect of Associated's opposition against MIP's application, it is entitled to rely upon all the goods listed in the specifications of its earlier marks, with the exception of diaries listed in the specification of earlier mark 1586405."

13. The Hearing Officer then dealt with the objections under sub-sections 5(1) and (2). He found the marks highly similar but not identical so only 5(2) was in issue. MIP took issue with his conclusions as the identity/similarity of the parties' respective goods. After referring to *Canon* and *British Sugar*, the Hearing Officer went on:

"52) I also bear in mind the comments of the GC in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ("Merica")* Case T-133/05, where, at paragraph 29, it is stated:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application

are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

53) [*The Hearing Officer set out the parties’ respective goods – see above*].

54) Beginning with MIP’s Class 16 goods and with the above guidance in mind, it is self evident that MIP’s goods made from paper and printed matter may both include *magazines, books and printed publications* (such as *newspapers*) and as such are identical to these terms in Associated’s specifications.

55) MIP’s *instructional and teaching materials in the form of printed matter* can all be *printed publications* and it follows that these too must be considered as identical goods.

56) Therefore, all of MIP’s Class 16 goods are identical to Associated’s goods.

57) In respect of MIP’s Class 41 services, namely *publication of books, newspapers and periodicals*, this is the service of producing Associated’s goods. They, therefore, share at least some of the same trade channels. Further, without the publication services there would be no end product. MIP’s services are essential to the existence of the goods covered by Associated’s specifications and, therefore, they are complementary in the sense described by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06. Therefore, whilst their nature and intended purpose may be different, the respective goods and services share a reasonably high level of similarity.”

14. Having considered the identity of the average consumer and the distinctiveness of Associated’s marks, the Hearing Officer concluded at paragraph 67 that there was a “very strong likelihood that the average consumer will believe that the goods and services provided under the respective marks originate from the same, or linked, undertaking.” The opposition therefore succeeded entirely.

## **The Appeal**

15. MIP’s Grounds of Appeal submitted

- a. that the Hearing Officer erred in finding that the use of Associated’s mark on books was sufficient to justify retention of the registration for books in general. It submitted that the specification should have been reduced to “guide books for travel and for city pubs, bars and clubs.”
- b. that the Hearing Officer was wrong to say that “printed publications” could not be divided save in an arbitrary manner and so failed to formulate a fair specification reflecting Associated’s use on a limited number of types of publication;

- c. that the Hearing Officer was also wrong to say that it was “self evident” that “goods made from paper” in MIP’s specification could include magazines, books and printed publications such as newspapers;
- d. the Hearing Officer went wrong in paragraph 55 in finding that “instructional and teaching materials in the form of printed matter” were “printed publications;”
- e. the Hearing Officer erred in paragraph 57 in his findings as to the similarity of “publication of books” and “books”

In addition, it was submitted on MIP’s behalf at the hearing of the appeal that the Hearing Officer should have permitted MIP an opportunity to submit a revised specification of goods made from paper which did not include printed publications and that I should either deal with such an application myself or remit it to the Registry for further consideration.

### **Standard of the appeal**

16. The parties agreed that this appeal is a review of the Hearing Officer’s decision and that the Hearing Officer’s decision involved assessments of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

“In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

A decision does not contain an error of principle merely because it could have been better expressed.

17. In addition, Dr Saunders submitted on behalf of MIP that I should follow the approach set out by Mr Iain Purvis QC sitting as the Appointed Person in case BL O/096/11, *Putterscope*, in which Mr Purvis held that in certain appeals, for instance as to the evaluation of distinctiveness, where the Hearing Officer’s assessment is not of multi-factorial issues, the appeal tribunal need not have the same degree of reluctance to overturn a Hearing Officer’s decision as is the case where the decision under appeal is as to the likelihood of confusion. He submitted that the lower level of reluctance to overturn the Hearing Officer’s findings would apply to the findings as to genuine use in this case so that I might be “more enthusiastic” about reversing a finding about genuine use, than one about confusing similarity/likelihood of confusion. I am not sure that in this case the distinction is one which is particularly helpful to me. If I consider that the Hearing Officer erred in his findings about genuine use, then I should overturn his decision. However, in my view the main issue for the

Hearing Officer was to identify a fair specification for Associated's marks, and the margin of appreciation in reaching his conclusions must be borne in mind on the appeal.

### **Findings of use of the earlier marks**

#### **a) Was the Hearing Officer wrong to find use on "books"?**

18. Of the three kinds of use on books relied on by Associated, the Hearing Officer found that there had been genuine use of the mark on travel/event guides and the CrushGuide. He rejected the use claimed in relation to the books recommended by the METRO book club.
  
19. The Grounds of Appeal challenge (for the purpose of s 6A) the finding that this amounted to proof of genuine use on books in general, rather than "guide books for travel and for city pubs, bars and clubs."
  
20. No issue was taken with the Hearing Officer's finding of use on the Rough Guides, but MIP's skeleton argument on the appeal added a point about the date of use of the mark on the CrushGuide (which was published in 2002), suggesting that it was too early for the purposes of section 6A. Mr Mead's evidence on behalf of Associated stated that the guide had been conceived in 2001 and published in 2002; no more accurate evidence was given as to when the book would have been sold in the UK. Mr Speck pointed out that this challenge to Mr Mead's evidence had not been raised below. Instead, at that stage MIP concentrated its objections upon the lack of evidence that the CrushGuide had been sold during the period relevant to the claim to revocation, in 2004-9. Its preliminary submissions and skeleton below referred only to that period. On the usual *Extreme* principles (*Pan World Brands Ltd v Tripp Ltd*, "*Extreme*" [2008] R.P.C. 2) as to challenging evidence in Registry proceedings, it is difficult for MIP now to suggest that the evidence does not show that the book was sold during 2002, although Mr. Mead's evidence is not specific as to when in 2002 it would have been sold, nor did he produce any evidence of actual sales.
  
21. Despite having raised the issue for the first time, I think, on the appeal, Dr Saunders did not "press the point particularly" at the hearing of the appeal to challenge to the Hearing Officer's finding of use on "books" in general. That seems to me to have been a realistic position. As to the "guide books for travel" point, Mr Speck drew my attention to the fact that the evidence showed clearly that one of the Rough Guides was a guide to events (such as concerts) in the UK, rather than a travel guide. Whether or not the mark was used on the

CrushGuide in the relevant period for section 6A, Associated's use of its marks on books was only on a narrow range of books. However, in my view the Hearing Officer cannot be said to have erred in finding that such use was sufficient to maintain the registration for "books" in general as a fair description of the goods, according to the test discussed below. To the extent that MIP pressed its appeal on this point, I reject this Ground of Appeal.

**b) Was the Hearing Officer wrong to find use on "printed publications"?**

22. The position in relation to "printed publications" is more complicated. The Hearing Officer found that there had been use on a variety of "printed publications" namely books, newspapers and magazines. MIP's position was that this did not justify retention of that broad term as an appropriate and fair description of the range of goods in relation to which Mark 1586405 had been used.

23. I was referred to a number of authorities on the manner in which a fair specification should be identified, most of which were referred to by the Hearing Officer in the decision. The law was considered in detail by Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in two decisions, *Nirvana* and *Extreme*. In the former (BL 0/262/06, 18 September 2006), he discussed the earlier cases at some length and I set out a passage from his judgment below. I hope I may be forgiven for having deleted certain passages from his analysis of the law which I think are less relevant to the issues which I have to decide:

"37. The correct approach to partial revocation under section 46(5) has been considered in a number of cases in the High Court and Court of Appeal. So far as I am aware, the first such case was *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767. ...

...

39. ... Neuberger J's approach was to apply a blue pencil to the existing wording of the specification... not an approach contended for by either party before him ...

...

44. In *MINERVA Trade Mark* [2000] FSR 734 Jacob J found ... that there had been genuine use of the trade mark ... in relation to printed stationery, but that the proprietor had not substantiated a claim to genuine use during the relevant period in relation to books and in particular a collection of poems. The trade mark was registered in respect of "paper and paper articles; cardboard and cardboard articles; printed matter; stationery; ... all included in class 16". Jacob J held that printed stationery was "printed matter", but that the term "printed matter" also embraced goods in relation to which there had been no genuine use, in particular printed literary matter such as books. Having referred to *Premier v Typhoon* and *Mercury v Mercury* he said at 738:

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. I think it is inevitable that at times one would have to 'dig deeper'. ... 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 commercial nonsense to maintain the registration for all goods caused [sic – I think this should read 'covered'] by the wide words.

That is not to say that the court will cut the registration right down ... 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 registration. Thus here I think that, although use in relation to printed stationery is established, stationery is a quite different sort of material from literary publications of the kind put out by Reed [the applicant for revocation] and the specification can be cut down.

45. Accordingly Jacob J revoked the specification in so far as it was registered for printed matter other than stationery. ...

46. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 17 Pumfrey J found that there had been genuine use of the trade mark during the relevant period in relation to cleaning substances for technical/industrial use. The trade mark was registered in respect of "cleaning and decontaminating substances and preparations; all included in Class 3", ... Having referred to *Premier v Typhoon*, *Mercury v Mercury* and *MINERVA*, Pumfrey J said:

21. ... The difficulty with Neuberger J's formulation is that while apt to deal with the case before him, it did not deal in terms with huge classes of goods described by single phrases like 'computer software' or 'cleaning substances and preparations'. I must therefore differ with respect from Neuberger J and agree with what Jacob J said in *MINERVA Trade Mark*. At times, it is inevitable that one is obliged to dig deeper.

22. The problem which is raised in an acute form in this case is how much deeper it is right to dig. It is not possible to draw a list of goods in respect of which the mark has not been used, and it seems to me that the question is the more general one: how should the specification of goods be narrowed to reflect the non-use? ... In my judgment, it would only be right as a matter of principle to divest the proprietor of part of his statutory monopoly if one is satisfied that he ought to have to demonstrate confusion in fact, or at least be obliged to rely upon section 10(2)... The fact of non-use has in itself nothing to do with the defendant and the defendant's activities, or lack of them, are prima facie irrelevant... It follows it seems to me that the second form of revocation sought by the defendants in the present case is not acceptable, leaving as it does a class of goods defined negatively by reference to the defendants' activities.

23. In my judgment, the task is best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark and assuming further that he will continue that use. Mr Campbell submitted that the specification of goods should in effect be drafted from scratch to encompass only the use which the registered proprietor has made of the mark. I accept that the starting point should be a limitation to the actual field of use. The difficulty lies in deciding on the width of the surviving specification, the correct formulation of which must largely depend on questions of fact and degree. Let me take an example to which Neuberger J refers in *Typhoon*. There the registration was (*inter alia*) for 'domestic containers'. Suppose the proprietor uses the mark only on red tea caddies. How does one limit the registration? Obviously the colour red is irrelevant since it does not

define a species of goods. But should the registration be limited to tea caddies? Neuberger J thought not... I would agree wholeheartedly with this statement of the problem, but the answer must, I believe, depend on the facts of the case.

24. I think the correct starting point as a matter of principle consists of the list of articles for which the proprietor has in fact used the mark. In arriving at a fair specification having regard to the proprietor's use, it is also necessary to remember that the effect of section 10(2) and (of 10(3), in limited circumstances) is to give the proprietor protection outside his specification of goods... There is no pressing need, therefore, to confer on the proprietor of a wider protection than his use warrants by unduly broadening the specification of goods. There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.

47. In the result, Pumfrey J partially revoked the registrations by restricting them to "all for non-domestic use". ...

48. In *DaimlerChrysler AG v Alavi* [2001] RPC 42 at [68]-[74] Pumfrey J adhered to the approach he had adopted in *Decon v Fred Baker*... In the result he restricted a registration for "articles of clothing; but not including footwear" to "sweaters, anoraks, polo-shirts, scarves, T-shirts and baseball caps". ...

49. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32, CA the trade mark in suit was registered in respect of "arrangement and booking of travel, tours and cruises; escorting travelers and arranging the escorting of travelers; providing tourist office services; all included in Class 39" and "booking and provision of accommodation, catering services for travelers; providing of day nurseries (other than schools); leasing and rental of computers; all included in Class 42". ... There was a dispute, however, as to the extent of partial revocation that should be ordered. Aldous LJ (with whom Waller and Scott Baker LJJ agreed), having cited *Premier v Typhoon*, *MINERVA* and *Decon v Fred Baker*, said:

29. I have no doubt that Pumfrey J was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paragraphs [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 or services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly on the rights of the public... 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 the 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.

50. Accordingly Aldous LJ held that the specifications should be restricted to “all for package holidays” on the basis that the average consumer would describe the claimant’s services as “package holidays”. This was a different restriction to that imposed by the judge at first instance, and it appears from the report that it was not one proposed by either party except by the claimant as a fallback position during the course of argument in the Court of Appeal.

...

53. In *ANIMAL Trade Mark* [2003] EWHC 1589, [2004] FSR 19 the trade mark in suit was registered for “clothing, footwear, headgear, baseball caps, sweatshirts, T-shirts”. It was common ground by the end of the trial that there had been genuine use during the relevant period in relation to T-shirts, jeans, vests, sweatshirts, hoodies, track tops, shorts, jumpers, cardigans, parka jackets, camisoles, strappy sundresses, printed cotton skirts, swimwear, knitted hats, fleece hats, sun hats and casual shoes. The defendant sought partial revocation of the mark so as to restrict the specification to “casual surf type wear for men” and “casual surf type wear for women aged under 30”. Applying *Thomson v Norwegian* and *West v Fuller*, Jacob J declined to restrict the clothing part of the specification, but did restrict “footwear” to “casual footwear” and “headgear” to the three types of hats for which use had been proved. He said:

20. The reason for bringing in 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 pernickety 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 the ‘fair description’ is one which would be given in the context of trade mark protection.

...

22. Thus I do not accept ... that the specification should be limited to exactly the kind (including ‘image’) of goods for which use has been proved. ...

23. So, should ‘clothing’ in the specification be qualified in some other way? The term covers a very wide spectrum of different sorts of garments. But putting aside such specialist things as diving suits, wetsuits, bullet-proof vests and so on, there is a core of goods which are likely to be bought by ordinary consumers for different purposes in their daily wear. The same woman or girl is likely to own T-shirts, jeans, dresses, both formal and informal. Both parties’ goods could easily end up in the same wardrobe or drawer. He or she knowing of the range of goods for which use has been proved would, I think, take ‘clothing’ to be fair as a description. He or she might limit the clothing to ‘casual clothing’ but I have concluded in the end that ‘clothing’ is appropriately fair.

...

54. While I appreciate that *ANIMAL* was decided after *Thomson v Norwegian* and *West v Fuller* whereas *DaimlerChrysler* was decided before those cases, it seems to me that there is slight tension between the two which is not resolved by that fact. ... but I consider that, as Pumfrey J expressly said in *Decon v Fred Baker* at [24] and as Aldous LJ implied in *Thomson v Norwegian* at [29], in deciding what specification is appropriate the tribunal must hold the balance not merely between the proprietor

and any defendant to a claim for infringement but also between the proprietor and other traders and the public. ...

55. I am only aware of one decision of the Court of First Instance bearing upon this issue. In Case T-126/03 *Reckitt Benckiser (España) SL v Office for Harmonisation of the Internal Market* [2005] ECR II-2861 the applicant sought to register the trade mark ALADIN as a Community trade in respect of various goods including cleaning preparations in Class 3. An opposition was lodged by the proprietor of an earlier Spanish trade mark ALADDIN which was registered in respect of “polish for metals”. The applicant required the opponent to furnish proof of use of this mark pursuant to Article 43(2),(3) of the CTM Regulation. The Opposition Division found that the opponent had only used its mark for a specific product, namely a product for polishing metals consisting of cotton impregnated with a polishing agent (“magic cotton”), and that the opposition was to be assessed on the basis that the opponent’s specification was notionally restricted to this product. On this basis the Opposition Division dismissed the [opposition], holding that there was no likelihood of confusion. The opponent’s appeal to the Board of Appeal was dismissed. The Court of First Instance allowed the opponent’s appeal, holding that the opponent should be taken to have proved use of its mark in relation to the goods in respect of which it was registered.

56. The Court held:

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, ... 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 – Vétoquinol (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 sub-categories 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 sub-category or sub-categories 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 subcategories.

47. The earlier trade mark was registered solely in respect of 'polish for metals'. That description restricts, with regard to both the function of the goods concerned, polishing, and to their intended purpose, for metals, the category of goods covering, under the Nice Agreement, 'cleaning, polishing, scouring and abrasive preparations'. Furthermore it should be noted that the later category itself falls more broadly within Class 3 of the Nice Agreement, which includes, in addition to cleaning, polishing, scouring and abrasive preparations, the following goods: 'bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.

8. In those circumstances, the earlier mark must be held to have been registered for a collection of goods forming a particularly precise and narrowly-defined sub-category of goods to which it belongs under the Nice Agreement.

49. It follows that, by providing the undisputed proof of genuine use of the mark in respect of a 'product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)', which is evidently a 'polish for metals' within the meaning of the sub-category of goods to which the earlier mark relates, the applicant has properly established that the mark had been put to use for that sub-category as a whole, it not being necessary to draw any distinction in that regard by reference to the public concerned.

...

51. The provisions of Art. 43 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so that they cannot be interpreted as broadly as OHIM would

have them be, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly defined category, as has been explained above.

57. It appears to me that the approach adopted by the English courts following *Thomson v Norwegian* is broadly consistent with that adopted by the Court of First Instance in *Reckitt v OHIM*. To the extent that there is a difference in approach, it may be explicable by the different issues that were under consideration by the respective courts: the English courts were considering applications for revocation while the Court of First Instance was considering the requirement for proof of use of an earlier trade mark in opposition proceedings. This may explain, for example, the Court of First Instance's observations at [51]. The main difference between the two approaches that I perceive is that the Court of First Instance does not articulate any very clear yardstick for determining when a sub-category of goods cannot be further divided, whereas the English courts have firmly adopted the perception of the average consumer of the goods in question as providing a suitable benchmark. To the extent that there is a difference, in my judgment I am bound by the decisions of the English courts rather than that of the Court of First Instance since the former are directly on point whereas the latter is not.

58. I derive the following propositions from the case law reviewed above:

(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period...

(2) Next the tribunal must arrive at a fair specification having regard to the use made: ...

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: ...

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark...

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used...

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description...

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved...

(8) The exercise of framing a fair specification is a value judgment ...

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties."

24. In *Pan World Brands Ltd v Tripp Ltd (Extreme Trade mark)* [2008] R.P.C. 2, Mr Arnold QC additionally considered the decision of the CFI in *Mundipharma*, saying :

"52 I considered the principles applicable under section 46(5) at some length in *Nirvana trade mark* (O/262/06) at [36]-[59]. Since then the CFI has given judgment in Case T-256/04 *Mundipharma AG v OHIM* .... In that case the opponent's mark was registered in

respect “pharmaceutical and sanitary preparations; plasters”. The applicant did not dispute that the mark had been used in relation to “multi-dose dry powder inhalers containing corticoids, available only on prescription” and the Board of Appeal found that the opponent had only proved use of the mark in relation to those goods. On appeal to the CFI the opponent contended *inter alia* that use should be taken to have been proven in relation to “therapeutic preparations for respiratory illness”. The CFI upheld this contention.

53 In its judgment, having recapitulated paragraphs [45] and [46] of its judgment in Case T-126/03 *Reckitt Benckiser (España) SL v OHIM (Aladin)* [2005] E.C.R. II-2861 and recorded that it was not disputed that the mark had been used in relation to “multi-dose dry powder inhalers containing corticoids, available only on prescription”, the CFI went on:

“(26) Next, it should be borne in mind that the earlier mark was registered for ‘pharmaceutical and sanitary preparations; plasters’. That category of goods is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently. Consequently, the fact the earlier mark must be regarded as having been used for ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’ confers protection only on the subcategory within which those goods fall.

(27) In the contested decision, the Board of Appeal held that the earlier mark was to be taken into consideration only in so far as it covered goods the genuine use of which was not contested. It thus defined a sub-category corresponding to those goods, namely ‘multi-dose dry powder inhalers containing corticoids, available only on prescription’.

(28) That definition is incompatible with Article 43(2) of Regulation No 40/94, as interpreted in the light of *ALADIN*, and applicable to earlier national marks pursuant to Article 43(3) of that regulation.

(29) The Court notes in this respect that, since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a subcategory of goods or services.

(30) The purpose and intended use of a therapeutic preparation are expressed in its therapeutic indication. However, the definition employed by the Board of Appeal is not based on that criterion as it does not state that the goods in question are intended for the treatment of health problems and does not specify the nature of those problems.

(31) Moreover, the criteria chosen by the Board of Appeal, namely the dosage form, the active ingredient and the obligation to obtain a doctor's prescription, are, as a rule, inappropriate for defining a subcategory of goods as contemplated in *ALADIN*, as the application of those criteria does not fulfil the abovementioned criteria of purpose and intended use of the goods. In fact, a given medical condition can often be treated using a number of types of medication with different dosage forms and containing different active ingredients, some of which are available over-the-counter whilst others are available only on prescription.

(32) It follows that, in failing to take into account the purpose and intended use of the goods in question, the Board of Appeal made an arbitrary choice of sub-category of goods.

(33) For the reasons set out in paragraphs 29 and 30 above, the subcategory of goods covering those the genuine use of which has not been contested must be determined on the basis of the criterion of therapeutic indication.

(34) The sub-category proposed by the intervener, namely 'glucocorticoids', cannot be accepted. That definition is based on the criterion of the active ingredient. As discussed in paragraph 31 above, such a criterion is not generally appropriate by itself for defining subcategories of therapeutic preparations.

(35) By contrast, the definition proposed by the applicant and OHIM, namely 'therapeutic preparations for respiratory illnesses', is appropriate in two ways: first, it is based on the therapeutic indication of the goods in question and, second, it allows for the definition of a sufficiently specific sub-category, as contemplated in *ALADIN*.

(36) In the light of the foregoing, the Court finds that the earlier mark must be deemed to have been registered, for the purposes of the present case, for 'therapeutic preparations for respiratory illnesses'."

54 Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective.

55 To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in *ANIMAL ...* is to be preferred to the slightly less generous approach of Pumfrey J. in *DaimlerChrysler AG v Alavi* [2001] R.P.C. 42."

25. In addition, in *Daimler AG v. Sany Group Co Ltd* [2009] EWHC 1003 (Ch), [2009] E.T.M.R. 58, Mr. Geoffrey Hobbs QC sitting as a deputy judge of the High Court said at paragraph 10 (I have replaced footnotes with case names):

"10. The required degree of precision has not yet been authoritatively defined by the European Court of Justice. In three decisions of the Court of First Instance [*i.e.* *Mundipharma*, *T-483/04 Armour Pharmaceutical Co v OHIM*, and *Aladin*] it has been indicated that the outcome should be a specification expressed in wording which covers no independent sub-category or sub-categories of goods other than the one(s) within which the relevant trade mark can be taken to have been used. In [*Mundipharma*] it was emphasised that the chosen wording should reflect the purpose and intended use of the relevant goods. I have previously expressed the view that the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify [*WISI, Datasphere*]."

26. The law has also been considered by Professor Annand, sitting as the Appointed Person in *Penn Fishing Tackle Manufacturing Co. v. Fox International Group (EXTREME)*, BL O/217/10

and most recently in BL O/082/12, *Challenger trade mark*. In the latter decision, Professor Annand pointed out at paragraph 25 that the often difficult question for the tribunal is to determine in the particular circumstances of each case the particular categories of goods realistically exemplified by the goods for which there has been genuine use.

27. The Grounds of Appeal here complained that the Hearing Officer had failed to “dig deeper”. MIP argued that “printed publications” remains too wide a specification, covering many additional sorts of goods. However, it did not identify any sub-category of “printed publications” appropriate to books, magazines *and* newspapers. When I asked Dr Saunders how his client said that “printed publications” could properly be subdivided into different categories, he referred me to a variety of goods identified in the Grounds of Appeal and his skeleton argument, none of which, in my view, are sub-categories of “printed publications”. On the contrary, those documents identified certain goods which may be printed publications but which are not books, magazines or newspapers. Moreover, there were unfortunately some inconsistencies in MIP’s position as to some of those goods, e.g. calendars were described in the Grounds of Appeal as “printed publications” but in MIP’s skeleton argument it was said that they were “printed matter” and could not properly be described as “printed publications.” Nevertheless, MIP did identify some goods (e.g. sheet music) which I think one could properly say are “printed publications” but are not books, newspapers or magazines. In argument, Dr Saunders suggested that the appropriate sub-category was simply “books” as magazines and newspapers are a sub-set of books. I do not accept that submission. It seems to me absolutely clear that the average consumer would not describe magazines or newspapers as books.

28. The Hearing Officer had to carry out the type of analysis described by Mr Arnold QC at paragraph 58 of *Nirvana* which I have set out above. It seems to me that this Hearing Officer did so, and in particular at paragraph 44 of the decision under appeal he considered how to reach a fair specification of goods by reference to how the average consumer would describe the goods or services in relation to which Associated’s marks had been used. He considered that a fair description of the three types of goods together was “printed publications.” The ‘nub’ of this appeal is whether he erred in concluding that “printed publications” was a fair description, on that analysis.

29. In my view, newspapers, magazines and books are all apt to be seen as core or at least significant goods within the description “printed publications” and it cannot be said to be wrong to decide that the average consumer would describe them as ‘publications’ and more precisely as ‘printed publications’. Moreover, rather than limiting the specification just to “books, magazines and newspaper,” which I think was the logical corollary of MIP’s argument. The term has the benefit of protecting the proprietor’s legitimate interest to be able to extend further his range of goods within the confines of the terms for which the trade mark was registered. I see no error of principle or material error in the Hearing Officer’s conclusion on this point.
30. The Hearing Officer did not give any reasons why he thought the term “printed publications” could not be divided other than in an arbitrary manner, but that does not, in my view, necessarily show that he made a material error in carrying out this task. Indeed, the difficulty which MIP experienced in seeking to divide the term amongst a variety of different goods, and in ascribing any other appropriate sub-categorisation to the goods on which use has been shown indicates, in my view, that any such division might well be arbitrary.
31. In the circumstances, it does not seem to me that the Hearing Officer made a material error in finding that “printed publications” was a fair specification for Associated to retain. I reject this second Ground of Appeal.

#### **Impact on the opposition**

32. The findings on use are relevant only in so far as they have an impact upon the opposition brought by Associated. The Hearing Officer found that Associated had used its mark for printed publications and so could rely on it and on that specification of goods as having been used for the opposition; even allowing for that being correct, MIP challenged the result of his findings on the opposition.
33. MIP submitted that “printed matter” and “printed publications” are not synonymous terms. However, it had conceded before the Hearing Officer that “printed matter” covered a wider category of goods than “printed publications,” but *included* “printed publications”. After some discussion, it was also conceded before me that where the two categories overlap they are identical, but MIP said that begged the question of what should be done in relation to the non-overlapping goods. However, apart from challenging the Hearing Officer's finding

that there had been use of "printed publications" in my view there is nothing in MIP's Grounds of Appeal appealing the finding that, if the registration for "printed publications" was maintained, it covered identical goods to "printed matter" and the application should be refused for "printed matter." That results from the decisions discussed at paragraph 35 below.

**c) Was the Hearing Officer wrong to uphold the opposition for "goods made from paper"?**

34. MIP appealed the finding that "goods made from paper" may include magazines, books and printed publications so that those goods are identical.
35. First, MIP complained that the Hearing Officer had relied upon the *Meric* case (see his paragraph 52, set out above) although it was not cited or discussed at the hearing before him. That was a case which held, in effect, that an element of overlap of identical goods is sufficient for an opposition to succeed whether the wider category is in the earlier or the later specification. *Meric* is a case which follows similar earlier General Court decisions, such as Case T-110/01, *Vedial* cited at paragraph 29 of *Meric*, and Case T-385/03 *Miles Handelsgesellschaft International mbH v OHIM, ('Biker Miles')*, [2005] E.C.R. II-2665; [2006] E.T.M.R. 5. The same conclusion was reached by Professor Annand in *Galileo trade mark* BL O/269/04, who said "There is no necessity for ... specifications to co-extend."
36. Mr Speck (who represented Associated at the hearing before Mr Bryant) accepted that *Meric* itself was not cited, but it is clear that the point about overlapping specifications was discussed at the hearing, and it seems to me that the point cannot have taken MIP by surprise.
37. Dr Saunders submitted that *Meric* did not abrogate the need to perform the assessment of similarity required by *Canon* or *British Sugar* in relation to the whole range of goods in the specification. I do not accept that submission. It appears to me that if a Hearing Officer makes a finding that goods or services are identical, on the basis that terms are synonymous or show a clear overlap with synonymous terms, there is no need to carry out the comparison necessary to establish similarity. To give an example discussed at the hearing, 'hats' may not be synonymous with 'headwear' (which might for instance include helmets), but overlaps with it and so is partly identical. If that is so, then *Meric* indicates that the

overlap is enough to justify a finding of identity and logically, in my judgment, there is no need to go further and consider whether the goods which do not overlap are similar.

38. MIP submitted that the Hearing Officer was also wrong to say that it was “self-evident” that “goods made from paper” in MIP’s specification could include magazines, books and printed publications such as newspapers. It complained that he had failed to take into account an earlier UKIPO decision (BL O/272/02 *Kompass*) in which it had been held that goods made from paper and cardboard did not cover printed publications. Nevertheless, it appears from the skeletons and the transcript of the hearing below that MIP accepted that at OHIM, including a decision in relation to the CTM application on which MIP’s current application is based, “goods made from paper” have been found to comprise newspapers, printed matter etc, if not printed publications. Further, it appears to me that practice at the UKIPO has not always followed the decision in *Kompass*. For instance, I am aware of a decision of Mr Oliver Morris, BL O/376/09 in which he found that the term “goods made of paper” covered all goods within Class 16. I also note paragraphs 49-50 of Mr Foley’s view in decision BL O/243/08 (a separate METRO dispute) that all of “Goods made from paper; printed matter; instructional and teaching materials in the form of printed matter”, would encompass identical goods to “Books, magazines, newspapers, printed publications and diaries; all included in Class 16.” Neither of those decisions appears to me to have been overturned on appeal.

39. In my view, it would be wrong in the circumstances to conclude that the Hearing Officer made a material error in finding that the broad term “goods made from paper” includes, for example, newspapers. That was a finding which it was open to him to make. That being so, the impact of the *Merix* case is such as to deem the overlap to affect the whole of “goods made from paper.”

40. MIP’s next submission was that the Hearing Officer was wrong not to carry out an assessment of similarity in relation to those goods in MIP’s broad specification for “goods made of paper” which are not identical to those in Associated’s specification and that the limited level of identity between such goods and the totality of “goods made from paper” meant that he was wrong to reject MIP’s application for “goods made from paper” outright. However, as I have said above, it does not seem to me that the approach advocated by MIP is consistent with the authorities such as *Merix* which indicate that an overlap of identical

goods between an earlier specification and a later wider specification justifies the refusal to register the whole of the latter. Had MIP's application specified a long list of individual items of goods made from paper which might bear printing but are not publications, such as the "paper bags, paper tissues, paper towels, etc" included in MIP's skeleton argument, the Hearing Officer's task would have been very different. However, he was asked only to compare "goods made from paper" with Associated's specifications. I do not accept that the Hearing Officer erred in his conclusion.

**d. Was the Hearing Officer wrong to find in that "instructional and teaching materials in the form of printed matter" were "printed publications"?**

41. MIP's next submission was that the Hearing Officer was wrong to find that "instructional and teaching materials in the form of printed matter" were "printed publications." Again, that seems to me plainly to have been a finding which it was open to the Hearing Officer to make; in my view there is a clear potential at the least for such goods to overlap, and I reject that submission as without merit.

**e. Was the Hearing Officer wrong to find similarity of "publication of books" and "books"?**

42. Next, MIP submitted that the Hearing Officer was wrong to conclude that there was a high level of similarity between 'books' and the 'publication of books' in general. It submitted more importantly that his decision that '*MIP's services are essential to the existence of the goods covered by Associated's specifications*' and so are complementary to them (see paragraph 57 of his decision) was wrongly based upon Case T-325/06, *Boston Scientific*. I was taken to the following passages in that decision:

"77. According to consistent case-law, in order to assess the similarity of the products or services concerned, all the relevant features of the relationship that might exist between those products or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary (*Sunrider v OHIM*, paragraph 27 above, paragraph 85; judgment of 15 March 2006 in Case T-31/04 *Eurodrive Services and Distribution v OHIM – Gómez Frías (euroMASTER)*, paragraph 31).

78. As regards the assessment of the similarity of the goods at issue, the Board of Appeal found, in paragraphs 22 to 24 of the contested decision, that, owing to their functional differences, apparatus for placing a suture, on the one hand, and hollow fiber oxygenators with detachable hard-shell reservoir, on the other hand, have a

different method of use, are not in competition with each other and are not interchangeable. However, the Board found, in essence, that the goods at issue were closely linked to the goods of the intervener in so far as they had a certain complementary character, since they could be used simultaneously in the field of medicine, for example during surgery. They might also be purchased through the same distribution channels and be found in the same points of sale, so that the relevant public could be led to believe that they came from the same undertaking.

79 Those findings must be upheld.

80 In this respect, it must be noted that the goods bearing the earlier trade mark and those covered by the mark applied for both concern the medical field and are therefore intended to be used in the context of a therapeutic treatment.

81 In addition, as the Board of Appeal rightly pointed out, all the goods covered by the mark applied for have a certain complementary relationship with those bearing the earlier trade mark.

82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).

83 It is also true that, as OHIM moreover acknowledged, apparatus for placing a suture cannot be considered to be indispensable or important for the use of hollow fiber oxygenators with detachable hard-shell reservoir.

84 However, it is clear that apparatus for placing a suture and hollow fiber oxygenators with detachable hard-shell reservoir can be considered to be complementary where, in surgery which has required an incision and during which an oxygenator has been used, the surgeon uses apparatus for placing a suture. Thus, in the course of a single, very specific procedure, namely a surgical operation, two apparatus, namely an oxygenator and apparatus for placing a suture, might be used, one bearing the trade mark CAPIOX and the other the trade mark CAPIO.

85 It follows that, even though the applicant claims that the goods at issue cannot be considered to be similar simply because they are both used in the field of medicine, which, according to the applicant, is the case of nearly all goods of significance, the goods at issue are similar because they are in fact in a certain complementary relationship and specifically target certain professionals in the medical sector. In addition, in the present case, contrary to what the applicant claims, the goods at issue are not similar solely because they are used in the field of medicine, but because they could be used in the same, very specific surgical operation, namely open-heart surgery.”

43. *Boston Scientific* related to very different kinds of goods to those in issue here, and also compared goods to goods, not goods to services. However, the finding in paragraph 82 of the judgment is broad, as is the reasoning in paragraph 78, identifying the essence of complementarity – that members of the public may be led to believe that the goods and services come from the same undertaking. Bearing that in mind, as well as the practice adopted when comparing goods to retail services (which seems to me to be rather closer in concept to the comparison the Hearing Officer had to carry out here) it seems to me that there was no error of principle or material error here in his finding that the service of ‘publication of books’ is complementary and therefore similar to ‘books.’ This Ground of Appeal also fails.

#### **Limiting MIP’s specification**

44. MIP’s final fall-back position was set out in its skeleton argument on the appeal but was not included in the Grounds of Appeal. MIP submitted that the Hearing Officer was wrong not to permit it an opportunity to submit a revised specification of goods made from paper which did not include printed publications. As I understand it, no application was made to Mr Bryant to consider an amendment to the specification of goods if the opposition would otherwise succeed. It submitted before me that if the appeal otherwise failed, MIP should be allowed to proceed in respect of goods made from paper not being printed publications, described in the skeleton as “*such as* paper, paper stationery, paper bags, paper tissues, paper towels, paper napkins, babies diapers, baking paper, coffee filters and toilet paper” [my emphasis]. Nevertheless, even on the appeal no formal application was made to amend the specification and no attempt was made to produce an alternate specification, save for the list of goods made of paper set out (apparently merely by way of example) in the skeleton argument.

45. MIP relied upon TPN 1/2011 and upon a pair of decisions of Mr Daniel Alexander QC, sitting as the Appointed Person. TPN 1/2011 was posted on 6 April 2011 and came into immediate effect. That was after the hearing before the Hearing Officer but prior to his decision.

46. The power to amend a specification (to narrow but not widen it) is found in section 39 of the 1994 Act and applicants have always had the opportunity to amend a specification *inter alia* to avoid conflicts with earlier marks. There is no doubt in my mind that MIP could at any

stage in the long-running application period of this mark have applied to amend and narrow down its specification, to seek to avoid its conflict with Associated. Plainly, it chose not to do so, even before the Hearing Officer.

47. The TPN reflects a decision of Mann J in *Giorgio Armani SpA v Sunrich Clothing Ltd* [2011] R.P.C. 15. In that case, the application was for all clothing, shoes and headgear in class 25 and the opposition was based on an earlier mark registered in Class 25 just for “clothing for men and boys”. The main issue on the appeal was whether the Hearing Officer had erred in refusing the application for all clothing, despite the limitation of the opposition to the scope of the opponent’s mark. That was indeed found to be an error, although the opposition succeeded for “clothing for men and boys”, giving rise to an issue of how the partially successful application should be amended. Mann J referred to the decision of Mr Richard Arnold QC sitting as the Appointed Person in *Sensornet* [2007] R.P.C. 7, and went on to consider how a fair specification was to be achieved in cases of partial opposition. Mann J held at paragraph 53 that:

“Since this case was one of partial opposition (in terms of the goods covered), Article 13 requires that there be registration of the mark in relation to goods in relation to which the mark was not opposed. The available procedures should enable that to be done fairly and efficiently.

...

The object of the exercise is to find a mechanism which enables the dispute to be decided and which gives effect to the decision in a fair way. I emphasise fairness. The object is not to give effect to technicalities which give rise to absurd results. Thus it would be absurd to require an applicant faced with limited opposition to propose an unconditional amendment application at an early stage to reflect the lesser position ... if his case is (as it is likely to be) that the limited opposition should fail.”

48. The TPN therefore seeks to provide such a mechanism. For defended oppositions it provides:

#### **“Defended Proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the

decision of the Hearing Officer will take that rewording into account and the proposed wording being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer will indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services."

49. The principle underlying Mann J's decision is to reflect the requirement of Article 13 of the Directive that where grounds for refusal of registration exist in respect of only some of the goods or services which that trade mark has been applied for it should be refused registration for those goods or services only; that is a process which the examiner or Hearing Officer may undertake, in the manner indicated in TPN 1/2011. As Dr Saunders conceded, the problem with relying on TPN 1/2011 (and on Mann J's judgment) so far as MIP is concerned is that unless I find that the Hearing Officer erred in rejecting the whole of MIP's challenged specification, this is not a case of 'partial revocation'. The Hearing Officer had not found that 'the proceedings should only succeed in part' nor were the proceedings 'directed against only some of the goods/services covered by the trade mark' – here all of the specification in Classes 16 and 41 were refused registration. I have rejected MIP's appeal against that finding and in those circumstances, the TPN does not apply.

50. Section 39 of the Act, by contrast, provides an applicant with a mechanism to make voluntary amendments to the application "whether in the hope of side-stepping an objection or for other reasons" (according to Mr Arnold QC in *Sensornet*) and such an application to amend may be considered even at the appeal stage of an opposition, in appropriate circumstances. The factors which should be borne in mind when such an application is made at so late a stage have been considered in a number of cases before the Appointed Person, for example by Mr Geoffrey Hobbs QC in *Citybond trade mark* [2007]

R.P.C. 13 and most recently by Mr Daniel Alexander QC in BL O/410/11 and O/468/11, *Multisys*. In *Citybond*, Mr Hobbs QC held at paragraph 15: “it is both permissible and appropriate for the purposes of Art. 13 to require the objector on the one hand and the proprietor of the relevant application ... on the other to be pro-active in pursuit of their respective interests and concerns ...” He concurred with the views expressed by Mr Arnold QC in *Sensornet* that the power that the registrar possesses to give effect to legitimate requests for the adoption of narrower wording, to eliminate legitimate objections, should be invoked sooner rather than later in the proceedings.

51. *Multisys* too was not a case of partial revocation falling within the ambit of TPN 1/2011, for the applicant was liable to lose the whole of its application in Classes 9 and 42, unless a suitable amendment was made. The applicant had been offered an opportunity to amend by the Hearing Officer, which it had refused, but as the applicant claimed to have been using its mark in relation to a narrower range of Class 42 services, the issue was whether it could limit its application to cover those services alone, to avoid there being a likelihood of confusion. No offer to amend the specification was made until the hearing of the appeal. Mr Alexander QC considered whether it was right to consider a ‘fall-back position’ at all (see paragraphs 73-88 of decision O/410/11) and decided to defer a final decision on refusal of the mark in Class 42 pending the supply of sequential written submissions about any narrower specification sought. After such submissions had been made, Mr Alexander QC produced a supplementary decision O/461/11 in which he set out at some length the factors for and against the admission of a revised specification at the appeal stage, concluding that the principles to be applied are:

#### **“Principles**

25. In my view, the principles applicable to consideration of fall-back positions by the Appointed Person for the first time may be summarised as follows.

26. First, there are no fixed rules as to how the tribunal should deal with fall-back specifications advanced at a late stage of proceedings and, specifically, for the first time on appeal to the Appointed Person. Each case must turn on its facts, having regard to the overall objective of achieving justice between the parties and with due regard to the public interest.

27. Second, particularly where a broad specification is in issue in opposition proceedings, the proprietor should consider whether a narrower specification would be less susceptible to objection and should put any such alternative forward for consideration at the earliest opportunity in the opposition proceedings so that it can be considered in the first instance by the Registrar. It should do so with regard to

Tribunal Practice Notice 1/2011. Applicants should not think that they will, in general, be able to get away with uncompromising defence of wide specifications until the last minute in the expectation that they will be allowed to narrow down to something permissible in the end.

28. Third, in some cases, it will be so obvious that a narrower specification is allowable that no sensible procedural objection could be taken to it being considered, even at a late stage. In some cases, of which *m.d.e.m* is an example, justice requires that such be done. In others, a narrower specification may give rise to more complex questions, including a need for evidence. In such cases, particularly where a fall-back position is presented for the first time at a late stage of proceedings, such as on a final appeal, the tribunal may be justified in refusing to consider it.

29. Fourth, in considering whether to admit it, the factors identified in the arguments for and against set out above are relevant and may have greater or lesser weight in any given case. Of particular weight is any prejudice likely to be suffered by one party or the other from considering or refusing to consider a fall-back position and any available alternative routes for the proprietor to obtain effective trade mark protection. The later a fall-back position is proposed and the less opportunity for considered objection given to an opponent, the more clearly must the fall-back position be allowable for there to be no risk of prejudice."

52. In the present case, MIP still has not produced a draft of any proposed amended specification and neither I, nor Associated, know whether the goods listed in the last paragraph of Dr Saunders' skeleton argument represented a list of goods for which registration might be sought, or were just examples taken from the long list annexed to his skeleton argument of goods made from paper which he said were dissimilar to "printed publications." If an amended specification is to be produced, therefore, this will either involve an exchange of further written submissions on the appeal, as happened in *Multisys*, or will involve the matter being remitted to the Registry.

53. In the circumstances, it seems to me that the factors which may be said to be in favour of permitting MIP to propose an alternative specification are that

- a. It seems clear that there must be some goods made from paper which are not "printed publications" and it is possible that some such goods are of commercial interest to MIP. However, it cannot be said that it is "obvious" that an amended specification would be unobjectionable, because MIP has given no indication of what goods would be comprised in any amended specification.
- b. It is possible that any goods which MIP may seek to include in an amended specification would be in the nature of those listed in the last paragraph of Dr Saunders' skeleton argument, which are everyday consumer goods, such that it

should not be necessary to have any evidence as to whether such goods are similar to the goods in Associated's specification.

54. On the other hand, there are plainly a number of factors which would militate against permitting MIP to pursue an amendment at this stage;

- a. Clearly had MIP wished "to contend that a narrower specification is allowable" it could have done so and should have done so long ago. This application has been proceeding in the UKIPO since November 2007, and the opposition was filed as long ago as 4 February 2008. Mr Mead's evidence was filed in September 2009 and from that date at the very latest MIP must have known that "goods made from paper" was at risk because his evidence clearly showed substantial use of Associated's mark for newspapers, if nothing else.
- b. Moreover, MIP should (I think) have been aware of the risk that Mr Bryant would find the goods to be identical, given the previous oppositions relating to various 'Metro' marks to which I have referred above.
- c. No fall-back position was formulated by the time of the hearing before Mr Bryant in late 2010, and none has been formulated still, although his decision was handed down in July 2011.
- d. The possibility that such a fall-back position would be taken was not raised in the Grounds of Appeal but only in the last paragraph of Dr Saunders' skeleton argument, giving Associated minimal notice of the point.
- e. MIP has had the benefit of specialist advice throughout. It seems likely, therefore, that a deliberate decision was taken not to raise the point until the last moment.
- f. Dr Saunders conceded that the TPN (at least) would apply only if I found that the Hearing Officer had erred, which is not the case.
- g. There is not an obvious fall-back position here. This is not a case like *Multisys* in which the applicant wishes to reflect in its amended specification the past use of the mark shown in its evidence. MIP filed no evidence on the revocation or opposition and I have no idea whether or for how it has been using the mark in the UK, nor what goods made from paper may or may not be of commercial interest to it, such that it would be able to show an intention to use the mark across the amended specification.
- h. If further submissions are made now, dealing with any application to amend the specification, Associated would be prejudiced in costs, unless I were to order costs to

be paid on an indemnity basis. It would also lose the usual protection of having the amended specification scrutinised by both a specialist first-instance tribunal and on appeal, unless I were to remit the issue to the Registry, something I would be reluctant to do, given the 'antiquity' of this application.

55. This seems to me to be a case in which (as Mr Alexander QC put it) MIP put forward an 'uncompromising defence' of its wide specification until the last possible moment, only tossing in the mere possibility of amending its specification, in an unspecified way, as a final point on the appeal. Even bearing in mind the provisions of Article 13 of the Directive, and the comments of Mann J in *Armani*, I have concluded that in the circumstances of this case it would be inappropriate, and unfair to Associated, to permit MIP to extend this opposition by seeking to amend its specification at this late stage. On this point too, the appeal fails.

#### **Costs**

56. It was common ground between the parties that the costs of the appeal should follow the event and reflect the usual scale. I therefore order MIP to pay a contribution of £1500 to Associated towards its costs of the appeal, in addition to the costs ordered to be paid to it by Mr Bryant. The costs of the appeal are to be paid by 5 pm on Thursday 26 April 2012.

Amanda Michaels  
11 April 2012

DR. NICHOLAS SAUNDERS (instructed by Messrs. Wilson Gunn) appeared on behalf of the Appellant/Applicant.

MR. ADRIAN SPECK (instructed by Messrs. Bird & Bird) appeared on behalf of the Respondent/Opponent.