

O-173-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION No. 1291921  
IN THE NAME OF PEDIGREE DOLLS AND TOYS LIMITED**

**AND**

**IN THE MATTER OF AN APPLICATION FOR REVOCATION  
THERE TO UNDER No. 81167  
BY WARNER BROTHERS ENTERTAINMENT, INC.**

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No. 1291921 in the name of Pedigree Dolls and Toys Limited**

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**IN THE MATTER OF an Application for Revocation  
thereto under No. 81167  
by Warner Brothers Entertainment, Inc.**

**BACKGROUND**

1. On 6 February 2003, Warner Brothers Entertainment, Inc., made an application for revocation of trade mark registration number 1291921, for the mark WILLIE WONKA, standing in the name of Pedigree Dolls and Toys Limited. The registration is in Class 16 and in respect of the following specification of goods:

Printed matter, printed publications, story books, colouring books, comics, cartoons, magazines, journals; articles of stationery; adhesives; artists' materials; paper, paper articles, cardboard, cardboard articles; paint brushes; instructional and teaching materials (other than apparatus); playing cards; all included in Class 16.

2. The application for revocation is made under Sections 46(1)(a) and 46(1)(b) and is expressed as follows:

that within a period of five years following the date of completion of the registration procedure, the mark has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which it is registered, and there are no proper reasons for non-use.

that such use has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use.

3. On 12 June 2003, the registered proprietors filed a counterstatement in which they deny the grounds on which the application is made.

4. Both sides seek an award of costs. Both sides filed evidence.

5. The matter came to be heard on 26 and 27 July 2004, when the registered proprietors were represented by Mr Guy Tritton of Counsel, instructed by Marks & Clerk, their trade mark attorneys. The applicants for revocation were represented by Mr Thomas Moody-Stuart of Counsel, instructed by Field Fisher Waterhouse, their trade mark attorneys.

**REGISTERED PROPRIETORS- EVIDENCE-RULE 31(2)**

6. This consists of a Witness Statement dated 11 June 2003, by Jerimy George Reynolds, Director and Chief Executive of Pedigree Dolls and Toys Limited, a position he has held since December 1985. Mr Reynolds says that he is directly involved in the day to day business affairs of his company and its associated companies, and is responsible for trade mark and other affairs.

7. Mr Reynolds says that the registered proprietors' use of WILLIE WONKA has been partly in relation to goods described as 'Willie Wonka Fun Packs', which consist of children's books in the form of an annual based on a particular character, with an accompanying video tape or toy/plaything on the same theme as the annual. These are packaged in various styles with a representation of their stylised WILLIE WONKA mark on the front. Mr Reynolds says that his company, through its authorised user, Pedigree Books Limited, has over the past ten years built a substantial business in the UK in relation to the goods covered by the trade mark registration.

8. He refers to exhibit JGR1 which consists of a leaflet entitled 'Pedigree 2001' detailing various publications. An inner page bears the title WILLIE WONKA in a multi-coloured, stylised lower case script, showing various annuals and boxes, the front depicting a character such as Noddy, Action Man, Sindy etc, with the words WILLIE WONKA in the bottom left-hand corner in the same script as the title, and PEDIGREE in the bottom right. A chart on the reverse shows these to have publication dates ranging from April to October 2001. Some of the annuals are stated to be the 2002 edition, but are shown to have publication dates within this range.

9. Exhibit JGR2 consists of an order form for Pedigree Books products, listing, inter alia, WILLIE WONKA fun packs, listing these as 'Sindy Annual 2001 + Doll', 'Shoot Annual 2001 + Ball' and 'Fox Kids Annual 2001 + Video'. Exhibit JGR3 consists of a Mr Reynolds' business card which amongst others has the WILLIE WONKA name on the reverse. Mr Reynolds says that this has been the practice for some 5 years.

10. Mr Reynolds recounts his company having relocated to new premises, and to records having been mislaid or destroyed during the move. He refers to a collection of invoices which he exhibits as JGR4 to JGR10. These relate to:

238 WILLIE WONKA Mixed Magic Pads sold to W H Smith Wholesale on 3 December 1996,

90 WILLIE WONKA Mixed Magic Pads sold to Eason & Son Ltd on 3 December 1996,  
12 WILLIE WONKA Power Rangers Magic Pads sold to Johnsons News of Luton on 31 January 1997,

23 WILLIE WONKA Mixed Magic Pads sold to T Cox & Son on 30 July 1997

9 WILLIE WONKA Action Man Magic Pads sold to Robell Research (UK) Ltd on 30 September 1997,

50 WILLIE WONKA Fun Packs-Rupert Annual 2001 + Video, and 10 WILLIE WONKA Fun Packs-Sindy Annual & Doll, sold to Sainsburys, Shirley on 31 October 2000,

60 WILLIE WONKA Fun Packs-Noddy Annual 2001 + Tape, sold to Sainsbury's, Sevenoaks on 31 December 2001,

11. Exhibit JGR11 consists of leaflets showing various WILLIE WONKA toys and games that Mr Reynolds says was issued to the trade at the end of 2002. The pages themselves are undated. Mr Reynolds does not give any details of the numbers issued, or where and how they were distributed.

12. Mr Reynolds says that his company has a business relationship with Remus Playkits, a German based company, stating that during 1999, various categories of goods from their range were consolidated under his company's WILLIE WONKA mark. He refers to exhibit JGR12 which he describes as a bundle of pictorials reflecting the various products, namely colouring and activity books, that were intended for this range under the WILLIE WONKA trade mark. It appears that apart from test sampling with various retailers these products did not get into production.

13. Mr Reynolds continues saying that for some years, the Pedigree Group, and in particular, Pedigree Books Limited, has managed Sainsbury's Annuals business, and had been looking to extend this into other areas including the use of dedicated brands. He recounts having made a presentation to the Sainsbury's management in the Spring/Summer of 2002, exhibit JGR13 being a visual extract from the presentation. Mr Reynolds highlights that the WILLIE WONKA mark featured in this presentation. The exhibit consists of a display stand, the main section headed 'Sainsbury's - Bookmark Children's Library', a side section bearing the name WILLIE WONKA on the top, and WILLY WONKA several times along the side. The exhibit itself cannot be dated. Exhibit JGR14 consists of an identical display that Mr Reynolds says was used in a similar presentation to Morrisons in the same year.

#### **APPLICANTS- EVIDENCE-RULE 31(4)**

14. This consists of two Witness Statements. The first is dated 21 September 2003, and comes from Ian Peter Thomas, Managing Director and part owner of Jani-King (GB) Limited, the regional office of Jani-King International, Inc. Mr Thomas says that 11 years ago he founded Jani-King (GB) Limited, a franchise company. Mr Thomas's Statement consists entirely of comments on the Statement made by Mr Reynolds, primarily on the reasons why Mr Reynolds' company did not proceed with the production of the products in conjunction with Remus Playkits. Whilst I do not consider it appropriate to summarise these statements, I will take them fully into account in my decision.

15. The second Witness Statement is dated 18 September 2003, and comes from Jacqueline Lake, an investigator with Farncombe International Limited, a position she has held since 1986.

16. Ms Lake recounts having been provided with a copy of Mr Reynolds' Statement, and being instructed to investigate certain statements made by Mr Reynolds. She first goes to the use of the mark in relation to WILLIE WONKA fun packs. Ms Lake recounts having conducted a search of the Internet, and whilst she did find annuals, some with accompanying toys relating to characters mentioned by Mr Reynolds (exhibits JL1, JL2 and JL3) she did not locate any of the fun packs.

17. Ms Lake says that she made a direct approach to the proprietors and was told by an un-named employee that they had not produced WILLIE WONKA fun packs recently and had none in stock. The employee is also said to have confirmed that Pedigree did not have any 2001 annuals available.

18. Ms Lake goes on to give an account of her contacts with Sainsbury's to investigate Mr Reynolds' claims, stating that representatives from the stores in Shirley and Sevenoaks could not recall WILLIE WONKA FUN PACKS being sold in these stores, although one could remember representatives of Pedigree coming to the store with books and other items. Ms Lake states that she contacted Sainsbury's head office to enquire about the presentation Mr Reynolds is said to have made, stating that she was told that the person to whom the presentation would have been made had left the company, and that enquiries made by a member of the Sainsbury's legal department did not find anyone who recalled the presentation. Similar investigations with Morrisons confirmed that a presentation had been made at 11am on 28 May 2003, and that the exhibit shown as JGR14 formed part of the presentation.

## **REGISTERED PROPRIETORS- EVIDENCE- RULE 31(6)**

19. This consists of a further Witness Statement, dated 19 December 2003, by Jeremy George Reynolds. The Statement consists of submissions responding to the comments made by Ms Lake and Mr Thomas. Whilst I do not consider it appropriate to summarise these submissions in detail, I will take full account of them in my decision.

20. Mr Reynolds states that the presentation said to have taken place on 28 May 2003 was but one of a number of contacts. He questions the quality of Ms Lake's investigations suggesting that it is selective, and that full disclosure of the results of her investigations should have been made. Mr Reynolds questions the standing of Mr Thomas to give evidence relating to non-food markets.

## **APPLICANTS- EVIDENCE-RULE 31(7)**

21. This consists of Witness Statements by Leighton John Cassidy, and Rachel Li-Mei Tan.

22. The first Witness Statement by Mr Cassidy is dated 22 March 2004. He states that he is a New Zealand qualified Barrister and Solicitor, and is employed by Field Fisher Waterhouse as a paralegal in the Trade Mark and Brand Protection Group of that firm.

23. Mr Cassidy refers to his having undertaken internet searches into the range of toy and games manufacturers in the UK, details of which are shown as exhibits LJC1, LJC2 and LJC3, the aim being to show that after the demise of Remus Playkits the registered proprietor could have sourced products from elsewhere. He goes on to refer to further investigations conducted via the Companies House website, and the individual company's own websites, the results of which are shown as exhibits LJC4 to LJC24. These, not surprisingly, show that there are numerous toy and game manufacturers from which the registered proprietors could have sourced alternative products.

24. Mr Cassidy's second Witness Statement is dated 18 March 2004. He refers to exhibit JGR13 to Mr Reynolds' Statement, in particular, to the books depicted on the display. He recounts a telephone call to the publishers of some of the books, stating that he was told that these were first published between September and December 2002, post-dating the date that Mr Reynolds says that the display dates from. By way of confirmation, Mr Cassidy refers to exhibits LJC25 to LJC28, which consist of prints taken from the Amazon UK website.

25. The final Witness Statement is dated 18 March 2004, and comes from Rachel Li-Mei Tan, a solicitor with Field Fisher Waterhouse in the Trade Mark and Brand Protection Group of that firm.

26. Ms Tan refers to Mr Reynolds' criticism of Ms Lake's investigations and the absence of the full reports, in response exhibiting RLT1 which consists of a copy of Ms Lake's reports dated 28 August 2003 and 15 September 2003. Ms Tan refers to paragraph 2.1 of the report dated 28 August 2003 in which Ms Lake mentions investigations dated 12 December 2002, saying that the earlier investigations have no bearing on the contents of Ms Lake's Statement of 18 September 2003.

**REGISTERED PROPRIETORS- FURTHER EVIDENCE RULE 31(8)**

27. This consists of two Witness Statements. The first is dated 6 July 2004, and comes from Jeremy George Reynolds.

28. Mr Reynolds responds to the implied assertion by Mr Cassidy, that four of the book titles appearing on the display stand (JGR13) used in the presentations to Sainsbury's were published after the date that the presentations were said to have taken place. He states that it is common practice for publishers to promote new titles some months prior to publication. He says that these thumbnail images are used as part of this process, the thumbnails being available on the Internet and are routinely extracted by traders for use in presentations. Exhibits JGR15 to JGR17 consist of three thumbnails extracted by Mr Reynolds from a website on 8 June 2004, all shown to have a publication date in October 2004. Mr Reynolds says that the images used in exhibit JGR13 are digital images of point-of-sale units that were prepared by Mr Geoffrey Reynolds for use in mock-ups for the presentation at Sainsbury's in Spring/Summer 2002.

29. Mr Reynolds continues saying that during the ongoing sorting of historical records, two further invoices were discovered. These are shown as exhibits JGR18 and JGR19, and relate to sales of Wonka fun packs to two Sainsbury's stores in November and December 2001.

30. The remainder of Mr Reynolds' Statement consists of submissions on the evidence filed by the applicants. Whilst I do not consider it to be appropriate or necessary to summarise these I have read them and will take them fully into account in my decision.

31. The final Witness Statement is dated 7 July 2004, and comes from Michael Stamp, National Accounts Director for Pedigree Books Limited, a position he has held since 1 January 2001, having worked within the sales industry for 32 years.

32. Mr Stamp says that leading into 2002, Pedigree noticed a niche market opportunity within supermarkets for managing and upgrading their book and stationery sections. He says that he was asked to be personally responsible for arranging meetings and presentations, confirming that the meetings mentioned by Mr Reynolds did take place and that he assisted in gathering the evidence filed by Mr Reynolds. Specifically, Mr Stamp says that he initially made a pitch for business during a meeting with Mr Martin Weeks on 25 May 2002, and subsequently, he and

Mr Reynolds made a full presentation to Mr Weeks on 26 July 2002. Mr Stamp exhibits a copy of his diary at MS1, referring to the entry for the presentation meeting with Mr Weeks. Exhibit MS2 consists of a copy of the minute that Mr Stamp says he prepared following the meeting with Morrisons.

33. Mr Stamp goes on to refer to three meetings he attended with Sainsbury's on 4 and 23 September 2002, and 19 November 2002. Exhibit MS4 consists of an extract from his diary relating to the 19 November 2002 entry. Exhibit MS5, MS6 and MS7 consist of copies of the minutes that Mr Stamp says he prepared following the meetings.

34. That concludes my review of the evidence insofar as it is relevant to these proceedings.

### **PRELIMINARY ISSUES**

35. Prior to the hearing the parties had raised four issues that were to be discussed prior to the substantive issues being heard.

### **FURTHER EVIDENCE**

36. The applicant for revocation sought to adduce additional evidence under the provisions of Rule 31(8). This consisted of two Witness Statements by Jerimy George Reynolds, a Witness Statement by Steven Richards, Publishing and Business Development Director of Pedigree Books Limited, a Witness Statement by Geoffrey Reynolds, and a Witness Statement by Michael Stamp.

#### **Jerimy George Reynolds.**

37. Both of Mr Reynolds' Witness Statements are dated 6 July 2004. The shorter Statement consists of submissions on the registered proprietors' evidence and the merits of the case. I deemed it to add nothing of substance to the case and declined to admit the Statement.

38. The longer of Mr Reynolds' Statements included three further exhibits, JGR15 to JGR19, that went, inter alia, to the availability of the images of certain books prior to their date of publication. This is a question central to the registered proprietors' claim to have used the mark and the Statement was duly admitted, but on the direction that the applicants would be allowed two months from the date of the hearing in which to file any evidence that they may wish to adduce in reply. They did not file any such evidence. I have summarised Mr Reynolds' Witness Statement above.

#### **Stephen Richards**

39. This Statement added nothing new to the case and was not admitted.

## **Geoffrey Reynolds**

40. This Statement added nothing new to the case and was not admitted.

## **Michael Stamp**

41. The Statement provided corroborative evidence that went to establishing that the presentations made to Morrisons and Sainsbury's had taken place. The Statement exhibited a copy of Mr Stamp's diary showing appointments with representatives of these two organisations. The question of whether or not these presentations took place is central to the registered proprietor's claim to have used the mark. The Statement was duly admitted but on the direction that the original diary be made available for inspection by an expert who would provide a report on the authenticity of the entries within two months of the date of the hearing. The registered proprietors were allowed two months from the date of the receipt of the report in which to file any evidence that they may wish to adduce in reply. I have summarised Mr Stamp's Witness Statement above.

42. The applicants for revocation submitted a two-part report from Robert W Radley, a Forensic Handwriting and Document Examiner on 27 September 2004. The registered proprietors provided their reply evidence in the form of a report by Riley & Welch, Forensic Document Examinations Inc, and a second Witness Statement by Mr Stamp, received on 27 October 2004. I will not summarise the forensic handwriting reports but will incorporate their findings in my decision.

## **DISCOVERY**

43. In her Witness Statement dated 18 September 2003, Jacqueline Lake, an investigator with Farncombe International Limited stated that on 3 July 2003 she had been provided with a copy of the Witness Statement of Jerimy George Reynolds and instructed to conduct investigations relating to certain statements made by Mr Reynolds. In her report shown as exhibit RLT1 to the Witness Statement by Ms Tan, the applicants' representative in these proceedings, Ms Lake made reference to investigations that took place on 12 December 2002 although no report of these investigations has been exhibited.

44. The registered proprietors sought disclosure of the first report; the reason for the request being set out in the letter of 8 July 2004 from Marks & Clerk. The registered proprietors considered the report to be relevant, and whilst acknowledging that there is no general obligation to disclose, argued that it was not acceptable for the applicants to disclose part of their investigations. The applicants stated that they placed no reliance on the report and resisted the disclosure request. That the applicants did not intend to rely on the report had little bearing on my decision whether disclosure should be ordered.

45. The registered proprietors believed that the report may contain information adverse to the applicants' case. Mr Tritton stated that it was not that the registered

proprietors thought Ms Lake's initial investigations had revealed otherwise hidden use of the mark that they could rely on, but rather that Ms Lake's subsequent reports inferred that the meetings with the supermarkets did not actually take place. I took the view that there was sufficient evidence on this point already on file and that the investigations into Mr Stamp's diary negated the need for any further enquiry. I could not see any benefit in having the report admitted and the request for disclosure was denied.

### **STRIKING OUT**

46. The registered proprietors had requested that certain parts of the applicants' reply evidence be struck out as not being in reply. Mr Tritton stated that on the basis that I had earlier admitted the broad totality of the registered proprietors' further evidence, he did not intend to press for the striking out.

### **ADJOURNMENT**

47. This case is one of four revocations running concurrently. The parties had requested that I adjourn two of the actions relating to classes 16 and 28, and subsequently the remaining two cases in Classes 3 and 25. I determined that the additional evidence that had been admitted, and the evidence that may result from a forensic examination of Mr Stamp's diary dealt with the concerns of the parties and would be sufficient to enable the issues to be determined. I could see no reason to adjourn any of the proceedings and the request was refused.

### **DECISION**

48. The statutory provisions of Section 46 under which this application has been made are as follows.

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer to the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date."

49. Section 100 is also relevant. It reads:

"**100.**- If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

50. The mark was placed on the register on 19 May 1989, which means that the relevant period for consideration of the attack under subsection (a) is from that date to 18 May 1994, and under subsection (b), any five year period between 18 May 1994 and the date of the making of the application for revocation, in this case, 6 February 2003, in both cases subject to the proviso in subsection (3).

51. The first question is whether the evidence shows there to have been any genuine use of the mark in relation to the goods for which it is registered? In Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 the European Court of Justice considered the question of what constitutes *genuine use* in the following terms:

"Genuine use must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others that have another origin."

52. The *Ansul* decision stated genuine use entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. Such use must be in relation to goods or services that are already on the market, or about to be marketed and or for which preparations are underway to secure customers, for example, advertising. The assessment of whether there has been genuine use must take into account all of the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, and may include giving consideration, inter alia, to the nature of the goods or services at issue, the characteristics of the market concerned, and the scale and frequency of use; the use need not always be "quantitatively significant" for it to be deemed genuine.

53. In the *Police* trade mark case [2004] RPC 35, the Appointed Person considered that the *Ansul* judgement did not limit the factors to be taken into account in establishing whether use was genuine only to the three areas specifically mentioned. The judgement had stated that all facts and circumstances relevant to establishing whether there had been real commercial exploitation should be included in the equation, and that the size of a proprietor's undertaking may be relevant.

54. Further guidance on the scale and frequency of use can be found in *La Mer Technology Inc v Laboratoire Goemar SA*'s trade mark case 2004 WL 2945720. This is the decision of a resumed appeal hearing following a reference to the ECJ on various questions relating to the meaning of "genuine use". In his decision Blackburne J stated:

"31. Whether in any given case the proven use amounts to genuine use ("whether the commercial exploitation of the mark is real" as paragraph 38 of *Ansul* puts it) will depend on all of the facts and circumstances relevant to establishing such a state of affairs, including the characteristics of the market concerned and of the products or services in question, and the frequency or

regularity of use of the mark. Even minimal use will be sufficient if, in the market concerned, the proven use is considered sufficient to preserve or create a market share for the goods or services protected by it. Thus, the sale or offering for sale (in, say, a trade magazine) of a single exceedingly costly and highly unusual item carrying the mark in a specialised market, for example a very large and complex piece of earth-moving equipment, may very well be considered by itself to be sufficient in the market for such equipment to preserve or create a market share for items of that kind which carry the mark whereas the sale of a low priced everyday product in a widespread market, for example a single jar of face cream bearing the mark or the exposure for sale of, say, half a dozen such jars for sale on a shop shelf, would almost certainly not be. It would be irrelevant to this conclusion that, in the latter example, the purpose of the proprietor of the mark (or of some third-party acting with the proprietor's consent) when offering the jar of cream for sale was to create a share in the market for face cream sold in jars bearing the mark."

55. Mr Justice Blackburne referred back to the decision of Jacob J in the earlier part of the appeal:

"15. Jacob J himself ventured an answer to those questions. At paragraph 29 of his judgment ([2002] FSR 51 at 293) he said this:

"I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to "genuine" use. There is no lower limit of "negligible". However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely "colourable" or "token", that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further enquire whether that advertisement was really directed at customers here. ...

Nor do I think that the absence of a *de minimis* rule significantly affects the policy behind the legislation. Yes, marks must be used within the relevant period, but there seems no reason to make a trader who has actually made some small, but proper, use of his mark, lose it. Only if his use is in essence a pretence at trade should he do so. And of course, if he has only made limited use of his mark it is likely that the use will be only for a limited part of his specification of services. If he has a wider specification, that can and should be cut back to just those goods for which he has made use ..."@

56. The evidence of use on file is thin to say the least, and much of what there is suffers from a number of defects. Exhibit JGR1 is a leaflet for the Pedigree 2001 range. An inner section is headed WILLIE WONKA in lower-case and a slightly stylised font represented in multiple colours, but is still clearly the mark as registered, or certainly a form not differing in substance. Beneath this title can be seen the words AUnique book and Toy combinations@and depictions of various products

incorporating a children's annual with either a dressing-up outfit, doll, audio cassette, sports timer, wristwatch or a Pokemon or dragon figure. All bear the same WILLIE WONKA mark and the Pedigree name.

57. The exhibit contains a loose-leaf page headed with the WILLIE WONKA name represented in the same manner. On the left of the page is a depiction of the same products as previously mentioned. The right hand side of the page shows similar packs for Noddy, Pokemon, Action Man and Digimon, and at first glance gives the impression that these are part of the WILLIE WONKA range. However, on closer inspection it can be seen that unlike the products on the left-hand side they do not bear the WILLIE WONKA name. These packs are depicted on the main leaflet under the heading of MAGIC SOUND.

58. In cross-examination Mr Moody-Stuart put it to Mr Reynolds that these packs were not WILLIE WONKA products. Mr Reynolds conceded that they were not and although unclear on how they came to be represented in this way, tendered the suggestion that the sheet had been constructed from the main leaflet and the images blown up to be helpful to the applicants. I am concerned that evidence has been presented in proceedings without any indication that it has been constructed. Mr Reynolds says that this was done because the original images were small, but as far as I can see the images on the main leaflet and those on the loose-leaf page are, if not the same, very close in size. The main leaflet has three columns yet the page only shows two, the one in the middle having been deliberately excluded, as has the MAGIC SOUND title. And how did WILLIE WONKA come to appear on the top of the page? Mr Reynolds does not know. If, as Mr Reynolds says the intention was to increase the size to make the WILLIE WONKA products more apparent, why not just enlarge the whole page or relevant part of the page? It has obviously been carefully constructed and I am left to ponder the suggestion made by Mr Moody-Stuart, that far from it being an error as Mr Reynolds says, this is, in fact, a calculated attempt to expand the range of goods upon which the mark has been used.

59. Setting this aside, the main leaflet depicts eight WILLIE WONKA packs, the final page consisting of an order form. In cross-examination Mr Reynolds stated that of the eight products shown under the WILLIE WONKA name, only two, the Action Man and Sindy packs were actual products, the remainder being mock-ups for presentation to the trade. Mr Reynolds explained that his company may sell products either as WILLIE WONKA fun packs, or as separate items according to the demands of the customers. This explanation would be consistent with the order form which lists products such as ANoddy Annual 2002 and sound unit@under the heading APedigree Magic Sounds and Willie Wonka@, and also as ANoddy Annual 2002 and read-along tapes@under APedigree Willie Wonka@.

60. Exhibit JGR2 consists of an order form listing three products under WILLIE WONKA: Sindy Annual 2001 and doll, Shoot Annual 2001 and ball, and Fox Kids Annual 2001 and video. Under examination Mr Reynolds stated that these three products were all WILLIE WONKA fun packs. By a comparison of the product codes on the order form and those shown on the invoices exhibited, Mr Moody-Stuart

asserted that only one, the Sindy Annual had actually been sold as a WILLIE WONKA fun pack. Mr Reynolds agreed that this was the case but reiterated that all three had been presented to the trade as being available as WILLIE WONKA fun packs or individual products. The invoices shown in other exhibits confirm the sales of WILLIE WONKA fun packs but do not add anything further.

61. On the basis of this evidence I am content that the registered proprietors have at least offered children's annuals in conjunction with playthings for sale in the UK under the name WILLIE WONKA, an act that of itself constitutes use (*ELLE* [1997] FSR 19), and have actually sold a limited number of these goods. Whatever the motive that led to the construction of the page inserted into JGR1 (even if genuine it would not have furthered their case) I see no reason to consider either of these actions were anything other than part of a genuine trade. As Mr Tritton stated, the decision in *Laboratoire de la Mer* [2004] ETMR 47 indicates that if the use is part of a genuine commercial trade, the limited extent of the actual sales is of no consequence.

62. The registered proprietors refer to a relationship with a company trading under the name Remus Playkits, stating that in 1999 various categories of goods from their range were consolidated under the WILLIE WONKA name. Exhibit JGR12 consists of a bundle of pictorials that Mr Reynolds says reflect the products that were intended for the range, and that these were presented to a number of retailers in the UK, but beyond test sampling did not materialise into actual products. Remus went into Administrative Receivership in mid 2002. In cross-examination Mr Reynolds suggested that the demise of this relationship was the cause of the mark not having been put into use in relation to these goods. Mr Moody-Stuart pointed to the evidence that showed that the proprietors had used the mark in relation to WILLIE WONKA magic pads before Remus had come onto the scene, asserting that there was no good reason why they could not have done so again. In his answer Mr Reynolds stated that technically there was no reason, but that commercially there may be a different answer. I am not sure what Mr Reynolds is saying. It may well be that he is referring to the unworkable pricing structure mentioned in his evidence, but whatever, I can only interpret his answer as confirmation that with Remus gone, Pedigree did not take any steps to try and get these goods onto the market, and that the reasons for non-use are entirely down to them.

63. This brings me to the presentations that the registered proprietors say were made to Morrisons and Sainsbury's supermarkets. The evidence resulting from Ms Lake's investigations cast doubt upon whether these presentations had in fact taken place. The proprietors responded by filing additional evidence from Michael Stamp, National Accounts Director for Pedigree Books Limited. Mr Stamp says that he had arranged the presentations and exhibited a copy of his diary containing entries relating to these events. The applicants challenged the authenticity of the entries and engaged an expert to examine the diary. The registered proprietors did likewise.

64. Both experts highlight that parts of the relevant entries have been written in different inks, and at different times although cannot be precise about the timing. Is this surprising? There seems nothing out of the ordinary for a diary to have entries

made and later amended or added to, or for appointments to be entered out of chronological sequence, and whilst there may be some suspicion about the disproportionate use of the ink type used in the presentation entries, the expert cannot be conclusive. There is no dispute that the writing is that of Mr Stamp.

65. In her evidence, Ms Jacqueline Lake, says that she contacted Sainsbury's and Morrisons to find out whether anyone could recall the registered proprietors having made presentations. The investigations with Sainsbury's revealed that in December 2000, the registered proprietors had been to Sainsbury's in Sevenoaks with books and other items, but not that this was in relation to WILLIE WONKA branded goods. The Morrisons investigations confirmed that a presentations had taken place but this was after the relevant date in these proceedings.

66. The only information relating to the actual presentations to Sainsbury's and Morrisons consists of what Mr Reynolds calls a 'visual extract', examples of which are shown at exhibits JGR13 and JGR14. These exhibits consists of images of point-of-sale display stands for a range of books. The Sainsbury's stand consist of a large centre section headed 'Sainsbury's- Bookmark Children's Library'. Either side of this is a smaller stand, both with the same header, the right side having the additional title 'Sindy' reflecting the books in that section, with the left-hand side bearing the heading WILLIE WONKA with the words WILLY WONKA repeated vertically along the side of the stand although strangely the spelling is WILLY WONKA rather than WILLIE WONKA. Apart from the use of the supermarket name, the Morrisons stand is identical.

67. In his evidence Mr Cassidy asserted that four of the book titles appearing on the display stand were published after the date that the presentations were said to have taken place. In response Mr Reynolds stated that it is common practice for publishers to promote new titles some months prior to publication. Thumbnail images of the covers are used as part of this process and are available on the Internet and routinely extracted by traders for use in presentations. The question of the authenticity of these digital images was pursued at the hearing. Whether they were or were not available as Mr Reynolds says is a question of fact. I allowed the applicants one month in which to conduct investigations and file any evidence on this point. In their letter of 24 August 2004, the applicants=representatives gave notice that they would not be filing any evidence. In the circumstances I see no reason to doubt Mr Reynold's evidence relating to the availability of the digital images.

68. The digital images appear to have been available for use even if the books had not yet reached the shelves. Whilst the applicants=expert may have suspicions, neither he, nor the proprietors=own expert is able to conclusively say that the entries in Mr Stamp's diary are anything other than genuine; they certainly cannot say that they are fraudulent or have been doctored to give a false impression of events. There is also corroborative evidence of at least one of the presentations having taken place at the time and date claimed. In the circumstances I do not see that there is anything that should lead me to consider the diary evidence as unreliable, or that the presentations did not take place as claimed.

69. In his evidence Mr Stamp says that Pedigree noticed a niche market opportunity within supermarkets for managing and upgrading their book and stationery sections. The display stands and presentations appear to be part of a pitch for the business in relation to books; there is no evidence relating to stationery. The difficulty I have is that I am not sure what *managing and upgrading* actually means in terms of the use of WILLIE WONKA in relation to goods and services. Were Pedigree seeking to be a form of franchise selling books within the supermarkets, or was the intention simply to provide a display on which the supermarkets were to sell their books? None of the books in the display appear to be marked as WILLIE WONKA or to be from the *fun-pack* range, which leads me to the view that it is the latter. But whatever is the case, it is clear from Section 100 that the onus is on the registered proprietors to show what use has been made of the mark, and if evidence purporting to show use is put forward, it should clearly define that use and not leave it to be inferred. In my view the evidence relating to the presentations is inconclusive and cannot be taken as establishing use of the mark in relation to any goods covered by the registration.

70. Where there has been use of the mark but not in respect of the whole range of goods or services covered by the registration, under the provisions of Section 46(5), the revocation will be in respect of all of the goods or services for which the mark has not been used.

71. When considering partial revocation of a mark, the starting point was for the court to find as a fact what use had been made of the trade mark. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC. 293 it was stated that because of the rights conferred by Section 10(2) of the Trade Marks Act 1994, fairness to the proprietor did not require a wide specification of goods or services. This was approved in *Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd* [2003] RPC 32. In the Thomson case Aldous L.J. conducted a useful critique of recent case law relating to revocation and referring to the *Decon* case said:

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?

72. He cited with approval the approach in *West (T/A Eastenders) v Fuller Smith & Turner plc* [2003] FSR 44, stating that the aim is to arrive at "a fair description which would be used by the average consumer for the products in which the mark has been used by the proprietor". He went on to say:

In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.

73. In the *Animale* trade mark case [2004] FSR 19, to which I was referred, Jacob J. stated that the reason for bringing in the public perception is because it is the public which uses and relies upon trade marks, stating:

"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, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.

Moreover, trade marks do not normally vanish at the time of purchase. Labels are a constant reminder of the maker. An average consumer would bear this in mind in formulating a fair description. That is a particular answer to Mr Mellor's suggestion that the fair description should be limited to the intended age of the purchaser. Today's girl surfer is tomorrow's wearer of elegant "Animale.@"

74. The specification for which the mark is registered is as follows:

Printed matter, printed publications, story books, colouring books, comics, cartoons, magazines, journals; articles of stationery; adhesives; artists' materials; paper, paper articles, cardboard, cardboard articles; paint brushes; instructional and teaching materials (other than apparatus); playing cards; all included in Class 16.

75. The specific goods for which use of WILLIE WONKA has been shown to have been used is children's annuals sold in conjunction with a toy, plaything, video or the like, in a form referred to as a *Fun pack*, and an item listed as being a *Magic pad*.

76. Notionally, terms such as *Printed matter* and *Printed publications* would cover the goods for which use has been shown, I do not consider the public would describe such goods in these terms. The same is the case in respect of the descriptor *Books*.

The public would understand the goods sold under the WILLIE WONKA mark to be "books" but as this description is broad enough to cover books quite different to those sold by the registered proprietors, this would not be the way that the public is likely to refer to them. Books are generally grouped by subject matter or type, for example, reference, fiction, children's, etc, groupings that I consider the public will be familiar with, and other than by use of the specific type, or the title or author of a particular book, will be the way in which they are likely to describe a book. The goods that the proprietor have used the mark in connection with could be described as "children's books" but as with the term "books" this would cover all types of books, the only difference being that they would be specifically intended for children. Being such a general description it is not the way that the public would regard the books that have been sold under the WILLIE WONKA name. The registered proprietors' evidence lists the goods as "annuals" which is, I believe, a reflection of how the public would regard and describe them; it is its own, recognised subset of books. I do not consider that the term "fun pack" would be understood.

77. Having arrived at the description "annuals", I should consider whether a fair description would be one that relates to the actual use, reflecting the fact that these have been sold in conjunction with a toy, plaything, video/sound cassette, or the like? Adapting the guidance in the *Animale* case, my feeling is that this would be an accurate description of the goods, but it would not be one which the average consumer would pick for trade mark purposes—he would surely say "annuals" or "children's annuals". Thus the "fair description" is one which would be given in the context of trade mark protection, and on that basis I believe it would be correct to leave this as "annuals".

78. There is no specific information on what the "magic pad" actually is. It is not a description that I consider would clearly describe any particular type of goods to the public, at least not without further explanation. Mr Reynolds describes the item as being stationery that could be used for various purposes "including artist's materials as they were used for creative learning". From this description it sounds more like an item that would be described by the public as an "activity book" rather than stationery. But as I have already said, the onus placed on the proprietor of a mark is not just to show that there has been use, but also, amongst other things, what goods (or services) that use has been in relation to. I believe it would be wrong for me to guess at what is meant by the term "magic pads", and consequently, I cannot take the evidence relating to this item as establishing use in relation to any goods.

79. Taking into account the reasons given above, I find that the registered proprietors have established that there has been use of the mark in relation to "annuals" but not in respect of any other goods. Consequently, the application for revocation under section 46(1) succeeds in respect of all goods other than "annuals" and the registration will be revoked accordingly with effect from 6 February 2003.

80. The application for revocation on the grounds of non-use for the reasons given above succeeds, albeit in part. The applicant is therefore entitled to an award of costs. I order the registered proprietor to pay to the applicant the sum of £2,100, the sum takes into account that the application did not succeed in its entirety but also that a significant amount of time was spent dealing with the preliminary issues relating to the new evidence sought to be filed by the registered proprietors. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 23<sup>rd</sup> day of June 2005**

**Mike Foley  
for the Registrar  
the Comptroller-General**