

O-175-05

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No. 1291923
IN THE NAME OF PEDIGREE DOLLS AND TOYS LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
THERE TO UNDER No. 81169
BY WARNER BROTHERS ENTERTAINMENT, INC.**

TRADE MARKS ACT 1994

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No. 1291923 in the name of Pedigree Dolls and Toys Limited**

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**IN THE MATTER OF an Application for Revocation
thereto under No. 81169
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 1291923, for the mark WILLIE WONKA, standing in the name of Pedigree Dolls and Toys Limited. The registration is in Class 28 and in respect of the following specification of goods:

Toys, games, playthings; sporting articles; all included in Class 28.

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.

7. 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.

8. Mr Reynolds says that the registered proprietor's 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 on the same theme and/or a toy or game. These are packaged in various styles with a representation of their stylised WILLIE WONKA 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.

9. 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.

10. 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 an example of Mr Reynolds's business card, that depicts, amongst others, the WILLIE WONKA name on the reverse. Mr Reynolds says that this has been the practice for some 5 years.

11. 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 Sainsbury's, Shirley on 31 October 2000,

60 WILLIE WONKA Fun Packs-Noddy Annual 2001 + Tape, sold to Sainsburys, Sevenoaks on 31 December 2001.

12, 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 on the numbers issued, or where and how they were distributed.

13. 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.

14. Mr Reynolds says 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)

15. This consists of two Witness Statements. The first is dated 26 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.

16. 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.

17. 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.

18. 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 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.

19. 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)

20. 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 in their Statements. Whilst I do not consider it appropriate to summarise these submissions in detail, I will take full account of them in my decision.

21. 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.

22. Mr Reynolds questions the standing of Mr Thomas to give evidence relating to non-food markets.

APPLICANTS= EVIDENCE-RULE 31(7)

23. This consists of two Witness Statements by Leighton John Cassidy, and a Witness Statement by Rachel Li-Mei Tan.

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

25. 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 that the registered proprietors could have sourced alternative products from.

26. Mr Cassidy's second Witness Statement is dated 18 March 2004. He refers to exhibit JGR13 to Mr Reynolds' Statement, in particular, to some of 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.

27. 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.

28. 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 copies 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.

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

PRELIMINARY ISSUE - ADJOURNMENT

30. This case is one of four revocations running concurrently between the parties. Prior to the hearing a number of preliminary issues were raised that required me to consider the admittance of further evidence, discovery and a request for striking out in relation to the case involving Class 16. 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

31. 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."

32. 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."

33. 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 **A**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."

34. 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.

35. 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.

36. Further guidance on the scale and frequency of use can be found in *La Mer Technology Inc v Laboratoires 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."

37. 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 ..."@

38. What evidence there is showing use of WILLIE WONKA is primarily in relation to what Mr Reynolds calls Afun packs@, a combination of a children's annual with a toy/plaything, timepiece, audio/video cassettes or the like, the item being related to the subject matter of the annual. Exhibit JGR1 is a promotional leaflet dating from 2001. 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 WILLIE WONKA fun packs, eight in all, the annuals being shown in combination with a witches outfit, dolls, audio cassettes, a wrist and stop watch, and plush toys. With the exception of the watches and audio cassettes, and of course the annuals, all of these items would be covered by the registration. All individually bear the same WILLIE WONKA mark and the Pedigree name.

39. 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. He 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 an 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@.

40. The exhibit also 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.

41. 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.

42. The order form at exhibit JGR2 appears to show the heading WILLIE WONKA FUN PACKS, listing beneath three versions as being available; Sindy Annual 2001 and doll, Shoot Annual 2001 and ball, and Fox Kids Annual 2001 and video. Under examination Mr Moody Stuart took Mr Reynolds through a comparison of the product codes on the order form and those shown on the invoices exhibited, putting it to Mr Reynolds that of the three listed only one was a fun pack. Mr Reynolds disputed this saying that all three were presented to the trade as being available as WILLIE WONKA fun packs but it was up to the individual customer whether they take the product as a fun pack or as individual annuals.

43. Exhibit JGR11 shows WILLIE WONKA being used in relation to colouring and activity books although bears no date of origin. Mr Reynolds says that they are products described in exhibit JGR1 but I can find no reference to such goods in that exhibit. Mr Reynolds says that the leaflet forming JGR11 was issued to the trade at the end of 2002 for 2003, potentially within three months of the date of application for revocation. I am therefore not able to say whether exhibit JGR11 shows use or preparations for use that fall within or outside the three month exclusion of Section 46(3).

44. Exhibit JGR12 is stated by Mr Reynolds to relate to a range of goods intended to be produced in collaboration with Remus Playkits in 1999, although none of the exhibit itself is dated. The exhibit shows the WILLIE WONKA mark being used on colouring/activity books with crayons, pens paints, etc, craft kits, hair bands and ties, a belt, and cosmetics, all for children. With the exception of the belt none of these goods would fall within the scope of the registration. Mr Reynolds says that beyond test sampling his company had little success because the pricing structure proved unworkable, and that the project was put on hold following Remus going into administrative receivership in mid-2002. What this test sampling involved is not explained, nor does Mr Reynolds say what efforts were made to put the goods on the market. Consequently, I do not consider that exhibits JGR11 or JGR12 constitute evidence on which I can base a decision that there has been any genuine use of the mark in relation to the goods shown.

45. On the basis of the evidence I am content that the registered proprietors have offered a number of toys/playthings for sale, albeit as a package in combination with a children's annual 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.

46. 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.

47. 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 Deacon case said:

As 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?@

48. 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:

AIn 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 useYThus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.@

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

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."

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

Toys, games, playthings; sporting articles; all included in Class 28

51. The specific goods for which use of WILLIE WONKA has been shown to have been used consist of a witches dressing-up outfit, dolls, audio and video cassettes, a wrist and stop watch, a ball, and plush toys, in combination with an annual in a form referred to as a 'fun pack'. Unlike the annuals which may be obtained as a separate item, there is no evidence that these additional items were available outside of the fun packs. With the exception of the watches and audio/video cassettes, and of course the annuals, all of these items would be covered by the registration.

52. There is no question that children's dressing-up outfits, dolls and plush toys are toys or playthings (in Collins English Dictionary these terms have the same meaning). I have no doubt that the consumer of such goods would regard them as toys, but as the term 'toys' covers a diverse range of products are more likely to describe them by reference to the more specific sub-categories of toys. I would therefore state the use shown to be in respect of children's dressing-up costumes, dolls and toy figures. These are descriptions that I consider both the public and trade would understand. How the public would describe a 'ball' would depend upon whether it is seen as an item suitable for use in participating in a sporting activity or simply for playing with. Given that the ball in this case is being sold as a companion to a children's annual I take the view that it will be the latter. But whatever, I do not consider that this use establishes use in relation to sporting articles.

53. On the evidence before me I find there to have been genuine use in relation to 'children's dressing-up costumes, dolls, figures, and balls'. Having arrived at this point 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 an annual? I believe to restrict the specification would be unfairly restrictive, and would not take into account the fact that although sold together, the annuals and their accompanying item will be separated after purchase. To link the article to the annual would not be a meaningful limitation of the goods, but rather a restriction on the manner in which they are traded.

54. I therefore order that the registration be revoked in respect of all goods other than: 'children's dressing-up costumes, dolls, figures, and balls'. The revocation to be effective as of 6 February 2003.

55. The application for revocation on the grounds of non-use for the reasons given above succeeds. The applicant is entitled to an award of costs. I order the registered proprietor to pay to the applicant the sum of £1,500. 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 23rd day of June 2005

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