

O-177-10

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION

NOS 1319477, 1319478, 1419333 AND 1419651

IN THE NAME OF GALILEO INTERNATIONAL TECHNOLOGY, LLC

OF THE TRADE MARK:

GALILEO

IN CLASSES 9, 39 AND 42

AND THE CONSOLIDATED APPLICATIONS FOR REVOCATION

THERE TO UNDER NOS 82390, 82391, 82392 AND 82393

**BY EUROPEAN COMMUNITY, REPRESENTED BY THE EUROPEAN
COMMISSION.**

Trade Marks Act 1994

**In the matter of registration nos 1319477, 1319478, 1419333 and 1419651
in the name of Galileo International Technology, LLC
of the trade mark:
GALILEO
in classes 9, 39, 9 and 42
and the consolidated applications for revocation
thereto under nos 82390, 82391, 82392 and 82393
by European Community, represented by the European Commission**

1) Section 46 of the Trade Marks Act 1994 (the Act) reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Section 100 of the Act states:

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

Consequent upon section 100, in revocation for non-use proceedings the onus is upon the registered proprietor to prove that it has made genuine use of a trade mark, or that there are proper reasons for non-use.

2) All four registrations stand in the name of Galileo International Technology, LLC (GI). The completion of the registration process for the four registrations was as follows:

1319477	2 March 1990
1319478	27 July 1990
1419333	3 March 2000

1419651

18 May 1992

Registration no 1319477 is in respect of:

electrical and electronic apparatus and instruments; computers; data processing apparatus; parts and fittings for all the aforesaid goods; all included in Class 9.

Registration no 1319478 is in respect of:

transport of passengers and of goods by air; reservation services relating thereto; all included in Class 39.

Registration no 1419333 is in respect of:

electrical and electronic apparatus and instruments; computers; word processors; data processing apparatus; electrical and optical data processing apparatus; apparatus and instruments; all for the retrieval, storage, input, processing and display of data; semi-conductor memory apparatus; micro processors; computing apparatus; keyboard apparatus for use with computers; printers for use with computers; computer programmes and computer software; punched (encoded) cards and punched (encoded) tapes; magnetic tapes and discs; disc drives; modems; electrical and electronic communication apparatus; computer communication apparatus; parts and fittings for all the aforesaid goods; all included in Class 9.

Registration no 1419651 is in respect of:

computer services; computer programming; design of computer software; all included in Class 42.

3) European Community (EC), represented by the European Commission, on 23 January 2006 filed applications for the revocation of all four registrations under section 46(1)(a) of the Act. It seeks revocation of 1319477, 1319478, 1419333 and 1419651 from 2 March 1995, 27 July 1995, 3 March 2005 and 18 May 1997 respectively. As per the decision of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *BSA by R2 Trade Mark* [2008] RPC 22 and per practice direction TPN 1/2007, the earliest dates from which revocation can take place are 3 March 1995, 28 July 1995, 4 March 2005 and 19 May 1997. Nothing, in terms of the evidence filed, turns upon the dates of revocation being one day later. At the hearing the parties agreed to the amendment of the dates of the revocation to 3 March 1995, 28 July 1995, 4 March 2005 and 19 May 1997. **In relation to registration no 1319478 EC seeks revocation in respect of *transport of passengers and of goods by air*. In its counterstatement GI states that the trade mark has been used in respect of all of the goods (sic) of the registration. At the hearing an amended specification was offered:**

reservation services relating to the transport of passengers and of goods by air; all included in Class 39. Consequently, the specification is now limited to within the parameters of the application for revocation and so there is nothing more to consider in relation to this registration, in relation to which the application of EC has succeeded. In relation to the other registrations EC seeks revocation of the specifications in their entireties. GI states in its counterstatements that it has used the trade marks in relation to all of the goods (sic) of all of the registrations. At the hearing GI submitted an amended specification for registration no 1419333, *punched (encoded) cards and punched (encoded) tapes* being deleted.

4) At the hearing Mr Malynicz raised a pleadings issue that had not been foreshadowed in his skeleton argument. He submitted that in relation to registration nos 1319477, 1419333, and 1419651, as the applications had been made in respect of all of the goods and services of the registrations, if GI showed use in relation to any goods/services of each registration then the application(s) should fail. Section 46(5) of the Act states:

“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.”

It is inherent in this subsection that where there is use for some goods or services the application shall be revoked for those goods or services, where they fall within the parameters of the application for revocation. The registered proprietor in its counterstatement can identify the goods/services upon which it claims there has been use; it is the counterstatement that sets out the final parameters of the application. In this case in its counterstatements GI states that it has used the trade marks in respect of all of the goods (sic) for which they are registered. The corollary of Mr Malynicz’s argument is that if GI does not show use on all of the goods and services of the registrations, the registrations should be revoked in their entireties. The applications will be considered upon the basis of the use, if any shown, and a specification constructed reflective of that use, if it is partial use.

5) Almost all of the evidence of GI has been furnished by Brian J Morgan, Mr Morgan is a trade mark attorney acting for GI and, consequently, he is acting as a conduit for the evidence of GI rather than being the fountain of the evidence. Mr Gary Chedumbrum has filed a brief witness statement. Mr Chedumbrum is vice president, finance EMEA of Travelport International Limited, this was previously Galileo International Limited (GIL). Mr Chedumbrum confirms that the evidence submitted by Mr Morgan has been supplied by his company. He confirms that both his company and GI are part of the same group of companies and share the same ultimate parent company, Travelport Inc. The evidence of use of GI in relation to the United Kingdom relates to use by GIL. **Taking into**

account the statement of Mr Chedumbrum and the absence of any conflicting evidence, use by GIL is taken to be use with the consent of GI.

6) The evidence of Mr Morgan gives rises to difficulties. Effectively, he exhibits material supplied by GIL but gives no details of turnover in relation to specific goods and services. If he had given such evidence it would have been hearsay evidence. The evidence that has been furnished lacks clarity and specificity in relation to date, jurisdiction and the exact nature of the goods and services in relation to which GI claims the trade mark has been used.

7) EC furnished a witness statement by Olivier Laidebeur. Mr Laidebeur is the lawyer acting for EC in this case. Mr Laidebeur's evidence consists of submissions and a critique of the evidence of GI rather than evidence of fact. The observations of Mr Laidebeur are taken into account but, not being evidence of fact, will not be summarised.

8) Under section 46(3) of the Act use after the expiry of the five year periods and before the date of the applications will defeat the applications in respect of the goods and services for which use has been shown, provided that such use began three months before the date of application, unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made. (In these proceedings the three month proviso does not have a bearing upon the outcome of the case.)

Witness statement of Brian J Morgan of 23 February 2007

9) Various documents are exhibited to the witness statement (many of them have annotations bearing the word Anlage and a reference number, indicating that they have been used for proceedings in German):

BJM1 - Pictures of CDs - FocalpointNet 15 August 2002, Viewpoint June 2002 – Copyright notice for Galileo International. GALILEO appears above INTERNATIONAL and below device of stylised globe.

BJM2 – A document that states, inter alia, “bookmarks the Galileo wireless Web site on his or her Sprint PCS or AT&T Wireless phone”. There is no indication that this relates to use in the United Kingdom. Pages from galileo.com – no indication of United Kingdom use.

BJM3 - photographs of a monitor, a keyboard and a PC which have upon them GALILEO and device. Other trade marks can be seen upon the PC: intel inside and energy with a star device, below this appears an illegible word of three letters and the words Pollution Preventer. – there is no indication of use in the United Kingdom.

BJM4 – this has a front page that shows that the exhibit was prepared for proceedings in relation to a Community trade mark. It consists of pictures of CDs:

- Focalpoint 3.5 - GALILEO above INTERNATIONAL and below device of stylised globe – 21 November 2003.
- Galileo IDS Installation CD – November 2003 - GALILEO above INTERNATIONAL and below device of stylised globe,
- FocalpointNet – 30 May 2002 - GALILEO above INTERNATIONAL and below device of stylised globe - Copyright notice for Galileo International.
- Focalpoint Relay 3.3 – March 2002 -GALILEO above INTERNATIONAL and below device of stylised globe.
- SNCF Installation CD-ROM – 23 January 2004 – Contents SNCF Client V1.00.06 - GALILEO above INTERNATIONAL and below device of stylised globe.
- Viewpoint Maps and Touring Viewpoint – Viewpoint Mapping July 1 – September 30 2004 - GALILEO above INTERNATIONAL and below device of stylised globe –. Copyright notice for Galileo International.
- FocalpointNet – August 2000 - GALILEO above INTERNATIONAL and below device of stylised globe - Copyright notice for Galileo International.
- Focalpoint Print Manager - 8 September 2001- GALILEO above INTERNATIONAL and below device of stylised globe –Copyright notice for Galileo International.

BLM5 – screenprint of Focalpoint Logon - GALILEO below device of stylised globe.

BJM6 – letter to The Global Village of London EC1N 7TJ advising of an installation date of 15 April 2004. A survey had taken place on 27 February 2004. Invoice to The Global Village dated 7 June 2004 for “one off charges” of £2,250 (ex VAT) - GALILEO above UNITED KINGDOM and below device of stylised globe. Galileo and address and Galileo International Limited and address appear upon the invoice. Details of order: 9 March 2004 – “Winback – SB x 25 licences, 2 x ITIN PRINTERS, 1 X SPRITE TXT PRINTER” - one off gross charge of £3870 and on going gross charges of £778.50. Included in the exhibit are the following comments:

“However their Dolphin Back office system will need interfacing to Galileo...”

“The site will be ready for Galileo install on 15th April.”

“Austin is in tomorrow to oversee the installation of the Gal software and hopefully look into the printing and the MIRS file dumping. Our network guy will also be in for the morning so hopefully there should be few problems”.

“We have two Galileo floor walkers in from Monday next week until day x 7 (to be decided).”

“Installed kit” – FOCALPOINT 3.5 HYBRID SITU
FOCALPOINT 3.5 SE 5 – 10 LICENCE
FOCALPOINT MIR TO DISK
VIEWPOINT MAPPING FOR FP NET
VIEWPOINT MAPS (FP 35 SE)
VIEWPOINT 3.0
VIEWPOINT 3.0

Survey for Travel 2/4 of Glasgow – dated 26 November 2003 includes following references:

64MB Memory for Dell G1
64MB Memory for Dell GN+
128MB Memory for Dell GX50
128MB Memory for Dell GX100

Galileo/Synstar Survey Form – all workstations are IBM

Job Sheet Report for Travel 2 Ltd of London, N19 5PH

Proposal to The Global Village dated 19 January 2004, many references to GALILEO.

“The Benefits of Galileo

Galileo’s strength lies in its truly global reach (covering 116 countries – more than any other GDS) and technical superiority. Galileo’s track record in the industry is impressive – Galileo was first to introduce a Windows based PC product to agency community (Focalpoint), first to implement electronic ticketing (1997), first to offer full graphical desktop application for air, car and hotel (Viewpoint – 1998), first to introduce full XML API with structured data (2000), first to offer full re-book facilities on Wireless applications (June 2000) and first to introduce “low cost” carrier booking (Virgin Express – December 2000).”

Ticket printers – Sprite ATB printer
Itinerary/dump printers – Oki 320

“Galileo’s solution is offered without the supply of PC hardware.”

“Daily via our service partner Synstar (www.synstar.com) we complete 50 onsite jobs in the UK per day.”

“Has access to 34 trained and dedicated Synstar engineers in the UK with a total of over 200 years of service in the field.”

“Training is handled in the UK by Parity Training”.

“Galileo UK would be willing to offer onsite training if the facilities allow.”

“When Galileo win an agency from Amadeus, the agency is advised that there is an automated process for migrating PNRs and Profiles into Galileo.”

“Careful control is exercised at each stage to ensure all parties understand and conform with obligations to minimise the risk of airlines receiving booking errors.”

“Focalpoint™ is Galileo’s Premier Access Platform allowing direct access to the Galileo Central System to book Air, Cars, Hotels and Rail direct.”

“Viewpoint™ revolutionises the way users interact with the Galileo Central System. Using structured data, Viewpoint™ delivers a powerful, flexible graphical interface to every aspect of the Galileo booking process.”

“Viewpoint™ Maps is our CD-ROM based hotel-mapping product. Viewpoint™ Maps provide over 2000 colour maps of major cities and resorts around the globe. RoomMaster properties and reference points are automatically plotted on the maps and additional agent specific customer reference points can be plotted. All maps can be printed as required.”

“Galileo Viewtrip™ gives your customers real time access to up-to-the-minute customer itinerary information, online. All that the customer does is enter their Galileo booking locator number and surname to access their itinerary.”

Galileo 360° Fares is used in relation to agency private fares, public fares and airline private fares and custom fares.

Financial proposal:

“Galileo will offer The Global Village a sign on bonus of **£6,560** upon contract signature which will cover the capital charges shown above. An additional “Go Live” bonus of **£45,000** will be provided once The Global Village migrates fully from their existing Amadeus solution to Galileo.”

“Galileo will offset the above highlighted monthly equipment charge to zero if The Global Village achieve a minimum of 55,000 segments per year. This equates to a total saving of **£45,510** over the five year term of the proposal.”

The proposal states if The Global Village volume of traffic reaches prediction it will receive incentives to the value of £382,070.

“Parity runs 20 specialised courses on Galileo systems ranging from introduction sessions to upgrade overviews.”

“Galileo offers a standard 1 year warranty on all Galileo supplied equipment with the exception of

Unimark Mark 1 ATB (3 Years Parts & Labour)”.

An agreement with The Global Village was signed on 19 March 2004.

Subscriber Agreement

“1.1 Galileo United Kingdom produces, obtains and distributes products and services to subscribers for the display of information on air carrier schedules, fares, seat availability and other travel related products and provides subscribers with the ability to make reservations and/or issue tickets and/or provide other related services.

1.2 In particular Galileo United Kingdom distributes products and services supplied by both Galileo International and by itself and others.”

“14.1 During the period of this agreement, the Subscriber will pay to Galileo United Kingdom the charges and fees set out in the schedules to this agreement, and the charges for any ancillary services such as training; these charges will be based upon the Galileo United Kingdom price lists published from time to time.”

Agreement:

Installation of purchased equipment: ATB ticket printer and core itinerary printer.

Rental equipment, monthly site fee with back up, Focalpoint 3.5 special edition licences, MIR, MIR to disk and Sprint 1.

Segments relate to bookings made in relation to air travel, car hire and hotel accommodation. GUK pays the subscriber an incentive for each booking made using the GALILEO system. The subscriber is not paid an incentive for Leisurehopper, domestic rail, Eurostar or ferry bookings made by the subscriber.”

“On the Subscriber achieving the below Annual segment count (“The Equipment Segments”) Galileo shall refund the payments made in relation to the equipment listed in Schedule 1-6 in that Year..

In each 12 months period of this contract 50,000 Segments”

“The Subscriber agrees to produce a minimum of 275,000 Active Air Segments (The “Minimum Segments”) in the 60 months following the Contract Start Date of this Agreement. In the event the Subscriber fails to achieve this amount, or the Subscriber terminates this Agreement before the expiry of 60 months from the Contract Start Date, the Subscriber shall repay to Galileo United Kingdom a proportion of the £53,560 as follows:”

In the part of the agreement relating to operation of the apparatus the following appears:

“10.2 The Subscriber agrees to operate the Apparatus strictly in accordance with the operating instructions given from time to time by Galileo United Kingdom. The Subscriber further agrees to use the Apparatus solely for the performance of the business functions set out in the Manuals, provided that the Subscriber may use the Equipment to perform any functions specified by the manufacturer to the extent that this use is not contrary to any operating instructions given from time to time by Galileo United Kingdom. Nothing in this clause will prevent the Subscriber from using any Equipment in any manner that the Subscriber chooses when any such Equipment is not on line to the Galileo System, provided that any such use will not adversely affect the Galileo System.”

Clause 10.4 states:

“The Subscriber agrees that neither the Subscriber nor any third party will attempt to undertake or will undertake maintenance, repair work, alterations, modifications or connections of any nature whatsoever of or to the Rented Equipment, the Software Products or the Communications Link unless this has been approved by the prior written consent of Galileo United Kingdom.”

BJM7 – Portman of London E14 9TB. Installation date 12 July 2003.

Trailfinders of London W8 6FT – Installation date 22 October 2002. The survey form has a list for additional equipment that is required. This includes additional memory for Dell G1, Dell GN+, Dell GX50 and Dell GX100.

BKM8 – Best@travel of London W1T 3AP – installation date of 1 December 2003.

GALILEO web services development agreement between Galileo International LLC and Worldwide Journeys PLC of London W1T 3AP:

“Galileo owns and operates certain XML-based Web services with a SOAP application programming interface collectively called Galileo Web Services. Galileo Web Services enable End-Users to obtain certain

Galileo travel reservation functions and services through Web sites and on-line applications that are integrated with Galileo Web Services.”

“Galileo offers a standard 1 year warranty on all Galileo supplied equipment with the exception of

Dell PC (3 Years Parts Only)

Unimark Mark 1 ATB (3 Years Parts & Labour)”

BJM9 – In technical requirements the following appears “A Galileo PCC with the ‘Shop’ function enabled.” There is no indication as to what PCC stands for in this context, however, in other documentation there is reference to PCC standing for pseudo city code. There is nothing to indicate that PCC is an acronym for personal computer. The exhibit also includes, inter alia, what appears to be a PowerPoint® presentation for Galileo API Products

BJM10 – Copies of pages from galileo.com and acriss.org downloaded on 10 July 2006 (ie after the date of the applications) are included in the exhibit. A copy of car voucher guide for Belgium is included in the exhibit. Also included in the exhibit is documentation relating to hotel reservation systems. These emanate from Cendant, at one time the parent company of GI. Reference is made in the documentation to GALILEO. There is nothing to indicate that the document relates to United Kingdom usage. Screen shots show prices in United States dollars.

BJM11 – pages downloaded from various GALILEO websites on 10 July 2006 (ie after the date of the applications).

BJM12 – Picture of Customer Fares CD – a stylised globe appears to the left of GALILEO. Copyright notice for Galileo International of 2001. Copies of pages from various websites downloaded on 10 July 2006. Covers of several GALILEO brochures without provenance. Documents relating to GALILEO SpecialAgent, XML Select, Cendant and Inside Shopper, all without provenance. (One of the covers of the brochures includes the words La svolta and so, presumably, emanates from Italy.)

BJM13 - A photograph of a computer mouse upon which appears a stylised globe, below appears GALILEO and below this SIGMA. There is no indication of the provenance of this mouse. The rest of the exhibit consists of customer education books for various GALILEO products: Client File Plus™ (published in April 2003), Payment Calculation Tool (published in April 2003), RoomMaster® using FocalPoint® (published in April 2003), CarMaster™ using FocalPoint® (published in April 2003), CarMaster™ using Viewpoint™ (published in April 2003), Design Your Own Itinerary (published in November 2001, Using Galileo® (with a copyright date of 2003), Galileo® using Viewpoint™ (with a copyright date

of 2003), FocalPoint® 3.5 Expert (published in April 2003). The last two mentioned publications refer to Parity Training, a United Kingdom firm, and gives contact details for persons in the United Kingdom. Client File Plus™ and TravelScreen™ (published in November 2001), Dynamic Data Exchange (published in August 2003, Selective Access™ (published in May 2001), Scriptwriter Plus™ (published in August 1999), Custom Check™ (copyright notice for Galileo International of 1999-2000), Help Desk TroubleShooting (copyright notice for Galileo International of 2006), AccesRail (a Swedish publication in English), Galileo E-Tracker. Only the two documents referring to Parity Training have a clear indication of United Kingdom provenance.

BJM14 – trade name value allocation across the globe for GALILEO in 2001. The total revenue for the United Kingdom is given as \$132,605,041.

BJM15 – Documentation relating to Travelpoint™ - GALILEO above INTERNATIONAL and below device of stylised globe. Copyright notice for Galileo International of 1996. The following appears in the documentation:

“Through Travelpoint, Galileo provides the information that travellers need to plan their complete itineraries.”

“Travelpoint is available to travellers only through travel agents in partnership with Galileo.”

“Travelpoint installs quickly and easily and runs fast on most IBM compatible PCs.”

“The Agency Pseudo City Code provides the agency name and address, which displays to the user during the reservation process”

“ your clients must have an IBM compatible personal computer”.

Floppy disc for Travelpoint with a date of December 2006 and Copyright notice for Galileo International of 1996.

BJM16 – Leaflets relating to various GALILEO products – all are software products for use in reservation and management of travel and accommodation. The leaflets bear copyright dates of 1998. There is no indication as to the jurisdiction in which they have been used. The following appears:

“It has been implemented on a variety of popular hardware platforms including UNIX, IBM AS400, Tandem and Data General.”

BJM17 – leaflet for Viewpoint™ system. There is a copyright notice of 1999 but no indication of the jurisdictional provenance of the leaflet.

BJM18 – leaflets for ViewTrip system and XML Select. Both have copyright dates of 2000. There is no indication of jurisdictional provenance. The XML leaflet advises of the operating system and hardware requirements.

BJM19 - a quick reference guide to booking hotels using the GALILEO system, a leaflet relating to THOR worldwide negotiated hotel rates programme, a leaflet on EDIFACT Select – the leaflet advises that the system is supportable on a variety of popular hardware platforms including UNIX, IBM, Tandem, Dec Alpha and Data General, a leaflet on 24 hours a day access and a booklet entitled “Galileo with the new airline commission structure”. The last booklet emanates from the Netherlands. All of the material has internal information that indicates that it was produced before the date of the applications for revocation. Only the Netherlands booklet has an indication of jurisdictional provenance.

BJM20 – copy of a leaflet relating to GALILEO wireless, there is a copyright date of 2000 but no jurisdictional provenance. Two pages relating to Trailfinders ICN network. A page relating to Flight Centre UK GALILEO connectivity, inter alia, the following items are identified: CISCO 2600, SITA Circuit, GALNET Circuit, Citrix Server, Satelcom 2003 Router.

BJM21 – copies of quick reference guides relating to a variety of GALILEO systems. Internal evidence shows them all emanating from prior to the date of the applications for revocation but there is no jurisdictional provenance. A list of travel agencies in the United Kingdom downloaded from the travelgalileo.co.uk website on 21 July 2006. It is not clear as to what the purport or relevance of this list of agencies is.

BJM22 - picture of a computer mouse upon which GALILEO appears below a stylised globe and above the word SIGMA. There is no indication of the provenance of this photograph. Course book for using GALILEO, Travel2 and Travel4 shown on the front, exhibit BJM6 relates to Travel2. Course books for using GALILEO Viewpoint, Focalpoint (from April 2003) – from Parity Training, the undertaking that delivers training for GI in the United Kingdom. The telephone number has a United Kingdom code. Various course books in relation to which it is not possible to establish that they have been used in the United Kingdom. However, they do further illustrate the nature of the goods/services that GI offers. One part of the exhibit, for AccessRail, is clearly identified as emanating from Sweden.

BJM23 – CD for Focalpoint Relay this bears the name GALILEO over which a stylised globe appears. It has the date March 2002 upon it. A claim to copyright by Galileo International appears upon the CD. A CD for Custom Fares, to the right of a stylised globe GALILEO appears. This bears a claim to copyright by Galileo International of 2004.

Witness statement of Brian J Morgan of 18 September 2008

10) Exhibited at BJM C is a copy of a document supplied by KPMG, whom Mr Morgan describes as the appointed accountants for the Galileo Group of Companies. The exhibited is headed "Galileo Trademark/Tradenname Value Allocation Summary 2001. Total revenue in dollars is given for the United Kingdom, the figure is \$132,605,041. The table does not identify the period to which this figure relates. It also does not identify if this figure relates to the value of the sales of services ie the cost of the transport and accommodation, or to the revenue that GI has received in relation to the goods and services which it supplies.

Witness statement of Brian J Morgan of 18 November 2008

11) Mr Morgan states that exhibited at BJM D are copies of the financial returns for GIL, a wholly owned subsidiary company within the Galileo Group of Companies, sharing the same ultimate parent company as GI:

- Directors' report and financial statement 31 December 2000. The principal activity of the company is described as being to act as the United Kingdom sales and marketing organisation for Galileo International LLC by promoting and supporting automated distribution services to the United Kingdom travel industry. In the 9 months ended on 31 December 2000 the company generated a turnover of £36,269,000 and a profit before tax of £66,000. The turnover in the United Kingdom was £14,663,000 (the rest of the turnover coming from other geographical areas).
- Report and financial statements of 31 December 2001. A turnover of £17,712,000 is reported for the United Kingdom.
- Report and financial statements of 31 December 2002. The report states that the turnover and pre-tax profit is attributable to one activity, the distribution of the GALILEO GDS system. The turnover for the United Kingdom was £12,067,000.
- Report and financial statements of 31 December 2003. The principal activities of the group are described as being to act as the United Kingdom sales and marketing organisation for Galileo by promoting and supporting automated distribution services to the United Kingdom travel industry and to act as a tour operator and travel agency. The report states that on 4 November 2003 GIL acquired 100% of the issued share capital of Travel 2 Limited, Travel 2 Limited is a tour operator and travel agency. The group has two classes of turnover, travel distribution and travel agency. The turnover for 2003 was £43,144,000. The report includes the following note:

“Revenues generated from fees charged to travel suppliers for bookings made through the Company’s computerised reservation system are recognised at the time the reservation is made for air bookings, at the time of pick-up for car bookings and the time of check-out for hotel bookings. Revenues from leased equipment charges to system subscribers are recognised over the term of the contract at contracted rates.

The financial statements show that the ultimate parent undertaking of GIL is Cendant Corporation.

- Report and financial statements of 31 December 2004. The principal activity of the company is described as being to act as the United Kingdom sales and marketing organisation for Galileo by promoting and supporting automated distribution services to the United Kingdom travel industry. The company also owns 100% of the issued share capital of Travel 2 Limited which acts as a tour operator and travel agency. On 22 October 2003, the company acquired 100% of the issued share capital of Stylesummer Limited. The company name was changed from Stylesummer Limited to Cheap Tickets Limited on 25 February 2004. The principal activity of Cheap Tickets Limited is that of the ownership and licensing of trade marks and domain names. Cendant Corporation, on 30 June 2006, announced that it had agreed to sell its travel services division, which includes GIL, to The Blackstone Group. The transaction was completed on 23 August 2006. The statement consolidate those of GIL, Travel 2 Limited, Travel 4 Limited and Cheap Tickets Limited. In 2004 the turnover of the business was £58,962,000 for travel distribution, and £197,956,000 for travel agency, these figures relate to the whole of Europe. The total turnover in respect of the United Kingdom was £207,694,000. The company status of Travel 4 Limited was dormant.
- Report and financial statements of 31 December 2005. The principal activity of the company is described as being to act as the United Kingdom sales and marketing organisation for Galileo International LLC by promoting and supporting automated distribution services to the United Kingdom travel industry. On 15 December 2006 GIL sold its investments in Travel 2 Limited and Travel 4 Limited. Turnover relates to a single class of business, travel distribution. The turnover for the United Kingdom was £5,586,000, from £9,712,000 the previous year.
- BJM E consists of a selection of invoices. Mr Morgan states that Galileo International Limited changed its name to Travelport International Limited on 2 June 2008, exhibited at BJM F is a printout from the website of Companies House showing the change of name. The invoices for 2002 exhibited at BJM E were recovered from hard copy storage. From 2003 onwards the information is retained on the computer system in electronic

copy only, no hard copies are available. Consequently, when printing the 2003 and 2004 invoices from the electronically stored information, exhibited at BJM G, the details upon the invoice are correct, however, the information at the top and the bottom of the pages captures the current information, rather than the information that would have been displayed on the invoices at the time of their issue. Galileo International Limited and the Galileo & Globe device trade mark, as shown on the 2002 invoices, would have been shown. In confirmation of this there is a witness statement from Jeffery Esprit of Travelport International Limited (previously GIL). Included in the invoices are references to Oki and Sprite printers. The invoices are all dated 1 July 2002. With the exception of one invoice to Galileo International LLC, all of the invoices are to undertakings in the United Kingdom. The invoices relate to maintenance and rental charges. Invoices to Dawson and Sanderson Ltd, El-Sawy Travel, J & G Executive Travel and Eagle Travel refer to GALILEO PCs. The invoices exhibited at BJM G all emanate from 2003 and 2004 and are all directed to American Express Europe Ltd in London.

- Exhibited at BJM H are copies of job sheets for: Bath Travel Service of Bournemouth (for a system installation on 20 November 2002); Cosmos Coach Tours of London (for a system installation on 17 September 2002); BTI UK of Farnborough (for a system installation on 27 September 2000); Portman of London (for a system installation on 16 October 1999); Portman of Bristol (for a system installation on 12 September 2002); Trailfinders of London (for a system installation on 30 October 2000); Forward Travel Management of Derby (for a system installation on 21 June 2001); HRG UK of Liverpool (for a system installation on 11 January 2000); Forward Travel Management of Derby (for a system installation on 25 June 2003); FCM Travel Solutions of Glasgow (for a system installation on 15 January 2003).

12) Mr Morgan furnished a further witness statement. This can be characterised as being submission rather than evidence of fact so no summary of it appears here, however, the points raised therein are born in mind in the deciding of these consolidated proceedings.

Decision

13) A convenient summary of the criteria relating to genuine use was given by the General Court (GC) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlo (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 There is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the registration (Case C-234/06 P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*VITAFRUIT*, paragraph 99 above, paragraph 40; *Charlott France Entre Luxe et Tradition*, paragraph 99, paragraph 35; see also, by analogy, *Ansul*, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (VITAFRUIT, paragraph 99 above, paragraph 41, and Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (VITAFRUIT, paragraph 99 above, paragraph 42; Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 37; see also, by analogy, Ansul, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT) [2002] ECR II-5233, paragraph 47).”

14) GI considers that other than for the small concessions that it has made that its registrations should be maintained in their entireties. Putting aside software, the evidence of use in relation to goods effectively boils down to a couple of pictures of PCs bearing the GALILEO name and device, a computer mouse bearing the name GALILEO and invoices referring to GALILEO PCs. The evidence shows that part of the package that GI furnishes includes the rental or sale of equipment. Use of a sign for rental and sale of equipment is not the same as use of the sign for the goods. Equipment that is being rented is most likely to bear the renter’s name or trade mark, to identify the goods as belonging to it. The pictures of the PCs and mouse have no provenance. However, even if they did all that this indicates is that the goods have been rented or are used for accessing the GALILEO systems, not that GI is creating or maintaining a market in computer hardware. Indeed such a position is indicated in the proposal

documents the GIL uses, the proposal document to The Global Village (to be found at BJM6) under clause 6.4 of the subscriber agreement states:

“6.4 The Subscriber will not remove or obscure any identifying marks from the Rented Equipment, the Communications Link, the Software Products or the Media or subject them to any lien or encumbrance.”

“Identifying marks” indicates that the goods are marked to show that they are the property of GIL and only rented to the user. The invoices that refer to GALILEO PCs can simply refer to computers that GI has rented to an undertaking. If GI was maintaining or creating a market in computer hardware one would expect to see documentation relating to the capabilities of the equipment eg the nature of the processor, the speed of the processor, the RAM, the main memory capacity and the nature of the connections. There is no such documentation. One would also expect to see brochures and manuals for such equipment, none has been adduced. On the other hand there is clear identification of the equipment of other undertakings eg Oki, Sprite, UNIX, IBM, Tandem, Dell, Unimark and Data General. There is also clear identification of the hardware and operating system requirements for the use of GALILEO applications.

15) There has been use of GALILEO on its own, in many documents for instance. There has also been a lot of use of GALILEO in juxtaposition with a stylised globe. It is not uncommon for one trade mark to be used with another. In this case the perception of the two trade marks is not of a combined trade mark but of two separate trade marks that will sometimes be used together and sometimes separately. The perception is not of a composite trade mark. There is also use of GALILEO with INTERNATIONAL. International is a word very much used in relation to trade marks and trade names, it, of itself, lacks distinctiveness. The presence of the word INTERNATIONAL does not alter the distinctive character of the trade markⁱ.

16) EC has criticised the evidence, it does not consider that it is specific enough, that it does not dot every “i” and cross every “t”. There are deficiencies in the evidence, it is not focused, it does lack specificity. Nevertheless, the documentation relating to installation of GALILEO systems in a variety of undertakings is clear and irrefutable. A good amount of the evidence is without provenance in itself but it does aid in identifying the nature of the goods and services that GI has furnished by use of the name GALILEO. EC accepts the use of the trade mark in relation to certain of the class 39 services, services that are effected by the systems and services that GI furnishes. The proposals, and subsequent agreements, give a clear picture of the business of GIL and also show that such a business has been conducted for a number of years by reference to GALILEO.

17) EC attacks the evidence on the basis that it does not show external use. External use relates to sales or promotion to a third party, there is no requirement

that it is use to the general public or the final purchaser of a product or service. There is clear and definite evidence of external use of GALILEO, in promotional material, on software, on manuals, on teaching aids, in contracts. There is no doubt that that there has been external use of the trade mark.

18) EC has also criticised the revenue model of GI/GIL. The systems and software may not cost the user anything, indeed the use of the system and software could bring the user money. As the accounts of GIL show revenue is primarily generated from the providers of transport and accommodation (see report and financial statements of 31 December 2003). There is no requirement for the trade mark to generate revenue from the end user. There are a variety of business models which do not generate revenue directly from the user eg free newspapers and search engines. The question to be considered is whether a market is being created or maintained in relation to the goods/services. The financial statements show that the business model brings in a significant sum each year. The evidence also shows that the GALILEO system is in competition and has been trying to supplant the AMADEUS system. The evidence also shows that the system is used by large undertakings eg Trailfinders and American Express.

19) It is necessary to decide upon a fair description for the goods and services for which genuine use has been shown and which fall within the parameters of the specification. The description must not be over pernicketyⁱⁱ. It is necessary to consider how the relevant public, which for these goods would be the public at large, describe the goodsⁱⁱⁱ. The GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 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, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Mariefelde 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 sub-categories.

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

20) The only goods for which use has been shown is computer software for travel and accommodation reservations. In considering the appropriate specification it is necessary to consider the parameters of the specifications of the registrations. In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade^{iv}”. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning^v. In the case of registration no 1319477 a normal and fair reading of the specification is that it encompasses computer hardware but not software, software would not normally be described as apparatus. **Consequently, there has been no use of the trade mark in respect of the goods encompassed by registration no 1319477, which must, therefore, be revoked in its entirety.** Registration no 1419333 includes computer software. In *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850 Laddie J commented upon specifications that encompass computer software at large:

“The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to Mr Silverleaf that the registration of a mark for “computer software” would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff's type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable. In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software

which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

In this case the software is used in a clearly defined and specific field. A field in which there is clearly a category of specific software targeted at a specific market, as shown by the competition with the Amadeus software. **Taking into account the *Reckitt Benckiser* and *Mercury* judgments, a fair specification, in relation to registration no 1419333, is *computer software for travel and accommodation reservations* and the registration should be revoked in respect of all of the other goods.**

21) In *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 Jacob J stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

The specification of registration on 1419651 is:

computer services; computer programming; design of computer software; all included in Class 42.

The class of the services in which they are placed may be relevant in determining the nature of the services^{vi}. Installation, repair and maintenance of computer hardware is appropriate to class 37 and so is not encompassed by the class 42 specification. The core of the meaning of *computer programming* and *design of computer software* is that of creating and/or designing software at the request of a commissioner, it is not the installing of already existing software. There is no evidence of use of the trade mark in relation to these services. *Computer services* covers all computer services in the class and so includes the services for which it has been decided that there has been no use. It would be perverse to decide that the trade mark has not been used in relation to *computer programming* and *design of computer software* and then allow a term that includes these terms. It is also clear that GI furnishes specific services in and for a discrete and clearly defined market. GI rents computer hardware and rents and leases software; it installs, maintains and updates computer software. All of

these activities take place within the discrete area of travel and accommodation reservation. Owing to the breadth of the general term *computer services*, the principles of *Mercury* apply, mutatis mutandis. **A fair specification, in relation to registration no 1419651 is:**

rental of computer hardware, rental and leasing of computer software, installation, maintenance and updating of computer software; all for use in relation to travel and accommodation reservations.

Possible amendment to specifications

22) At the hearing it was agreed that GI would be granted four weeks from the date of the issue of this decision in order to suggest alternative specifications based on the findings in this decision. **Any such specifications must be within the parameters outlined in the decision.** Allowing GI this facility is not to be taken as being tantamount to a general review of the findings of this decision. Any proposed specifications must clearly fall within the parameters of the revised specifications. GI has conceded the revocation in relation to registration no 1319478. Registration no 1319477 is to be revoked in its entirety. Consequently, in relation to these two registrations there is no possibility of amendments to the specifications.

Costs

23) For the most part EC has been successful in its applications and so is entitled to a contribution towards its costs. Costs are to be awarded on the following basis:

Application fee x 4:	£800
Applications and accompanying statements:	£300
Considering counterstatements:	£200
Considering evidence of GI:	£1,500
Preparation for and attendance at hearing:	£500
Total:	£3,200

As GI is allowed a period of four weeks to file submissions in relation to the revised specifications for registration nos 1419333 and 1419651 this decision is provisional. A supplementary decision will be issued subsequent to the filing of any submissions by GI or after 4 weeks, if no submissions are received. The period for any appeal and for the payment of costs will run from the date of the issue of this supplementary decision.

Dated this 28 day of May 2010

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

Mr Simon Malynicz of counsel, instructed by Marks & Clerk, appeared for GI.
Mr Olivier Laidebeur of Office Freylinger SA, appeared for EC.
The hearing took place on 7 May 2010.

ⁱ In relation to this issue see the judgment of the GC in *Esber, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-353/07*:

“29 The complex signs used in the evidence differ, essentially, from the earlier word mark as a result of the presence of the word elements ‘global coloring concept’ and ‘gcc’ together with the image of a globe and, sometimes, the additional word element ‘colorants & technologies’ below the sign. It is therefore necessary to examine whether those variations are capable of affecting the distinctive character of the earlier word mark.

30 In that regard, it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see Case T-135/04 *GfK v OHIM – BUS (Online Bus)* [2005] ECR II-4865, paragraph 36 and the case-law cited).

31 In the present case, the words ‘global coloring concept’ constitute one long word element, and are always juxtaposed with the term ‘coloris’ and positioned below it. In the evidence submitted, the size of the letters in those words is never greater than that in the term ‘coloris’. In contrast, in a number of items of evidence those words are appreciably smaller than the term ‘coloris’, and their position is thus clearly secondary. In addition, they are words with a general meaning. Furthermore, the word ‘coloring’ refers to the goods concerned and, consequently, has a certain descriptive character.

32 Similar considerations apply to the word element ‘gcc’. That element is also always juxtaposed with the term ‘coloris’ and positioned below it, and its size is not predominant in relation to that of the term. In addition, it does not have an obvious meaning or a particular inherent quality, and the fact that it is an acronym of ‘global coloring concept’ does not alter that assessment.

33 In the light of those considerations, it must be concluded that the word elements which accompany the earlier word mark COLORIS do not affect its distinctive character.

34 As for the figurative element representing the globe, it does not alter the distinctive character of the earlier word mark either. It is a generic representation which is not reproduced in a particularly creative or unusual way. In addition, nor does its size, which is not disproportionate in relation to the other elements of the signs concerned, call that finding into question.

35 Lastly, as for the word element 'colorants & technologies', it must be found that, when used, it is always placed conspicuously below the other elements, so that it has a clearly secondary position. In addition, it is a complex word element made up of a sub-element, 'colorants', which refers expressly to the goods concerned and which thus has a descriptive character, and another sub-element, 'technologies', which has a generic character. In the light of those considerations, it can be concluded that that complex word element also does not affect the distinctive character of the earlier word mark.

36 In conclusion, it follows from the foregoing that the complex forms, including the earlier word mark, used in certain items of evidence do not have any differences which alter the distinctive character of the earlier mark, within the meaning of Article 15(2)(a) of Regulation No 40/94. Consequently, the Board of Appeal did not err when it took those signs into consideration for the purpose of assessing the evidence of genuine use of the earlier mark.

37 That conclusion cannot be called into question by the applicant's other arguments. First, the argument that the sign made up of the word element 'coloris global coloring concept' together with an image of a globe is a registered mark different from the earlier mark has no factual basis, since that sign was registered as a trade mark only on 22 November 2004, that is, after the expiry of the relevant period. Moreover, since the complex sign is a particular representation of the earlier word mark which does not alter its distinctive character, the fact that it was registered as a trade mark is not relevant.

38 Second, as to the argument that, in the evidence, the signs are not used as marks but merely refer to an undertaking, it must be stated first that it has no factual basis. The case-file does not show that, in the evidence submitted by the intervener, the signs concerned were used as a trade name or refer to an undertaking or to a particular type of company. In addition, it is not well founded. The fact that a word element is used as the company's trade name does not preclude its use as a mark to designate goods (see, to that effect, judgment of 27 September 2007 in Case T-418/03 *La Mer Technology v OHIM – Laboratoires Goëmar (LA MER)*, not published in the ECR, paragraph 74)."

ⁱⁱ *Animal Trade Mark* [2004] FSR 19:

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

value judgment as to the appropriate specification having regard to the use which has been made.”

ⁱⁱⁱ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is-- how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

^{iv} *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

^v *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

^{vi} *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.