

O-210-13

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 2 392 931
IN THE NAME OF RAZA SYED IN RESPECT OF THE MARK: ALIAS

AND

AN APPLICATION FOR REVOCATION UNDER NO 84340
BY BAKER AND MCKENZIE LLP

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In the name of Raza Syed in respect of the Trade Mark: ALIAS

And

An Application for Revocation under No 84340

By Baker and McKenzie LLP

The Background and Pleadings

1. Raza Syed (RS) is the registered proprietor of trade mark registration 2 392 931 consisting of the word ALIAS. The trade mark was filed on 27/05/2005 and completed its registration procedure on 09/12/2005. It is registered in respect of the following goods:

Class 03:

Cosmetics, toiletries, perfume

2. Baker and McKenzie LLP (BM) seek revocation of the trade mark registration on the grounds of non use based upon Section 46(1) (b) of the Trade Marks Act 1994. RS filed a counterstatement denying the claim in respect of the goods set out above, save in respect of "cosmetics". I will return to this point later. No reference is made to proper reasons for non use. Rather, with the exception of cosmetics for which no defence is made, the defence rests on there being genuine use of the mark.
3. RS filed evidence and written submissions. Neither side requested a hearing and so I take this decision following careful consideration of the papers.
4. Following amendments to the TM26 during the proceedings, revocation is sought under Section 46(1) (b) in respect of the time period from 6 February 2007 to 5 February 2012. Revocation is therefore sought from 6 February 2012.

DECISION

Legislation and case law

5. The relevant parts of section 46 of the Act read:

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

(a)

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

(c)

(d)

(2) For the purpose 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.”

6. Section 100 is also relevant, which reads:

“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.”

7. When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

1. Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].
2. The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].
3. The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].
4. The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].
 - (a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].
 - (b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].
5. All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].
6. Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

The Registered Proprietor’s evidence

8. This is a witness statement, from Raza Syed. In 2006, Mr Syed explains that he presented his toiletry/perfume product that he had developed to a number of companies. It was subsequently agreed that he would supply Nield Distribution Limited (NDL) with a

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

parfum de toilette. At the time, NDL were a leading distributor in the United Kingdom but ceased to trade in 2008. Exhibit RS1 is an example of the packaging of the aforementioned product and Exhibit RS2 contains a photograph of the parfum de toilette product. I note that each clearly bear the trade mark ALIAS. Exhibit RS3 is a selection of invoices from RS to NDL dated between February 2007 to January 2008. The products to which the invoices relate are clearly ALIAS parfum de toilette. Mr Syed also confirms the turnover for this period, which was £63,594.76 between February and December 2007 and £4,653 for 2008. My Syed goes on to explain that his product was also offered for Christmas 2007 to another company, MST Limited. However, these orders were subsequently not supplied due to the sale of MST to a third party. Mr Syed ends by asserting that genuine use of the ALIAS trade mark in respect of toiletries and perfume within the relevant period in these proceedings has been established by the materials contained within the aforementioned exhibits. Cancellation of this trade mark would therefore be damaging to his business.

9. The evidence of use is dated within the relevant period; the invoices provided contain sufficient information concerning the commercial volume of the use, the length of the period and the frequency; and, finally, the evidence shows that the mark has been used as registered and in connection with parfum de toilette. Consequently, the evidence of use, considered as a whole, consists of sufficient indications concerning the place, time, extent and nature of use of the registered trade mark for at least some of the goods in respect of which it is registered.

10. However, the evidence filed by the opponent does not show genuine use of the trade mark in connection with all the goods covered by the earlier trade mark. Use of the mark has solely been in respect of parfum de toilette, a type of perfume. In deciding therefore, upon a fair specification, I am mindful that the description must not be over-precise². It is necessary to consider how the relevant public would likely describe the goods³. The General Court ("GC") in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 ("Aladin")* held:

"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.

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

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 subcategories 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.”

11. I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

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

12. As I have already said, the use shown has been upon parfum de toilette, a type of perfume. To my mind, for the registration to remain in force for “toiletries”, proven use would have been required against a range of toiletry products. This has not been shown here. Further, perfume is not, in my view, a term within which there exist a number of clear sub categories. Bearing this in mind, I consider therefore that the evidence filed demonstrates genuine use in respect of the term perfume but not in respect of the term toiletries. I also bear in mind that as regards cosmetics, the registration is undefended. The net effect of all this is that the registration is revoked in respect of “toiletries” and has effectively been surrendered in respect of “cosmetics”. The revocation will take effect from 6 February 2012. The registration remains valid in respect of perfume.

COSTS

13. It is clear that each of the parties has achieved a measure of success in these proceedings with the effect of no one party being clearly more successful than the other. I therefore make no award of costs and direct that each party bears its own costs.

Dated this 21st day of May 2013

**Louise White
For the Registrar
The Comptroller-General**