

O-229-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NOS 1436588 and 1436589  
IN THE NAME OF FUGRO NV  
OF THE TRADE MARK:**

**SKYFIX**

**AND THE APPLICATIONS FOR REVOCATION THERETO  
UNDER NOS 81864 AND 81865  
BY  
BRITISH SKY BROADCASTING GROUP PLC**

## **Trade Marks Act 1994**

**In the matter of registration nos 1436588 and 1436589  
in the name of Fugro NV  
of the trade mark:  
SKYFIX  
and the applications for revocation  
thereto under nos 81864 and 81865  
by British Sky Broadcasting Group plc**

### **BACKGROUND**

1) On 21 September 2004 British Sky Broadcasting Group plc, which I will refer to as BSB, filed applications for the revocation of two trade mark registrations of the word: SKYFIX. The registrations are currently in the name of Fugro NV; at the time of the filing of the applications for revocation, they were in the name of Thales Geosolutions Group Limited. I will refer to the registered proprietor as Fugro throughout the decision. The registrations are for the following goods and services:

*apparatus, instruments and computer programmes, all for use in surveying, position-fixing, telecommunications, data transmission or data processing; parts and fittings for all the aforesaid goods; all included in Class 9;*

*telecommunications and data transmission services; all included in Class 38.*

The registration process for no 1436588 was completed on 7 February 1992, the process for no 1436589 was completed on 18 May 1992.

2) BSB claims that the trade mark had not been put to genuine use in relation to the goods and services of the registrations within five years following the dates of the completion of the registration processes. Consequently, the registrations should be revoked as per section 46(1)(a) of the Trade Marks Act 1994 (the Act). Further, or alternatively, BSB claims that use of the trade mark has been suspended for an uninterrupted period of five years and so the registrations should be revoked as per section 46(1)(b) of the Act. If it is found that the trade mark has been used in respect of some goods and services, BSB states that the registrations should be revoked in respect of the remaining goods and services. BSB requests revocation of no 1436588 from 7 February 1997 under section 46(1)(a) of the Act or from 19 September 2004 as per section 46(1)(b) of the Act. BSB requests revocation of no 1436589 from 18 May 1997 under section 46(1)(a) of the Act or from 19 September 2004 as per section 46(1)(b) of the Act. BSB requests an award of costs.

3) Fugro denies the grounds of revocation and seeks an award of costs.

4) Both sides furnished evidence.

5) A hearing was held on 2 August 2006. BSB was represented by Mr Malynicz of counsel, instructed by Olswang. Fugro was represented by Mr Rawlence of Mewburn Ellis.

6) There is for the most part a duplication of the evidence. These cases should have been consolidated prior to the filing of the main evidence. I intend dealing with the cases together and this decision will cover both cases.

## **EVIDENCE**

### **Evidence of Fugro**

#### **Evidence of Alastair Rawlence**

7) Mr Rawlence is a trade mark attorney acting for Fugro. He exhibits a copy of Thales Geosolutions SkyFix offshore positioning services brochure. The brochure advises that the SkyFix GPS network is one of the largest commercial GPS networks of reference stations in the world. It has been in operation for ten years and has at any one time an average of over one thousand offshore users worldwide. The brochure states:

“Each Thales GeoSolutions office has installation engineers available both to install and support offshore SkyFix systems providing assistance nearby every major offshore oil and gas field in the world..... In addition, a further team of GPS specialists, based in the UK, provide both technical and development support to the Thales GeoSolutions Group for the SkyFix services.”

The brochure bears a United Kingdom address and a 2003 copyright date.

8) Thales Geosolutions material relating to the SkyFix 90938 decoder is exhibited. It is a receiving unit that can interface directly with existing SkyFix antennae. An article from ‘The Hydrographic Journal’ is exhibited, it is written by employees of Thales Geosolutions. In the article the following appears:

“Navigation signals are from Thales GeoSolutions’ SkyFix Premier service, which has been introduced to mitigate the effects of ionospheric disturbances...”

The system is being used upon a ship.

9) A list of equipment bearing a date of 4 April 2002 is exhibited. It has references to Thales SkyFix DGPS receivers and Thales SkyFix Spot receivers. It is stated that the equipment was supplied under contract to a United Kingdom based client but no details of the client are given.

10) Mr Rawlence states that the registrations were originally in the name of Decca Limited. They were then assigned to Racal Survey Group Limited. A printout from the website of Companies House shows that Racal Survey Group Limited changed its name

to Thales Survey Group, then Thales Geosolutions Group Limited and finally to Fugro TGS Group Limited. Mr Rawlence states that the registrations were then assigned to Fugro NV.

11) An article from 'The Hydrographic Journal' of July 2003 is exhibited. It relates to the launch of SkyFix XP. The article states:

“Thales has launched a new generation of decimetric Differential GPS (DGPS) positioning systems, offering the oil, gas and hydrographic industries new levels of accuracy and quality of service....”

The article goes on to state:

“SkyFix XP's associated new MultiFix 4 software package builds on the high levels of quality control.....”

Pages from the Internet are exhibited. They emanate from 28 November 1999, 9 March 2000, 2 February 2001 and 3 February 2004. The pages emanate from Racal Survey, Racal and Fugro. They all describe SkyFix as a DGPS system for offshore use. The Fugro pages refer to the use of Multifix IV Positioning and QC software.

### **Evidence of Rob Hayles**

12) Mr Hayles is a software manager of Fugro Intersite Limited, which is a wholly owned subsidiary of Fugro. Mr Hayles states that SKYFIX has been used continuously in the United Kingdom by Fugro Intersite Limited, and the predecessors in title, since 1990. SKYFIX is the brand name of a worldwide satellite based global positioning system. SKYFIX GPS systems are used for seismic exploration, rig moves and construction products. Mr Hayles states that associated software packages under the trade mark SKYFIX have been developed by Fugro Intersite Limited, and its predecessors in title, for the hardware systems. No material showing such use is exhibited. Support systems are also provided by telecommunications and data transmission services to clients via a global computer network controlled from Fugro Intersite Limited's centre in Aberdeen.

13) A CD is exhibited, it emanates from September 2001. Amongst other things, it deals with the coverage of the SkyFix and Skyfix Spot systems; supplying maps of the coverage. The CD includes the following:

#### **“Thales GeoSolutions - Coverage Maps**

##### **SkyFix Low Power and High Power Coverage**

Thales GeoSolution SkyFix and SkyFix Premier DGPS Services cover almost all coastal regions in the world. Corrections are provided via Low Power and High Power communication satellites. Subscribers to the SkyFix DGPS Service receive corrections via Inmarsat-C geostationary communications satellites. The SkyFix

Spot DGPS Service functions in a similar way, except the satellite transmissions are provided by powerful High Power or Spot beams focused on geographical regions. Thales now also provide a DGLONASS Service with two GLONASS reference stations in Brazil.

The following maps show the Thales GeoSolutions global and regional SkyFix and SkyFix Spot coverage. Stations with dual-frequency capability for the SkyFix Premier Service have been marked with an extra circle around the symbol.”

A copy of part of an operators manual for SkyFix Mk 5 is exhibited. It bears a copyright notice of 2003 Fugro. A version history lists amendment dates of 20 December 2002, 1 April 2003 and 29 November 2004. The manual includes the following:

“The 90982 SkyFix Mk5 receiver is a new generation receiving unit for offshore DGPS applications. The unit is the successor to the 90938 SkyFix Mk3 Receiver and is packaged to fit into a 19-inch rack taking only 1U of rack space.

The unit has been designed for use with a new Fugro L-Brand Antenna Type 90984. To ensure compatibility with existing ship fits, the unit is also capable of interfacing directly to the existing 70MHz SkyFix Spot Beam Antenna 90962 and the SkyFix MiniDome ...”

14) A copy of a contract between TSSL Temasa of Spain and Racal Survey Ltd is exhibited. The contract bears the date of 21 February 2000; it states that it is for the supply of GPS differential correction signals. The contract, at page 11, refers to the service that is to be provided:

“Provision of GPS differential correction data, world-wide, on a pay-when-use (PWU) basis from SkyFix reference stations which are strategically sited to cover the principal areas of interest and connected by permanent data communications links to the control centre in Aberdeen.

Each reference station is equipped with dual GPS receivers, PCs and software.”

The contract goes on to state upon which vessels the service will be available. The contract also states that:

“SkyFix Demodulators are controlled remotely by our Network Control Centre in Aberdeen.”

A copy of a contract bearing the date 25 September 2002 is exhibited. Mr Hayles states that the contract is between Racal and TotalFinaElf Exploration UK PLC and was for the hire of SKYFIX GPS systems and associated hardware and software. On a page bearing the name Racal, which bears a reference to being a quotation (rather than a contract) there is a reference to a SkyFix 90938/M DGPS Receiver c/w antenna system. A further page refers to a primary positioning system. It states that the primary positioning system will

be “Racal’s SkyFix DGPS”. There are references to SkyFix reference stations. The document goes on to state that “each reference station is equipped with dual GPS receivers, PCs and software”. The document has a section headed quality control software. This section states that:

“Racal’s MultiFix II provides the ability to monitor, analyse and verify the quality of DGPS data in real time. It is recommended that this system be used at all times to verify the quality of the offshore positioning solution.

Differential corrections from both SkyFix and DeltaFix input and the data is filtered and assessed for quality before being used in the computation of the solutions.”

A schematic diagram of rig move equipment shows various equipment. One box shows SkyFix receiver. There is no other reference to SkyFix. There is a reference to “PC running MultiFix II QC Software”. There are also pages exhibited which relate to the hire of SKYFIX equipment. The equipment is described as being demodulators. Software is described as being Multifix, GPS receivers as Trimble 4000 series; there is also a reference to Inmarsat Dome.

15) An agreement between France Telecom marine and Racal Survey Limited is exhibited. It relates to the supply of GPS differential correction signals and bears a date of 1 April 2000. The agreement refers to SkyFix data. Skyfix is described as “a differential global positioning service transmitted via Inmarsat pre-assigned channels by RACAL to its subscribers”. The system is for use onboard ship. There are annexes relating to a schedule of rates, scope of supply and system description. SkyFix, in relation to equipment, is used in relation to a decoder/demodulator. Other trade marks referred to include Inmarsat and Landstar. There is reference to SkyFix reference stations. There is a reference to a SkyFix receiver. A section dealing with network monitoring states that the primary software used is Racal’s Hub software, the second level of monitoring is carried out by Racal’s Multifix software. Mr Hayles states that the goods and services were supplied to the French customer from the United Kingdom.

16) Exhibited is a page from the Internet. It is headed Institute of Engineering Surveying & Space Geodesy and was downloaded on 31 January 2006. There is a reference to use of Racal’s “SkyFix system’s data and facilities”. A letter from Thales Navigation Ltd dated 21 August 2002 is exhibited. It is addressed to Thales GeoSolutions Group. It relates to the enclosure of copies of the SkyFix upgrade system requirements specification. The final material exhibited by Mr Hayles is a copy of details about Thales GeoSolution SkyFix station coordination procedure.

### **Evidence of BSB**

17) This consists of a witness statement by Sarah Wright. Ms Wright is an assistant solicitor at Olswang. Ms Wright exhibits section D of the agreement between Racal and TotalFinaElf Exploration UK, which is referred to in paragraph 14. This section deals

with the scope of work governed by the agreement. It states that the contractor will provide rig and vessel based positioning services for offshore semi-submersible and jack-up drilling units as required. The contractor will provide positioning equipment and various other equipment. These are identified generically rather than by trade mark.

## **DECISION**

### **Preliminary issue**

18) At the hearing both sides asked to have additional evidence admitted. This consisted of a statement by Mr Rawlence correcting an earlier error and Ms Wright's evidence. Both sides were content for the additional evidence to be admitted. I agreed to the admission of the additional evidence. Ms Wright's evidence was admitted on the proviso that the evidence would be resubmitted forthwith accompanied by form TM54, as required by rule 31A(7) of the Trade Marks Rules 2000 (as amended). (This has since been complied with.)

### **Substantive issue**

19) Section 46 of 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.”

Consideration has to be taken, also, of section 100 of the Act which 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 the onus is upon the registered proprietor to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

20) It was Mr Malynicz's position that Fugro had not demonstrated use in relation to the services provided in the United Kingdom. At the hearing, he conceded that there had been use for certain goods, if for export purposes only. Mr Malynicz's premise turned on the lack of evidence that the services had been received within the United Kingdom or its territorial waters or the United Kingdom sector of the continental shelf, as per section 107 of the Act. He considered that Fugro could not rely upon section 46(2) of the Act as this relates to the affixing of the trade mark upon goods; it does not cover services. It seems to me that this must be correct as this section of the Act specifically relates to the use of goods and does not diverge from First Council Directive 89/104 of December 21, 1988. Fugro's claim to use in relation to services rests very much on the three contracts/agreements which it has exhibited. The TSSL Temasa and France Telecom marine contracts are with undertakings from outside the jurisdiction. There is no indication that the services have been supplied within the jurisdiction. The services were supplied for vessels and so the vessels might have entered and used the services within the jurisdiction. However, there is no evidence to that effect. Taking into account the nature of the service, which is linked to offshore use, it seems to me that the key question rests as to where the customer is based and where its vessels are based, rather than where vessels might be temporarily. The hub of the services supplied by Fugro is clearly Aberdeen; in passing-off terms this might be considered the attractive force and location of the goodwill. However, the location of the goodwill and the location of where the trade mark has been used can, and in the case of the TSSL Temasa and France Telecom marine contracts appear to be, very different matters. The two cannot be conflated. The question for revocation purposes is where the trade mark has been used; that Aberdeen is the nerve centre of the operations is not determinative. India is the hub of the operations of some banks and insurance companies in the United Kingdom; the services that are being supplied are being supplied to the United Kingdom, not to India, the location of use is the United Kingdom. In relation to the TSSL Temasa and France Telecom marine contracts, I am in agreement with Mr Malynicz that these contracts cannot be used to support the maintenance of the registration in relation to services as they do not demonstrate use of the trade mark in relation to services within the jurisdiction.

21) TotalFinaElf Exploration UK PLC is a United Kingdom company. The contract gives the address for North Sea operations as Aberdeen. The locations for mobilisation and demobilisation are given as Rosyth, Faslane, Portsmouth, Devonport, Gateshead and Leith. (It is not clear what mobilisation and demobilisation mean, although I suspect that they mean making the equipment operative or inoperative.) The contract relates to the northern North Sea (see clause G 2 c), so the actual services could be used outside the jurisdiction. As I have indicated above, I do not consider that this is the key issue. Owing to the nature of the services, I am of the view that the key matter is the centre of activity of the customer in relation to the services being provided. This is clearly Aberdeen; all the ports of mobilisation, demobilisation are in the United Kingdom. It could be that the equipment to make use of the services may not be activated until the vessel or rig is outside the jurisdiction; but this is a matter of when the customer chooses to use the service, not when and where the service is being provided to. If the service has been paid for there is no requirement for it to be used; one is paying for the right to use

the service, this is the key matter. I am of the view that the TotalFinaElf Exploration UK PLC establishes use of the trade mark for services within the United Kingdom.

22) In *Ansul BV v Ajax Brandbeveiliging BV* Case C-40/01 the European Court of Justice (ECJ) stated:

“In the light of the foregoing considerations the reply to the first question must be that Article 12(1) of the Directive must be interpreted as meaning that 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 mark. 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. The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

So, if I am wrong in relation to my view of the effects of the TotalFinaElf Exploration UK PLC contract, this is not the end of the matter. Fugro’s position could still be saved if it could be shown that it was trying to create or preserve an outlet for its services. There is nothing token or spurious about the use by Fugro. It is also clear that the services it furnishes are of a specialist nature for a specialist market. The absence of promotional material was criticised but in such a specialist and niche area this says little in my view. There is the clear evidence of Fugro’s contract with TotalFinaElf Exploration UK PLC for its services; both undertakings being based in the United Kingdom for the purposes of the contract. A contract has been negotiated for the services with a United Kingdom company, the negotiating of the contract shows the creation or preserving an outlet for its services. So I consider that on this basis Fugro would satisfy the *Ansul* test.

23) *Ansul BV v Ajax Brandbeveiliging BV* sets no de minimis figure for use. In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-416/04 P the ECJ stated:

“71 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 (see, to that effect, order in *La Mer Technology*, paragraph 22).

72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

Taking into account the nature of the services, the limited proof of use within the jurisdiction serves, in my view, a real commercial purpose.

24) Having decided that there had been genuine use in relation to goods and services, I need to decide what a fair description of the goods and services should be. There is a tranche of case law in relation to this matter:

*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.”

*Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03*

“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 Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark

was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or 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.”

*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."

Mr Malynicz also referred to *Omega SA v Omega Engineering Inc* [2003] FSR 49:

"2. The Hearing Officer has summarised the evidence of use which had been put in by the trade mark owners, the attack being based on non-use. Somewhat sadly, he had apparently good cause to criticise the quality of that evidence. It remains the case that those concerned to prove use of trade marks should provide clear evidence relating to the goods or services which are relevant, not to other goods, and should ensure the evidence is concise, precise but yet complete.

3. The upshot of all this, so far as I am concerned, boils down to a very narrow point. The trade mark owners wish to keep within the specification the following goods, "signalling instruments and apparatus". To justify this the only uses which they have, are for display boards and screens and associated technical equipment for information boards on railway stations and scoreboards at sports grounds. Mr. Edenborough accepts that probably on any basis the specification is too wide. It would include flags used by guards on the trains, or that used to be used by guards on trains. It would include semaphore flags, Morse code transmitters, and so on. He suggested there could be fall-back positions: "public information display apparatus" or perhaps, if he was relying only on the apparatus that was used on railway stations, "passenger information display apparatus".

4. Before one gets, however, to that, one must ask whether scoreboards and railway information screens (for which use has been proved) are properly to be regarded as "signalling instruments and apparatus". Mr. Edenborough submits that they are. In a technical sense there is something in what he says. You look at the screen for information and because it is providing information visually it is, in a sense, sending out a signal. But I do not think it is right to regard trade mark specifications from a technical point of view. It is much more important to regard them from a trade point of view. These specifications are not patent claims, they

are specifications of goods for the purposes of trade. I do not believe that anybody in the ordinary way of things would regard a display screen as a "signalling instrument or apparatus". On the contrary, in the ordinary way of things someone who looks at a television screen or other sort of screen would regard that as the thing which had received the signal. Technically, as a matter of information science, maybe a thing is also providing information and in that sense sending a signal, but in the commercial sense it is not a signalling instrument.

5. The Hearing Officer, I think, approached it completely accurately. He said as follows:

"[The proprietor] showed use of the trade mark in relation to public information display apparatus. However, I cannot see how such goods are encompassed by the specification of the registration. Ms. Arenal argued that *signalling instruments and apparatus* would encompass such goods as they receive a signal. Just because a product receives a signal it does not make it a piece of signalling apparatus. Televisions and radios receive signals, it would not be normal to describe them as signalling apparatus."

6. That seems to me to have approached the matter entirely accurately and properly. This appeal is by way of review only. So it has to be shown that the Hearing Officer has gone wrong in principle or made a manifest error on the evidence. To my mind, far from making such a mistake, on the contrary, I think he got it completely right. I therefore dismiss the appeal."

25) Mr Rawlence considered that the evidence supported the maintenance of the specifications in their entireties. He considered that there had been evidence in relation to use on software. The primary basis for this was the copy of the 'SkyFix Mk 5 Operators Manual' exhibited at FG2, in the introduction the following is written:

"The unit includes a 300Mhz PC Processor, which runs the user interface and the Remote I/O application code. The processor also provides the capability for future development of the system. For example, you will be able to run position processing algorithms on the internal PC."

It was his submission that the software was bundled with the receiver and so was use of the trade mark on software. It is not a submission that I find attractive. The computer in front of me bears the trade marks of the maker of the computer, of the maker of the processor, of the supplier of the operational software and of the monitor; all separate, all different. The submission is based on assertion without evidence. Mr Hayles claims that there has been use in relation to software. However, there is no evidence to this effect. Indeed, the evidence is to the opposite effect; where there is reference to software, it is to Multifix or to Racal Hub software. Mr Hayles in his evidence claims use of the trade mark by reference to the specifications rather than to actual use as evidenced by the exhibits, which clearly lacks specificity. Mr Rawlence argued that because the service provided used telecommunications and transmitted data, the class 38 specification should

be left intact. It seems to me that this is the sort of argument that was advanced and rejected in *Omega SA v Omega Engineering Inc*. A bank will use telecommunications and data transfer services, that does not mean that that would be a fair description of its services. Nowadays, there is hardly an undertaking that does not use such services. Fugro's customers are not paying for a telecommunication service or a general data transmission service.

26) What would be a fair description of the goods and services? I have no doubt from the evidence that the service would be described as a GPS or DGPS service. The purpose of the goods is to allow for the provision of the service, so the goods will be limited to this function also. (As I have indicated, there is no evidence of use of the trade mark in relation to computer programmes.) Mr Malynicz's position was that if the goods and services were to be limited it should be by reference to DGPS rather than GPS. Mr Hayles describes the services provided as being GPS using communications satellites to relay the differential corrections. The contracts refer to DGPS or GPS differential correction data. However, there is also reference to the SkyFix GPS network eg at AJR1. In the TotalFinaElf Exploration UK PLC contract there are references to DGPS data, DGPS systems, performance of DGPS. However, there are also references to GPS. In the schematic diagram the box marked SkyFix receiver has two lines leading to it; one marked differential corrections source antenna and the other GPS antenna; there are three lines leading from the box, marked raw GPS pseudo-ranges, differential corrections and FCI. I have had some difficulty in deciding whether to side with Mr Malynicz or not. The majority of the literature in relation to the service refers to DGPS, this appears to be the service for which the customers are specifically paying. It seems to me that this does, therefore, represent a valid sub-category and that by limiting the goods and services to relating to DGPS, I am not being over pernickety.

## **Conclusion**

27) I consider that the specifications of the registrations should be limited to read:

*1436588: Apparatus and instruments, all for use in differential global positioning fixing; parts and fittings for all the aforesaid goods; all included in Class 9.*

*1436589: Differential global positioning services; all included in class 38.*

BSB clearly set out that it was seeking revocation under section 46(1)(a) as well as section 46(1)(b). There is no evidence that there has been use on other goods or services since the completion of the registration process and so I consider that the partial revocation should be based upon the claim under section 46(1)(a). Therefore, the partial revocation is to take place from 7 February 1997 in respect of registration no 1436588 and from 18 May 1997 in respect of registration no 1436589.

## **COSTS**

28) As each side has had a measure of success, I consider that each should bear its own costs.

**Dated this 10th day of August 2006**

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