

O-248-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 82195
BY STEPHEN WILLIAMS, DEWI RICHARDS, DAVID BIRD
AND DAVID O'BRIEN (TRADING AS LOVETRAN)
FOR REVOCATION OF REGISTRATION No. 1584236
STANDING IN THE NAME OF NIGEL WANLESS**

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(trading as Lovetrain)**

**for Revocation of Registration No. 1584236
standing in the name of Nigel Wanless**

BACKGROUND

1. Trade Mark No. 1584236, LOVE TRAIN, is registered in respect of “Services in the fields of stage presentations, discos, nightclubs, cabarets and dances and publishing; all included in Class 41”. It was applied for on 7 September 1994. The registration process was completed on 11 September 1996. The registration is subject to a disclaimer of the word LOVE but nothing turns on the presence of the disclaimer.
2. On 16 June 2005 Stephen Williams, Dewi Richards, David Bird and David O'Brien (trading as Lovetrain) applied for revocation of this registration claiming non-use during the period ending on 22 June 2004. In the alternative, if the proprietor can show use during that period, the applicants seek revocation with effect from 16 June 2005. Although the statement of grounds does not refer to the relevant Section of the Act, the above claims are clearly intended to relate to Section 46(1)(b) of the Act. At this stage it seems that the attack was against all the services of the specification.
3. The registered proprietor filed a counterstatement and, pursuant to Rule 31 of the Trade Marks Rules 2000 (as amended) evidence of use of the mark under cover of a witness statement from Mr Wanless himself.
4. Presumably in response to the evidence filed, the applicants sought leave to amend their statement of case. The substance of the amendments was to accept that use had been shown in relation to disco and cabaret services and, accordingly, to restrict the attack to the balance of the specification, that is to say services in the field of stage presentations, nightclubs, dances and publishing. The amended statement of case has been admitted into the proceedings.
5. At about the same time Mr Williams, one of the applicants, filed a witness statement in support of the application for revocation.
6. By letter dated 28 April 2006 the parties were offered the opportunity to file written submissions or request a hearing. Neither side has asked to be heard. Written submissions have been filed by GW & W, Groom Wilkes & Wright LLP, the applicants' professional advisers.
7. Acting on behalf of the Registrar and with the above-mentioned material in mind I give this decision.

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

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

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

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

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

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer 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.”

8. Section 100 of the Act is also relevant and places the onus on a proprietor to show use when a challenge arises.

9. The leading case on what constitutes ‘genuine use’ is the ECJ’s judgment in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)*, [2003] R.P.C. 40. It sets out what constitutes qualifying and disqualifying use. In the latter category is use which is merely token or internal to the undertaking concerned. For the use to qualify as genuine it must be consistent with the essential function of a trade mark and must be aimed at creating or preserving an outlet for the goods and services concerned. In other words it must be use on the market. These guiding principles are evident from paragraphs 36 to 38 of the *Ansul* case.

10. Mr Wanless’ witness statement (and 11 exhibits) explains how he came into ownership of the registration. It also explains the derivation of the business conducted under the LOVE TRAIN mark which started as a weekly event at an establishment called the Town & Country Club in Leeds. The original event was held in 1989 though the previous proprietor did not file a trade mark application until 1994. Mr Wanless describes events during that period in the following terms:

“The events involved a 1970’s themed theatre-style show including an on-stage performance by myself and a number of performers and musicians.”

11. That, of course, pre-dates the relevant five year periods in the current case. More recently, and of relevance to this action, Mr Wanless says:

“5. Love Train continued at the Town & Country Club on a weekly basis until the venue closed in 1999, since which time I have continued promoting and organising Love Train to date both as regular nights and other individual events at a number of venues around the UK. Love Train has been performed weekly at The Ritz, Whitworth Street, Manchester since 1999 and I refer to the exhibits marked “NW02” and “NW03” which refer to myself in connection with Love Train at The Ritz as well as a number of other Love Train events. In keeping with the themed 70’s performance of Love Train and for the sake of marketing and promotional material, I tend to operate under the alias ‘Brutus Gold’ and hence references to ‘Brutus’ or ‘Brutus Gold’ are references to me. I refer to exhibit “NW04” which is a newspaper article from 21 April 2003 as evidence of the same as well as the exhibit marked “NW05” which is another article for bbc.co.uk dated September 2003 showing a picture of myself alongside the caption ‘Brutus Gold with his dancers at Love Train’. In addition, I refer to exhibit “NW06” to verify the number of Love Train events held between June 2000 and May 2001. Love Train is also currently held weekly on Fridays in Edinburgh at City Nightspot, and I refer to the exhibit marked “NW07” in this regard.

6. Since 1995, I have invested significant funds into the production of promotional materials for Love Train. As evidence of the same I refer to the exhibit marked “NW08” which provides details of my website www.brutusgold.com dating back to 2001 accompanied by printouts of pages from that website as they appeared in January 2002 and a number of invoices relating to the design and hosting of the same. In addition I undertaken [sic] radio advertising and have had numerous promotional materials made in connection with Love Train including brochures, DVDs, posters and leaflets as indicated by the exhibit “NW09”, which includes promotional artwork from 2003; numerous invoices dated between 2000 and 2002; and, a number of letters from my suppliers indicating their longstanding relationship with myself and Love Train. The exhibit marked “NW10” is my current brochure, which I have been using since 2004.
7. The exhibit marked “NW11” contains further miscellaneous recent correspondence to show that I promote and run Love Train and have done so since at least 1995 as I have indicated above.”

12. On the strength of this evidence the applicants concede that the mark has been used in relation to discos and cabarets. They were manifestly right to do so. There can be no doubt that Mr Wanless has shown genuine use within the scope of the specification in respect of those services. The real issue is whether that use extends to the full scope of the specification or a more limited part of it as the applicants claim.

13. At this point I should refer briefly to the applicants and the nature of their interest. They have filed an application of their own for the mark LOVETRAIN (No. 2366547). Mr Wanless’ registration is an obstacle to it progressing past the examination stage. The applicants use LOVETRAIN as the name of a band that offers live musical entertainment.

14. Mr Williams, one of the applicants, has filed a witness statement in which he says that they have been aware of Mr Wanless’ use of LOVE TRAIN for many years and have had no problem with his use of that name on the basis that the services he provides are different to theirs. It seems from Mr Williams’ evidence that the parties have been in discussion in the past with a view to a co-existence agreement. According to Mr Williams, Mr Wanless has “refused to agree to the terms of settlement that we suggested”. He does not say what those terms were.

15. He goes on to describe a telephone call he made to Mr Wanless’ organisation to establish the scope of the latter’s business. In particular he says he enquired whether LOVE TRAIN was a live music act and was told it was not. The entertainment provided was said to be in the nature of a disco and cabaret. The precise date and the name of the (female) person contacted are not given. This part of Mr Williams’ evidence is hearsay and in my view can be given little weight. His evidence taken as a whole serves to explain the background and context to the dispute.

16. Before turning to consider the scope of the registered proprietor’s specification and evidence of use in more detail it is appropriate to set out how a fair description of services is to be arrived at.

17. The Court of Appeal considered the approach to be adopted in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*, [2003] R.P.C. 32 with *Aldous L.J.* holding that:

“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.”

18. Accordingly, fairness to the proprietor does not require an overly broad specification. In deciding how to describe the use shown the tribunal must have regard to the nature of the trade and how the notional consumer would describe such use.

19. In *Reckitt Benckiser (Espana), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the Court of First Instance considered how to approach the issue of use where a trade mark has been registered for a broad category of goods that might itself contain a number of sub-categories. The Court held that:

“45 It follows from the provision 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.”

20. That case involved the issue of proof of use within the context of opposition proceedings but the same principles should apply when considering genuine use for revocation purposes. The earlier mark was registered for a specification solely in respect of ‘polish for metals’. The Court noted that this description restricted the goods both as to function (polishing) and intended purpose (for metals) and considered that the OHIM Board of Appeal had been wrong to deem the earlier trade mark to be registered for a narrower specification of a “product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)”. In short the sub-category of goods ‘polish for metals’ was sufficiently precise and narrowly defined.

21. Geoffrey Hobbs QC, sitting as the Appointed Person, considered these earlier authorities in *WISI Trade Mark*, [2006] R.P.C. 22 and concluded as follows:

“15 According to this approach, fair protection is to be achieved by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify.

16 This I take to be entirely consistent with the listing process envisaged by Pumfrey J. in *Decon* and with normal trade mark practice. It is not necessary for the purposes of the Nice Agreement to refer to characteristics that may be present or absent without changing the nature, function or purpose of the specified goods. It is therefore normal for registered trade mark protection to be conferred without reference to such matters as the style or quality of the goods of interest to the proprietor of the trade mark.”

22. Returning to Mr Wanless’ evidence, much of it goes (as it needed to) to the fact of use, geographical coverage, dates of use etc as distinct from the precise nature of the services provided. As the fact of use has been accepted I need only concentrate on those Exhibits that illuminate the nature of the services provided. In doing so I take into account the applicants’ written submissions on what in their view the evidence shows.

NW02 - extracts from the Manchester Student Guide refer to Love Train as offering a soul/disco/funk night but does not describe the nature of the entertainment in more detail;

NW04 - an Evening Gazette article (Teesside) describes Mr Wanless (Brutus Gold) as a funky DJ. The article is essentially a lengthy write-up of

Mr Wanless' history and his alter ego Brutus Gold. It is not entirely clear from this whether his appearances are always under the name LOVE TRAIN, though there is, a mention of the 'Lurve train';

- NW05 - an article from the www.bbc.co.uk website entitled "On board the Love Train". It is described as being a "parody of all things disco". Although primarily disco-based I note that the side panel to the main question and answer interview says that "Brutus doesn't perform alone. There's a whole cast who dance, DJ and sing";
- NW07 - extracts from an events listing site indicating that LOVE TRAIN is available for clubs and club nights and again refers to the services in terms of disco;
- NW08 - material from the Brutus Gold website which describes the entertainment as being "the UK's longest running 70's disco cabaret show";
- NW09 - artwork and advertisements for LOVE TRAIN where it is described as "Interactive Disco Fun" and "The Greatest Disco Experience in the World...". Contained in the same exhibit is a "To whom it may concern" letter from David Brewis confirming that he was commissioned to write and produce songs, lyrics and backing tracks for LOVE TRAIN. This document appears to have been generated for the purposes of these proceedings rather than being a spontaneously generated contemporaneous document. As such it should in my view have complied with the evidential requirements of Rule 55 of the Trade Marks Rules 2000. However, so far as I am aware it has not been objected to by the applicants;
- NW10 - the current LOVE TRAIN brochure which does not shed a great deal of further light on the nature of the entertainment save to confirm that, the aim is to "reinstate disco to its rightful place". It does, however, confirm that in addition to Brutus Gold there are a number of other 'players' involved in the show. The brochure adopts the MTV description of it being "Interactive disco fun";
- NW11 - customer recommendations. One relates to a booking of LOVE TRAIN for a wedding reception. I note that one of the partners refers to LOVE TRAIN as "this amazing 70's disco show".

23. I conclude from the material that LOVE TRAIN is the name used in relation to what is primarily a DJ based disco show. However, it would be wrong to define it too narrowly. In addition to the DJ element the show includes dancers and singers. Whether it always includes them is not clear but certainly they feature in some if not all performances. So far as I can tell from the material available to me, if and to the extent that singers and dancers are involved they form part of the disco-themed show. In other words if you hire LOVE TRAIN you get the package. The singers and dancers do not appear to be available (at least not under the name LOVE TRAIN) other than as part and parcel of the disco show. With those

findings in mind I turn to the specification of the registration in suit and the issue of what constitutes a fair description of the services in question having regard to the use shown.

24. It is clear from the evidence I have described above that the services offered by Mr Wanless are predominantly referred to by reference to the provision of discos. That is how I would expect consumers to ask for the services. It is a readily understandable and appropriate term and a natural trade category. It would seem from the evidence that Mr Wanless' customers include private individuals (for wedding receptions, parties, etc.) and business customers. The latter are likely to include clubs and corporate customers who require services of this kind for workplace and office events and functions. However, I have no reason to suppose that these various types of consumers would themselves use, or expect to see, different words used to describe the services.

25. Does that mean that "services in the field of discos" is a sufficient description of Mr Wanless' activities? I do not think it is. As I have explained above, although the core service is a disco, there is more to it than simply the provision of a DJ service. It can include accompanying dancers and singers. It is for that reason that the applicants have accepted that the proprietor has a legitimate right to retain cabaret services. Collins English Dictionary defines cabaret as "a floor show of dancing, singing or other light entertainment..." That neatly encapsulates the wider range of services provided by Mr Wanless within the context of his disco-based services. It is not a coincidence that the Brutus Gold website describes the business as offering a 'disco cabaret show' (NW08).

26. That leaves "services in the fields of stage presentations, nightclubs,dances and publishing". There has been no indication from the registered proprietor that he is prepared to accept a reduction of his specification to the disco and cabaret services dealt with above.

27. I infer that he feels he is entitled to retain the full specification including these particular services. As each gives rise to slightly different considerations they need to be addressed individually.

28. Starting with "services in the field of stage presentations", Mr Wanless might well say that his show is or involves a stage presentation. But does fairness to the proprietor require such a broad term when the terms disco and cabaret services appear to adequately describe what the proprietor does? Firstly, the term stage presentation is not a natural way of describing a disco type show albeit that it might be accompanied by elements of dance and singing that could be part of a stage show. To put the matter another way is it plausible that someone wanting to hire a show of the kind offered by Mr Wanless would ask for a stage presentation? The answer to that is, in my view, that they would not. Secondly, the term stage presentation more naturally describes an event in a theatre. It may go wider than that and cover, say, a West End musical and perhaps other such shows. Those are not areas of the entertainment business in which Mr Wanless is engaged. I see no need, in the interests of fairness, to allow him to retain a specification that would cover such services.

29. Next there are “nightclub” services. I note that one of the pages from the Brutusgold website in NW08 has repeated small print with the words “parties, competition, girls, chicks, atmosphere, nightclub, nightclubs, venue, venues, nights, nightout, Leeds, Manchester, Middlesbrough etc. Such references may simply be intended to ensure that the site is picked up in Internet search engines. But I accept that there is no reason why the services offered under the LOVE TRAIN mark should not be offered in nightclubs. Indeed, nightclubs may be entirely suitable for the provision of such services and a productive source of business. But the mere provision of a service at a nightclub does not mean that it is a nightclub service. To take an example, someone hired to provide food and drink in a nightclub is not thereby a provider of nightclub services. It is a question of fact based on the circumstances of the particular case. I do not think Mr Wanless would be seen as providing nightclub services viewed from the consumers’ perspective.

30. “Services in the field of dances” raises rather different issues. It is not entirely clear what the term means. The most obvious interpretation is that it refers to the service of organising dances. That is not something that Mr Wanless appears to engage in. He does, however, provide dancers as part of his disco cabaret services. I am prepared to accept that services in the field of dances would be wide enough to include the provision of dancers. I have already accepted that the term cabaret services includes a dance element within it. I take the view that “services in the field of dances”, even if I am right as to the possible breadth of the term, is likely to be taken as the provision of a self-contained service (a ballet company or such like group dedicated to the provision of such services). Mr Wanless is not engaged in the organisation of dances or the provision of dancers in this sense. Consumers wishing to engage such services would be unlikely to approach Mr Wanless. He provides dancers only as part of his disco/cabaret service and a specification that reflects these latter terms adequately protects his interests.

31. The final service is “publishing”. I do not know the basis on which Mr Wanless seeks to maintain this term. He is plainly not in the business of offering a publishing service to third parties. The evidence confirms that he puts out promotional material in support of his disco/cabaret services. But that is merely evidence that these entertainment services are offered. It is not evidence of a publishing service. I can see no basis for the retention of this term.

32. In summary the proprietor has shown genuine use of the mark LOVE TRAIN in relation to “Services in the fields of discos and cabarets”. The registration falls to be revoked under the terms of Section 46(5) of the Act in respect of the balance of the specification.

33. The applicants have pleaded two alternative dates from which the revocation should take effect.

34. Their primary position is that it should take effect from 22 June 2004. Under the provisions of Section 46(6)(b) revocation on the above basis will take effect from that date and the rights of the proprietor will be deemed to have ceased from that date.

COSTS

35. The applicants have been wholly successful on the basis of their amended statement of case. However, the original blanket attack was only reduced in scope when the registered proprietor filed evidence. It seems from the applicant's own evidence that they had been aware of Mr Wanless' use of LOVE TRAIN for many years. As they had been seeking a co-existence arrangement they must also have known enough about his business to have restricted the scope of their attack in the first place – something that only happened when evidence was filed. Against that, Mr Wanless has persisted in his defence of the full specification even after the applicants reduced the extent of their action. The net effect of these considerations seems to me to be that neither side should be favoured with an award of costs.

Dated this 31st day of August 2006

**M REYNOLDS
For the Registrar
The Comptroller-General**