

TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION No. 80831
IN THE NAME OF WI-FI ALLIANCE
FOR REVOCATION OF TRADE MARK No. 810576
IN THE NAME OF WILHELM SIHN JR KG

DECISION

1. On 15 May 2002 Wireless Ethernet Compatibility Alliance Inc (now called Wi-Fi Alliance) (**‘the Applicant’**) applied under sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 for revocation of the registration of trade mark number 810,576 **WISI**.

2. The trade mark was registered in the name of Wilhelm Sihh Jr. KG (**‘the Proprietor’**) with effect from 10 September 1960. In an Official Notice entitled *‘Date on which a mark is actually entered in the Register’* printed at pp. 1536, 1527 of Issue No. 5725 of the Trade Marks Journal published on 1 June 1988 it was confirmed that, prior to June 1986, the date of the Trade Marks Journal in which the fact of registration was recorded in the list of ‘Trade Marks Registered’ was the date of actual registration. That was 24 May 1961 in the case of trade mark number 810,576. The mark was registered for use in relation to *‘electrical and electronic apparatus and instruments included in Class 9’*.

3. The application for revocation under section 46(1)(a) was made upon the basis that:

Within the period of 5 years following the date of completion of the registration procedure for registration no. 810576, the mark **WISI** has not been put to genuine use in the United Kingdom, by the proprietor, or with his consent, in relation to some or all of the goods for which the mark has been registered, and there are no proper reasons for such non-use.

4. The application for revocation under section 46(1)(b) was made upon the basis that:

In the alternative, the use of the trade mark **WISI** in relation to some or all of the goods specified in Registration No. 810576 by the proprietor, or by another with his consent, has been suspended for an uninterrupted period of 5 years, and there are no proper reasons for non-use.

5. In its counter-statement filed on 15 August 2002 the Proprietor claimed to have used the trade mark **WISI** in the United Kingdom *'since at least 1960 in relation to electrical and electronic apparatus and instruments, being the goods for which the Trade Mark is registered in Class 9'*. The pleading provided no particulars of the apparatus and instruments for which the mark had been used. It sought retention of the registration for the full width of the specification of goods for which the mark had been registered and it made no concessions with regard to the possibility of part-cancellation. It appears to have been assumed that use within the language of the specification of goods, however broadly described, was sufficient to negate the requests for revocation.

6. This was also the stance adopted in the evidence filed on behalf of the Proprietor under rules 31(2) and 31(6) of the Trade Marks Rules 2000. For its part, the Applicant filed evidence under rule 31(4) in which it retreated to the position that the mark **WISI** had not been used by or with the consent of the Proprietor in relation to any goods in Class 9 other than '*television transmission and reception apparatus*'.

7. The application for revocation was determined without recourse to a hearing. The Applicant made brief written submissions in a letter sent to the Registry on 12 October 2004. The letter was apparently not copied to the Proprietor or its agents of record. No submissions were made on behalf of the Proprietor. The determination was made on the basis of the papers on file by Mr. John MacGillivray acting on behalf of the Registrar of Trade Marks.

8. In a written decision issued on 4 January 2005 (BL O-002-05) Mr. MacGillivray held that the rights of the Proprietor should be revoked with effect from 25 April 1966 in relation to all goods for which the trade mark **WISI** had been registered other than:

Apparatus and instruments for receiving and transmitting television signals, apparatus and instruments for receiving and transmitting radio signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes.

He ordered the Proprietor to pay the Applicant £1,000 as a contribution towards its costs of the Registry proceedings.

9. The Proprietor appealed to an Appointed Person under section 76 of the Act contending that the hearing officer had erred:

- (1) by omitting the word '*frequency*' from the expression '*radio signals*' in the specification of goods which he permitted the Proprietor to retain;
- (2) by unduly restricting the specification of goods which he permitted the Proprietor to retain;
- (3) by revoking the rights of the Proprietor with effect from a date prior to the date of the application for revocation.

I shall deal with each of these points in turn.

Point 1

10. Consistently with the evidence on file, the hearing officer found in paragraph 39 of the decision under appeal that there had been genuine use of the mark **WISI** in relation to the following goods (emphasis added by me):

Apparatus and instruments for receiving and transmitting television signals, apparatus and instruments for receiving and transmitting radio **frequency** signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes.

It appears from paragraph 42 of the decision that he intended to confine the specification of the registration in suit to goods of the kind which he had identified and defined in paragraph 39. I am satisfied that the omission of the word '*frequency*' from the expression '*radio signals*' in the specification of goods which

he permitted the Proprietor to retain was the result of a clerical error. The appeal on point (1) is allowed.

Point (2)

11. Point (2) calls for consideration of the degree of particularity with which an order reducing the scope of a specification of goods under section 46(5) of the Act should identify and define the goods for which the trade mark is to remain registered.

12. The task is to reduce the coverage of the registration so as to prevent the proprietor from claiming absolute protection for the trade mark under sections 5(1) and 10(1) of the Act (Articles 4(1)(a) and 5(1)(a) of Council Directive 89/104 of 21 December 1988) in relation to goods of the kind for which there has without proper reason been no genuine use. The goods for which such protection is to remain in place should be defined with due regard for the principles of legal certainty and proportionality. That is to say, the goods for which the trade mark remains registered need to be specified in terms that clearly (as a matter of linguistic expression) and fairly (as a matter of commercial reality) define the limits within which it would be appropriate to accept that '*a likelihood of confusion shall be presumed*' in the event of unauthorised use of an identical sign for identical goods: see the tenth recital to the Directive and Article 16(1) of the TRIPs Agreement.

13. In his analysis of the position in Decon Laboratories Ltd v. Fred Baker Scientific Ltd [2001] RPC 293 (which was subsequently approved by the Court of Appeal in Thomson Holidays Ltd v. Norwegian Cruise Line Ltd [2003] RPC 32

and in West (t/a Eastenders) v. Fuller Smith & Turner Plc [2003] FSR 44) Pumfrey J. observed that *'it would only be right as a matter of principle to divest the registered proprietor of a part of his statutory monopoly if one is satisfied that he ought to have to demonstrate confusion in fact or at least be obliged to rely on s.10(2)'* (paragraph 22). He went on to confirm that the relevant task is best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark and assuming further that he will continue that use (paragraph 23). The correct starting point consists of the list of articles for which the proprietor has in fact used the mark (paragraph 24). In arriving at a fair specification it is necessary to hold the balance between the legitimate interests and requirements of the proprietor and those of other traders and the public by not allowing the proprietor to retain a specification of goods which confers wider protection than can properly be said to be warranted by the evidence of use (paragraphs 24 to 26).

14. In Case T-126/03 Reckitt Benckiser (Espana) SL v. OHIM (14 July 2005) the Court of First Instance considered the operation of the analogous rule in proceedings governed by Article 43(2) of Council Regulation 40/94 of 20th December 1993 on the Community trade mark that:

If the earlier Community trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.

The rule is extended to earlier national trade marks by Article 43(3) which provides that:

Paragraph 2 shall apply to earlier national trade marks by substituting use in the Member State in which the earlier trade mark is protected for use in the Community.

15. The Court approached the task of identifying and defining the goods for which protection should be retained on the basis of genuine use in the following manner:

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.

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. I do not think that section 46(5) (Article 13 of the Directive) calls for a different approach to be adopted when making an order for revocation '*in respect of only some of the goods*' for which a trade mark is registered. In the interests of legal certainty the goods for which registration is retained should be identified and defined in positive terms. It is not acceptable for goods to be specified for registration '*only in so far as the goods ... concerned do not possess a particular characteristic*': Case C-363/99 Koninklijke KPN Nederland NV v. Benelux Merkenbureau (POSTKANTOOR) [2004] ETMR 57, p. 771 at paragraphs 111 to 117.

17. The terminology of the resulting specification should also accord with the perceptions of the average consumer of the goods concerned. That is clear from Thomson Holidays at paragraph 31 where Aldous LJ said:

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. This point was further elaborated by Jacob J. in Animal Trade Mark [2004] FSR 19, p.383 at paragraph 20:

The reason for bringing [in] 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 pernickety 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.

19. In the present case it has been shown to my satisfaction that the specification of goods formulated by the hearing officer under section 46(5) identifies and defines the goods for which there has been genuine use of the trade mark **WISI** in terms which do not fully apply the above considerations to the examples of use provided in the evidence on file. In order to do so fully it is necessary, in my view, to enlarge the wording of the specification of goods set out in paragraph 39 of the hearing officer's decision so as to make it read as follows:

Apparatus and instruments for receiving, transmitting, **amplifying, processing and measuring** television signals, apparatus and instruments for receiving, transmitting, **amplifying, processing and measuring** radio frequency signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes; **parts and fittings for the aforesaid goods.**

20. Although the Applicant filed written submissions in response to the Proprietor's statement of case on appeal, it did not contradict the Proprietor's contention that the specification of goods put in issue by the appeal was unduly

restricted having regard to the evidence of use that had been provided to the Registrar. That leads me to suppose that it would have been useful for the hearing officer to have received detailed submissions from the Proprietor as to what a fair specification would be on the basis of the evidence on file before he came to a final conclusion on at least that aspect of the determination.

21. The appeal on point (2) is allowed to the extent indicated in paragraph 19 above.

Point (3)

22. Section 46(6) of the Act provides as follows:

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.

This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under section 46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under section 46(1)(b).

23. I should emphasise that section 46(3) prevents an application for revocation under section 46(1)(a) or section 46(1)(b) of the Act from succeeding 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.

This is subject to the proviso 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.

24. In paragraphs 47 and 48 of the decision under appeal the hearing officer said:

47. I have found that the registered proprietor has not shown use of its mark across the full width of the specification for which the mark was registered, either in relation to Section 46(1)(a) or Section 46(1)(b) and that Section 46(5) applies. Its specification was limited accordingly. In light of my earlier findings it seems to me reasonable that my order under Section 46(5) – see paragraph 43 (above) should take effect from the date of five years following the date of completion of the registration procedure for the mark in suit.

48. It is my decision therefore, that the registration should be partially revoked with effect from 25 April 1966, the date of five years following completion of the registration procedure.

It is implicit in his rejection of the pleaded defence of use ‘*since at least 1960 in relation to electrical and electronic apparatus and instruments, being the goods for which the Trade Mark is registered in Class 9*’ that he found no basis in the

evidence for refusing to part-cancel the registration in question under section 46(3).

25. In paragraph 12 of the Proprietor's Grounds of Appeal it was contended that *'the Section 46(1)(a) ground was negated by the appellant's Rule 31(2) evidence under the provisions of Section 46(3)'* and further contended that *'the appellant was not made aware of the need to prove use for a period earlier than the Section 46(1)(b) period of five years preceding the date of the application for revocation'*.

26. I think the true position is that the Proprietor set out to adduce evidence of use *'since at least 1960'* for the purpose of negating both the section 46(1)(a) ground and the section 46(1)(b) ground under the provisions of section 46(3) *'in relation to electrical and electronic apparatus and instruments, being the goods for which the Trade mark is registered in Class 9'*. And I can see no substance or merit in the suggestion that the evidence in support of the defence under section 46(3) was not intended to negate the possibility of revocation with effect from 25 May 1966 (the day following the fifth anniversary of completion of the registration procedure) or 15 May 2002 (the date of the application for revocation) and all dates in between.

27. Save to the extent indicated in paragraph 19 above, the proprietor was unsuccessful in its defence under section 46(3) in relation to the requests for revocation under both sections 46(1)(a) and 46(1)(b). The hearing officer was therefore entitled to make an order for part-cancellation with effect from the day following the fifth anniversary of completion of the procedure for registration of

trade mark number 810,576. That is what he intended to do. It is not clear why he regarded 25 April 1966 as the pertinent date. In the light of the Official Notice I have referred to in paragraph 2 above, the pertinent date appears to have been 25 May 1966. I think that date should be substituted for the date specified in paragraph 48 of the decision under appeal. The appeal on point (3) is allowed to that extent.

28. In Omega SA v. Omega Engineering Inc. [2003] FSR 49, p.893 Jacob J. decided that the date of application for revocation should be taken to be the relevant date for revocation in the absence of any clearly formulated request for revocation from an earlier date under section 46(6)(b). By failing to adopt that approach, the applicant for revocation had unfairly prejudiced the proprietor in its defence of the registration in issue. The Court accepted that the pleading did not put in play use going back beyond the five year period immediately before the application for revocation; because that was not fairly put in play, use before that period was not an issue in the case; and although the onus lies on the proprietor of the registration to prove his use, the proprietor did not have to prove use for a period which was not properly in issue. These were not purely technical pleading points: *‘What happened here is that the proprietors set about proving use within the last five years, that is to say the five year period before the date of application for revocation. They did not set about proving use for an earlier period’* (paragraph 9). In the result, the decision of the Registrar’s hearing officer to order revocation with effect from the date of the application for revocation was upheld.

29. In the present case, the Proprietor points to the absence of any clearly formulated request for revocation from a date anterior to the date of the application for revocation and contends that this, of itself, should result in the order for part-cancellation being made as of 15 May 2002 rather than 25 May 1966. I do not think so. The proprietor effectively joined issue with the Applicant on the question whether the registration of trade mark number 810,576 became and remained to any extent vulnerable to revocation for non-use during the period 25 May 1966 to 15 May 2002. It also allowed the Registrar's hearing officer to proceed to a determination of the application for revocation on the basis that this was, in substance, the question that had to be decided by reference to the papers on file. The absence of a clearly formulated request for revocation with effect from a date prior to 15 May 2002 does not appear to me to have affected the scope of the defence put forward under section 46(3). I do not accept that it should now, for the first time on appeal, be taken to have done so. I am not prepared to shut my eyes to what I perceive to be the realities of the case.

Conclusion

30. The appeal succeeds to the extent that I have indicated above. In relation to point (1) I will make no order for costs because I consider that the matter could and should have been dealt with as a 'slip rule' correction to the text of paragraph 43 of the decision under appeal. In relation to point (2) I will make no order for costs because I consider that there would probably have been no need for an appeal if the Proprietor had (as I think it should have) conceded the possibility of part-cancellation and provided the hearing officer with detailed submissions as to

what a fair specification would be on the basis of the evidence on file. In relation to point (3) I direct the Proprietor to pay the Applicant £225 within 21 days of the date of this decision as a contribution towards its costs of considering and responding in writing to the Grounds of Appeal on that point. That sum is payable in addition to the sum of £1,000 awarded by the hearing officer.

Geoffrey Hobbs QC

12 September 2005

Michael Edenborough instructed by Messrs Fitzpatricks appeared as Counsel on behalf of the Proprietor

The Applicant was not represented at the hearing

The Registrar was not represented at the hearing.