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TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2488045

BY

EVENING STANDARD LIMITED

TO REGISTER THE TRADE MARK:

URBAN FOX

IN CLASSES 9, 16 AND 38

AND

THE OPPOSITION THERETO

UNDER NO 99041

BY

TWENTIETH CENTURY FOX FILM CORPORATION

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1) On 20 May 2008 Associated Newspapers Limited filed an application to register the trade mark **URBAN FOX** (the trade mark). On 27 February 2009 the trade mark was assigned to Evening Standard Limited (Evening Standard). The trade mark was published in the *Trade Marks Journal*, for opposition purposes, on 6 March 2009 with the following specification:

computer hardware and computer software; computer programs; computer software and hardware to enable searching of data and connection to databases and the Internet; on-line electronic publications; electronic publications (downloadable); electronic newspapers, sections, columns and articles; data storage media; modems; discs; compact discs, tapes, cartridges, wires, cards and filaments, all for bearing encoded programmes for computers; CDs; Blu-ray discs and other recordable media; CD-Roms; DVDs; pre-recorded video tapes and cassettes; digital music (downloadable) provided from the Internet; digital music (downloadable) provided from MP3 Internet web sites; video tapes, games and cassettes; computer accessories, screen savers, mouse pads, keyboards, bank cards and debit cards (encoded or magnetic); digital imaging devices and digital signal processors; data-processing equipment and computers; electrical, cinematographic, optical, checking (supervision) and teaching apparatus and instruments; apparatus for recording, transmission and reproduction of sound and images; magnetic data carriers; recording discs; parts and fittings for all the aforesaid goods; none of the aforesaid relating to animals;

paper, cardboard and goods made from cardboard; printed matter; printed publications; periodical publications; newspapers; magazines; supplements, books; periodicals, leaflets, address books; autograph books; notebooks; reference books; manuals; catalogues; newsletters; calendars; diaries; brochures; document cases; folders; conference folders; bookbinding materials; posters; instructional and teaching materials (other than apparatus); user guides and training manuals, stationery; artists' materials; photographs; photograph albums; drawings; decalcomanias; stickers, maps, holiday and travel guides, tickets and folders; bank cards and debit cards (other than encoded or magnetic); parts and fittings for all the aforesaid goods; none of the aforesaid relating to animals;

telecommunication services; network services; computer inter-communication services; broadcasting services; television, cable television, and radio broadcasting services; broadcasting and transmission of programmes; operation of broadcasting facilities; information and advisory services relating to telecommunication services; news services; news agency services; syndicated writing services concerning the Internet and on-line computer services; communication services provided by electronic, computer, cable, teleprinter, teletype and electronic mail means; Internet service providers (ISP); provision of web pages; communication services provided on the Internet; transmission of information; communication by computer terminals; message sending services; telegraph services; wire services; telecommunication of information including web pages, computer programs and any other data; provision of email services; rental of telephones, rental of telephone lines, rental of premium rate telephone lines; search engines services; providing an on-line search engine service; providing access to and leasing time to computer databases; provision of telecommunications access and links to computer databases and the Internet; providing user access to the Internet; Internet portal services; telecommunication services provided in relation to the Internet; providing access to digital music web sites on the Internet; providing access to MP3 web sites on the Internet; delivery of digital music by telecommunications; computer bulletin and message boards; text messaging services; online property portals; providing access time to and leasing access time to computer databases; advisory and consultancy services relating to all the aforesaid services; all the aforementioned services also provided on-line from a computer database or from the Internet.

The above goods and services are in classes 9, 16 and 38 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 6 May 2009 Twentieth Century Fox Film Corporation (Twentieth Century) filed a notice of opposition to the registration of the trade mark. It relies upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

3) Section 5(2)(b) of the Act states:

“(2) A trade mark shall not be registered if because -

.....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(3) of the Act states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Section 5(4)(a) of the Act states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade”.

The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

4) Twentieth Century relies upon two trade mark registrations:

i) Community trade mark registration no 142943 for the trade mark **FOX**, it was applied for on 1 April 1996 and the registration process was completed on 19

October 1998. As the trade mark had been registered for more than five years at the date of the publication of Evening Standard's application it is subject to proof of use¹. Twentieth Century claims that it has used the trade mark in respect of the following goods and services of the registration:

photographic, cinematographic, teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; motion picture films; television programs recorded on film and video tape; pre-recorded video cassettes, pre-recorded video tapes and pre-recorded video discs; sound recordings and other audio and audio-visual materials including pre-recorded phonograph records, pre-recorded audio tapes and pre-recorded audio compact discs; computer software programs and CD-ROMs; computer games and computer game cassettes, cartridges and CD-ROMs; video and computer game cassettes and cartridges adapted for use with television receivers; talking machines; pre-paid telephone cards; computer mouse pads/mats;

paper and paper articles, cardboard and cardboard articles; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); playing cards;

clothing, footwear, and headgear;

toys and games, including video and computer games (not adapted for use with television receivers); hand-held computer games and computer game cassettes and cartridges; full-size stand alone arcade games; electronic games and accessories;

business management, including assistance and advice in the establishment of retail stores in the field of entertainment-related merchandise;

communication services, namely, broadcasting of television and radio programs; cable television and cable radio services; satellite television services;

education and entertainment services, namely, production and distribution of motion picture films, television programs, and pre-recorded video tapes, pre-recorded video cassettes, pre-recorded video discs; education and entertainment services in the nature of production and distribution of audio materials and other audio and audio-visual works;

on-line computer services.

The above goods and services are in classes 9, 16, 25, 28, 35, 38, 41 and 42 respectively of the Nice Agreement concerning the International Classification of

Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

ii) United Kingdom trade mark registration no 2283698 of the trade mark FOX, it was applied for on 22 October 2001 and the registration process was completed on 19 December 2003. As the trade mark had been registered for more than five years at the date of the publication of Evening Standard's application it is subject to proof of use. Twentieth Century claims that it has used the United Kingdom trade mark in respect of the same goods and services as it claims in respect of the Community trade mark. However, the specification of the United Kingdom registration contains less goods and services than the Community trade mark. Taking the differences in the specifications into account the claim to use can only relate to the following goods and services:

photographic, cinematographic, teaching apparatus and instruments; magnetic data carriers, recording discs; motion picture films; television programs recorded on film and video tape; pre-recorded video cassettes, pre-recorded video tapes and pre-recorded video discs; sound recordings and other audio and audio-visual materials including pre-recorded phonograph records, pre-recorded audio tapes and pre-recorded audio compact discs; computer software programs and CD-ROMs; computer games and computer game cassettes, cartridges and CD-ROMs; video and computer game cassettes and cartridges adapted for use with television receivers; talking machines; computer mouse pads/mats; but not including telecommunication apparatus, any such goods for use in relation to industrial processes, or any such goods relating to foxes.

toys and games, including video and computer games (not adapted for use with television receivers); hand-held computer games and computer game cassettes and cartridges; full-size stand alone arcade games; electronic games and accessories;

business management, including assistance and advice in the establishment of retail stores in the field of entertainment-related merchandise;

education and entertainment services, namely, production and distribution of motion picture films, television programs, and pre-recorded video tapes, pre-recorded video cassettes, pre-recorded video discs; education and entertainment services in the nature of production and distribution of audio materials and other audio and audio-visual works; but not including any such services relating to foxes.

on-line computer services; but not including any such services relating to the monitoring and control of industrial processes.

The above goods and services are in classes 9, 28, 35, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and

Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) Twentieth Century also claims that **FOX** is a well-known trade mark as per section 6(1)(c) of the Act. However, it does not state in relation to which goods and services this claim is made and so this claim cannot assist it.

6) In relation to section 5(2)(b) of the Act Twentieth Century claims that all of the goods and services of the trade mark are similar or identical to the goods and services of its earlier registrations. It claims that the respective trade marks are aurally, visually and/or (sic) conceptually similar. Twentieth Century claims that it has made extensive use of its trade mark in the United Kingdom, in the European Union and worldwide, in relation to television transmission services, media, film and entertainment services. It claims that its trade mark has been used in the United Kingdom since 1960. Twentieth Century claims that, consequently, its trade mark has enhanced distinctiveness and a significant reputation.

7) Twentieth Century, under section 5(3) of the Act, claims that, owing to its reputation in relation to the trade mark **FOX**, the use of Evening Standard's trade mark would take unfair advantage of or be detrimental to the distinctive character or repute of its trade mark. It claims a reputation in relation to all of the goods and services upon which it claims to have used the Community trade mark.

8) Twentieth Century claims, in relation to section 5(4)(a), that it has a goodwill in relation to the goods and services upon which it claims to have used its Community trade mark by reference to the sign **FOX**. It claims to have used the sign in the United Kingdom since 1960.

9) Evening Standard filed a counterstatement. It admitted that Twentieth Century is one of the world's largest film studios. Twentieth Century is put to proof of the use that it claims in relation to FOX. Evening Standard admits that its application covers goods and services which are identical or similar to those covered by the earlier trade marks, Twentieth Century is put to proof of the extent of the identity (sic) and similarity of the goods and services at issue. Evening Standard denies or puts Twentieth Century to proof in respect of the other claims that the latter makes. Evening Standard states that the respective trade marks are sufficiently different for all of the grounds upon which Twentieth Century relies to fail.

10) Only Twentieth Century filed evidence. The parties were advised by the Trade Marks Registry that it was considered that the case might benefit from a hearing. Neither party requested a hearing, each party filed written submissions.

Evidence of Twentieth Century

Witness statement of Mr Tom Blackett

11) Mr Blackett is chairman of the brand consultancy Siegel+Gale. He was previously the deputy chairman of Interbrand.

12) Mr Blackett states that his work involves analysing and identifying “superior” brands and their performance in the United Kingdom and worldwide. Mr Blackett states that he is recognised as a leading expert in the field of branding and has appeared as an expert witness in disputes involving brands before the High Court and the Trade Marks Registry. He has written books and articles about brands and branding issues.

13) Mr Blackett states that he is familiar with Twentieth Century, which he describes as one of the most highly recognised media, television and entertainment providers in the world. Mr Blackett states that Twentieth Century is also known by the names 20th CENTURY FOX or simply FOX.

14) Mr Blackett states that he first encountered the FOX trade mark in the 1950s when he visited the cinema and was struck by the TWENTIETH CENTURY FOX brand at the beginning of the films. He states that the “drama of the illuminated edifice bearing the 20th Century Fox name, the raking searchlights and the stirring fanfare, always heightened the sense of anticipation I felt”. Mr Blackett is conflating FOX with a composite trade mark including the words 20th Century Fox. His narrative does not relate to FOX simpliciter. When he states that he first came across the FOX trade mark he is actually talking about another trade mark which happens to include the word fox. Mr Blackett states that awareness of the FOX brand has grown rapidly since the 1980s, when Twentieth Century was restructured into three principal operating units: Twentieth Century Fox Film Corporation, Fox Television Stations Inc and Fox Broadcasting Company. He states that it is his view that the FOX brand is currently one of the most popular and desirable brands in the entertainment, news, media and broadcasting fields in the United Kingdom. He states that the FOX brand is one that is highly rated by both consumers and experts alike in the United Kingdom. Mr Blackett does not explain what he means by experts. Again it is not possible to clearly ascertain to which trade mark he is referring. His opinion is not supported by any objective evidence in relation to awareness of FOX simpliciter in the United Kingdom and in relation to what this trade mark may have been used. It is the claim of Twentieth Century that it has a reputation in respect of all the goods and services for which use has been claimed in relation to the Community trade mark. Mr Blackett does not connect his statement to the goods and services which are the basis of the opposition of Twentieth Century.

15) Mr Blackett states that Twentieth Century has employed a wide range of media, including outdoor billboard advertising, press advertising and high profile

advertisements on television and within cinemas. He states that this has allowed Twentieth Century to build the FOX brand amongst a wide variety of audiences. Again, the original conflation of trade marks by Mr Blackett leaves it unclear as to what trade mark(s) he is actually referring. Again this opinion is unsupported by any objective evidence. There is also no indication as to what the position was as of 20 May 2008 and what the position was at the date in relation to FOX simpliciter in relation to the goods and services the subject of the claim of Twentieth Century. It is to be born in mind that the European Court of Justice (ECJ) in *General Motors Corporation v Yplon SA* Case C-375/97 stated, in relation to a reputation that will satisfy section 5(3) of the Act, that the trade mark must be known by a significant part of the public concerned by the goods and services covered and that this will be established in the following manner:

“27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

16) Mr Blackett states that the FOX brand is well-known for a number of reasons. He states that in part it is due to the goods and services provided by Twentieth Century, which are highly praised. He states that it is also due to Twentieth Century’s well worked marketing campaigns, which have built up the desirability of the FOX brand.

17) Mr Blackett goes onto to state that he is aware that the popularity of the FOX brand has increased in the United Kingdom and the world since Twentieth Century was founded in 1935. He goes go on to explain why he is of this opinion. As he is referring to the brand from 1935 it is not possible to see how this relates to use of FOX simpliciter. Twentieth Century itself makes no claim of use of FOX simpliciter prior to 1960.

18) Mr Blackett states that the FOX brand has considerable strength and value. Mr Blackett states:

“The Fox brand has been one of the most successful new brands launched...”

It is not clear if Mr Blackett is using new to refer to the launch in 1935 of “the illuminated edifice bearing the 20th Century Fox name, the raking searchlights and the stirring fanfare” or of the launch of the brand FOX simpliciter. If the latter it would be necessary to distinguish between the two brands and identify when the new brand was launched.

19) Mr Blackett goes on to give his view as to confusion. Arden LJ in *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA Civ 842 stated:

“62. Firstly, given that the critical issue of confusion of any kind is to be assessed from the viewpoint of the average consumer, it is difficult to see what is gained from the evidence of an expert as to his own opinion where the tribunal is in a position to form its own view. That is not to say that there may not be a role for an expert where the markets in question are ones with which judges are unfamiliar: see, for example, *Taittinger SA v Allbev Ltd* [1993] FSR 641. However, the evidence of Mr Blackett on confusion was of no weight in this case: he merely gave evidence as to his own opinion about a market which would be familiar to judges. If more cogent evidence of customer perception is needed, the traditional method of consumer surveys must (subject to my second point) carry more weight and is to be preferred. Mr Mellor went so far as to suggest that expert evidence is inadmissible on the question of consumer perception. **I do not consider that it is necessary to go quite that far because there are exceptional situations, but I note that in *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at 290-291 Millett LJ, with whom Hobhouse and Otton LJ agreed, considered that the evidence of trade witnesses who gave their opinion of the likelihood of confusion was “almost entirely inadmissible”. He added: “It is not legitimate to call such as witnesses merely in order to give their opinions whether the two signs are confusingly similar. They are experts in the market, not on confusing similarity.”** The cogency of their evidence must in any event, save where expert knowledge of the particular market is required, be in real doubt. Its use may therefore lead to a sanction in costs. (Mr Mellor also made objections to the evidence of Mr Tildesley, but in the circumstances it is unnecessary for me to deal with these separate objections.) If the objection can be dealt with as one going to weight, this is often the course which the court takes: *Re M & R (Minors) (Sexual abuse: expert evidence)* [1996] 4 All ER 239.”

(Emphasis added)

In fact Mr Blackett is not an expert in any particular market, he is an expert in branding.

20) Mr Blackett states that the FOX and TWENTIETH CENTURY FOX brands are inextricably linked and both benefit each other. This emphasises the conflation that Mr Blackett has made between two trade marks.

21) The questions of use and reputation are for the tribunal to decide on the basis of facts, on hard evidence eg examples of use, turnover and advertising figures in relation to a particular trade mark, in relation to specific goods and services within the parameters of the statute and case law. Those facts have to relate to the material dates, in this case the dates of application and publication, 20 May 2008 and 6 March 2009. It could seem that Twentieth Century is trying to have the statement of Mr Blackett supplant the decision making powers of the

tribunal. It is not doubted that Mr Blackett has made his statement in good faith. However, in the conflation of the trade marks, the lack of specificity in relation to goods and services, the lack of identification with the material dates, the absence of supporting objective exhibits, his statement can have very little weight. Effectively he moves the matter little further forward than Evening Standard's admission that Twentieth Century is one of the world's largest film studios.

Witness statement of Ms Tina M Pompey

22) Ms Pompey is assistant secretary of Twentieth Century. She states that she has knowledge of Twentieth Century's marketing, financial and sales figures and brand advertising associated with the FOX logo and FOX word mark. Ms Pompey does not explain what is meant by the FOX logo. After making this statement she does not distinguish between use of the FOX logo and FOX simpliciter.

23) Ms Pompey gives a history of the formation and growth of the company from 1915 onwards. In October 1985 Fox Inc was formed. Fox Inc consists of three principal operating units Twentieth Century, Fox Television Stations Inc and Fox Broadcasting Company. She states that Fox Television Stations Inc was formed in March 1986 with the purchase of 6 independent television stations from Metromedia, Inc in the cities of New York, Los Angeles, Chicago, Dallas, Washington DC and Houston. Fox Broadcasting Company was launched in May 1986 as a satellite delivered national programme service for independent stations. In October 1986 Fox Broadcasting Company went onto the air. Fox 2000, a mini studio focusing on general entertainment, and Fox Searchlight Pictures, which produces specialised films aimed at "sophisticated adult audiences", were later established.

24) Ms Pompey states that in 1994 Fox launched the FX cable channel in the United States. It is not clear to which particular undertaking she is referring by reference to Fox. The FX channel currently reaches more than 95 million homes in the United States. In 1994 Fox Sports was formed. It broadcasts sporting events: the National Football League, the Super Bowl, Major League Baseball, college football Bowl Championship Series and NASCAR racing. All of these activities appear to be based in the United States. Ms Pompey states that Fox Sports reaches more than 99 million viewers in the United States and over 1 billion viewers worldwide. She does not make clear what she means by 'reaches'. There is no indication of the platforms that are used in the United Kingdom and the European Union. In January 2001 the National Geographic Channel was launched by National Geographic TV and Film and the Fox Network. There is no explanation as to what is meant by the Fox Network. It is not clear what bearing a television channel called National Geographic has upon issues relating to the use of the trade mark/sign FOX or even in combination with other matter. In February 2002 the News Corp owned Speedvision was relaunched as the Speed channel, this provides coverage of motorsports. It is

not seen how this has a bearing upon the use of FOX in the United Kingdom. On 11 June 2002 the television programme *American Idol* was first broadcast in the United States. Ms Pompey states that this programme is broadcast in the United Kingdom on ITV2. She gives no details as to when this started, nor does she explain how this relates to use of FOX. On 1 July 2003 Fox Cable Networks launched Fuel TV, which is dedicated to action sports. No indication is given as to how this relates to the use of FOX in the United Kingdom. In 2005 Fox Interactive Media was formed to oversee News Corporation's new media acquisitions. Ms Pompey describes Fox Interactive Media as a "portfolio of leading social networking, entertainment, sports and information sites that offer a platform and tools for consumers to express themselves, communicate with each other, and engage with media". She states that the worldwide network includes MySpace, IGN, FOXSports.Com, AskMen and Flektor. In four of the five names there is no reference to FOX. There is no indication as to the number of the users of this network in the United Kingdom or the European Union. On 24 May 2005 Fox Reality Channel was launched, the channel features reality shows syndicated from other networks. There is no indication as to the presence of this channel in the United Kingdom or the European Union. Ms Pompey states that there is also a linked website, FoxReality.com. In July 2005 News Corporation purchased MySpace. Again, no indication is given as to how this relates to the use of FOX. In 2006 Fox Atomic was created. Atomic, as Ms Pompey describes it, produces and markets theatrical films and digital content, targeting 17-24 year olds, across all media platforms. There is no indication as to Fox Atomic's position in the United Kingdom or the European Union. In March 2007 News Corporation announced the formation of a joint venture with NBCU to distribute online video. The venture is known as Hulu. There is no indication as to how this relates to the use of FOX and/or its relevance to the United Kingdom. On 4 December 2007 Fox Entertainment Group acquired Beliefnet, an online "faith and spirituality" network. There is no indication as to how this relates to use of FOX and how this relates to the position in the United Kingdom or the European Union.

25) Ms Pompey states that there has been unbroken and continuous use of the FOX logo and FOX word mark in connection with Twentieth Century's goods and services since it first offered its goods and services in the United Kingdom. She states that the two trade marks are used on Twentieth Century's website fox.co.uk. Ms Pompey states that all of Twentieth Century's goods and services have been advertised, marketed, offered and rendered in connection with the FOX logo and the FOX word mark for several decades. She states that the use of the FOX logo and the FOX word mark began in 1935, with the formation of Twentieth Century.

26) Ms Pompey states that Twentieth Century maintains an Internet site at fox.co.uk which was launched in the United Kingdom during December 1996. She states that the website promotes a variety of goods and services relating to Twentieth Century's home entertainment, cinema (Fox Film Club), DVD, Blu-Ray

and television products. At exhibit 1 is a page from fox.co.uk downloaded on 18 January 2010 and so after the material dates. Historic pages from websites are readily available from the Wayback Machine and are regularly presented in evidence. The top of the page bears the legend 20th Century Fox International. At the top right hand of the page and the bottom there appears a logo for 20th CENTURY FOX. There is a copyright notice identifying Twentieth Century. At the top of the page there is a button headed "About Fox" and an e-mail button labelled "Fox Film Club".

27) Ms Pompey states that Twentieth Century has maintained the website foxtv dvd.co.uk since February 2003. She states the website provides for the sale of DVDs of the television programmes of Twentieth Century. Pages from the website downloaded on 19 October 2009, after the material dates, are exhibited at exhibit 2. The second page shows the logo for 20th CENTURY FOX. There is a copyright notice identifying "Fox and its related entities". At the top of the first page there is the device of a stylised television in which appears the words FOX Tv DVD. Pictures relating to various DVDs can be seen, the trade marks used in relation to the actual DVDs cannot be seen. Ms Pompey states that Twentieth Century advertises, markets and promotes its films under the FOX logo and FOX word mark in the United Kingdom. She exhibits a list of films at exhibit 3 but there is nothing to identify these films with the use of FOX simpliciter. She refers to the promotional efforts in relation to the two trade marks. Ms Pompey states that the films released in the United Kingdom from May 2002 to May 2008 resulted in total box office receipts of over US\$1.4 billion dollars. Ms Pompey states that Twentieth Century's DVDs and Blu-Ray products are all packaged, marketed and sold in conjunction with the FOX logo and the FOX word mark. At exhibit 4 are copies of retail sleeves or advertisements for DVDs and Blu-Ray products. Three of these were released after the material dates. Two, *The Last King of Scotland*, and *Prison Break* were released before the material dates. The logo for 20th CENTURY FOX appears twice on *The Last King of Scotland*. The website address fox.co.uk appears on the rear label. There is also a reference to Fox Searchlight Pictures. No trade mark can be seen on the advertisement for *Prison Break*. On the material relating to DVDs released after the material dates the logo for 20th CENTURY FOX can be seen, on *Night at the Museum 2*, *Aliens in the Attic* and *glee*. No use of FOX without TWENTIETH CENTURY can be seen. *Alien in the Attic* is described as a TWENTIETH CENTURY FOX production. Ms Pompey states that Twentieth Century markets and distributes videos and DVDs of its film and television titles through retailers worldwide, including WH Smith and major supermarkets, department stores and electronic media stores in the United Kingdom. At exhibit 5 are pages downloaded from the website of WH Smith on 22 January 2010, after the material dates, showing various DVDs for sale. It is not clear which DVDs are the products of Twentieth Century, although *500 Days of Summer* is highlighted. Neither the trade mark FOX nor the logo for 20th CENTURY FOX can be seen on any of the pages.

28) Ms Pompey states that Twentieth Century has released some of the most significant and popular films of all times. She lists some of these films. At exhibit 6 is a list of the all time most successful films at the box office. There is nothing in the exhibit which shows use of FOX, or even the logo for 20th CENTURY FOX.

29) Ms Pompey states that in the United Kingdom Twentieth Century has advertised in popular magazines. She states that these advertisements display the logo for 20th CENTURY FOX and the FOX word mark. At exhibit 7 is a copy of an advertisement for the film *500 Days of Summer* from *Glamour Magazine* of 12 September 2009, after the material dates. The only trade mark that can be clearly seen is that of Amazon. Advertisements for *Family Guy Something*, *Something Darkside* and *Marley and Me* are also exhibited. No trade marks of Twentieth Century can be seen and there is indication as to from when the advertisements emanate.

30) Ms Pompey states that Twentieth Century has created educational resources and teaching aids. She states that such educational resources are available in the United Kingdom. At exhibit 8 is a lesson plan entitled *Bring Learning to Life*. This is linked to the release of *Night at the Museum 2*, a film that was released after the material date. The logo for 20th CENTURY FOX can be seen on the front cover as can the words TWENTIETH CENTURY FOX HOME ENTERTAINMENT. FOX simpliciter does not appear in the lesson plan, although Ms Pompey states that **all** such products are “advertised, promoted, marketed, offered and rendered in connection with the Opponent’s famous FOX Logo and FOX word mark”. Ms Pompey states:

“Commercials depicting the FOX Logo and FOX word mark in connection with the Opponent’s goods and services have aired on cable and network television during many of the most popular Fox shows broadcast in the USA, which are also broadcasted internationally, including the UK.”

It is not clear if she is stating that the advertisements have been broadcast in the United Kingdom or if the programmes have. She states that programmes of Twentieth Century include *The Simpsons*, *South Park*, *Prison Break* and *Buffy the Vampire Slayer*. Ms Pompey states that advertisements promoting the goods and services of Twentieth Century “in connection with the FOX Logo and FOX word mark” have run on Comedy Central, MTV, ESPN, CNN, Headline News, Discovery, The Learning Channel and CNBC networks. She states that many of these channels are broadcast the United Kingdom and the European Union; she does not indicate which channels. No copies of advertisements have been furnished and so it is not possible to see what trade marks have been used and in relation to what goods and services. Ms Pompey states that Twentieth Century “strongly engages” in outdoor advertisements which depict the FOX logo and FOX word mark. She states that Twentieth Century also uses radio advertisements in the United Kingdom. No pictures of any outdoor

advertisements are shown, no recordings of radio advertisements have been provided. No details of the outdoor and radio advertisements have been given.

31) Ms Pompey states that in 2007 Twentieth Century and Arts Alliance Media, which she describes as a provider of digital film distribution in Europe, signed a deal to distribute Twentieth Century “content” on Arts Alliance Media’s Vizumi Network. She exhibits, at exhibit 9, a press release from Arts Alliance Media. The top of the press release bears the logos of Universal and Twentieth Century. It is headed:

“ARTS ALLIANCE MEDIA ANNOUNCES FIRST EUROPEAN COMMERCIAL DIGITAL CINEMA VIRTUAL PRINT FEE AGREEMENTS WITH TWENTIETH CENTURY FOX AND UNIVERSAL PICTURES”.

It goes on: “AMSTERDAM, June 25th 2007 – Twentieth Century Fox (“Fox”), Universal Pictures International (“Universal”). The article then uses the abbreviated form, Fox, on four occasions. A section of the press release is headed “About Twentieth Century Fox” in which it refers to Fox Filmed Entertainment, Fox Entertainment Group (which is referred to as FEE), Twentieth Century Fox, Fox 2000 Pictures, Fox Searchlight Pictures, Fox Atomic and Twentieth Century Fox Animation. Outside the abbreviated use of FOX, there is no use of FOX simpliciter. Although this is a press release by a third party, it is reasonable to assume that Twentieth Century agreed to its contents, so this abbreviated form of Twentieth Century’s name was used with the consent of Twentieth Century. Ms Pompey states that in 2008 Twentieth Century and ITV plc entered an international production partnership. At exhibit 10 is a press release relating to this, it was released on 19 June 2008, after the date of application. It is headed “Twentieth Century Fox Television and ITV enter groundbreaking international partnership”. It begins “Twentieth Century Fox Television”, this is then abbreviated to TCFTV on 4 occasions. The release refers to Mr Lee Bartlett “who recently joined ITV from the Fox network”. Mr Bartlett then refers to FOX twice. The director of ITV productions is quoted, he refers to FOX once. The release ends with references to Twentieth Century Fox Television Distribution and 20th Century Fox Television.

32) Ms Pompey exhibits, at exhibit 11, a copy of an article from chicagobusiness.com dated 13 May 2009, after the material dates. This relates to a partnership agreement between McDonald’s and Twentieth Century. Reference throughout the article is to 20th Century Fox or 20th Century. In 2008 Twentieth Century and Apple announced that customers who purchased a DVD will receive an additional digital copy of the film. The press release, at exhibit 12, relating to this is headed “Twentieth Century Fox & Apple Introduce iTunes Digital Copy”. Reference is then made to Twentieth Century Fox, Fox Filmed Entertainment, FFE, Twentieth Century Fox, Fox Searchlight Pictures, Fox Atomic, Twentieth Century Fox Animation and Twentieth Century Fox Home Entertainment. In the penultimate paragraph the following appears: “FFE also

includes Twentieth Century Fox Home Entertainment, the worldwide marketing, sales and distribution company for all Fox film and television programming”.

33) Ms Pompey states that in 2009 Twentieth Century, Spot411 and The Cimmaron Group announced a partnership to launch FoxPop. A copy of the press release in relation to this is at exhibit 13. The date of the release and the launch was 10 November 2009, after the material dates. Ms Pompey also exhibits, exhibit 14, a press release relating to a partnership between Twentieth Century and LG. This release emanates from after the material date. Despite indicating in the article that it will refer to Twentieth Century Fox in the abbreviated form of Fox, the release refers to it as Twentieth Century Fox throughout.

34) Ms Pompey states that the FOX brand has enjoyed a high level of media coverage in the British press and obtained significant exposure through magazines. She states that due to the vast number of articles making reference to the FOX logo and the FOX word mark in the United Kingdom she only makes reference to a selection of articles and awards. Again there is a conflation between the two trade marks and this case is concerned with claims about use of FOX simpliciter. The material at exhibits 15 – 19 is as follows:

- *screendaily.com* – article from 7 January 2005, list of top twenty films. This identifies three films as emanating from 20th Fox. 20th Fox is also listed as no 4 in the list of United Kingdom film distributors.
- *Guardian Unlimited* – article from 15 July 2005 which is headed “FOX to hit billion dollar sales mark by Monday”. Reference is made to Twentieth Century Fox and then to Fox on 5 occasions.
- *Revolution* – article from 6 May 2005. Reference is made to 20th Century Fox on two occasions. There is a web address of foxstudioclassics.co.uk. FOX simpliciter does not appear in the article.
- British Video Association website – details of 2007 awards. Reference is made to Twentieth Century Fox Home Entertainment on 6 occasions, the Twentieth Century Fox logo and searchlights appears twice. There is no use of FOX simpliciter.
- *BBC News Online* – article from 25 February 1998 in relation to the film *Titanic*. The article refers to Twentieth Century Fox International and Twentieth Century Fox. There is no use of FOX simpliciter.
- *Daily Mail* – article from 8 May 2008. The article is headed “Fox helps to boost News Corp profits”. The article begins with “Strong viewing figures at the all-American Fox News Channel”. It ends by referring to the ownership of 20th Century Fox.
- *The Times* – article from 29 December 2007. The article refers to the success of various film studios. Reference is made to Twentieth Century Fox 4 times. There is no reference to FOX simpliciter.

- *The Times* –article from 28 December 2007. The article is headed “Apple wooing 20th Century Fox”. Twentieth Century Fox is referred to in the article. There is no use of FOX simpliciter.

35) Ms Pompey states that that the advertising expenditure made by Twentieth Century to promote its products and FOX trade mark in the United Kingdom is as follows:

2003	in excess of £25 million
2004	in excess of £25 million
2005	in excess of £39 million
2006	in excess of £42 million
2007	in excess of £28 million

There is no indication of how much of this relates to goods and services where there is use of FOX simpliciter, or even to what goods and services it relates. Consequently, the size of the expenditure is not instructive in relation to the issues in question in this case.

36) Ms Pompey states that Twentieth Century maintains an Internet site at fox.com and “other related sites targeting various national audiences”. Ms Pompey states that these websites promote and offer the goods and services of Twentieth Century in conjunction with the FOX logo and the FOX word mark and are accessible in the United Kingdom. She states that Twentieth Century operates the website fox.co.uk in the United Kingdom. At exhibit 20 are screen shots from the website fox.com. These were downloaded on 19 January 2010, so after the material dates. There is use of FOX on the website. The second page of the screen shot gives television listings, as the times are given as ET and PT, this is for an audience in the United States. The screen shot for fox.co.uk was downloaded on 19 January 2010, after the material dates. At that top left hand corner and bottom left hand corner it bears the Twentieth Century Fox name and searchlight logo. The copyright notice refers to Twentieth Century Fox Film Corporation. At the top right hand there are buttons for Fox Film Club, and About Fox. Ms Pompey states that between 17 March 2006 and 13 January 2010 it received 3.7 million page views. She states that in the same period the site received 2 millions. Twentieth Century has, therefore, used a period which ends 19 months after the date of application and 9 months after the date of publication. There is no indication as to the number of unique visitors, and the number of visitors who are from the United Kingdom or the European Union. There is no clarity as to how the number of visits has been calculatedⁱⁱ.

37) Ms Pompey states that Twentieth Century has vigorously sought protection for and enforced its rights in the FOX word mark worldwide. She states that Twentieth Century has applied for and registered its trade mark in numerous jurisdictions around the world and throughout (sic) the United Kingdom and the European Union, using both national and Community trade mark systems. She

states that Twentieth Century has instructed local counsel in the United Kingdom to oppose or take any other appropriate action to ensure that conflicting trade marks are not registered or are removed from the register. Ms Pompey lists 32 United Kingdom and Community trade mark registrations of Twentieth Century which include the word FOX. Two further trade mark registrations are for a stylised and non-stylised 20th TELEVISION. The registrations include a number which include Twentieth Century Fox in one form or another. The registrations of Twentieth Century are not relevant to the issues in this case, nor can it be seen as relevant as to how and why Twentieth Century commence proceedings. The issues in this case all revolve around use of FOX, the simple registrations of this trade mark, owing to the proof of use requirement, are not enough; demonstrating the lack of relevance of listing trade mark registrations.

Findings of fact

38) Twentieth Century must establish its claims to reputation and goodwill as of the date of the application for registration of the trade mark, 20 May 2008. In relation to the proof of use it must establish genuine use during the period 7 March 2004 and 6 March 2009. In relation to the proof of use Twentieth Century has made no claim to use of the trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. It has made the claim that it has used the trade mark FOX simpliciter.

39) In all of its evidence Twentieth Century has conflated the use of TWENTIETH CENTURY FOX and FOX and what Ms Pompey calls the FOX logo, although she never explains what she means by this. (It has been assumed that she is referring to the logo that consists of 20th CENTURY FOX on a pedestal with searchlights.) In her evidence Ms Pompey states that **all** educational resources and teaching aids are advertised, promoted, marketed, offered and “rendered with the Opponent’s famous FOX Logo and FOX word mark”. The only educational material/teaching aid that is exhibited is a copy of lesson plan. In this exemplum in support of Ms Pompey’s statement there is no use of FOX simpliciter. This clearly contradicts Ms Pompey’s statement. The only use of FOX simpliciter prior to the material dates is use clearly as an abbreviation in a few press releases and press articles. Twentieth Century has not put in one single piece of evidence showing use of FOX simpliciter by Twentieth Century itself in the United Kingdom prior to the material dates, despite the claims it makes to extensive use. This is evidence that would clearly be within its control. Ms Pompey states that the use of the FOX word mark by Twentieth Century began in 1935, with the formation of Twentieth Century, yet she is unable to furnish one piece of evidence to support this claim. This can be reasonably be described as astonishing; a claim to over seventy five years of use by Twentieth Century but not one exhibit, prior to the material dates, furnished. In its statement of grounds, Twentieth Century claims to have used FOX since at least 1960, not 1935. There is nothing to suggest that FOX was used simpliciter from 1935 onwards.

40) Mr Arnold QC, sitting as the appointed person, in *EXTREME Trade Mark* BL O/161/07 stated:

"Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

In *MOO JUICE Trade Mark* [2006] RPC 18, Kitchin J, in relation to the application of rule 31(3) of the Trade Marks Rules 2000, stated:

"To my mind the requirement laid down by r.31(3) is not therefore satisfied by a proprietor who simply asserts, through a relevant witness, that the trade mark has been used. Such a bare assertion would provide no evidence as to the actual use made by the proprietor. The evidence must provide a sufficient explanation of how the mark has been used for the tribunal to conclude that the proprietor has an arguable defence to the application."

This principle must equally, or even more so, apply to the position where a substantive decision is to be given. In this case the evidence on behalf of Twentieth Century is assertion. Assertion that despite the enormous claims that have been made is unsupported by actual evidence of use. Taking into account the absence of substantiating evidence, taking account the clear contradiction between statements such as the one relating to the educational resources and teaching aids, taking into account the conflation of two or three trade marks, the assertions in the evidence of Twentieth Century cannot be the basis for a finding of fact in relation to use and reputation.

41) Twentieth Century made clearly unsustainable claims to use in relation to the goods and services of its Community trade mark registration. (There is, for instance, nothing to suggest any use in relation to *photographic, cinematographic, teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images*, under any trade mark.) It made the same claims in relation to its United Kingdom registration, despite it not encompassing all of the goods and services, and in relation to reputation and goodwill. It has not resiled from this position. In its written submissions it continues with the clearly unsustainable claims. In those submissions it still does not make any claim that the use shown is differing in elements which do not alter the distinctive character of the mark in the form in which it was registered or that the use of TWENTIETH CENTURY FOX or TWENTIETH CENTURY FOX and

device is use of FOX. It is clear, anyway that the presence of TWENTIETH CENTURY before FOX does alter the distinctive character of the trade mark from the form in which it was registered. For the sake of completeness the latter scenario will be considered, even though it has neither been pleaded nor submitted.

42) TWENTIETH CENTURY acts as a description of FOX, in use it is the beginning of the trade mark or, when used in the composite trade mark, stands upon FOX, in this format 20th is represented in numerical form. There is nothing to suggest that the average consumer would see the FOX element as being a separate entity, of being a trade mark in its own right. This position is reinforced by the fame of TWENTIETH CENTURY FOX as a producer of films, a matter that is effectively accepted by Evening Standard in its counterstatement. The public has been educated to see TWENTIETH CENTURY FOX as one entity, one trade mark.

43) Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

The ECJ in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated :

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as

envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular 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.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

MFE Marienfelde GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-334/01 the GC considered the practical application of the *Ansul* criteria:

“34 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 (*Ansul*, paragraph 43).

35 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.

36 In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities

or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.”

A few references to FOX, being used as an abbreviation, in press releases and press articles does not support a claim to Twentieth Century creating or maintaining a market by reference to the sign FOX in relation to any of the goods and services in relation to which it claims use. (The press articles, not being advertisements, are also not use by or with the consent of the proprietor.)

44) Twentieth Century has not shown genuine use of the trade mark FOX in relation to the goods and services in relation to which it claims to have used the trade mark in the period of five years up to and including 6 March 2009. The ground of opposition under section 5(2)(b) of the Act is, therefore, dismissed.

45) The position in relation to claiming a reputation under section 5(3) of the Act, where the material date is 20 May 2008, is even weaker. The claim to reputation is dismissed and, consequently, so is the ground of opposition under section 5(3) of the Act.

46) If Twentieth Century had particularised what goods and services in relation to which it claims the trade mark FOX is well-known, its claim would have also failed.

47) A similar provision to section 5(4)(a) of the Act is to be found in Article 8(4) of Council Regulation 40/94 of December 20,1993. This was the subject of consideration by the General Court (GC) in *Last Minute Network Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Joined Cases T-114/07 and T-115/07. In that judgment the GC stated:

“50 First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51 However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a

Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.”

The reasoning of the GC, *mutatis mutandis*, is applied in relation to the Act, consequently the material date is the date of the filing of the application for registration, 20 May 2008.

48) How goodwill is to be established has been dealt with in several judgmentsⁱⁱⁱ. *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 establishes that one cannot just follow a formula or demand certain predetermined requirements to be met. However, goodwill cannot be established on the basis of conjecture and/or speculation. In this case there is a dearth of evidence aimed at the sign upon which Twentieth Century relies and at the material date. A few references in press releases and press articles is all that can be mustered. Taking into account the breadth of the claims made by Twentieth Century there should be a plethora of evidence of use. The sparseness and nature of this use is such that it does not establish a protectable goodwill by reference to the sign FOX at the date of application. Consequently, the ground of opposition under section 5(4)(a) of the Act is dismissed.

Costs

49) In its written submissions Twentieth Century states:

“We would request costs over and above the usual scale as the Opponent has been put to considerable expense in preparing the Witness Statements and gathering the evidence.”

It is impossible to see how the evidence that has been furnished required considerable expense in preparation and gathering. The registrar does not, anyway, vary from the scale of costs simply because some effort may have been expended in the collation of the evidence. In this case the evidence is not directed to the use of the trade mark FOX simpliciter, it is not directed to the material dates. The evidence of Mr Blackett has little to commend it, it can be characterised as a series of assertions of fact, including an assertion about the ultimate question, namely that which the tribunal has to decide. The evidence of Ms Pompey begins with matter that is neither relevant to the United Kingdom nor the European Union. It then conflates two or three trade marks and specificity in relation to the issues in this case is absent. Evening Standard responded to the submission of Twentieth Century in the following terms:

“It is noted that the opponent has asked for an award of costs off the scale, given the considerable expense of preparing the evidence in this

case. The opponent respectfully requests that it be compensated likewise for the significant expense of having to review the evidence, the large part of which was not relevant to the opponent's case."

It may be possible to have sympathy with this submission, however, it does not represent a justification for making an award outwith the scale of costs.

50) Evening Standard having been successful it is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Preparing a statement and considering the other side's statement:	£500
Considering the evidence of Twentieth Century and filing written submissions:	£500
Total	£1,000

Twentieth Century Fox Film Corporation is to pay Evening Standard Limited the sum of £1,000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of August 2010

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

ⁱ Section 6A of the Act reads:

"(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) 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

(b) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

ⁱⁱ The need for clarity in relation to web traffic and visits is shown by the Advertising Standards Authority in its ruling on the complaint brought against Cool Diamonds.com Ltd:

“The ASA noted Cool Diamonds kept a log of all the 'hits' to their website on their servers. We noted they had used the 'hits' figure because they believed it was an accurate reflection of the interest generated by their website. We acknowledged their point that a previous ASA adjudication had considered that the term 'hits' was unlikely to mislead readers.

We noted 'hits' referred to the number of items, such as files or images, retrieved from a website and that it was not equivalent to the number of pages viewed by a user or the number of visitors. We noted the more files or images present on a certain webpage, the more 'hits' the website received, which meant that one visitor could generate a high number of hits. We understood that

'hits' was not recognised as a measurement of website traffic by the Joint Industry Committee for Web Standards in the UK (JICWEBS); it only recognised measurements of unique users, page impressions or visits. We also noted the Institute of Direct Marketing website stated "Hit - a highly contentious term that rarely indicates the number of visitors to a website ... So from a marketing point of view, the bottom line is that the hits are misleading - they are never synonymous with the number of site visitors or page-views".

We considered that readers were likely to understand that the claim "5 million hits" was a reference to the websites popularity and that hits was a reliable measure of that popularity. We considered that some readers might go so far as to infer that each month Cool Diamonds had five million visitors or that five million web pages had been viewed by visitors. Because the number of hits a website received was unlikely to reflect, or be a reliable measure of, the number of visitors to the site or pages viewed, we concluded that the claim was likely to mislead readers into thinking the website was more popular than it was."

ⁱⁱⁱ *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, *Loaded BL O/191/02, Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).