

O-303-15

TRADE MARKS ACT 1994

**IN THE MATTER OF
CONSOLIDATED APPLICATION NOS 500465, 500466 & 500467
BY THE BRITISH BROADCASTING CORPORATION
FOR REVOCATION OF UK TRADE MARK REGISTRATIONS
1241754, 1241753 & 1213593 FOR THE MARK:**

TIMELORD

IN THE NAME OF WISEMAN INDUSTRIES LTD

BACKGROUND AND PLEADINGS

1. Wiseman Industries Ltd is the registered proprietor of UK trade marks 1213593, 1241753 & 1241754 each consisting of the single word TIMELORD. The relevant details of the marks are as follows:

TM no. and relevant dates	Registered goods	Goods defended
<p>1213593</p> <p><u>Filing date:</u> 27 February 1984</p> <p><u>Date of entry in the register:</u> 27 February 1984</p>	<p>Class 1:</p> <p>Chemical products for use in industry and science; chemical products included in Class 1 for use in agriculture; tempering substances; chemical preparations for soldering; adhesives included in Class 1.</p>	<p>Chemical preparations for use as corrosion inhibitors; chemical de-scaling preparations; chemical fluids for use as leak sealants.</p>
<p>1241753</p> <p><u>Filing date:</u> 13 May 1985</p> <p><u>Date of entry in the register:</u> 13 May 1985</p>	<p>Class 3</p> <p>Cleaning preparations; abrasive preparations (not for dental use); soaps; perfumes; cosmetics; non-medicated toilet preparations; non-medicated preparations for the care of the hands; dentifrices.</p>	<p>Soaps; cleansing solutions and glass cleaner.</p>
<p>1241754</p> <p><u>Filing date:</u> 13 May 1985</p> <p><u>Date of entry in the register:</u> 13 May 1985</p>	<p>Class 5</p> <p>Pharmaceutical and sanitary preparations and substances; disinfectants (other than for laying or absorbing dust); insecticides; preparations for killing weeds and destroying vermin.</p>	<p>Medicinal creams for the protection of the skin; disinfectants.</p>

2. The British Broadcasting Corporation (the applicant) seeks revocation of the trade mark registrations under section 46(1)(b) of the Trade Marks Act 1994 (the Act) for non-use in the five year period 26 June 2009 to 25 June 2014, the 'relevant period'.

3. The proprietor filed counterstatements indicating that the marks had been used in the relevant period in respect of the named goods. There is no claim to any proper reasons for non-use. The proceedings were consolidated.

4. The proprietor filed evidence in these proceedings. The applicant filed written submissions. Neither side requested a hearing, the proprietor opting to file written submissions in lieu of a hearing.

5. The applicant requests an award of costs in its favour. The proprietor reserves its submission on costs. I make this decision following a review of all of the papers before me.

The legislation and leading case-law

6. The relevant section of the Act is Section 46(1) which states that:

“The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c)...

(d)...

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

7. Section 100 is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

8. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

9. Although minimal use may qualify as genuine use, the Court of Justice of the European Union (CJEU) stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that “*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question*”. The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

The proprietor’s evidence

10. This takes the form of two witness statements by Harvey Wiseman dated 11 September 2014 and 17 March 2015. Mr Wiseman is the Director of Wiseman Industries Limited (formerly Chemical Direct Limited).

11. He states:

“In the course of its business as a manufacturer and merchant of chemical products, my company is permitted to use the registered trade marks of Alan Wiseman Adhesives Limited. My father, Dr Alan Wiseman, is a Director of Alan Wiseman Adhesives Limited and has recently retired.”

12. I note that the contested trade marks were assigned from Alan Wiseman Adhesives Limited to Wiseman Industries Ltd with effect from 27 March 2015, the

implication being that prior to this Wiseman Industries Ltd used the marks under an implied licence. This point has not been raised by the applicant and accordingly, I will not consider it any further.

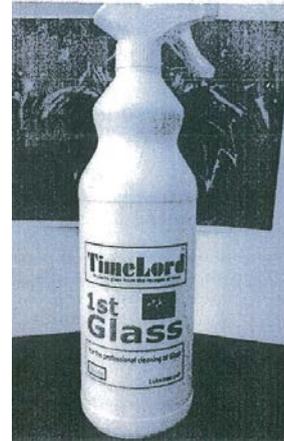
13. Mr Wiseman states that his company has used the TIMELORD trade mark in the period 26 June 2009 to 25 June 2014 in relation to medicinal creams for the protection of the skin, disinfectants, soaps, cleaning solutions, glass cleaner and chemical preparations for use as corrosion inhibitors.

14. He says that the TIMELORD product range was actively marketed and sold to builders' and plumbers' merchants, construction companies, industrial and retail outlets by his company. He confirms the company was known as Chemical Direct Limited until May 2013 and as Wiseman Industries Limited from 10 May 2013 until the present. He states that the TIMELORD range of products continues to be available from his company.

15. Mr Wiseman states that 50% of the total sales made by his company were associated with TIMELORD products with the approximate total sales for 2012-2013 being £32,000.

16. Attached to Mr Wiseman's first statement is an exhibit made up of a number of documents. The first page of the exhibit provides product codes for TIMELORD products all of which start with the letters CD followed by a number. The products on the list are described as hand soap, concentrated disinfectant, barrier cream, corrosion inhibitor, descaler, cleanser, leak sealer, silencer, rapid descaler, rapid cleanser and professional glass cleaner. Pages 3-7 are prints of pages from the Chemical Direct website which Mr Wiseman says describe his company and the products available. The exhibit is not dated. Four photographs of the goods are shown. Each has the word 'TimeLord' prominently displayed above the description of the product. The products shown are those described in paragraph 18. Pages 8-10 are enlarged photographs of the same products referred to above. They are packaged as shown here:





17. Pages 11-18 are described by Mr Wiseman as 'a selection of my company's invoices'. Eight invoices have been provided which are dated between 5 March 2011 and 9 May 2013. Customers are located in Plymouth, Swindon, Oldham, London, Aberdare and Caerphilly.

18. The invoices show sales of goods described, for the most part, as 'Timelord' products, and in some cases, identified by the product codes provided by Mr Wiseman on the first page of this exhibit and described at paragraph 16. These are hand soap and hand cream, disinfectant and glass cleaner, cleanser, inhibitor, descaler and leak sealant.

19. Pages 19 and 20 are handwritten delivery notes. The first is for 7 boxes of corrosion inhibitor and 3 boxes of descaler and is dated 30 May 2012. The second is for 15 x corrosion inhibitor, 4 x descaler and 1 x leak sealer and is dated 21 June 2012.

20. Pages 21 and 22 are copies of cheques from Bradbury Plumbing and Heating Supplies and Central Heating and Plumbing relating to two of the aforementioned invoices which Mr Wiseman states that he has filed in order to show that the orders have been completed.

21. In his witness statement, Mr Wiseman states that Page 23 refers to the 'Chemical Direct' website and is a print of data indicating the number of visitors to the website in the period 23 September 2011 to 19 August 2014 and gives details of the pages that were viewed. It is not clear where this page has originated and it is not dated, however, it refers to the period 23 September 2011 to 19 August 2014. With the exception of the most recent two months within this period, website visitor numbers are shown to be between 100 and 500 per month.

22. Pages 24 and 25 are described as photographs of a promotional TIMELORD phone case and mug which Mr Wiseman states were "given away by my company's sales representatives in the relevant period". The phone case is described on the photograph as 'iPhone cover used to get extra cases 2013-14'. It is shown in the following form:



23. The mug is described on the photograph as, 'promotional cup given out by reps Sept 2013.' The quality of the representation is poor and not all of the words can be seen. It is shown as below:



24. Mr Wiseman's second witness statement attaches exhibit HW2 which comprises 14 statements from 'a selection' of Mr Wiseman's customers, "indicating their knowledge of the TIMELORD brand and confirming that they have bought TIMELORD products." The 14 statements are signed and dated and are addressed 'to whom it may concern'. They do not contain a statement of truth. They are all

dated between 2 February 2015 and 12 February 2015 and all take the same form, as follows:

"I can confirm that as a customer of Wiseman Industries Ltd (formally Chemical Direct Ltd) we have purchased their 'TimeLord' formulation branded Corrosion Inhibitor and various other branded products in this range during the last five years. We first purchased this product in _____."

25. The dates of first purchase range from 12 October 2004 to 13 November 2013.

The applicant's submissions

26. With regard to the proprietor's evidence the applicant states that, *"the material contained in the Exhibit is of little or no probative value, being undated, unexplained or obscure."*

27. It accepts that the website, www.chemical-direct.com, is a live website but draws my attention to the fact that the prints from it are undated. Furthermore, the applicant contends that the pages taken from the website show that the products supplied and manufactured by the proprietor 'include' TimeLord products.

"It is respectfully submitted that mention of different products on which the Trade Mark may be applied does not constitute sale of products bearing the Trade Mark."

28. Further points raised by the applicant are as follows:

- The website data page is undated.
- Photographs of packaging are unclear and it is not clear if products bearing the mark were sold or offered for sale.
- Only 6 of the invoices bear reference to the goods claiming to be sold under the mark.
- Mr Wiseman claims to have sold £32,000 of goods in the period 2012-2013. Invoices for that period only total £1000.
- The volume of promotional products given out to drive sales is not made clear.

Genuine use

29. The contested mark is shown on the packaging of the goods in the photographs shown at paragraph 16 and on the promotional goods shown at paragraphs 22 and 23 of this decision.

30. No claim has been made by the applicant that the form in which the proprietor claims to have used the mark has altered the distinctive character of that mark from that as registered. Had such an issue been raised I would have concluded that the stylisation of 'TimeLord' (which is as shown on the photographs of bottles taken from the Chemical Direct website), is minimal and would not have altered the distinctive character of the proprietor's mark.¹

31. The second witness statement by Mr Wiseman comprises a number of statements from customers who have purchased TIMELORD goods. These take the form of 'to whom it may concern' letters.

32. In considering such evidence I am mindful of the decision in *First Group Plc v National Car Rental System Inc.*² in which Mr Hobbs sitting as the Appointed Person said:

"Their evidence was given in the form of synchronised statements written in what appear to have been closely prescribed terms. Such statements invite scepticism of the kind expressed by Lord Esher M.R. in *Re Christiansen's TM* [1885] 3 RPC 54 at 60:

'Now, to my mind, when you have evidence given upon affidavit, and you find a dozen people, or twenty people, all swearing to exactly the same stereotyped affidavit, if I am called upon to act upon their evidence, it immediately makes me suspect that the affidavits are then not their own views of things and that they have adopted the view of somebody who has drawn the whole lot of the affidavits, and they adopt that view as a whole and say 'I think that affidavit right' and they put their names to the bottom.

The hearing officer took the view that no real weight could be given to the evidence of these three witnesses in relation to the issues that he was required to determine. I think he was right to adopt that position."

33. In *DUCCIO Trade Mark* BL O343-09, Professor Ruth Annand, sitting as the Appointed Person observed:

"There are two ways in which 'to whom it may concern letters' can be introduced in Registry proceedings. First, the writer of the letter can provide a verifying affidavit, statutory declaration or witness statement to which his or her letter is exhibited. Second, the party seeking to rely on the letter can provide an affidavit, statutory declaration or witness statement to which the third party letter is exhibited. In the first case, the letter is part of the writer's own evidence. In the second case, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act."

¹ See the test laid down by Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark* (O/262/06) and in *REMUS trade mark* (O/061/08), and the guidance given by Mr Hobbs QC (sitting as the Appointed Person), in *Catwalk*.

² (BL O/531/02)

34. Tribunal Practice Notice (TPN) 5/2009 concludes from this that Hearing Officers will give hearsay evidence of this kind such weight as it deserves (as per section 4 of the Civil Evidence Act 1995), assessing each case on its own merits. Accordingly, hearsay evidence will not be discounted simply because it is hearsay. So, for example, substantial weight may be given to a hearsay statement made in letters or documents created around the time of the issue or event to which it relates. On the other hand, a Hearing Officer may decide to afford less weight to a hearsay statement made in a letter solicited by a party some time after an event, for the purpose of the proceedings, than he or she would have given to the same statement if it had been made in a witness statement and accompanied by a statement of truth. Further, if the person making such a hearsay statement had any motive to conceal or misrepresent matters, and the Hearing Officer decides that the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight, he or she may give the statement no weight at all.

35. Section 4 of the Civil Evidence Act 1995 permits hearsay evidence in civil proceedings but provides the following guidance as to the weight to be accorded to such evidence:

“Considerations relevant to weighing of hearsay evidence.

(1) In estimating the weight (if any) to be given to hearsay evidence in civil proceedings the court shall have regard to any circumstances from which any inference can reasonably be drawn as to the reliability or otherwise of the evidence.

(2) Regard may be had, in particular, to the following –

(a) whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;

(b) whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;

(c) whether the evidence involves multiple hearsay;

(d) whether any person involved had any motive to conceal or misrepresent matters;

(e) whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;

(f) whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.”

36. In making a finding with regard to the proprietor's evidence I bear in mind the decision of the General Court in *New Yorker SHK Jeans GmbH & Co KG v OHIM*:³

"53. In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07 *P Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."

37. I also note that in the decision of Mr Daniel Alexander QC (sitting as the Appointed Person) in *PLYMOUTH LIFE CENTRE*⁴, he stated:

"...it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

38. I also note the decision in *Catwalk*⁵ where Mr Hobbs QC (also sitting as the Appointed Person) stated in his paragraph 22:

"When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use. As to which see paragraphs [17] to [19] and [24] to [30] of the Decision of Mr. [Daniel] Alexander QC sitting as the Appointed Person in *PLYMOUTH LIFE CENTRE Trade Mark* (BL O-236-13; 28 May 2013)."

³ *Case T-415/09*

⁴ *BL O-236-13*

⁵ *BL O/404/13*

39. I also bear in mind the comments of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*,⁶ when he stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. V. Comptroller-General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

40. I accept that it would have been better had the proprietor provided turnover figures in respect of sales of goods under the TIMELORD mark broken down by the relevant years and in relation to specific goods. An indication of the amount spent on advertising and promotion of the brand would also have assisted. I would assume that such figures are available to Mr Wiseman. The fact that the evidence could have been better marshalled, however, does not mean that I should simply dismiss it.

41. The evidence includes invoices showing sales made. I note the applicant’s point that invoices total an amount lower than the sales claimed by Mr Wiseman in the year 2012-2013. However, Mr Wiseman states that the invoices are a ‘sample’ of invoices for the relevant period. The invoices provided are dated within the relevant period and six of the eight show goods sold as ‘Timelord branded’ or ‘Timelord own

⁶ BL O/404/13

brand'. The remaining 2 invoices include goods with the product codes identified by Mr Wiseman earlier in the exhibit as being 'Timelord' goods. Further weight is given to this point by the invoices which refer to the Timelord brand and also include the product codes. I also note that those product codes can be seen on the packaging/bottles in the photographs from Mr Wiseman's Chemical Direct website.

42. The website data page provided at page 23 of Mr Wiseman's evidence is not dated but clearly refers to the period 23 September 2011-19 August 2014 and shows (with the exception of two months in that period) website visitors between 100 and 500 per month. Example pages from the website are included within the evidence but are not dated.

43. Clearly there has been a degree of promotional activity in respect of TIMELORD. Photographs have been included of a phone case and a mug bearing the mark, though the numbers of these goods ordered and the extent of their distribution is not clear.

44. The applicant has disputed the sufficiency of the evidence provided by the opponent, but has not questioned its veracity. Whilst the evidence of use is not extensive, in its totality, it is sufficient, just, to show genuine use of the mark within the relevant period.

Fair specification

45. Having concluded that the trade marks have been used I must go on to consider for which goods and arrive at a fair specification.

46. I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29. I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for 'motor vehicles' only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to 'dig deeper'. But the crucial question is how deep?

30. Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31. Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

47. The comments of Mr Justice Jacob in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20. The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pedantic 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 threeholed 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.”

48. The comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used 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.”

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

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

50. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. (with whom Underhill L.J. agreed) set out the correct approach for devising a fair specification where the mark has not been used for all the goods/services for which it is registered. He said:

“63. The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would

describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2002] EWCA Civ 1828, [2003] RPC 32; and in West v Fuller Smith & Turner plc [2003] EWCA Civ 48, [2003] FSR 44. To my mind a very helpful exposition was provided by Jacob J (as he then was) in ANIMAL Trade Mark [2003] EWHC 1589 (Ch); [2004] FSR 19. He said at paragraph [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus 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.”

51. In these proceedings the proprietor seeks to defend its registrations in respect of the following goods:

Class 1

Chemical preparations for use as corrosion inhibitors; chemical de-scaling preparations; chemical fluids for use as leak sealants.

Class 3

Soaps; cleansing solutions and glass cleaner.

Class 5

Medicinal creams for the protection of the skin; disinfectants.

52. In its submissions, dated 12 May 2015, the proprietor's representative comments on the use described by the proprietor in his notice of defence in the following terms:

“Mr Wiseman says in his first Witness Statement that the mark has been used in relation to “medicinal creams for the protection of the skin, disinfectants, soaps, cleaning solutions, glass cleaner and chemical preparations for use as corrosion inhibitors”. It is clear from the evidence as a whole, however, that this is not an exhaustive description of all the goods involved. The Forms TM8(N) do not list all the goods for which the

mark was used in the relevant period and in respect of which evidence was filed, and we set out below a detailed list of the goods shown in the evidence...

“In relation to registration No. 1213593...the TM8(N) asserts use of the mark in relation to chemical preparations for use [as] corrosion inhibitors; chemical descaling preparations; chemical fluids for use as leak sealants. The use shown by the evidence, however, is on the following goods:

*Corrosion inhibitors for heading [sic] systems
Descalers for heating systems
Silencers for heating systems
Sealants for leaks*

It is submitted that the average consumer would fairly describe these goods as “chemical products for use in industry” but if further categorization is thought appropriate they might be described as “chemical products for use in the plumbing and heating industries”.

In relation to Registration No. 1241753...the TM8(N) asserts use of the mark in relation to soaps, cleaning solutions and glass cleaner. The use shown by the evidence, however, is on the following goods:

*Hand soap
Barrier cream
System cleanser for heating systems
Rapid cleanser for heating systems and for use in flushing machines
(i.e. plumbing equipment used to clean heating systems)
Glass cleaner*

It is submitted that an appropriate specification would be “cleaning preparations for use with plumbing equipment; cleaning preparations for heating systems; glass cleaning preparations; soaps; non-medicated preparations for the care of hands”.

In relation to Registration No. 1241754...the TM8(N) asserts use of the mark in relation only to medical creams for the protection of the skin but the use shown by the evidence also includes disinfectants. An amended specification might therefore read “medicinal creams for the protection of the skin; disinfectants (other than for laying or absorbing dust)”.

53. At paragraph 14 of its submissions the applicant states:

“In the event that the Examiner decides that the evidence is sufficient to demonstrate use of the Trade Marks as Registered, we submit that the evidence does not relate to all Goods claimed to be used in the counterstatements.”

54. Mr Wiseman has provided a number of photographs from a website which show the goods available under the TIMELORD mark. Whilst these are not dated, the

product codes shown on the goods are the same as those listed on the invoices for the relevant period. The chemical goods indicate that they are for use in radiators, central heating systems and heating systems. Having considered all of the evidence and the proprietor's suggested limitations I conclude that a fair specification for each of the three marks is as follows:

1213593

"chemical products for use in the plumbing and heating industries".

1241753

"cleaning preparations for use with plumbing equipment; cleaning preparations for heating systems; glass cleaning preparations; soaps; non-medicated preparations for the care of hands".

1241754

"medicinal creams for the protection of the skin; disinfectants (other than for laying or absorbing dust)".

55. This is how the average consumer would refer to these goods and it is neither too broad nor too pernicky.

Conclusion

56. The consequence of the findings above is that the proprietor's marks will be revoked for non-use except in relation to the goods I have listed in paragraph 54 of this decision. Revocation will take effect from 26 June 2014 in accordance with s. 46(6).

Costs

57. The applicant has requested costs in its favour. The proprietor states at the conclusion of its submissions dated 12 May 2015:

"We wish to reserve our submissions on costs in these proceedings."

58. Therefore I invite the proprietor to provide, within 28 days of the date of this decision, submissions with regard to costs.

59. The proprietor should copy its submissions to the applicant's representatives.

60. The applicant will have 21 days from the date of receiving any such submissions in which to submit any written comments it wishes to have taken into account.

61. A final decision on costs will follow receipt of the proprietor's submissions and any response from the applicant. The appeal period for the substantive and

supplementary decisions will run from the date of the supplementary decision on costs.

Dated this 30th day of June 2015

**Al Skilton
For the Registrar
The Comptroller-General**