

O-323-05

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2149359
IN THE NAME OF LOOKC LIMITED
OF THE TRADE MARKS:**

**MOVIE STAR
MOVIESTAR
MOVIE-STAR**

(A SERIES OF 3 TRADE MARKS)

IN CLASS 9

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 81505
BY
APPLE PROJECTS LIMITED**

Trade Marks Act 1994

**In the matter of registration no 2149359
in the name of LookC Limited
of the trade marks:
MOVIE STAR
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(a series of 3 trade marks)
in class 9
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thereto under no 81505
by Apple Projects Limited**

BACKGROUND

1) On 10 November 2003 Apple Projects Limited, which I will refer to as Apple, filed an application for revocation of registration no 2149359 for the trade marks:

**MOVIE STAR
MOVIESTAR
MOVIE-STAR**
(a series of three)

The trade marks are registered for the following goods:

apparatus for recording, transmission and reproduction of sound or images; computer hardware; computer software; but not including software relating to movie stars.

The above goods are in class 9 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.

The registration process was completed on 29 May 1998.

It currently stands in the name of LookC Limited, which I will refer to as LookC. At the time of the application for revocation the registration was in the name of Applied Technologies Manufacturing Limited.

2) Apple states that investigations have determined that the trade marks have not been used in relation to the goods for which they are registered within a period of five years from the date of registration or, in the alternative, for a continuous period of five years. Apple requests that the registration is removed from the register as per sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (the Act).

3) Apple states that it contacted Applied Technologies Manufacturing Limited advising the latter of the results of its investigations as to use. Apple offered Applied Technologies Manufacturing Limited the option of cancelling the registration in its entirety or assigning it to Apple for a nominal consideration. Apple states that

subsequent correspondence with Applied Technologies Manufacturing Limited resulted in a complete lack of co-operation and outlandish, preposterous and inappropriate requests which were wholly unacceptable to it. Apple requests the revocation of the registration in its entirety and an award of costs. Apple requests that if it is unsuccessful there should be no award of costs against it owing to the behaviour of Applied Technologies Manufacturing Limited described above.

4) Following the filing of the application the case did not follow the normal course as there was no response to the application in the time allowed. Eventually the case was the subject of an appeal before the appointed person in relation to this matter and its consequences. The decision in relation to this has the reference BL O/348/04. The effect of that decision is that the case has been put back on a normal footing and evidence has been filed by both sides.

5) A hearing was held on 7 December 2005. LookC was represented by Mr Golightly, of the company. Apple was represented by Ms McFarland of counsel, instructed by William A Shepherd & Son Limited.

EVIDENCE

Evidence of LookC

6) This consists of a witness statement by Samuel James Golightly. Mr Golightly is a director of Applied Technologies Manufacturing Limited. He states that on 19 June 2002 Applied Technologies Manufacturing Limited changed its name to LookC Limited; exhibited at exhibit 1 is a copy of a printout from Companies House to confirm this. Mr Golightly then goes on to deal with matters which were the subject of the appeal and which there is no need to rehearse here.

7) Mr Golightly states that the trade mark MOVIESTAR was used extensively by Applied Technologies Manufacturing Limited during the period October 1997 to August 2001. He states that the products in question were in the nature of circuit boards, patch panels and related goods for use as part of a personal computer based closed circuit television recording system. He states that the components facilitate the recording, transmission and reproduction of both sounds and images. Mr Golightly states the circuit boards were in the form of so-called PCI¹ controllers which are items of computer hardware adapted to be secured to the mother boards of personal computers. He states that in addition application software for creating a PC based CCTV security system was supplied under the trade mark MOVIESTAR.

8) Mr Golightly exhibits at exhibit 2 a scan of a label which was applied to boxes used for the products in question. He states that this label was used throughout the period of early 2000 to August 2001. The label describes the product as a PC based CCTV security system. It advises that the package contains a MovieStar PCI controller card, a MovieStar patch panel, an interconnect lead, an installation and user guide and an application software CD.

¹ PCI stands for Peripheral Component Interconnect

9) Mr Golightly exhibits at exhibit 3 a scan of the front, top and one side of a box which was used for the products in question. He states that the box was used throughout the period October 1997 to August 2001. The box describes the product as the "MovieStar PCI Interface". The box proclaims: "record and edit videos from your camcorder on the PC!".

10) Mr Golightly exhibits at exhibit 4.1 – exhibit 4.30 samples of various invoices issued by Applied Technologies Manufacturing Limited in 2000 and 2001 relating to MOVIESTAR. Only one of the invoices bears the name of the sender, Applied Technologies Manufacturing Limited. The earliest invoice is dated 10 January 2000, the latest 2 October 2001. The recipients of the invoices and the goods for which the invoices have been sent are listed below:

Protobase Ltd	1 Moviestar PCI
G Herron	1 Moviestar PCI
	1 Moviestar 4 input lead
Baywatch Security	1 security lead set
	1 Moviestar PCI
Maplin Electronics Ltd	20 Moviestar PCI cards
GC Electronics	1 Moviestar PCI
Tring Business Systems	1 VGA-2-PAL Pro
	1 Moviestar PCI
Astro Medical Systems Ltd	1 Moviestar PCI
	1 motion picture printer port
	1 VGA-2-PAL Pro
	1 PCI fitting kit for K3012
CCTV Installations Ltd	1 Moviestar 4 input lead
Combined Precision Components	25 Moviestar PCI cards
KRA co uk Limited	1 Moviestar PCI card and lead
Zone Communications (in Australia)	40 Moviestar PCIs
	40 Moviestar 4 input leads
	3 repaired (sic) Moviestar cards
Alfia Services Limited	10 Moviestar PCIs
	10 Moviestar 4 input leads
Combined Precision Components	30 Moviestar PCI cards
	20 Moviestar 4 input leads
	4 – security packs
	15 VGA-2-PAL gamers
Don Hanks	2 Moviestar PCIs
	2 Moviestar 4 input leads
Seneca Consumables Ltd	1 Moviestar PCI
Combined Precision Components	30 Moviestar PCI cards
	20 Moviestar 4 input leads
Senstec	5 Moviestar PCIs
	5 Moviestar 4 input leads
AAA Computers	1 Moviestar PCI
	1 Moviestar 4 input lead
Power Products	5 Moviestar PCIs
M D Francis	1 Moviestar PCI
Maplin Electronics Ltd	10 Moviestar PCI cards

	5 VGA-2-PAL gamers
Addidon & Lee	1 Moviestar PCI
JAF Graphics	1 Moviestar PCI
Senstec	3 Moviestar PCIs
Maplin Electronics Ltd	1 Moviestar TV Tuner
CEC (UK) Ltd	2 Moviestar PCIs
BA Allen	1 Moviestar PCI
	1 VGA-2-PAL Pro
	1 PCI fitting kit for K3012
Newpool Solutions Limited	1 Moviestar 32 bit security pack with telepaging
Matrix Marking	2 Moviestar PCI video capture cards
Stowood Scientific Instruments	1 Moviestar PCI video capture cards

11) Mr Golightly states that during the period October 1997 to August 2001 he estimates that Applied Technologies Manufacturing Limited sold between 4,000 and 5,000 systems under the trade mark MOVIE STAR.

Evidence of Apple

12) This consists of a witness statement by Gary William Anthony Johnston, who is the managing director of William A Shepherd & Son Limited and a trade mark attorney. Mr Johnston's statement consists solely of submissions in relation to LookC's evidence and not evidence of fact. I would not normally comment upon this here. However, I note that Mr Johnston states that at best the registration should only be maintained in respect of *computer hardware; computer software; interconnection leads for use therewith*. Mr Johnston goes on to state that the sales are de minimis and that the registration should be revoked in its entirety.

Evidence in reply of LookC

13) This consists of a further witness statement by Mr Golightly. Most of Mr Golightly's statement is submission rather than evidence of fact and I will say no more about this part of his statement. Mr Golightly states that the goods sold under the trade mark MOVIE STAR would have been used in association with a range of other electronic components to form a complete CCTV surveillance system. Images would be initially captured by a television camera and then would be fed to a MOVIE STAR board. This board would act as a physical interface and electronic control to enable the output of the camera to be recorded. Mr Golightly states that the units sold by Applied Technologies Manufacturing Limited typically cost £79 each.

DECISION

14) Section 46 of the Act reads as follows:

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to

the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

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

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

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

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

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

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

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

(a) the date of the application for revocation, or

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

Consideration has to be taken, also, of section 100 of the Act which states:

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

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

Preliminary Issues

15) Mr Golightly wished to adduce additional evidence into the case. This consists of a brief witness statement and two exhibits. Notice of the evidence and a copy of it (not in proper evidential form) was received by the Registry on 5 December 2005. A copy of the evidence in the form of a witness statement was received on 6 December 2005. Rule 32A(6) of the Trade Mark Rules 2000 (as amended) states:

“The registrar may, at any time if she thinks fit, give leave to either party to file evidence upon such terms as she thinks fit.”

In various proceedings before the Registry the issue of admission of additional evidence has been considered, by analogy, on the same basis as the admission of additional evidence on appeal; which is covered by *Hunt-Wesson Inc's Trade Mark Application* [1996] RPC 233, *Wunderkind Trade Mark* [2002] RPC 45, *État Française Représentée Par la Ministère de L' Agriculture de la Forêt v Bernard Matthews Plc* [2002] ETMR 90 and *EI Du Pont de Nemours & Company v ST Dupont* [2004] FSR 15. In this case I am at two removes from these judgments: this is consideration at first instance and a case of revocation for non-use. In his letter received on 5 December 2005 Mr Golightly states that he has just uncovered the evidence. He does not explain why or how he has “just” uncovered the evidence. “Just” uncovered could cover a multitude of sins. Without further explanation it is no explanation. At the hearing Mr Golightly did not indicate that the evidence was not available to him earlier eg it was with a third party.

16) I decided to allow the evidence into the proceedings. The evidence does not require an evidential reply. Indeed, I find it difficult to envisage how or in what manner Apple could put in evidence of fact strictly in reply. It is noted that Apple has put in no evidence of fact in this case. The admission of the evidence will not put any major burden upon Apple. The goods shown in the evidence are referred to in the sales invoice at exhibit 4.6, so there is no surfacing of a new product. All of these reasons could allow for the admission of the evidence on the balance of convenience but for no stronger reason. The key reason I allowed the evidence in is that it was explanatory; it defines what the product described in the invoice is. It assists me in making my decision. So despite the feebleness of the reason for the late filing of the evidence I decided to admit it into the proceedings.

17) The evidence consists of a witness statement by Mr Golightly and exhibits 5.1 and 5.2. Mr Golightly states that the exhibits show the front and back of packaging for a MovieStar tuner. The goods are described on the packaging as a MovieStar TV Tuner. The packaging gives details of the pack contents:

“MovieStar TV Tuner PCI card
Internal Audio Lead
Driver and Application Software on CD
Installation Instructions
Warranty Card”.

From this evidence I am able to deduce that the product the subject of exhibit 4.6 is a TV tuner PCI card.

18) Ms McFarland wished to refer to a letter which had been sent to the Registry by LookC dated 29 March 2004. It has not been adduced into the proceedings. If Apple considered the letter germane to its case it should have filed it as evidence. I take no cognisance of this letter as it has not been put into the proceedings as per rule 55(1) or 55(3). However, I have looked at the letter and I cannot see that it would assist the case of Apple. Ms McFarland’s claims in her skeleton argument revolved around the footer of the letter from LookC stating that LookC is a subsidiary of ATM PLC. That LookC is a subsidiary of ATM PLC does not stop it being a legal entity in its own right and having its own property both tangible and intangible. Mr Golightly has produced documentation showing that change of name to LookC. It is also to be noted that the vat number on all of the invoices is the same as that on the letter and that the company registration number on the letter is the same as that shown in the Companies House details at exhibit 1; which show the change of name from Applied Technologies Manufacturing Limited to LookC Limited. So even if the letter was in the proceedings nothing would have turned upon the matter.

19) The fundamental argument of LookC appears to be that as its PCIs and related goods are used in computers which when linked with other equipment can capture, store and show images and sound then it should retain all of its specification, including *apparatus for recording, transmission and reproduction of sound or images*.

20) Ms McFarland attacked the validity of the evidence of LookC. It was her submission that the evidence lacked clear provenance as to date and that the invoices did not prove use of the trade mark by the proprietor. It was her position, as it had been that of Mr Johnston, that if the registration was to be revoked partially the front part of it should be removed and Look C left with *computer hardware; computer software; interconnection leads for use therewith*.

21) Ms McFarland described, in her skeleton argument, the invoices submitted by Mr Golightly as “a series of purported invoices”. She states that none of them being originals “puts in question the veracity of these copies”. I do not understand how adducing the originals into the proceedings would change their status, unless there is an implication that they were doctored. I feel that I have no option but to view Ms McFarland’s submissions as impugning the main evidence of Mr Golightly. Mr Johnston’s evidence, which is in fact submission, does not impugn the evidence. Mr

Golightly was not called for cross-examination. Latham LJ dealt with the proper approach to impugning the evidence of a witness in Latham LJ in *Deepak Fertilisers and Petrochemical Limited v Davy McKee (UK) London Limited* [2002] EWCA Civ 1396:

“49. The general rule in adversarial proceedings, as between the parties, is that one party should not be entitled to impugn the evidence of another party’s witness if he has not asked appropriate questions enabling the witness to deal with the criticisms that are being made. This general rule is stated in Phipson on Evidence 15th Edition at paragraph 11-26 in the following terms:

“As a rule a party should put to each of his opponent’s witnesses in turn so much of his own case as concerns that particular witness, or in which he had a share, eg if the witness has deposed a conversation, the opposing counsel should put to the witnesses any significant differences from his own case. If he asks no questions he will generally be taken to accept the witness’s account and will not be permitted to attack it in his final speech. Failure to cross-examine will not, however, always amount to acceptance of the witness’s testimony, if for example the witness has had notice to the contrary beforehand, or the story itself is of an incredible or romancing character.”

50. The caveat in the last sentence that I have quoted, is important particularly in the context of the Civil Procedure Rules in which, by Part 32 r. 1(3) the court is given a power to limit cross-examination. Nonetheless, the general rule remains a valid rule of good practice and fairness. The judge of fact is, however, in a different position from the protagonists. So long as a matter remains clearly in issue, it is the judge’s task to determine the facts on which the issue is to be decided. However it seems to me that where, as in the present case, an issue has been identified, but then counsel asks no questions, the judge should be slow to conclude that it remains an issue which has to be determined on the basis of an assessment of reliability or credibility without enquiry of the parties as to their position. The judge should be particularly cautious of doing so if he or she has not given any indication of concern about the evidence so as to alert the witness or counsel acting on the side calling the witness, to the fact that it may be that further explanation should be given in relation to the issue in question.”

I consider that Ms McFarland’s submissions require something far more substantial than unfounded speculation to back them. It is too late to impugn the evidence of Mr Golightly. If Apple had doubts about the veracity of the invoices it could have investigated, eg by contacting the recipients of the invoices. If there was doubt about the veracity of Mr Golightly’s first witness statement he should have been cross-examined. There was no request for cross-examination. I can see no reason not to accept the veracity of the invoices exhibited by Mr Golightly.

22) I accept that in non-use cases the evidence should be of a high standard. As the Court of First Instance in *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-39/01 [2003] ETMR 98 held

“In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

In *Laboratoire De La Mer Trade Marks* [2002] FSR 51 Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

In this case the combination of the exhibits and the statement of Mr Golightly do establish use of the trade marks for the following goods: video capture cards, television tuner cards, application software for the aforesaid goods, input leads and patch panels. It is to be noted that the invoices identify certain goods as being Moviestar goods whilst others have no such identification. Taking into account the invoices emanated from Applied Technologies Manufacturing Ltd use without reference to Moviestar on the goods invoiced cannot, in my view, be considered to be use of Moviestar (or one of the variants of the series). The non Moviestar goods cannot be considered as proof of use in relation to such goods merely because of proximity to Moviestar goods. Mr Golightly in his first statement describes the goods as being in the nature of “circuit boards, patch panels and related goods for use as part of a personal computer based closed circuit television recording system”. Owing to the enormous similarity of the series of trade marks, I do not consider that anything turns upon the differences between them. If one stays they all stay.

23) The range of goods for which proof of use has been shown is very limited. The question is as to how they should be described in the specification. There is now much guidance as to the approach to be taken:

- *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

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

the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

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

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

- *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all a trade mark specification is concerned with use in trade."

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

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

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

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

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

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

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the

goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

- *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

- *Omega SA v Omega Engineering Inc* [2003] FSR 49:

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

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

4. Before one gets, however, to that, one must ask whether scoreboards and railway information screens (for which use has been proved) are properly to be regarded as "signalling instruments and apparatus". Mr. Edenborough submits that they are. In a technical sense there is something in what he says. You look at the screen for information and because it is providing information visually it is, in a sense, sending out a signal. But I do not think it is right to regard trade mark specifications from a technical point of view. It is much more important to regard them from a trade point of view. These specifications are not patent claims, they are specifications of goods for the purposes of trade. I do not believe that anybody in the ordinary way of things would regard a display screen as a "signalling instrument or apparatus". On the contrary, in the ordinary way of things someone who looks at a television screen or other sort of screen would regard that as the thing which had received the signal. Technically, as a matter of information science, maybe a thing is also providing information and in that sense sending a signal, but in the commercial sense it is not a signalling instrument.

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

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

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

In *Mercury Communications Limited v Mercury Interactive (UK) Limited* [1995] FSR 850 Laddie J dealt with the specific issue of computer software:

"In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for "computer software" will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software,

including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

24) It is my view that *video capture cards* and *TV tuner cards*, being PCIs, are very particular, specific and identifiable items. A potential purchaser of these products would view and describe them in that format, not for instance lumping them in, for instance, with graphics cards. A similar argument to that for software is appropriate to them; they are very much identified by their purpose. So I do not consider that in normal circumstances even leaving LookC with PCIs at large and application software therefor would be appropriate. It would certainly not be appropriate for the limited nature of the goods to leave LookC with *apparatus for recording, transmission and reproduction of sound or images*; this is well beyond the scope of the use shown and the way that the public would describe them. LookC have used the trade mark(s) on a limited number of components which when used with a large amount of other equipment can be used to record, transmit or reproduce sound or images; so equally could a transistor or a switch. This first part of the specification covers an enormous range of goods eg DVD players and recorders, record decks, amplifiers, loudspeakers. This first part of the specification is not a natural way of describing the goods upon which use has been shown. All of the goods, with the exception of input leads, are items of computer hardware or software. Apple have stated that if it is found that there has been genuine use of the trade marks then the specification should be limited to *computer hardware; computer software; interconnection leads for use therewith*. This is a far wider specification than the evidence warrants. However, this is what Apple has chosen and so I will limit the specification within the terms of Apple’s claim. **The registration will be limited to the following goods:**

computer hardware; computer software; interconnection leads for use therewith; but not including software relating to movie stars.

25) The application has been made under both sections 46(1)(a) and (b). Under section 46(6)(b) of the Act I can decide that the revocation should take effect from the date of application or an earlier date if I am satisfied that the grounds existed at an earlier date. In this case there is not the least suggestion that LookC, or Applied Technologies Manufacturing Limited, has used the trade mark on any other goods than those shown since the date of registration. **I consider, therefore, taking into account the claim under section 46(1)(a), that the revocation should take effect from 30 May 2003 (the day following the fifth anniversary of the completion of the registration process.**

COSTS

26) Each side has had a measure of success, therefore, each should bear its own costs.

Dated this 13th day of December 2005

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