

TRADE MARKS ACT 1994

O-357-03

IN THE MATTER OF APPLICATION No 80205

BY NEW LINE PRODUCTIONS INC.

FOR THE REVOCATION OF TRADE MARK No 2050918

**LOST IN SPACE**

IN CLASS 9

STANDING IN THE NAME OF

CHRISTIAN HOGUE

## **BACKGROUND**

1) The trade mark LOST IN SPACE is registered under number 2050918 in respect of goods in Class 9 and services in Classes 41 and 42. However, this application for revocation refers only to the goods in Class 9. A separate revocation application under number 80159 was filed in relation to the services. The mark is registered for the following goods:

Class 9: "Computer software, computer programs and data carriers therefore; computer generated graphics; pre-recorded computer graphics and animations on film, video tape, video disc, laser disc, compact disc and computer chips."

2) The application for registration was made on 12 January 1996 by Christian Hogue and the mark was placed on the register on 22 November 1996.

3) By an application dated 3 December 2001, New Line Productions Inc. of 888 Seventh Avenue, New York, New York 10106, USA applied for the revocation of the registration under the provisions of Sections 46(1)(a) & (b). The grounds state that within the five years following the date of completion of the registration procedure the mark has not been put to genuine use in the UK by the proprietor or with his consent in relation to the goods in Class 9 for which it is registered and that there are no proper reasons for non-use. In the alternative they contend that such use, in respect of goods in Class 9, has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.

4) On 3 March 2000 the registered proprietor filed a counterstatement denying all the grounds.

5) Both sides seek an award of costs. Both sides filed evidence.

6) At the hearing, on 29 July 2003, the registered proprietor was not represented but provided written submissions. The applicant for revocation was represented by Mr Cuddigan of Counsel instructed by Messrs Field Fisher Waterhouse.

## **REGISTERED PROPRIETOR'S EVIDENCE.**

7) The registered proprietor, Mr Christian Hogue, filed a witness statement, dated 19 April 2002. He states that his company specialises in animation and computer-generated graphics. He states

that his company supplies computer generated special and digital effects and 3D animations for particular projects for clients in the film, television, advertising and design industry. He claims to have in-house software expertise at the forefront of animation technology.

8) Mr Hogue states that his company began trading under the name LOST IN SPACE when the company was formed in 1990. Since when he claims that his company has produced computer-generated animation sequences for a number of block buster feature films such as “Terminator” and “Lost in Space”. Mr Hogue provides a number of exhibits many of which simply refer to advertisements, films etc that the company has produced or been involved in. Mr Hogue has not sought to specifically identify which of the goods and services (for which his mark is registered) he is showing use of with each exhibit. Instead he contents himself with a blanket statement that he has used the mark on all the goods and services covered in his specification. To my mind there is only one exhibit which mentions goods in Class 9:

CH3: In an article from Computer Graphics World dated April 1995 the article states: “In fact Lost In Space has also created a Softimage-to-RenderMan converter named Siren, and they now have a small side business selling the converter to other studios, such as Boss Film.”

#### APPLICANT’S EVIDENCE

9) The applicant filed two witness statements. The first, dated 25 July 2002, is by Amy Goodman the Senior Vice President of Business and Legal Affairs at the applicant company. She states that her company produced the film *Lost in Space* and that the proprietor contrary to his claim did not supply any goods or services to the applicant in connection with the film. She does accept that Mr Hogue “may have proposed to provide the applicant [with] computer graphic design services for the applicant’s film *Lost in Space*”.

10) The applicant’s second witness statement, dated 26 July 2002, is by Douglas Brian Reynolds Snr a private investigator. He states that in October 2001 he was instructed to carry out an investigation to determine whether the proprietor had used the mark in suit on goods in Class 9 in the past five years. In June 2002 he conducted an updated investigation into the same matters.

11) Mr Reynolds states that Mr Hogue, a Director of the company Lost In Space, describes his occupation as “Digital Designer Animation” in the annual return to Companies House. He also states that on the website of Lost in Space it states that the company is a computer graphic design agency specialising in 3D digital effects and animation. Mr Reynolds also states that the website states that the company primarily uses other companies software to create it’s graphics. At exhibits DR2 he provides print-outs from the website to corroborate these statements.

12) Mr Reynolds contacted the company twice asking about software. At exhibits DR3 & 4 are the responses including one from Christian Hogue stating that the company does not sell software. Mr Reynolds describes how he also contacted editors of magazines which had featured articles on Lost In Space. All stated that they were not aware of the company selling software. He also contacted major software suppliers and software outlets, none of which had ever heard

of software made by Lost In Space.

#### REGISTERED PROPRIETOR'S EVIDENCE IN REPLY

13) In his second statement, dated 19 November 2002, Mr Hogue states that:

“My company has been involved in the development, commissioning, marketing and distribution of software for approximately ten years. Mr Bruno Nicoletti, a programmer working under contract for my company and using our resources, designed the software which we have within the past five years marketed and licensed as SIREN.”

14) At exhibit LIS1 he provides a letter dated 27 April 1995 to himself from Mr Nicoletti which refers to a contract between the two men. In the letter Mr Nicoletti states that he wrote SIREN while under contract to Mr Hogue in 1993, but later expanded it at his own cost. He states that he sees it as a partnership. Mr Nicoletti states that he will set up a “sensible marketing campaign for it”. He also states that he will provide technical support but only to a limited degree. Lastly he refers to the fact that SIREN is currently US\$2,000 per license and that he wants 65% gross of each SIREN license.

15) At exhibit LIS2 Mr Hogue provides a copy of a facsimile dated November 1995 which he claims “gives activation details for a trial of the software”. The document does not contain details of costs of a license or any other sales details. It refers to activation details which are enclosed (but not provided in evidence) for “a period of 18 days”. The document does carry the name and address of the proprietor, but it is not clear to whom it was sent as the addressee is merely given as “Dr Ali Sahiner, Story Mine”.

16) Mr Hogue states that his company was listed as the contact for sales and further advice. He also states that sales of the software were to:

“Advanced users of animation and graphic design software for professional purposes. Customers were therefore either colleagues or fellow professionals in the industry. Since sales of software were to our industry peers who were buying the software because of its proven technical effect, developed by LIS, marketing was personal and targeted and the packaging was only ever functional (often simply a label would be attached to the software tape).”

17) Mr Hogue explains that due to its highly specialised nature the software is not sold through high street outlets. He states that SIREN works with RENDERMAN software and that an arrangement has been made with the owners of RENDERMAN so that Mr Hogue can sell licenses for RENDERMAN together with SIREN software. At exhibit LIS3 he provides a copy of a fax, dated 5 May 1994, to PIXAR (owners of RENDERMAN) which has various technical details of the SIREN software and relates to its inclusion in a “3<sup>rd</sup> party catalog”.

18) At exhibit LIS4 is a copy of an order placed by Mr Hogue for RENDERMAN software dated April 1997. At exhibit LIS 5 is a copy of a letter dated 13 March 1998, from the proprietor to Mr Ahmed Arslan offering to sell the "RENDERMAN toolkit U3.7".

19) Mr Hogue states that the "day to day work of my company involves customising existing software tools in order to achieve the graphics and effects that the particular commission requires. In this way, many commissions will incorporate, to a greater or lesser degree, bespoke software, in other words, software that is created specially for a one-off effect".

20) Mr Hogue states that his company is known for its "flowing liquid metal effects". At exhibit LIS6 he provides a video tape of a title sequence to the film "Death Machine" which shows this effect. At exhibit LIS7 is a list of the crew for this film and Mr Hogue is listed as the "digital special effects supervisor". He states that:

"Although we do not sell this program on to other animators for commercial reasons, we sell the effect onto our clients when they come to us with a brief requiring this technique".

21) Mr Hogue states that the finished work is presented to the client in the form of a video tape/disc or laser/compact disc with a Lost In Space label attached. He also explains that callers enquiring about software would usually be told that the company does not supply it in order to save time explaining that the software they supply is highly specialised.

22) At exhibit LIS8 & 9 Mr Hogue shows that he was involved in the movie *Lost In Space* as a sub contractor to VTR Group. Exhibits LIS 10 & 11 also show Mr Hogue credited with working on the movie, in addition to *Terminator 2* and *Death Machine*.

23) At exhibit LIS13 is an invoice from a company called "On Tap" to the proprietor relating to "Design and Programming of interactive presentation for the *Soundengine*". This is dated 13 December 1999. Mr Hogue states that this is part of the development of a "games related entertainment concept (*Soundengine*) that is being designed by my company and developed by outside contractors". He states that the programming has been done and that his company is in the process of securing financial backing. He states that the details of the software are therefore commercially sensitive.

24) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

25). The application for revocation was filed on 3 December 2001. At the hearing Mr Cuddigan requested that the period under review be amended to cover the five year period up to November 2002. This is not permissible, one cannot anticipate that a trade mark will not be used. The period in question under Section 46 must be prior to the date of the application for revocation.

26) There are two periods to be considered. Under Section 46(a) the period is the five years following registration which, in this case, gives a period of 23 November 1996 to 22 November 2001. Under Section 46(b) the period in question is 3 December 1996 - 2 December 2001. These periods are almost identical, for the purpose of the instant case I shall therefore consider the whole period 23 November 1996 - 2 December 2001; which produces no different result from considering each period separately.

27) The grounds of revocation are based on Section 46(1)(a) and (b) which read:

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

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

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

28) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. It reads:

“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.”

29) In considering this matter I look to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] ETMR 34. This was an appeal against a decision by the Registrar. In that case the question of whether a very limited amount of use in this country can be regarded as sufficient to be “genuine” was considered. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

30) On the question of onus of proof I note the comments from the *NODOZ* case [1962] RPC 1, in which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, .....

31) The proprietor has asserted that it “has been involved in the development, commissioning, marketing and distribution of software for approximately ten years”. The evidence shows that:

- Mr Nicolletti wrote software called SIREN in 1993;
- A trial of this software was given to Mr Sahiner in November 1995;
- The request was made on 5 May 1994 to include the SIREN software in a third party catalogue issued by PIXAR.

32) It is clear that the proprietor did develop a software package under the SIREN name. There is no evidence of use of the mark in suit, *LOST IN SPACE*, on this software. Even if I were to accept that the registered proprietor did append its mark to the packaging, and there is no evidence of this, all the above evidence is prior to the five years under consideration. Whilst I accept that the software is highly specialised and would be sold to others in the industry and not the general public, the proprietor has not provided any evidence of sales, marketing or indeed any activity with regard to this software in the relevant period 23 November 1996 - 2 December 2001.

33) The only other assertion regarding use on goods under class 9 is the comment by Mr Hogue that “Finished work is presented to the client in the form of video tape/disc or laser/compact disc”. In the proprietor’s written submission it is contended that the use of a *LOST IN SPACE* label on such items such as that provided at exhibit LIS6 is use in relation to the commissioned computer imagery, the software used in its creation and the format itself. The proprietor refers to the comments of Mr Justice Jacob in *Euromarket Designs Inc. v Peters and Crate & Barrel Ltd* [2000] EMTR1025 at paragraph 57 where he states:

“It may well be that the concept of ‘use in relation to goods’ is different for different purposes. Much may turn on the public conception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled ‘Boots’, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between the sign and goods may not make the use of the sign ‘in relation to’ the goods. Perception matters too.”

34) In its written submission the registered proprietor states that:

“Here it was said that ‘use’ of a mark on goods may be determined by the ‘public conception of that use’. We would suggest that ‘the public’ in this case must necessarily be the particular market of the goods in question. Our client’s customers are knowledgeable about computer-generated graphics and well aware that bespoke software needs to be created for the purposes of each project. They will understand that the purchase price of the special effect or image will include the costs incurred in designing and developing the software. Their perception will then be that they have purchased the software, the end effect and the format upon which it is presented to them. We would therefore submit that LOST IN SPACE serves a trade mark function in respect of all of these.”

35) I accept that the proprietor’s clients will be knowledgeable and they will accept that the price of the special effect or image will include a variety of costs incurred by the proprietor. However, whenever one purchases a product it is accepted that there are development costs which will be included in the price. When dealing with bespoke products these development costs will be commensurately higher. To my mind, the average consumer of the proprietor’s goods will not view the use of the mark in suit on a video cassette or disc as indicating that the video cassette or disc originates from the proprietor. It is merely a medium for the delivery of the product which the client ordered, a special effect or image. Similarly, the fact that software has had to be written or adapted would be considered by the consumer as part of the manufacturing process of the special effect or image. I therefore reject the proprietor’s contention and find that the proprietor has not filed evidence of use of the mark in suit in the period stipulated on any of the goods in its Class 9 specification.

36) Given the very specific nature of the revocation action, the proprietor had no reason not to file clear, unambiguous evidence of use of the mark in relation to the goods under attack. The proprietor has offered no evidence of proper reasons for non-use. It is my view that the registered proprietor has failed to discharge the onus that is placed on them by Section 100 of the Act.

37) The application for revocation under Sections 46(a) & (b) is therefore successful. I order the registered proprietor to pay the applicant the sum of £1500. This sum 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 20th day of November 2003

George W Salthouse  
For the Registrar  
the Comptroller-General