

O-369-10

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2238084
IN THE NAME OF JAMBA JUICE COMPANY
IN RESPECT OF THE TRADE MARK:**

JAMBA

IN CLASSES 9, 16, 35, 38, 41 & 42

AND

**AN APPLICATION FOR REVOCATION (NO 83108) ON THE GROUNDS OF
NON-USE BY FOX MOBILE DISTRIBUTION GMBH**

TRADE MARKS ACT 1994

In the matter of registration no 2238084 in the name of Jamba Juice Company in respect of the trade mark JAMBA in classes 9, 16, 35, 38, 41 & 42

and

an application (no 83108) by Fox Mobile Distribution GmbH for revocation on the grounds of non-use

Background and the pleadings

1. Registration 2238084 is for the trade mark JAMBA which stands in the name of Jamba Juice Company ("Juice"). The mark was filed on 3 July 2000 and it completed its registration procedure on 5 January 2001. The goods and services for which it is registered are:

Class 09: Audio and video recordings; discs, cassettes, cartridges, video tapes; electronic games; electronic amusement apparatus; games software; games consoles; games for use with television apparatus; telecommunications apparatus and instruments; apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, signals, software, information, data and code; software provided by telecommunications networks; music, sounds, images, text, signals, software, information, data and code provided by on-line delivery and by way of the Internet and the World Wide Web; publications in electronic format; computer software; computer hardware; computer software and telecommunications apparatus and instruments (including modems) to enable connection to databases and the Internet; parts and fittings for the aforesaid goods.

Class 16: Printed matter, printed publications, journals, periodicals, flyers, postcards, calendars, book markers, photographs, posters, stationery, labels, loose leaf binders, diaries, pencils, pens, fact sheets, handbooks, score cards.

Class 35: Advertising; dissemination of advertising matter; business information; commercial information; business research; statistical information; sales promotion; rental of advertising space on the Internet; market research; organisation of exhibitions for business or commerce; preparation of audio-visual presentations for use in advertising; provision of information and digital data all relating to advertising; data storage and retrieval, all for information, images, audio material and text; providing advertising, marketing and other promotional services for publications, business and individuals using a computer network; promotional services; organisation, operation and supervision of sales and of promotional incentive and membership schemes; advisory, consultancy and information services relating to the aforesaid, including such services provided online from a computer network or via the Internet or Extranets.

Class 38: Electronic communication services; digital transmission services; transmission of games; hire, leasing and rental of telecommunications, communications and broadcasting apparatus; telecommunication of information, including web pages, computer programs and any other data; music, sounds, images, signals, information, data and code provided by telecommunications networks; transferring and disseminating information and data via computer networks and the Internet; electronic mail services; provision of telecommunications access and links to computer databases and the Internet; telecommunication access services; website portal services; providing access to the Internet; advisory, consultancy and information services relating to the aforesaid, including such services provided online from a computer network or via the Internet or Extranets.

Class 41: Entertainment services; entertainment services by or relating to games, competitions, television appearances and audience participation events; lottery services; gaming and gambling services; production, presentation, syndication, distribution and provision of radio and television entertainment, films and video tapes; organisation, production, promotion and management of shows, concerts, performances and competitive events; sporting and cultural activities; games broadcasts; electronic game, quiz and competition services provided online from a computer network or via the Internet or extranets; providing on-line electronic publications; publication of electronic books and journals on-line; provision of on-line information in the field of sport and leisure; rental of telecommunications, television or radio apparatus, or of sound or video recordings; advisory, consultancy and information services relating to the aforesaid, including such services provided online from a computer network or via the Internet or Extranets.

Class 42: Website design, creation, maintenance and hosting services; computer services and on-line services; computer programming; drawing and commissioned writing, all for the compilation of web pages on the Internet; installation and maintenance of computer software; leasing access time to, and providing search, retrieval, indexing, linking and data organization capabilities for the Internet, electronic communications networks and electronic databases; maintaining, indexing and electronically distributing advertising material; advisory, consultancy and information services relating to the aforesaid, including such services provided on-line from a computer network or via the Internet or Extranets.

2. The official record for the registration shows that it was filed in the name of Carlton Interactive Media Limited, who assigned it to Carlton Communications Plc, who assigned it to Gala On-Line Limited, who changed their name to Gala Interactive Limited, who then assigned it to its current proprietor, Juice. Juice has been recorded as proprietor since 6 July 2004.

3. On 13 December 2007 Jamba GmbH applied for the revocation of Juice's registration under sections 46(1)(a) & (b) of the Trade Marks Act 1994 ("the Act"). On 18 May 2010 the Intellectual property Office was advised by the applicant that it had changed its name to Fox Mobile Distribution GmbH ("Fox"). I will refer to the

applicant as Fox throughout this decision even though it was called Jamba GmbH when it filed its application and evidence. Fox claims that:

“The Registered Proprietor has never used the trade mark in the UK, as it trades only in the US. The Applicant has investigated the Registered Proprietor’s activities and has found no evidence that the trade mark has been put to genuine use within the UK since its registration date by the Registered Proprietor or with its consent in relation to all or any of the goods and services for which it is registered.”

Fox adds that there are no proper reasons for non-use.

4. Juice filed a counterstatement denying the allegation of non-use, but only in relation to the following goods and services:

Class 9: Games software; games for use with telecommunications apparatus and instruments; software provided by telecommunications networks; software, information and data provided by on-line delivery and by way of the Internet and the World Wide Web; publications in electronic format; computer software.

Class 35: Advertising; dissemination of advertising matter; commercial information; information services relating to the aforesaid, including such services provided online from a computer network or via the Internet.

Class 38: Digital transmission services; transmission of games; telecommunication of information, including web pages, information provided by telecommunications networks; transferring and disseminating information and data via computer networks and the Internet; provision of telecommunication access and links to computer databases and the Internet; website portal services; information services relating to the aforesaid, including such services provided online from a computer network or via the Internet or Extranets.

Class 41: Entertainment services; entertainment services by or relating to games.

Class 42: Website hosting services; computer services and online services; maintain, indexing and electronically distributing advertising material; information services relating to the aforesaid, including such services provided on-line from a computer network or via the Internet or Extranets.

5. Both sides filed evidence. The matter then came to be heard before me on 16 September 2010. At the hearing, Fox were represented by Mr James Abrahams, of Counsel, instructed by SJ Berwin LLP. Juice did not attend the hearing, opting instead to file written submissions; the written submissions were provided by Mr Jeffrey Parker of Jeffrey Parker & Company.

The relevant five year periods

6. Fox's application for revocation is based on sections 46(1)(a) & 46(1)(b) of the Act. It seeks revocation with effect from either 6 January 2006 (section 46(1)(a)) or from 10 December 2007 (section 46(1)(b)). The relevant periods are:

Section 46(1)(a) – The registration procedure for Juice's mark was completed on 5 January 2001. The relevant period begins on 6 January 2001 and ends on 5 January 2006.

Section 46(1)(b) – The relevant period begins on 10 December 2002 and ends on 9 December 2007.

The evidence

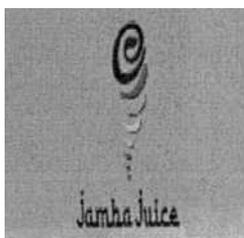
Juice's evidence filed with its counterstatement

7. The evidence is in the form of a witness statement (and accompanying exhibits) from Mr Jeffrey Parker, the trade mark attorney with conduct of these proceedings on behalf of Juice. Mr Parker explains that the facts and matters in his evidence have been provided to him by Juice's lawyers in the US.

8. Mr Parker states that the mark was used throughout 2007 for the goods and services set out in paragraph 4 above. He says that they were provided through Juice's websites at www.jamba.co.uk and www.jamba.com, both of which are accessible from the UK. He has been informed that in the period 1 January 2007 – 30 November 2007 there were 1,558 hits from visitors to the sites from the UK.

9. Mr Parker makes a number of claims as to what goods and services the evidence supports. I will bear this in mind but will not summarise the claims here. In his evidence he provides various pages from Juice's websites and explains that they were downloaded "today" (his evidence is given on 11 December 2008). He states that he has been informed that they, or others of which they are representative, have been available in the UK since January 2006 (for computer games) and since 22 October 2007 for wallpapers and screensavers. In terms of the web pages provided, these are:

- Exhibit B: A page containing screensavers. The print has www.jamba.co.uk at the bottom but jambaJuice.com:/screen_savers/ at the top. This means that the screensaver page must have been held on the .com website – the UK site is a mirror of the US site. The page carries two screensavers which may, presumably, be downloaded, both of which carry the following sign:



The page also has a number of navigational buttons on the top left hand side reading: Home, Menu & Nutrition, Community & Events, Jamba Locator, Jamba Fun, Jobs & Careers, Corporate.

- Exhibit A: A page showing two games (Jamba Maze Chase and Functional Break-Down) which a user can “play now”. The page carries the same logo as depicted above and it has the same navigational buttons. It also carries the .co.uk address at the bottom but the.com::/games/ address at the top. Further prints (presumably after clicking on the games) are shown for each game individually. The address at the bottom is .co.ukmazechase.html and .co.ukbreakdown.html. The first also states “This game is available world wide on the jambajuice.com website”.
- Exhibit A: A page for wallpapers which can, presumably, be downloaded. The logo above is again shown as are the navigational buttons. The .co.uk address is shown at the bottom and .com::/wallpaper/ at the top.
- Exhibit C: A print from ir.jambajuice.com headed “Investor Relations”. It is not the same website as those previously mentioned. It is a website giving corporate information. It explains that the Jamba Juice Company owns and franchises JAMBA JUICE stores. There is nothing to suggest that the stores operate in the UK. A logo (a slightly different one to that shown above) is shown which contains the words Jamba Juice. Also carried are the words “Created by nature, blended by Jamba”.
- Exhibit C: Further website prints of the same structure as those in Exhibits A & B, with the same navigational buttons. They are headed JAMBA in the NEWS, EVENTS (none listed are in the UK), FUNDRAISING. They all carry co.uk at the bottom but at the top is .com::/news/events/fundraising. They all carry the logo as depicted above.

10. At Exhibit D, Mr Parker provides a copy of a “Trademark/Service mark Statement of Use” made by Michael W Fox (the Vice President and Secretary of Juice) in connection with its US trade mark. The declaration relates to “computer software, namely downloadable computer game software and downloadable video game software from January 2006”. A website print forms part of the declaration which shows the Jamba Maze Chase game together with the words “This game is available world wide on the jambajuice.com website”.

Juice’s further evidence

11. This also comes from Mr Parker. The information he gives has been provided to him by Juice’s lawyers in the US or acquired through his own diligent investigation.

12. Mr Parker explains that his investigations have revealed that the trade mark was in use until July 2003 by its previous proprietors. He highlights that Juice obtained the registration (and also the jamba.co.uk domain name) from Gala Interactive (who were previously called Gala Online Ltd and who have since changed their name to Gala (2003) Limited). I will refer to this company as Gala. Gala obtained the mark and domain name from Carlton Communications Limited (“Carlton”) in 2002. Exhibit

JP2 contains an extract from encyclopedia.com consisting of an article dated November 4 2001 relating to the sale of the trade mark. The article reads:

“GALA Group, the bingo and casino operator, is set to acquire online games site Jamba.co.uk from Carlton Communications for about pound sterling 1.5m.

The purchase of Jamba will be the first move by Gala into online gaming. It is known to have looked at many possible actions before settling on Jamba.

Under the terms of the deal, which could be announced tomorrow, Gala is acquiring the website, the brand and the customer database from Carlton Interactive, the division of Carlton Communications which runs the company’s internet.”

13. Also in Exhibit JP2 there is an extract from the Annual and Transition Report of Gala Group Holding Ltd reporting on the transaction. The first highlighted extract reads:

“Gala Interactive

Gala Interactive is the interactive gaming division of our business. It was formed in November 2001 following the acquisition of the Jamba website from Carlton Interactive. We intend to exploit interactive platforms, with efforts initially focused on online gaming and digital television. We do not expect Gala Interactive to be a significant contributor to our operating results in the short to medium term but consider the division to be of potential strategic importance, affording new media opportunities through which to offer traditional and new gaming products and to further leverage the Gala brand.”

14. Further relevant references include: a) in relation to online gaming a reference is made to the Gala Games website on which “customers can also play quiz style games for free in the Jamba arcade”. It also states that such online gaming was launched during the latter part of 2002. Reference is made to the spending of 3.7 million on the acquisition of Jamba and the subsequent development of Gala Interactive.

15. Also in Exhibit JP2 there is an extract from a website called BRANDREPUBLIC. The extract is dated 6 November 2001. It provides details about the sale of the “entertainment site Jamba.co.uk”. Highlighted text includes:

“Gala is understood to be planning to add new games to the Jamba site and charging users to play games. Jamba will keep its name and it will be promoted alongside the Gala bingo brand.”

and

“Jamba was launched by Carlton Interactive in 1999. It has 750,000 registered users who play 600,000 games a month. The site is also available on NTL and ITV Digital’s interactive service ITV Active”.

16. Mr Parker states that Carlton had operated a gaming website under the Jamba trade mark since 1999 accessed via jamba.co.uk. He says that the trade mark sale also included the website, the playable games, the customer lists and the underlying technology. Mr Parker states that his investigations revealed that, during a transitional period, Gala's use of the JAMBA trade mark and the domain name continued but on a reduced level whereby it informed visitors to the site of the new name for the site, GALA GAMES.

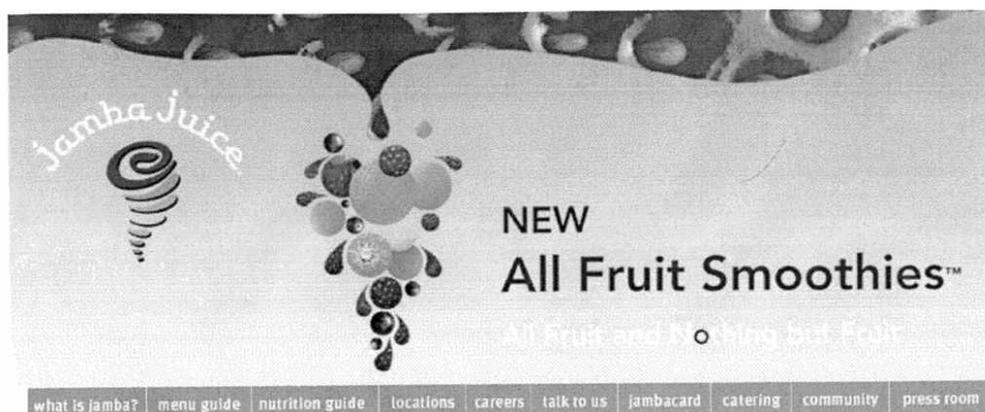
17. Mr Parker then refers to Exhibit JP3 which contains six prints from archive.org (an archive website). The pages are:

- i) An introduction to archive.org (which is also known as the waybackmachine) and how it operates.
- ii) Information from archive.org showing the number of pages that were held on jamba.co.uk on various dates. It lists 37 in 2001, 20 in 2002, 19 in 2003, 21 in 2006 and 16 in 2007.
- iii) A print said to show what the jamba.co.uk website looked like as of 1 December 2002. This is depicted below:



- iv) A print said to show the jamba.co.uk website as of 17 July 2003 – it is the same as that depicted above.

v) A print as of 10 February 2006. This is depicted below:



vi) A print as of 2 March 2000. As this is before either relevant period I do not need to reproduce it here.

18. In relation to iii) and iv), Mr Parker states that the trade mark “JAMBA by Gala Interactive” appeared clearly on the site informing customers of the new name for the site GALA GAMES. He states that it was a live interactive site where visitors could register to play games by clicking the button “REGISTER NOW TO PLAY”. He says that the use between (at least) 1 December 2002 and 17 July 2003 by the then owners in a transitional period to Gala Games shows use for various entertainment services.

Fox’s evidence

19. This is filed by Mr Raymond David Black of SJ Berwin LLP. He states that the information he gives is from his own knowledge unless otherwise stated. His evidence is filed primarily to introduce into the proceedings a report produced by enquiry agents Farncombe International. Mr Black highlights that no use in the UK was found and, indeed, that Juice operates juice stores in the US and the Bahamas. Some prints in Exhibit RDB2 are provided from Juice’s own website to support this proposition. In relation to the report, I do not need to summarise it in detail. It refers, principally, to the history of the trade mark in question (which I have already identified) together with the juice related business operated in the US and the Bahamas.

The law

20. The relevant parts of section 46 of the Act 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;

(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 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.”

21. Section 100 of the Act is also relevant, this 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.”

The leading authorities

22. The leading authorities on the principles to be applied in determining whether there has been genuine use of a trade mark are the judgments of the European Court of Justice (“ECJ”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks* [2006] F.S.R. 5 (“*La Mer*”). From these judgments, the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer*, paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer*, paragraph 34);

-the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer*, paragraph 44).

23. Although there are two relevant periods to consider (as set out in paragraph 6 above), the latter of these periods, in view of the provisions of section 46(3) of the Act, takes on greater initial significance. This is because genuine use in this period will be sufficient to save the registration even if there has been no genuine use at all in the earlier period. Therefore, I will concentrate, to begin with, on the period under section 46(1)(b), namely 10 December 2002 - 9 December 2007. There are two quite separate and distinct uses which are said to show genuine use, I will consider them in turn starting with Juice's own use.

Juice's use of the registered trade mark

24. The evidence as to Juice's use of its registered trade mark is provided in Mr Parker's first witness statement which accompanied Juice's counterstatement. The use is said to have taken place throughout 2007 which, therefore, constitutes the final year of the five year period. The evidence is summarised in paragraphs 7-10 above. I note that Mr Parker makes a statement in his first witness statement that use in relation to computer games started in January 2006 – this is inconsistent with his earlier reference to use having taken place in 2007 so this may just be a mistake, even if it is not then such a claim, absent any statistical information as to access etc., does little to advance Juice's case. In terms of submissions, Mr Parker (in writing) submitted that the case was a simple one and that his evidence demonstrates that the mark, as a matter of fact, has been used given that the websites were accessed by a significant number of users in the UK. He further submitted that this factual evidence had not been contradicted. Mr Abrahams submissions at the hearing attacked Mr Parker's evidence on a number of fronts including: i) that the use is not directed to the UK market, ii) that the use is merely promotional, iii) that there is no certainty that the use provided is "representative" of the use that may have taken place during the relevant period, iv) that the statistics as to web access from the UK are not informative, v) that there is no use at all for many of the goods and services (e.g. advertising).

25. For a registration to be saved from revocation any use made must be genuine use in the sense described in paragraph 22. Mr Abrahams, though, did not argue that the use was merely internal or that it was merely token use in order to preserve the registration. His arguments, instead, focussed more on whether the use was sufficient to have created or maintained an outlet or market for the goods/services concerned. To that extent, he also highlighted that in the context of this UK registration, such use must relate to the position in the UK market.

26. I can fully understand Mr Abrahams' concern when he questioned the reliability of Mr Parker's evidence. Mr Parker is giving evidence based on information given to him by Juice's US lawyers, information which the US lawyers presumably obtained from Juice. Mr Parker is, therefore, already a few steps away from actually knowing

what use has taken place. The prints from Juice's website which he provides in his evidence were obtained after the relevant period but, based on information given to him by the US lawyers, that they, or others of which they are representative, were in use during the relevant period. Mr Parker does not, of course, know this himself so this clearly raises a question mark over the evidence he has given. Fox (via a submission containing letter from SJ Berwin LLP) highlighted this, amongst other things, shortly after Juice filed its counterstatement. Juice filed no corroborative evidence. However, even setting aside the question of reliability, there are some fundamental issues on which I need to give my views.

27. Firstly, I should record my view that any claim that the trade mark has been used in relation to the majority of the services in classes 35, 38 and 42 is simply untenable. Juice's website provides information about Juice's products (which are juice type beverages provided in the US and the Bahamas), it provides company information of various types and, under the Fun & Games section, it provides some games/screensavers/wallpapers that a visitor to the website can play or download. However, this does not mean that Juice, via its website, is providing any form of advertising type service or other business service, nor any form of telecommunication type service nor any other computer services such as the hosting of websites. Juice may be advertising its business but it is not providing an advertising service that others may avail itself of. Juice may be providing information via a website but it is not providing a communication or telecommunication service itself, indeed, it is likely that Juice is availing itself of a telecommunication service in order for its website to be in operation. Similar things can be said of its other services, for example, its website is being hosted and maintained but it is not offering a service of this nature that others can avail themselves of.

28. There is greater potential to at least argue that computer games/screensavers/wallpapers are being provided and that such provision (at least in relation to the games) could constitute an entertainment service. However, the statistics provided to support the proposition that UK users have taken the goods or benefitted from the service tells me little. It is claimed that there were just over 1500 website "hits" from the UK in 2007. However, there is no information as to what constitutes a hit. There is no information as to the number of unique visitors from the UK. The number of hits to a website does not correlate to the traffic on the website. This is a clear and obvious ambiguity. Although I do not need to rely on it as such, noteworthy is the decision of the Advertising Standards Authority in Cool Diamonds.com Ltd case:

"We noted 'hits' referred to the number of items, such as files or images, retrieved from a website and that it was not equivalent to the number of pages viewed by a user or the number of visitors. We noted the more files or images present on a certain webpage, the more 'hits' the website received, which meant that one visitor could generate a high number of hits. We understood that 'hits' was not recognised as a measurement of website traffic by the Joint Industry Committee for Web Standards in the UK (JICWEBS); it only recognised measurements of unique users, page impressions or visits. We also noted the Institute of Direct Marketing website stated "Hit - a highly contentious term that rarely indicates the number of visitors to a website ... So

from a marketing point of view, the bottom line is that the hits are misleading - they are never synonymous with the number of site visitors or page-views".

29. The website hit problem is further compounded as no information is provided as to the number of these hits (which in itself is vague) that relate to the games, screensavers or wallpapers as opposed to some other part of the website. The reality is that there is no evidence or information at all to demonstrate that any UK visitor has played or downloaded a game/screensaver/wallpaper. This in my view is a fundamental issue which, in itself, dooms the registered proprietor's use to failure.

30. This position is worsened by two other factors. Firstly, I agree with Mr Abrahams' submission that any use made by Juice in relation to games, screensavers, wallpapers or entertainment services etc. is in the nature of promotional use. In Case C-495/07, *Silberquelle GmbH v Maselli-Strickmode GmbH*, the ECJ stated:

"20 For the reasons set out in points 48 and 56 of that Opinion, that condition is not fulfilled where promotional items are handed out as a reward for the purchase of other goods and to encourage the sale of the latter.

21 In such a situation, those items are not distributed in any way with the aim of penetrating the market for goods in the same class. In those circumstances, affixing the mark to those items does not contribute to creating an outlet for those items or to distinguishing, in the interest of the customer, those items from the goods of other undertakings.

22 In the light of the foregoing considerations, the answer to the question referred is that Articles 10(1) and 12(1) of the directive must be interpreted as meaning that, where the proprietor of a mark affixes that mark to items that it gives, free of charge, to purchasers of its goods, it does not make genuine use of that mark in respect of the class covering those items."

31. In the case before me Juice sells (in the US and the Bahamas) juice type beverages via its outlets. Its website is operated to promote and advertise that business. That it provides, at apparently no cost, games/screensavers/wallpapers to its website visitors is merely part of this promotional function. As per *Silberquelle*, such provision is about the encouragement of users to buy its juice products via its outlets and is not, in itself, an attempt to create or preserve an outlet in the market for games/screensavers/wallpapers or entertainment services. Such use is not genuine use.

32. I also agree with Mr Abrahams when he submitted that the use made was not directed at the UK market. In *Euromarket Designs Inc. v Peters & Crate & Barrel Ltd* [2000] ETMR 90, Jacob J stated:

"The right question, I think, is to ask whether a reasonable trader would regard the use concerned as 'in the course of trade in relation to goods' within the Member State concerned. Thus if a trader from state X is trying to sell *into* state Y, most people would regard that as having a sufficient link with state Y to be 'in the course of trade' there. But if the trader is merely carrying on

business in X, and an advertisement of his slips over the border into Y, no businessman would regard that fact as meaning that he was trading in Y.”

33. Also in *1-800 Flowers Inc v Phonenames Ltd* [2002] F.S.R. 12 it was stated:

137 I would wish to approach these arguments, and particularly the last of them, with caution. There is something inherently unrealistic in saying that A “uses” his mark in the United Kingdom when all that he does is to place the mark on the Internet, from a location outside the United Kingdom, and simply wait in the hope that someone from the United Kingdom will download it and thereby create use on the part of A. By contrast, I can see that it might be more easily arguable that if A places on the Internet a mark that is confusingly similar to a mark protected in another jurisdiction, he may do so at his peril that someone from that other jurisdiction may download it; though that approach conjured up in argument before us the potentially disturbing prospect that a shop in Arizona or Brazil that happens to bear the same name as a trademarked store in England or Australia will have to act with caution in answering telephone calls from those latter jurisdictions.

138 However that may be, the very idea of “use” within a certain area would seem to require some active step in that area on the part of the user that goes beyond providing facilities that enable others to bring the mark into the area. Of course, if persons in the United Kingdom seek the mark on the Internet in response to direct encouragement or advertisement by the owner of the mark, the position may be different; but in such a case the **221* advertisement or encouragement in itself is likely to suffice to establish the necessary use. Those considerations are in my view borne out by the observations in this court in Reuter v. Mulhens [1954] Ch. 50 . The envelopes on the outside of which the allegedly infringing mark was placed as advertising matter were sent by post into the United Kingdom by the defendants. It is trite law that the Post Office is the agent of the sender of a letter to carry it, and thus it was the defendants who were to be taken to have delivered the letter to the recipients and to have displayed the mark to them within this jurisdiction. No such simple analysis is available to establish use by the applicant within this jurisdiction if he confines himself to the Internet.

34. The position is that the business promoted on Juice’s website is a US business. There is no suggestion that the business is provided, or is to be provided, in the UK. Whilst the Internet is a global phenomenon and Juice’s website can be accessed by users in the UK, the nature of the website itself does not change and it will not strike a person in the UK as relating to a business provided in the UK. Whilst there is a .co.uk version of the website, this alone is not enough to change such a finding, particularly as it simply mirrors the .com website. There is no evidence that any active step has been undertaken to encourage anyone in the UK to use either of the websites.

35. Taken both individually and collectively, these factors all clearly go against Juice’s claim of genuine use. My finding is that Juice’s own use of its registered trade

mark is not sufficient to have created an outlet or market for the claimed goods and services in the UK. Genuine use has not been shown.

Use by the previous owners of the trade mark

36. The use said to have taken place by the mark's previous owners is detailed in Mr Parker's second witness statement. Mr Parker states that the mark was used until July 2003. Therefore, given the dates of the second relevant period, any claim relates only to the first 8 months of the period namely December 2002 - July 2003. Mr Parker explains that Gala obtained the trade mark registration and jamba.co.uk website from Carlton in 2002. The exact date is not clear, but reports of the acquisition start in November 2001. Any relevant use must, therefore, be the use that has been made by Gala and not by Carlton. In terms of submissions, Mr Parker (in writing) highlights the use he provided in his evidence, he considers that as the websites were clearly live within the period, and that the archive material shows the actual use, genuine use is demonstrated. Mr Abrahams, on the other hand, highlighted the lack of detail in the evidence and that Gala made no use (or none is shown) of the JAMBA trade mark on its website from which users accessing jamba.co.uk were re-directed.

37. The article from BRANDREPUBLIC states that Carlton had 750,000 registered users who play 600,000 games a month. This, though, is not evidence from the horse's mouth. It is evidence from a marketing publication – how they obtained this information is not clear. Even if it were accepted, the article is dated November 2001. The relevant period starts one year later and there is no evidence as to the number of registered users that Gala retained upon initial purchase of Carlton's business and there is no way of knowing how many were retained as of November 2002. A further problem exists in identifying how (and if) the registered mark was actually used and in relation to what goods/services. All the tribunal has to go on are prints from jamba.co.uk (those as of 1/12/2002 & 17/7/2003) which contain a link to re-direct those who have accessed it to the Gala Interactive website. Whilst the sign "Jamba by Gala Interactive" is used, this does not necessarily mean that this sign was also used on the Gala Interactive website. There is no evidence as to what signs appeared on the Gala Interactive website itself. As Mr Parker himself stated in his evidence, the use on the jamba.co.uk website informs someone of the new name for the website. Unless there is evidence showing that "Jamba by Gala Interactive" was used on the Gala Interactive website then I struggle to see how such use can equate to genuine use. This is because all it really constitutes is a reference to a previous use and it is not maintaining an outlet for goods or services.

38. The problem is compounded because no access statistics for jamba.co.uk are provided let alone for the Gala Interactive website. By December 2002 any previous customers of Carlton will have likely been informed (be it by visiting jamba.co.uk with the re-direction link or by some other method) of the new Gala Interactive website and, so, very few people (if any) may be landing on jamba.co.uk and seeing the Jamba by Gala Interactive sign. This, of course, is just guess work. The simple answer is that I do not know how many (if any) people encountered the Jamba by Gala Interactive sign on jamba.co.uk during the relevant period. This lack of objective information also applies to the Gala Interactive website (no statistics are

provided) but with the added problem that no prints from the website showing any Jamba marks have been provided.

39. Neither is there any evidence as to the goods/services provided on the Gala Interactive website and the relationship (if any) with the name Jamba. There is a reference that when the business was operated by Carlton it was an entertainment website offering online games, but what exactly was provided on Gala Interactive is not clear. The text contained in the BRANDREPUBLIC article that Jamba was to keep its name etc., is no more than that, intention/speculation. The only other evidence is from Gala's Annual and Transition report, but this provides little by way of objective detail and does not inform the tribunal as to the form and nature of any use that may have taken place.

40. In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01 [2003] ETMR 98* the General Court stated:

“47 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.”

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

“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.”

42. Beyond the concerns that I have already expressed in relation to the evidence that has been filed, there is a distinct lack of documentation and information for an objective assessment to be undertaken to support a finding of genuine use. Mr Parker may be in a difficult position given that the use claimed to have taken place is the use of a third party, however, this does not immunise Juice from the requirement to show that genuine use has taken place. On the basis of the evidence filed, I cannot find that genuine use has occurred in the period under section 46(1)(b).

43. In relation to the period under section 46(1)(b) of the Act, the application for revocation is successful. The registration will, therefore, be revoked. The only point in looking at whether the position under section 46(1)(a) is any different is to the extent that if no genuine use took place in this earlier period then the effective date of revocation would be earlier than that gained by way of its success under section 46(1)(b). I will, therefore, consider whether there are any differences that affect the position.

44. In relation to Juice's own use, Juice is in an even worse position because the use is said to have taken place throughout 2007, but this is after the expiry of the section 46(1)(a) period. The use by Gala is not worsened having regard to the earlier period, but it is not bettered in terms of the lack of objective documentation and information as to the exact nature of any use that may have taken place. The period

does, though, start in 2001 when the mark was being used by Carlton, i.e. before the sale to Gala. Whilst this could be said to place Juice in a better position, the nature of such use is so lacking in objective detail that a finding in Juice's favour is not possible. The only use is shown in Exhibit JP3 of Mr Parker's second witness statement. The sign itself is not even visible in this exhibit, the nature of any goods/services offered is not clear as much of the text is missing and the print falls before (not during) the relevant period. The bare, not from the horse's mouth, information in BRANDREPUBLIC, is not enough to overcome such paucity in the evidence. On the basis of the evidence filed, I cannot find that genuine use has taken place in the period under section 46(1)(a).

Conclusion

45. The application for revocation is successful. Juice's registration is hereby revoked under the provisions of section 46(6)(b) of the Act with effect from 6 January 2006.

Costs

46. Fox having been successful, it is entitled to a contribution towards its costs. I hereby order Jamba Juice Company to pay Fox Mobile Distribution GmbH the sum of £2100. This sum is calculated as follows:

Official fee for filing the application for revocation
£200

Preparing a statement and considering the other side's statement
£500

Considering Juice's evidence and filing its own evidence
£800

Attending the hearing
£600

47. The above sum should 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 22 day of October 2010.

**Oliver Morris
For the Registrar
The Comptroller-General**