

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 9855
BY OVATION COMMUNICATIONS PLC
FOR REVOCATION OF TRADE MARK NO 1412303
IN THE NAME OF BEEBUG LIMITED**

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**IN THE MATTER OF application No. 9855
by Ovation Communications Plc
5 for revocation of trade mark No 1412303
in the name of Beebug Limited**

DECISION

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Trade mark OVATION is registered under number 1412303 in Class 9 in respect of:

15 Computers; micro-processors; electronic apparatus and instruments, all for processing, storing, displaying or printing out data; computer software and computer programs; magnetic or optical apparatus for the storage of data; none being adapted for use as or with computer games; all included in Class 9

The registration currently stands in the name of Bedbug Limited.

20 By an application dated 4 November 1997, Ovation Communications Plc applied for this registration to be revoked under the provisions of Section 46(1) on the grounds that during a period of five years prior to the date of application for revocation, the mark has only been used in respect of desk top publishing software, and not in respect of any other goods for which it is registered. The applicants for revocation ask that the registration be revoked in respect of all
25 goods for which it is registered other than desk top publishing software, and also ask for an award of costs in their favour.

30 The registered proprietors filed a counterstatement in which they deny these grounds saying that they have used the mark in respect of a range of computer software and projection presentation systems, and have made preparations to extend this use to other products. The registered proprietors ask for an award of costs be made in their favour.

35 Both sides have filed evidence in these proceedings although neither party has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Registered proprietors' evidence

40 This consists of a Statutory Declaration dated 17 February 1998, and is made by Adrian Calcraft, a Director of Beebug Limited, a position he has held since 1988.

45 Mr Calcraft confirms that his company has used the trade mark OVATION since July 1990, and has continuously used, is using and intends to use the mark in respect of a family of products. He goes on to detail the chronology of the use his company has made, beginning with the first use (July 1990?) in connection with a word processor product for the Acorn computer market, which he says is still on sale today.

Mr Calcraft next refers to a desk top publishing product, again for the Acorn market which he says was released in 1996 saying that as a result of the number of sales his company achieved a considerable reputation in this product. He refers to exhibit AC1 which consists of a box and information sheets for a product described as OVATION PRO and which is described as “the complete desktop publishing solution for Acorn 32 bit systems”, and a page from a publication called Acorn User showing an advertisement for the OVATION PRO product. The box and information sheets do not give any indication of the date from which they originate, and the page from Acorn User is dated January 1998, which is after the date on which the application was made.

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Mr Calcraft says that in June 1997, his company released a product called OVATION Colour Supplement which is used by professional design houses in producing full colour supplements from Acorn data, and refers to exhibit AC2, which consists of a booklet headed “OVATION PRO - THE PROFESSIONAL DESKTOP PUBLISHER - COLOUR SUPPLEMENT”. This bears the company name Beebug and a date of publication shown as 1997.

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Mr Calcraft goes on to set out details of the following products which he says his company is intending to release under the OVATION trade name:

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an enhanced character recognition product to enable a scanned image of printed material to be converted to a file.

a software product which will provide E-Mail, WWW, Internet, Intranet and Bulletin Board access.

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A multi-purpose database product designed for the education market and which will have a comprehensive indexing system, will allow access to specific sets of records, enable records to be dynamically updated and allow card, spreadsheet and label type outputs

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Mr Calcraft says that there is code in existence for the first two products but no documentary evidence because his company is small and does not keep such records.

He next says that his company licenced use of the OVATION trade mark to Proxima Corporation, and that since 1992 that company has continuously been using the name in relation to projection presentation system products. He refers to exhibit AC3 which consists of a print from Proxima Corporations' Web site and promotional literature relating to a range of LCD projection panels sold under the name PROXIMA OVATION +, and which date from May - July 1996, September 1996 and August - September 1997. Each part of the exhibit contains a footnote saying that PROXIMA OVATION is a registered trade mark of Proxima Corporation and list the owners of other specified trade marks saying that “other trademarks are the property of their respective owners”. There is no mention that OVATION is the trade mark of the registered proprietors. Mr Calcraft confirms that the promotional literature is circulated worldwide and that the web page is obviously accessible worldwide.

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Mr Calcraft says that his company spends approximately £25,000 each year on advertising and promotional activities in relation to products sold under the OVATION trade mark, which includes the placing of advertisements in magazines, publishing specialist user and other

magazines, and through stands at trade shows and exhibitions. He says that through these activities the OVATION trade mark is regularly presented to a wide range of potential customers for all kinds of computer software, and refers to exhibit AC4 which consists of copies of RISC magazine (stated to be for users of Acorn RISC computers) published in the period December 1996 to October 1997, pages from the Christmas 1997 and January 1998 editions of Acorn User magazine and an undated copy of a page from Acorn Publisher Vol.4 Issue 3, all containing the same advertisement an advertisement for “OVATION PRO - THE PROFESSIONAL DESKTOP PUBLISHER and with some mentioning COLOUR SUPPLEMENT”. The exhibit also contains a copy of the booklet earlier referred to in exhibit AC2.

Mr Calcraft next refers to exhibit AC5, which consists of articles about his company’s OVATION PRO product that appeared in undated editions of Acorn Publisher, the February, March and September 1996 editions of Acorn User, and the September - November editions of Educational Computing & Technology. The exhibit also contains an article from a German magazine RiscPC.. He says that his company has won awards for its OVATION products, and refers to exhibit AC6 which contains copies of certificates from the 1996 and 1997 Acornuser Award for best DTP software and best DTP product categories, and the reader award category for best product.

Mr Calcraft says that although OVATION started life as one a one product brand, it is now more than that. He refers to advice he has received from his trade mark attorney relating to the possible consequences of not having used the mark in respect of all of the goods for which the mark has not been used. He says that his company has used, or made preparations to use the mark in respect of a range of computer software for various applications and gives his conclusion that confusion would result should another company use the OVATION mark for a computer software product. He concludes by confirming that OVATION is the “umbrella” brand for computer software directed at schools, homes, offices and computer enthusiasts.

Applicants’ evidence

This consists of a Statutory Declaration dated 1 June 1998 by David Brian Lutkin, a registered trade mark agent and principal of the firm of David Lutkin & Associates, the applicants’ trade mark agents in these proceedings. Mr Lutkin says that the information and statements contained within the Declaration have been drawn from his own records, other sources available to him or are within his own knowledge.

Mr Lutkin says that in August 1997 he approached the registered proprietors’ attorneys for consent to in relation to his clients application to register OVATION as a trade mark. He outlines the subsequent events, and in particular, the request for a payment of £20,000 plus costs, and refers to exhibit DLB1 which contains copies of the correspondence. This shows that the registered proprietors were made aware of the nature of the applicants’ business and were willing to licence use of the OVATION trade mark to the applicants for the sum of £20,000 plus costs.

Mr Lutkin next refers to his investigations via PC magazines to find out what use the registered proprietors had made of the OVATION mark, saying that he was unable to find any examples. He refers to an advertisement by the registered proprietors shown as exhibit DBL2 which promotes OVATION PRO describing it the OVATION DTP. The advertisement is undated although refers to the product as “voted the best DTP software in the Acorn User 1996 awards”.

Mr Lutkin continues by referring to the counterstatement, statement of case and Statutory Declaration filed in support of the registration, noting the extent of the use shown, and that neither the licenced use claimed in respect of projection presentation systems nor the preparations to extend the product range is substantiated by the evidence. He goes next to Mr Calcrafts' claim to
5 having been a Director of his company since approximately 1988 and refers to exhibit DLB3 which is a copy of a form to notify Companies House of a Change of Directors, and which shows Mr Calcraft as having taken up this position on 28 May 1986, which Mr Lutkin concludes casts doubt on the reliability of Mr Calcrafts' memory.

10 Mr Lutkin next goes to Mr Calcrafts' claim to have used the OVATION trade mark since 1990 in respect of a word processor product, saying that no evidence of past or present use has been provided. He says that he made enquiries at the website of Silicon Village, a retailer of products including the registered proprietors, and refers to exhibit DLB4 which consists of prints taken from the Silicon Village Computing web site on 28 May 1998. The prints set out details of the
15 Beebug software titles available directly from that company, and, inter alia, includes an entry for OVATION but no further details.

Mr Lutkin refers to his search of the registered proprietors' web site, the results of which are shown as exhibit DLB5 to DLB10, and which consist of prints taken on 28 May 1998. Exhibit
20 DLB5 contains two entries for OVATION; OVATION PRO referring to this product as their most recent "professional DTP software" and OVATION which is described as "our original DTP software". The exhibit also lists software available under other names, including HEARSAYII which is described as "communications software" which appears to be the same area of interest as the applicants. Exhibits DLB6 to DLB9 also list a range of products available under
25 various names, but only exhibit DLB6 mentions OVATION/OVATION PRO although gives no details of their application. Exhibit DLB10 is a print from the "about us" section of the website which says the company stocks a wide range of Acorn computers and a comprehensive supply of software, peripherals and related equipment and that they have now expanded their range to include PC computer systems and associated software. The exhibit also refers to the company as
30 providing a range of computer related services.

Mr Lutkin continues to recount his investigations which includes a search of the web site of Xemplair, an organisation with which the registered proprietors are involved. He refers to the results which are shown at exhibit DBL11 and which consists of prints taken on 28 May 1998
35 from various art/graphics, database, DTP and word processing software departments, noting that OVATION is only listed as a DTP product.

Mr Lutkin next refers to the Declaration made by Mr Calcraft in support of the registration. He notes that Mr Calcraft has omitted to mention that one of the software packages was a supplement
40 to the OVATION PRO DTP software, and that as Mr Calcraft has not confirmed that he has seen the application for revocation he is not competent to make the Declaration. He also comments that as exhibits AC1 to AC5 of Mr Calcrafts' Declaration are concerned with DTP software they are irrelevant and are indicative of Mr Calcrafts' ignorance of the facts. Mr Lutkin again challenges Mr Calcrafts' statement concerning the licenced use by Proxima Corporation, and that
45 OVATION is an "umbrella" brand for the registered proprietors saying that the evidence only shows use in respect of two DTP products. He also says that Mr Calcrafts' opinion that confusion would arise should another company use OVATION is in conflict with his statement that the

proprietors intend to launch communications software, as this is the same area for which they were prepared to grant the applicants a licence.

5 Mr Lutkin again challenges the claims made by Mr Calcraft in his Declaration, in particular, in respect of the range of products on which the OVATION mark has been or is intended to be used and the reasons given for the lack of documentary evidence. Mr Lutkin says that the evidence shows OVATION to be no more than a DTP product, and that the claims to use in connection with computer software directed at schools, homes, offices and computer enthusiasts is not supported by the evidence.

10 That concludes my review of the evidence insofar as it is relevant to these proceedings..

Decision

15 With all of the evidence in mind I now turn to consider the grounds on which a revocation may be based, and which are found in Section 46 of the Act, which reads as follows:

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

20 (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;

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

30 (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;

35 (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 for solely for export purposes.

45 (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.

5 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)

10 (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)

15 Although the applicants have not stated under which part of section 46 they object, the wording used suggests that the matter falls to be considered under subsection (b) of Section 46.

20 The applicants for revocation accept that the registered proprietors have used the trade mark OVATION in respect of desk top publishing software and are seeking to have the specification of goods limited accordingly. The evidence filed shows use of the mark OVATION in relation to these goods, albeit mostly with the letter O set apart on a darker background or in conjunction with the abbreviation PRO, neither of which in my view alters the distinctive character of the mark in the form in which it was registered. Consequently, I do not need to give any further
25 consideration to the position in respect of desk top publishing software.

In his Declaration, Mr Calcraft says that in the five years prior to the application for revocation being filed the registered proprietors have also used the trade mark in connection with a word processor product for the computer market and a software product to produce full colour
30 supplements. He goes on to say that later in 1998 the proprietors proposed to release further products under the OVATION mark, namely, software for use in character recognition, and to provide E-Mail and access to the WWW, Internet, Intranet and bulletin board, and in 1999, to release a multi-purpose database product for the education market.

35 The OVATION PRO product is described by the registered proprietors in their advertisements as combining “..fast, responsive word processing with state-of-the-art page layout features to deliver the ultimate desktop publishing system”. In a review published in Acorn User magazine in September 1996 (exhibit AC5) the product was described as “...not just a word processor....but
40 a dedicated page design package”. Both show that OVATION PRO has been used in connection with software for word processing, but only as part of a desk top publishing systems. It may well be that word processing software is an integral part of desk top publishing systems and would be covered by the description desk top publishing software, although I have no evidence of this and do not consider myself to be sufficiently knowledgeable that is the case. Avoiding the risk of denying the proprietors the protection they deserve is unarguably worth the risk of being
45 tautologous, and I find that the proprietors have shown use on word processing software for use in desk top publishing.

The exhibits show that the Colour Supplement product was available at least as early as May 1997. It is advertised alongside the OVATION PRO desk top publisher and is described “This fully integrated extension allows professional designers to produce output for high quality commercial litho printing.” which I take to mean that it is an “addition” although I cannot say whether it would be covered by the description desk top publishing software. Taking the same view on the risks, I find that the registered proprietor has established use in respect of software for use with desk top publishing software in producing colour supplements for litho printing.

Turning next to the software product for use in character recognition, the software to provide E-Mail and access to the WWW, Internet, Intranet and bulletin board, both of which Mr Calcraft says are going to be released later in 1998, and the multi-purpose database product which he says the proprietors plan to release in 1999. There is nothing in the evidence to show that the OVATION mark has actually been used in connection with these goods, or that there has been any development or preparation for such use. Mr Calcraft says that although codes were in existence for the first two products there is no documentary evidence because his company is small and does not keep such records. Nothing is said about the development or preparation for sale of the multi-purpose database product other than the proprietor “plans” to release this in 1999.

From Mr Calcrafts’ comments it is clear that the mark has not been used in relation to these products prior to the application being filed. The proprietor has not claimed the defence of there being proper reasons for non-use and therefore the question is whether there is evidence of any preparations for use. There are references in some exhibits to OVATION PRO being “the first release of a package in vigorous development”, but no specific details are given. It is my understanding that the creation of a new software product can be an expensive undertaking with a long lead in time before a product is ready for release. Information technology is by its nature a very competitive and fast moving market and I would have thought that a certain amount of market research and planning would have taken place before resources were committed to development. While I do not doubt Mr Calcrafts’ word when he says that work has been done, I would have expected there to be some form of record or audit trail which could have been filed to show that something had been done. In the absence of any such corroborative material, I find that I cannot deem there to have been use in respect of these products.

The registered proprietors say that the mark has also been used in relation to projection presentation systems by the Proxima Corporation, who have been using the mark under licence since 1992. Exhibit AC3 contains promotional materials showing that the mark PROXIMA OVATION has been used from at least May 1996 by the Proxima Corporation in connection with a range of computer linked LCD projection panels for use with overhead projectors. The materials contain a footnote saying that PROXIMA OVATION is a registered trade mark of the Proxima Corporation, gives details of the owners of other specified trade marks mentioned in the materials and says that other, unspecified trade marks are the property of their respective owners. There is no mention of the registered proprietors or any indication that they are the proprietors of the OVATION trade mark or that Proxima use OVATION under licence, nor have any details of the licence arrangements been supplied. Consequently, I am not able to satisfy myself that there has been any use of the mark in relation to projection presentation systems, either by the proprietors themselves, or with their consent.

It is clear from Section 100 of the Act that the onus for establishing the use made of the mark rests with the registered proprietors. I have found the evidence to only show use of the mark in respect of some of the goods for which it is registered, and under the provisions of Section 46(5) the specification must be reduced to relate to those goods only. The applicants seek to have the specification limited to desk top publishing software, although as I have found the evidence to show use in relation to a number of other goods I do not consider that such a limitation would be justified, although for the reasons given earlier this may well be the overall effect of my decision. I therefore order that the specification of registration number 1412303 be amended to read as follows:

Desk top publishing software; word processing software for use in desk top publishing; software for use with desk top publishing systems in producing colour supplements for litho printing.

In accordance with Section 46(6) the revocation of this registration in respect of the terms set out above shall date from 4 November 1997, the date of the application for revocation. The applicants having been successful, I order the registered proprietors to pay to the applicants for revocation the sum of £435 as a contribution towards their costs.

Dated this 2 Day of November 1999

M Foley
For the registrar
The Comptroller-General