O/472/11

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NOS. 2279047A AND 2279047B

FOR THE TRADE MARKS THE LIGHT AND A SERIES OF TWO MARKS THE LIGHT AND DEVICE IN THE NAME OF AEGON UK PROPERTY FUND LIMITED AND THE CONSOLIDATED APPLICATIONS FOR REVOCATION THERETO UNDER NO. 83599 AND 83600 BY THE LIGHT APARTHOTEL LLP

DECISION

Introduction

1. This is an appeal by Aegon UK Property Fund Limited ("Aegon") from the Decision of Mr Mark Bryant, Hearing Officer for the Registrar dated 27 April 2011 whereby he substantially upheld applications by The Light Aparthotel LLP ("TLA") to revoke two marks, 2279047A (THE LIGHT) and 2279047B (The words "The Light" in a logo), for non-use. The marks cover services in Classes 19, 35, 36, 37, 39, 41 and 42.

2. The applications for revocation are directed only at the following services:

> Provision of food and drink; restaurant, cafeteria and bar services; provision of hotel and other temporary accommodation

3. Completion of the registration procedures for both registrations was said by the Hearing Officer to have taken place on 21 March 2003 although there is a dispute about the correctness of the dates (see below). TLA sought revocation of the registrations, in respect of the above identified services, under s.46(1)(a) and (b) of the Trade Marks Act 1994 ("the Act") on the grounds that the marks had not been put to genuine use in the United Kingdom by the proprietor or with its consent. Aegon filed counterstatements, claiming that it has maintained a commercial interest in the marks and that they had been in continuous use for the services in question.

Background

4. Aegon operates an entertainment and shopping centre under the name "The Light" in the centre of Leeds. It leases shop and other premises to a range of undertakings, including restaurants, bars and a hotel. The centre is (and during the relevant periods was) prominently branded "The Light" in numerous ways identified in the evidence including above the entrances, on flags and other lighted signage, on the interior and exterior. Some of the signage also bears marks of the well-known undertakings who have taken space in the centre and who trade beneath them.

5. Its promotional material describes The Light as "Leeds' premier retail and leisure destination" and says that it combines "fantastic shopping with a wide variety of cafes restaurants, bars, a 13 screen multiplex cinema, a state of the art health club and a four star Radisson SAS hotel".

6. The Radisson SAS hotel (which prominently bears the Radisson SAS branding) is situated at one corner of The Light. Some way above its entrance the words "The Light" are affixed to the building. I will return to the significance of that below. The lease for that hotel entered into between the undertakings operating the Radisson hotel and a company related to Aegon describes the demised hotel premises as part of the "Centre", defined in the lease as "the land and buildings known as The Light, Leeds". The lease requires the Radisson SAS hotel to be operated in accordance with so-called "Benchmarking Requirements" which (in essence) include maintaining a level of performance consistent with those to be expected at four star hotels. If that is not done, the lease may be forfeit. An element of the rent payable depends on the turnover in hotel services and food and drink.

7. There are several restaurants and bars which have leased space in The Light, some well-known national brands, others more local. These include Starbucks, Browns, Café Rouge and Nandos. There is no dispute that at least some such undertakings have been offering food and drink from premises located within The Light during the relevant period. Each is prominently branded with its own mark. The leases with these restaurants

and bars also provide that an element of the rent is related to the turnover of those businesses.

8. Aegon, through its consultants, NB Real Estate Limited whose general manager,Mr Brian Oakley, has provided a statement, undertakes promotion of The Light as a destination, including running special events such as “Fun with Sushi” and “Taste of Leeds”. These are done as a combined effort by Aegon and the individual tenants who pay for this through their service charge. The sums devoted to these activities ran into hundreds of thousand of pounds annually during the periods in question, although they include the cost of operation of the centre’s web site and loyalty club (“the Elite” club).

Aegon’s case of use in outline

9. Aegon claims that it has been using its marks in respect of the services in issue during the relevant periods. Its case in a nutshell is that the fact that there are undertakings supplying hotel services and food/drink cafeteria and bar services at The Light coupled with the signage and a few other matters to which I will come below entitles it to maintain registrations for its mark The Light in respect of all the services which are provided by those other undertakings.

The Hearing Officer’s Decision

10. The Hearing Officer rejected Aegon’s argument. He held that the evidence filed by the proprietor, upon whom the burden of showing use lies, failed to demonstrate that the marks had been put to genuine use by Aegon or with its consent during either of the relevant five year periods in respect of all but one description of the contested services. The Hearing Officer comprehensively summarized the evidence in paragraphs [7] to [30] of the Decision and held that the marks had been used to denote the location of the services. However, he allowed Aegon to maintain a narrower registration for “Provision of food and drink in connection with the provision of conference and meeting room hire.” There is no cross-appeal from that Decision by the applicant.

Grounds of Appeal

11. Aegon alleges that the Decision contains four main errors.

(i) An erroneous assessment of the uncontested evidence concerning use.

(ii) An incorrect approach to determining whether use of the mark was "in relation to" or "in connection with" the services in question, a point which is alleged by Aegon to raise a matter of interpretation of EU law for which a reference to the Court of Justice may be required.

(iii) An erroneous construction of the term "temporary accommodation" in the specification.

(iv) An erroneous approach to determination of the effective date of revocation.

12. Although the first ground is said to consist of an erroneous assessment of the evidence, it was made clear at the hearing that Aegon was in substance challenging the Hearing Officer's approach to the determination more as a matter of law. Aegon contended that the uncontested evidence was that the marks were not used merely to identify shopping centre services, but were used in such a way as to establish the necessary link between the marks and the services for which they were registered. That raises the question as to what, as a matter of law, is required for such use to be shown. It is therefore convenient to treat the first two grounds of appeal together.

I. The approach to use "in relation to" goods or services

Section 46

13. Section 46(1)(a) and (b) of the Act provide:

> (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.

14. Section 46(1) must be interpreted in accordance with the equivalent provision in the Council Directive 2008/95/EC ("the Directive"). This provides in Article 12(1):

> **Article 12**
> **Grounds for revocation**
> 1. A trade mark shall be liable to revocation if, within a continuous period of five years, it has not been put to genuine use in the Member State in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.

15. Accordingly, in order to defeat an attack based on section 46(1), in so far as a proprietor relies on its own use and assuming no question of "proper reasons for non-use" arises, it must prove two things in respect of the relevant period.

(i) Genuine use

16. First, the proprietor must prove that its use of the mark was genuine and not merely token use, consistent with the essential function of a trade mark, having regard to all the relevant facts and circumstances. The requirements of sufficiency of use and examples of what would and would not count are set out in a number of cases, of which the most important are *Ansul* Case C-40/01 [2003] RPC 40; *Silberquelle* Case C-295/07 [2009] EMTR 28 and *La Mer TM* [2006] FSR 5). No issue on this aspect of use arises in this case because it is not in dispute that Aegon's use was sufficient and genuine.

(ii) Use "in relation to" goods or services

17. Second, unless is it obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of "use in relation to" goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

> "…even where the sign is not affixed, there is use "in relation to goods or services" within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party."

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in Article 43 of the Community Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/09[1], the General Court said:

> 23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being 'in relation to goods or services' (*Céline*, paragraph 21).
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> 24 Conversely, there is use 'in relation to goods' where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.

[1] See also *Alder Capital*, Case T-209/09, 13 April 2011 at [45]-[46].

21. The approach which requires the tribunal to consider whether there is a link, having regard to the essential function of a trade mark, is consistent with English authorities prior to *Céline*.

22. In *Premier Brands UK Ltd. v Typhoon Europe Ltd & Anor* [2000] EWHC 1557 (Ch) [2000] FSR 767, Neuberger J (as he then was) said:

> In my judgment, when considering whether the mark has been used "in relation to" goods within the meaning of Section 46(1), it is right to go back to the nature and purpose of a trade mark, and in this connection the observations of the ECJ in *Canon* are of assistance, as indeed, is the guidance given by the Court of Appeal in *Bach Flower Remedies* in the passages which I quoted. Although Mr Arnold took issue with this, contending that what mattered was not how members of the public perceive the usage, but "whether the mark is in fact acting as an indication of quality control", it appears to me that the difference between the two approaches is more apparent than real. In a sense, the two ways of looking at the matter can be conflated: does the use of the TY.PHOO mark on the Goods convey to members of the public that the source of the well known TY.PHOO mark or tea is responsible for, and in some way guarantees, the quality of the Goods?

23. In *Euromarket Designs Incorporated v. Peters & Anor* [2000] EWHC 453 (Ch), [2001] FSR 20 Jacob J, as he then was, drew attention to the range of factors relevant to whether there was use in relation to given goods or services, including public perception of what the marks denoted. He said:

> [57] In this connection it should be borne in mind that the Directive does not include an all-embracing definition of "use", still less of "use in relation to goods." There is a list of what may inter alia be specified as infringement (Art.5(3), corresponding to s.10(4)) and a different list of what may, inter alia, constitute use of a trade mark for the purpose of defeating a non-use attack (Art.10(2), equivalent to s.46(2)). 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 that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign "in relation to" the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel US shops to the UK in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging. And all the more so if, as I expect, the actual goods bear their own

trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.

24. Both these cases demonstrate that in considering whether use is in relation to given goods or services, the tribunal may take into account a number of factors, including whether the goods were in fact obtained from the proprietor, the presence or absence of other branding on the goods, how the goods were sold and so on. An approach which entitles the tribunal to make an overall assessment of this aspect of use is similar to that of *Ansul*, which requires regard to all the facts and circumstances in evaluating whether use was genuine.

25. The effect of these authorities, both at EU and at national level, is therefore that this aspect of the non-use provisions requires the tribunal to consider whether, having regard to all the facts and circumstances, the mark been used to identify to the average consumer the proprietor as the origin of, including, having responsibility for, the particular goods or services in question.

"in relation to"/"in connection with"/"for"

26. Aegon contends the term "in connection with" in Article 12 of the Directive means something wider than "in relation to" in the Act. It contends that a looser relationship between mark and goods/services suffices for the non-use provision. Counsel for Aegon drew attention to the fact that Article 5 of the Directive, which concerns infringement, uses the term "in relation to" and says that the different wording in Article 12, concerning non-use, must mean something different.

27. I am unable to accept Aegon's argument for the following reasons.

28. First, there is no real difference in meaning as a matter of language between "in relation to" and "in connection with" in this context. In either case, that language is intended to encompass more than the mark appearing physically on the goods.

29. Second, in *Compagnie Gervais Danone v. Glanbia Foods Society Ltd* [2010] IESC 36 (Macken J giving the judgment of the Supreme Court of Ireland) it was noted that other language versions of the Directive used a phrase more naturally translated as "*for* the goods and services" instead of "in connection with". This is similar to the position with Article 5 of the Directive where different language versions also use the equivalent of "for" instead of the English version's "in relation to" in the infringement provisions: see discussion in *RxWorks v. Hunter* [2007] EWHC 3061. The Irish Supreme Court said:

> "…no real distinction in law can be drawn between the requirements for use as expressed by the phrase *"in connection with the goods"* or indeed *"in relation to the goods"* on the one hand and the phrases *"for the goods"* on the other hand…"

30. The court therefore treated these phrases as identical. I share that view.

31. Moreover, the concept of use in Article 12 of the Directive is intended to be the same in all Member States. In *Ansul* at [29], the Court of Justice said:

> It is evident from all the provisions cited in the previous paragraph that it was the Community legislature's intention that the maintenance of rights in a trade mark be subject to the same condition regarding genuine use in all the Member States, so that the level of protection trade marks enjoy does not vary according to the legal system concerned (see, to that effect, Joined Cases C-414/99 to C-416/99 *Zino Davidoff and Levi Strauss* [2001] ECR I-8691, paragraphs 41 and 42).

32. The legislature cannot have intended the difference in language versions to reflect a difference in substance.

33. Third, Counsel for Aegon relied on [40]-[43] of *Ansul* in support of the argument that "in connection with" denoted a looser link. I do not accept that this is what the court was saying. In *Ansul*, the Court of Justice was considering whether there was genuine use of a mark for certain goods where there had been use by the proprietor in the aftermarket including for spare parts for those goods. The court held:

> 40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.
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> 41. That applies, *inter alia*, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paragraphs 35 to 39 of this judgment. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.
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> 42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.

34. At [43] of *Ansul*, the court went on to say that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered. In *Ansul*, the proprietor had provided the relevant goods under the mark. It was continuing to prove spare parts and servicing for those very goods using the mark. By use of the trade mark the proprietor was identifying the goods in question as its own. The judgment of the Court of Justice in *Ansul* cannot be taken as suggesting that the link or connection between the goods/services provided and the proprietor for the purpose of the use requirements can be so diffuse as to treat use as having taken place when the proprietor was not and never had been the origin of or responsible for the goods or services in question.

35. For these reasons, I am not able to accept Aegon's argument that "in connection with" differs in substance from "in relation to".

The Hearing Officer's findings

36. After a comprehensive review of the evidence, the Hearing Officer made the following findings:

(i) The mark THE LIGHT had not been used in connection with hotel restaurant or bar services (Decision para.[41]);

(ii) The hotel, bar and restaurant services provided within the centre are identified by the traders' own marks such as Radisson SAS, Nandos Maxi's etc. It is those marks that identify the origin of the respective services and not Aegon's mark (Decision para. [42]).

(iii) The location was provided by THE LIGHT but it was clear that (for example) the services are provided by Brio Pizza (Decision para. [43]).

(iv) The press articles illustrate clearly that the writers clearly recognized a distinction between the centre itself, serving as the location of the hotel services and that the consumer's perception would be no different (Decision para. [44]).

(v) The mark THE LIGHT was not performing its essential function namely to guarantee the identity of the services at issue (Decision para. [45]).

(vi) THE LIGHT provides food and drink only to delegates who are using its rented meeting rooms (Decision para. [53]).

37. Aegon contends, in effect, that these conclusions drawn from the evidence were wrong. In evaluating its argument, I bear in mind that this appeal is a review of the Hearing Officer's Decision. Robert Walker LJ (as he then was) said of such appeals:

> "…an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (*Reef Trade Mark* [2003] RPC 5 at [28]; see also *BUD Trade Mark* [2003] RPC 25).

Aegon's criticisms of the Hearing Officer's evaluation of the evidence

(i) Enquiries to The Light

38. It is said, first, that the Hearing Officer, failed properly to take account of the evidence of Ms Sarah Masoom. The Hearing Officer summarized the effect of this evidence in paragraphs [24] to [28] of the Decision. Ms Masoom states that, since October 2008, part of her role involves operating the centre's switchboard. She provides comments on the telephone enquiries she receives concerning the hotel and food and drink retailers located in the centre. She receives a number of calls a week from callers who believe they are calling the Radisson Hotel situated within the centre. She suggests that when speaking to directory enquiries they ask for THE LIGHT rather than "The Radisson". Ms Masoom also receives a couple of calls a day with general enquiries about the restaurants and bars within the centre and on occasions, callers have attempted to make table reservations with her.

39. Aegon contends that the Hearing Officer should have held that this evidence established the existence of a relevant link.

40. I am unable to accept that submission. The fact that some members of the public phone The Light's customer service switchboard with enquiries about the hotel and other services cannot, without more, establish that the mark was used in relation to those services. Mr Masoon is careful to point out that she did not enquire why the callers were telephoning The Light rather than the hotel. Aegon say that members of the general public must have made a link between the marks and those services. That does not follow. The communications are consistent with members of the public making no relevant link between the marks and the services but that they considered that the services were being provided by others at a place referred to as "The Light". Customers are likely to call because they believe that the centre's switchboard would be able to give them the relevant information – or would at least know to whom the customer should be put through. None of the communications establish that members of the public see The Light as denoting the (or even *a*) provider of hotel, bar and restaurant services any more than someone calling a helpline at, say, Victoria station to discover when the newsagent there

opens in the morning would consider that those who operate the station or its helpline are providers of newsagents services.

(ii) Signage

41. Aegon contends that the manner in which the signage bearing The Light appears, including the prominent use of "The Light" on the building in which the hotel is situated, amounts to "co-branding" with those providing the services. However, all of the signage depicted in evidence serves to identify The Light as the shopping and leisure centre on the one hand and the individual undertakings within it as providing the services in question on the other. That is reinforced by Aegon's evidence showing how the The Light is identified as the shopping and entertainment centre. That evidence says that a person entering the centre could hardly miss the fact that he or she was entering single premises branded as The Light. They could therefore hardly miss the fact that this was a shopping centre which would normally be expected to provide a venue for individual undertakings to provide their services. The Hearing Officer was therefore right to reject Aegon's argument based on signage.

(iii) Promotion by Aegon and newspaper articles about The Light

42. Aegon contends that the Hearing Officer drew the wrong conclusion from the way in which The Light was promoted by Aegon and how it was described in the press. I do not think he did. Each of the uses distinguishes between The Light as the venue and the provider of the services in question (e.g. Radisson SAS, Starbucks). One of the articles says "I've stayed at The Light, the address of the brilliantly positioned Radisson SAS hotel in Leeds", others refers to the hotel or restaurants being "in" The Light. That is consistent with the way in which Aegon describes these undertakings on its web-site as being located "within" The Light. So far from showing there was a relevant link with the services provided by the undertakings as a result of use of the marks, it shows the opposite.

(iv) The forfeiture/revenue sharing provisions in leases and the "co-branding" argument

43. Aegon relies on the provisions in the leases obliging the hotel to continue to operate at the standard of a four star hotel or risk forfeiture and the turnover-related rent as relevant to whether there is a link. It is said that these create and reinforce the link and that the Hearing Officer was wrong to disregard them. I cannot accept this argument either.

44. First, the fact that an operator of a shopping centre includes quality control provisions in leases cannot turn use which is not otherwise use in relation to services into such use. Nor can the fact that the income received depends on the financial performance of the services provided by the tenants. If anything, this material serves to reinforce the point that the operator of the shopping centre is not responsible for the quality of the goods or services, even though it may have recourse to forfeiture is a tenant consistently falls short of a given standard. It is not uncommon for landlords to provide that tenants must conform to certain standards of behavior, if for no other reason than to protect the interests of other tenants of neighbouring properties. That does not mean that the landlord is using a sign identifying the property in respect of the services or activities undertaken by its tenants.

45. Aegon contends that this situation is equivalent to a "co-branding" exercise. This is not justified. Co-branding would involve a representation that Aegon was in a meaningful sense responsible for the services offered by the undertakings which provided them and was entitled to share in the goodwill thereby generated. There is nothing in the evidence to indicate that the providers of the services would have been content to see Aegon take credit for services which they were providing which would be the effect if Aegon was using the mark The Light for those services. The argument that Aegon would suffer a diminution in its reputation if the services provided by its tenants were below par does not in my view reflect reality, since the average consumer would not attribute the provision of services to Aegon. The Hearing Officer was therefore right to reject this argument.

(v) Food, drink and the limitation on the specification

46. A slightly different point is taken with respect to provision of food and drink.

47. Food and drink promotions and events took place at the light The Light organised by or on behalf of Aegon. These involved third party providers being invited to The Light to undertake food and drink displays, in one case as part of a city-wide festival. Two examples are specifically referred to in Aegon's skeleton argument: "Fun with Sushi at the Light" and the launch of a fat-busting food "at" The Light. I emphasise "at" to highlight that these uses are no different to the alleged use in relation to the food and drink provided by the permanent restaurant tenants. The Light identifies the location where the food and drink is to be provided by others. The Hearing Officer was therefore right to reject the argument based on this use.

48. However, the Hearing Officer found that there had been use in relation to food and drink provided to delegates who were using The Light's rented meeting rooms. He therefore considered the appropriate scope of a specification of services to reflect this specific and limited use. He had regard to the applicable principles derived from *Thomson Holidays Ltd. V. Norwegian Cruise Lines Ltd.* [2003] RPC 32 ("the 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 its use"); *Animal TM* [2004] FSR 19 ("forming a value judgment as to the appropriate specification having regard to the use which has been made") and *ALADIN* Case T-126/03 ("goods or services which are sufficiently distinct to constitute coherent categories or sub-categories"). He concluded that an appropriate specification, having regard to the proven use was "Provision of food and drink in connection with the provision of conference room and meeting room hire". This was a justified conclusion in the light of the evidence.

Use by third party with consent

49. Finally, for completeness, in this case, it is not necessary to consider the situation where a proprietor has licensed a third party to use its mark for the goods or services of

the third party and relies on the third party's use with consent. Although there were some shades of this wider argument at the hearing, Aegon is here, in substance, relying on its own use of the mark The Light, not use by its tenants (e.g., Starbucks) of the mark The Light. It would be very surprising were an undertaking such as Starbucks to consider that *it* was using the mark The Light to denote its café services: not even Aegon describes it in these terms choosing instead to say in its publicity material that Starbucks is "within" The Light (see above).

50. I therefore reject Aegon's criticisms of the Hearing Officer's findings. In my judgment, he reached the right conclusion for the right reasons.

Conclusion on the main ground of appeal

51. Although the Hearing Officer did not refer to *Céline* or expressly consider the issue from the perspective of identifying a link, he applied the statutory wording "in relation to" directly. In so doing, he adopted the right approach. In evaluating the evidence, the Hearing Officer made no error of principle which would justify interference on this appeal. On the basis of his findings, it is, in my judgment, clear that there was no use in relation to the majority of the services in issue within the meaning of s.46.

Reference

52. The possibility of a reference to the Court of Justice was floated in the skeleton argument by Aegon but was not pressed with vigour at the hearing. TLA did not suggest that a reference was necessary. There is, in my judgment, no need for a reference to the Court of Justice notwithstanding the absence of direct Court of Justice authority on the meaning of "in connection with" in Article 12 of the Directive. First, there is no real doubt as to whether "in connection with" and "in relation to" involve, in substance, the same concept. Cases before the General Court assume that *Céline* provides the correct test for the equivalent provision in the Community Trade Mark Regulation. In *Land Securities TM* [2008] EWHC 1744 (Pat), [2009] RPC 5, [2008] ETMR 67, at [53], Floyd J said that the guidance given by existing Court of Justice case law was general enough to make it unnecessary to decide the case without the delay and expense of a reference. That

is the position here. Second, this is, in my judgment, a case in which the issue relates to the application of relevant principles to the facts of the case rather than any real debate over what those principles are. A reference is not appropriate in those circumstances: see, for example, *Jivraj v. Hashwani* [2011] UKSC 40 at [73].

II. Construction of "hotel and other temporary accommodation services"

53. Aegon's next ground of appeal is that the Hearing Officer wrongly construed the meaning of the term "temporary accomodation" in the specification. Aegon contends that "temporary accommodation" can mean accommodation other than sleeping accommodation and can include, for example, the provision of meeting and conference rooms. Aegon points to (internet) searches, a search of the IPO web site, a case from the Irish Patent Office and a case relating to enforcement notices relating to planning controls in support of the argument. Wide-ranging as these researches are, they do not grapple with the fact that phrase used in the specification is not "temporary accommodation" *tout court*. The full specification in this respect is "hotel and other temporary accommodation services". The words "temporary accommodation" must be construed as part of the phrase as a whole. In my judgment, the specification contemplates hotels and accommodation like hotels such as motels, temporary serviced apartments, guest houses and the like – places where people stay for a short period. This does not encompass meeting rooms and the like, even though such places may be temporarily occupied. I therefore reject this ground of appeal.

III. Date from which revocation should take effect

54. The final ground of appeal is that the Hearing Officer was wrong to order revocation from an earlier date than that specifically requested in box 7 of forms TM26(N), namely 10 October 2009.

55. Section 46(6) of the Act provides that revocation may take effect from an earlier date than the date of application, in the following terms:

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

56. The statute does not itself require the applicant specifically to request any given date from which it wishes revocation to take effect. Nonetheless, the prescribed form requires that to be done so that the proprietor is given adequate notice of the period for which it has to prove use. Only one date was identified namely the date at the end of the five year period relied on for the purpose of s.46(1)(b).

57. Sub-section 46(1)(a) provides a single defined period for proof of non-use, namely the 5 year period from completion of the registration procedure. In this case, that period is said by Aegon to have come to an end on 15 February 2008 (i.e. somewhat earlier than the Hearing Officer held). No date was identified in TLA's forms TM26 as the relevant date for the purpose of s.46(1)(a).

58. The question is whether, in the absence of identification of any other date for the purpose of s. 46(1)(a), it was open to the Registrar to order revocation from an earlier date than that specifically mentioned in forms TM26(N).

59. In *Omega SA v. Omega Engineering Inc* [2003] EWHC 1334 [2003] FSR 49 at [11], Jacob J said:

> "If a party wants revocation to take effect from a date earlier than the date of application for revocation, in my judgment it should set out what date it wants and explicitly allege that the grounds for revocation existed at an appropriate earlier date."

60. He went on to say that one could not read the statement of grounds in that case as seeking an earlier date simply by reference to the combined provisions of s.46(1)(a) and s.46(1)(b). *Omega* was a somewhat unusual case in that the applicant claimed revocation going back to 1960, inviting the court to conclude that this was the date of completion of

the registration procedure. The registered proprietor had not attempted to prove use going back anything more than 5 years from the date of application of registration and the applicant for registration had not identified any earlier date. It would have been unfair to permit revocation to take place at an earlier date in those circumstances. The judge held that the pleading (in that case on an earlier version of the form) did not fairly put in play use for the earlier period.

61. The position is different in this case. It is true that no date was identified for the purpose of s.46(1)(a) but, in the counterstatements, Aegon said:

> The registered proprietor denies that the trade mark has not been put to genuine use as alleged or at all. In particular, it is denied that the trade mark has not been put to genuine use in the first possible five-year period or the period 10 October 2004 to 9 October 2009.

62. In marked contrast to *Omega*, both the first five year period for s.46(1)(a) and the period ending 9 October 2009 for s.46(1)(b) were clearly treated as being in play. Even if the dates were ambiguous in the applicant's form TM26(N), the counterstatement left no doubt that two separate periods, one ending at the end of the first five year period and the other ending on 9 October 2009 were regarded as being in issue.

63. This is therefore an unusual case. First, nothing turns on the precise dates of use. Second, both periods were treated as being in issue. Third, I am satisfied that grounds for revocation existed at the earlier s.46(1)(a) date and that the proprietor has had a fair opportunity to adduce evidence for the five year period from the date the mark went on the Register. The question is therefore whether, notwithstanding the terms of forms TM26(N), I should refuse revocation as from the earlier date. I have taken into account Counsel for Aegon's well-founded submissions on the importance of the pleadings but this is an unusual case, far from the *Omega* situation. In all the circumstances, I propose to order revocation from the earlier s.46(1)(a) date. Since there has been some confusion over what this is, the parties should agree the correct s.46(1)(a) date, failing which an order will be made on paper submissions.

Overall conclusion

64. This case for challenging the Decision was appealingly presented by Counsel for Aegon but, in my judgment, the Hearing Officer was right. The appeal is therefore dismissed.

Costs

65. The Hearing Officer awarded £700 in respect of preparation for and attendance at the hearing, reduced for partial success.

66. Since TLA has been successful on appeal but the arguments were similar to those before the Hearing Officer and the confusion over dates could have been avoided by greater clarity in form TM26(N), I confirm the award of the Hearing Officer below and award an additional £500 by way of costs of this appeal.

DANIEL ALEXANDER QC
Appointed Person

20 October 2011

Representation

Michael Edenborough QC, instructed by Trowers & Hamlins LLP, for the registered proprietor.

Linda Harland, Reddie & Grose, for the applicant for revocation.