

IN THE MATTER OF REGISTERED TRADE MARK NOS. 365200, 1199776 AND
1384452 IN THE NAME OF GAIL BOURA AND CLIVE BOURA

AND IN THE MATTER OF APPLICATIONS FOR REVOCATION THEREOF
NOS. 81604, 81605 AND 81606 BY NIRVANA SPA & LEISURE LIMITED

DECISION

Introduction

1. On 3 February 2004 Nirvana Spa & Leisure Ltd (“the applicant”) applied to revoke each of the following registrations of the trade mark NIRVANA (“the registered trade mark”) standing in the name of Gail Boura and Clive Boura (“the proprietors”) for non-use pursuant to section 46(1)(b) of the Trade Marks Act 1994:
 - (1) No. 365200 registered in respect of “perfumes; perfumed soap; toilet articles; all included in Class 3”;
 - (2) No. 1199776 registered in respect of “deodorants (not for personal use); medicated preparations for the prophylaxis or treatment of diseases or disorders of the skin, scalp, teeth and the mouth; sanitary preparations; disinfectants (other than for laying or absorbing dust)”;
 - (3) No. 1384452 registered in respect of “body sprays; soaps; perfumes; essential oils; cosmetics; non-medicated toilet preparations; preparations for the hair; dentifrices; anti-perspirants; deodorants for use on the person; skin care preparations; all included in Class 3”.

2. The proprietors subsequently conceded that No. 1199776 should be revoked, leaving only Nos. 365200 and 1384452 in issue.
3. After both parties had filed evidence and attended a hearing, David Landau acting for the Registrar held in a single written decision dated 26 January 2006 (O/030/06) that both registrations should be revoked save to the extent that the registrations covered the following goods: “hair care preparations; moisturisers, shower and bath preparations, shaving, make-up removers”. The applicant now appeals, contending that both registrations should be revoked in their entirety, alternatively revoked save to extent that they cover “hair care products”. There is no cross-appeal by the proprietors.

Relevant provisions of the Trade Marks Act 1994

4. Section 46 of the 1994 Act provides in relevant part as follows:
 - 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 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;...
 - (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...
 - (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.
5. These provisions implement Articles 10(1),(2)(a) and 13 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. They correspond to Articles

15(1),(2)(a),(3) and 50(1)(a),(2) of Council Regulation 40/94/EC of 20 December 1993 on the Community trade mark.

The hearing officer's decision

6. In a long and detailed decision, the hearing officer decided in summary as follows:

- (1) The proprietors had demonstrated genuine use of a trade mark in relation to goods in Class 3 within the relevant period. With one immaterial exception, the trade mark which the proprietors had established use of was NIRVANA NATURAL rather than the registered trade mark.
- (2) Use of the trade mark NIRVANA NATURAL was use of the registered trade mark in a form differing in elements which did not alter the distinctive character of that trade mark in the form in which it was registered.
- (3) Such use had been with the consent of the proprietors.
- (4) Such use had not been made in relation to all the goods in respect of which the registered trade mark was registered. A fair specification for the goods in relation to which the trade mark had been used, having regard to the fact that some of the goods were marketed as having multiple uses, was as set out above.

Standard of review

7. This appeal is a review of the hearing officer's decision. Counsel were agreed that, as indicated in *BUD and BUDWEISER BUDBRÄU Trade Marks* [2002] EWCA Civ 1534, [2003] RPC 25, the hearing officer's decision involved assessments of the kind to which the approach set out by Robert Walker LJ in *REEF TM* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applied:

In such circumstances 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.

A decision does not contain an error of principle merely because it could have been better expressed.

Grounds of appeal

8. The applicant appeals on two broad grounds. First, it contends that the hearing officer erred in principle in holding that use of the sign NIRVANA NATURAL was use of the registered trade mark in a form differing in elements which did not alter the distinctive character of the trade mark in the form in which it was registered. Secondly, it contends that the hearing officer erred in principle in holding that a fair specification for the goods in relation to which the trade mark had been used was as set out above.

Use in a form differing in elements which did not alter the distinctive character of the trade mark

The law

9. In *BUD and BUDWEISER BUDBRÄU* Lord Walker of Gestingthorpe (with whom Pill LJ agreed) held that the correct approach to section 46(2) of the 1994 Act was as follows:

43. ... The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin’d choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who:

'normally perceives a mark as a whole and does not proceed to analyse its various details.'

The quotations are from para. [26] of the judgment of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.

10. So far as I am aware, the Court of First Instance has considered Article 15(2)(a) of the CTM Regulation, which corresponds to section 46(2) of the 1994 Act, in four cases. In Case T-156/01 *Laboratorios RTB SL v Office for Harmonisation in the Internal Market* [2003] ECR II-2789 at [44] the Court of First Instance held that use of GIORGI, MISS GIORGI and GIORGI LINE did not constitute use of J GIORGI since they altered the distinctive character of the mark, but gave little in the way of reasons.
11. In Case T-135/04 *GfK AG v Office for Harmonisation in the Internal Market* [2006] ETMR 58 at [33]-[41] the Court of First Instance held that use of a device which included (i) the word BUS printed in white on black rectangles, (ii) a symbol of three interlinked triangles printed in solid black and (iii) a black square, the three elements being arranged horizontally, did constitute of a mark comprising (i) the symbol of three interlinked triangles printed in black lines on a white background, (ii) the word BUS printed in black on a white background and (iii) the words "Betreuungsverbund für Unternehmer und Selbständige eV" printed in black on a white background, the three elements being arranged vertically, since the differences did not alter the distinctive character of the mark. With regard to the omission from the mark as used of

the words “Betreuungsverbund für Unternehmer und Selbständige eV” the Court held as follows:

36. Secondly, so far as concerns the reference ‘Betreuungsverbund für Unternehmer und Selbständige eV’, it must be noted that the assessment of the distinctive or dominant character of one or more components of a complex trade mark must be based on the intrinsic qualities of each of those components, as well as on the relative position of the different components within the arrangement of the trade mark (see, to that effect, Case T-6/01 *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR II-4335 at [33]-[35]).
 37. In the present case, the reference in question is a string of words, written in small characters and occupying a secondary position, at the bottom of the sign. Its meaning (Association for the assistance of businessmen and the self-employed, registered association) refers to the services in question. Therefore, in the light of the descriptive content of that element and its accessory position in the presentation of the sign, it must be held that it is not distinctive.
 38. That conclusion is not called into question by the applicant’s argument that the removal of the element in question renders meaningless the word ‘bus’, which constitutes the acronym of the former owner of the earlier mark. The parties agree that the word ‘bus’ has an intrinsic distinctive character. Even assuming that the relevant public were to notice that it may also constitute an acronym, its distinctive character is not affected by the removal of the explicative element.
 39. Nor is that conclusion called into question by the argument, advanced by the applicant at the hearing, that the words in issue refer to the former owner of the sign and, thus, individualise the earlier trade mark. Even if it is conceded that the words refer to the name of the trade mark’s former owner, that fact would have no effect on the assessment of that element’s descriptive content and of its place in the visual presentation of the sign which, here, support the conclusion that the element lacks distinctive character.
12. In Case T-147/03 *Devinlec Développement Innovation Leclerc SA v Office for Harmonisation in the Internal Market* (unreported, 14 January 2006) at [24]-[31] the Court of First Instance held that use of the sign QUANTIEME in plain block capitals but with the letter Q turned into a stylized watch or clock face constituted use of the mark Quantième in lower case with a plain initial capital. With regard to the stylisation of the letter Q, the Court held at [29] as follows:

... although it is true that the stylization of the letter 'q' is more pronounced in the representation of the sign used than in that of the earlier national trade mark, the distinctive character of the earlier mark is still based on the entire verbal element of that mark. In any case, since the stylization of the letter 'q' suggests, as has just been said, the face of a watch, it is not particularly distinctive for goods in Class 14, the only goods for which the applicant has furnished proof of use of the earlier mark....

13. In Case T-149/03 *Il Ponte Finanziaria SpA v Office for Harmonisation in the Internal Market* (unreported, 26 February 2006) at [50] the Court of First Instance held as follows:

Article 15(2)(a) of Regulation No 40/94, to which the applicant refers, relates to a situation where a national or Community registered trade is used in trade in a form slightly differently from the form in which registration was effected. The purpose of that provision, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of the trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the aforementioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of the sign which constitutes the form in which it is used in trade. However, Article 15(2)(a) does not allow the proprietor of a registered trade mark to avoid his obligation to use that mark by relying in his favour in the use of a similar mark covered by a separate registration.

14. So far as this last case is concerned, I would make two comments. First, the suggestion that the sign must differ from the mark as registered “only in negligible elements” does not appear to me to be consistent with the Regulation, which merely requires that the differences not alter the distinctive character of the mark, or with the CFI’s own jurisprudence in the two preceding cases (neither of which is referred to). Secondly, the conclusion that Article 15(2)(a) does not permit reliance upon use of a mark covered by a

separate registration appears to me to be difficult to reconcile with the judgment of the European Court of Justice in Case C-353/03 *Société des Produits Nestlé SA v Mars UK Ltd* [2005] ECR I-6135 holding that a trade mark may acquire distinctive character in consequence of use of that mark as part of or in conjunction with another registered trade mark.

15. It is clear from *BUD and BUDWEISER BUDBRÄU* and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.
16. In Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819 the European Court of Justice held at [24] (repeated at [29] and in the Court's formal ruling) that:

In making that assessment [ie of the distinctive character of a mark], account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered...

The Court went on at [26] to hold that:

... the global appreciation of the likelihood of confusion must, as regards the visual aural or conceptual similarity of the marks in question, be based on the overall impression created by them, bearing in mind, in particular, their distinctive and dominant components.

17. In Case C-3/03P *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* [2004] ECR I-3657 at [32], [36] and Case C-120/04 *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2006] ETMR 13 at [30] the European Court of Justice held that the overall impression created in the mind of the relevant public by a complex trade mark may in certain circumstances be dominated by one or more of its components.

18. Conversely, the Court of First Instance has consistently held that the public will not generally consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark: Case T-191/01 *Alejandro v Office for Harmonisation in the Internal Market* [2003] ECR II-2251 at [53]; Case T-117/02 *Grupo El Prado Cervera SL v Office for Harmonisation in the International Market* [2004] ECR II-2073 at [51]; Joined Cases T-117/03 to T/119/03 *New Look Ltd v Office for Harmonisation in the International Market* [2004] ECR II-3471 at [34]; *Devinlec v OHIM* at [74]. This principle supports the Court's reasoning and conclusions with regard to Article 15(2)(a) in *GfK v OHIM* and *Devinlec v OHIM*.
19. The Office for Harmonisation in the Internal Market's Opposition Guidelines Part 6 dated March 2004 state:

6.2.1.4 Use of word marks with generic or descriptive additions

Where a registered word mark (or any other mark) is used together with a generic indication of the product or descriptive term that is not integrated into the mark, this will be considered as use of the registered mark. Additions which are just indications of characteristics of the goods and services, such as their kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services, do in general not constitute use of a variant.

These cases have in previous practice been analysed under the variation rule, with the variation usually considered to be immaterial. According to this principle, the following additional elements were not considered as altering the distinctive character of the mark:...

Seven examples are given, one of which is Decision 2451/2000 *Adrião Tubarão Mendes SA v Chemisch Adviesbureau Drs JCP Schreuder BV* (unreported, 23 October 2000) in which the Opposition Division held that use of the expressions BIODERMA COSMETIQUE JUVENILLE, BIODERMA COSMETIQUE ALOES, BIODERMA COSMETIQUE ETERNELLE and BIODERMA COSMETIQUE BIOLOGIQUE in Portugal constituted use of the trade mark BIODERMA PORTUGAL since the differences did not alter the distinctive character of the mark.

20. The Guidelines also state:

6.3 Use of more than one mark

In each case it has to be carefully evaluated whether the added or omitted elements represent a change to the mark or depict another mark. It is quite common in some market areas that the goods and services bear not only their individual mark, but also the mark of the business or product group (house mark). In these cases the registered mark is not used in a different form, but the two independent marks are validly used at the same time.

...

The addition of another word does not alter the distinctive character of a mark when the added word will be perceived as another registered mark because of the double use of the ® symbol.

...

This situation is to be distinguished from cases where the symbol ® is only depicted once after the various word elements. In such cases, this indication could be perceived as referring to the combination as a whole.

...

There is no use of two-or-more marks, but use of one composite mark where the different elements appear together as a 'unitary whole'. This is the case where they are actually merged together. However, as always, each case has to be assessed on its own merits. The customs in the specific sector might play a decisive role in the evaluation.

...

6.4.1 Standards for determining the admissibility of a variant

According to Article 15(2)(a) CTMR, the 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, shall also constitute use of the registered trade mark. This means that differences between the form in which the mark is used on the mark and the registered form are acceptable as long as the *distinctive character* of the mark is not altered.

...

An absolute obligation of use of the mark in the form in which it was registered would ignore the reality of the market, in particular the constant evaluation in the marketing of products and the needs of trade mark owners to adapt the use of their mark in the new contexts. On the other hand, the modifications in the use must not alter the distinctive character of the mark.

There are two questions to be answered. First, it must be clarified what is to be regarded as the distinctive character of the mark as registered. Secondly, it must be evaluated whether the mark as used alters this distinctive character.

There is interdependence between the strength of the distinctive character of a mark and the effect of alterations. Marks of strong distinctive character may be less influenced by changes than marks of limited distinctiveness. On the other hand, additional or omitted elements in the mark are more likely to affect the distinctive character of marks of limited distinctiveness.

...

Where a mark is composed of several elements only one or some of which are distinctive and have rendered the mark as a whole registrable, an alteration of that element or its omission or exchange by another element will generally mean that the distinctive character is altered.

21. The passages I have quoted above appear unchanged in the Office's draft revised Guidelines dated July 2006, which are presently under consultation.

The hearing officer's decision

22. The hearing officer's findings and reasoning with regard to this issue were as follows:

44. ... It was Mr Fernando's submission that the trade mark upon which use had been shown was NIRVANA on its own. If Mr Fernando is correct then the issue of 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' is headed off at the pass; there is no question to be considered as the use of the trade mark is as registered. Ms Lane referred to Jacob LJ's example of Palmolive soap, if in a slightly different context. I was surprised by Mr Fernando's submission. Having considered all the evidence I considered that, with a few exceptions, it was a given that the use was of NIRVANA NATURAL. The NATURAL element might or might not alter the distinctive

character of the trade mark as registered, however, it is not something that would be subsumed in the consciousness of an average consumer. It is certainly not soap as in Palmolive soap, in the context of this case that sort of use comes in the use of terms such as rosemary shampoo and orange and barley shampoo. I am also influenced in this in the way that NATURAL is used in relation to NIRVANA. The NATURAL element of NIRVANA NATURAL has to be considered. There are a few examples of NIRVANA on its own and I will consider these in the context of considering use of NIRVANA NATURAL.

...

46. Both counsel accepted the material period to be from 3 February 1999 to 3 February 2004. A good deal of the evidence emanates from prior to the material date, some of it does not bear a date and some of it emanates from after the material date. Of course the period of use is confined to the material period. However, other material can be helpful in putting the business into a context... The material prior to the beginning of the material period shows that in the beginning the use of NATURAL was subservient to NIRVANA. By the time of the beginning of the material period the nature of the use had changed; as can be seen from the extract from *Company* of February 1999 exhibited at CB4....

...

56. For the most part the trade mark that has been used with the consent of the proprietors is NIRVANA NATURAL. The only occasion upon which NIRVANA on its own has been used on material that clearly emanates from the material period by NN [the proprietors' firm] is very limited. This occurs in the pages downloaded from the NN website exhibited at SNS 8. On that occasion it is in the form of a quotation that is quoted in the section 'What The Media Say': 'Nirvana is a market leader in its field....' This is attributed to the owner of the Martin Dorcott Hair Salon. The same page does have a quotation referring to the 'Nirvana of Haircare' and the homepage exhibited at SNS4 states 'you have reached nirvana. prepare to indulge yourself.' I do not consider that these two occurrences can be viewed as trade mark use; they make a pun of the word nirvana. There are various press articles where NIRVANA is referred to rather than NIRVANA NATURAL. Mr Fernando submitted that such use was use with the consent of the proprietors. It is an interesting submission but one that I have difficulty in accepting. Why would there be consent? How would there be consent? Where is the proof of consent? Where is the proof of any involvement of the Bouras or NN? If the press pieces were advertisements in which the copy could be assumed to be controlled by NN or the Bouras, that would be accepted as use by the proprietors; that after all is the normal case in revocation cases. However, there are no conventional advertisements produced. The press coverage is via advertorials and features; there is no establishment that either NN or

the Bouras had control of the copy. I am not prepared to accept that use of NIRVANA on its own in the press material exhibited represents use with the consent of NN or the Bouras.

57. So there is one identifiable use in the material period by the proprietors of NIRVANA on its own and that in the form of a quotation from a third party on a webpage. I do not consider that such use establishes use of NIRVANA on its own, by the proprietors or with their consent, in relation to the creation or preservation of an outlet for the proprietors' goods...

...

60. In considering the issues here it is necessary to keep in mind that the test is the perception of the average consumer. It does not relate to the intention of the proprietor; it is the effect that counts. It is clear that NN has used NIRVANA NATURAL constantly, it is on the products, it is on the website. In the material period there is no indication of the use of NIRVANA on its own originating from NN, any such use originates from the press....

61. There are, to my calculations, fifteen English language press or press related references to NIRVANA where it is not followed by NATURAL. The majority of these are outside the material period. Six clearly emanate from the period when the NATURAL element did not have equal billing with NIRVANA. Five originate from after the change in the packaging, where the two elements have equal billing. It is not possible to attribute the other four. (I have excluded the punning use of NIRVANA.) Mr Fernando submitted that the dropping of the NATURAL element in these press references showed the way that the average consumer would perceive the trade mark in use. Ms Lane submitted that the fact that the vast majority showed use of NIRVANA NATURAL was indicative of the way that the average consumer would view the use of the trade mark. I don't think that the instances of use assist me greatly. All of these emanate from the press, this cannot be considered to represent the average consumer. One does not know what constraints the writers would be under; whether when reproducing NIRVANA NATURAL they were reflecting their own perception or just being punctilious. So the press usage, one way or the other, has not weighed greatly with me.

62. Ms Lane referred to the use of the ® symbol after NIRVANA NATURAL on the packaging; a good deal of the use shown does not show the symbol. I am not convinced that the presence of this symbol will have a great effect upon the average consumer. This symbol and TM are so common that they certainly don't register with me when I am purchasing a product; for persons of failing eyesight, such as me, it would be difficult to even discern. The use of this symbol might indicate the intention of the proprietors but as I have stated above it is effect not intention that has to be considered. However, the intention it might indicate is ambiguous. It could be as Ms Lane submits indicate

that NIRVANA NATURAL as an entirety is seen as the trade mark. However, it could also be argued that the Bouras knowing what their trade mark registrations are felt happy for the symbol to appear after NATURAL owing to their belief that NATURAL being completely non-distinctive would not be seen to have any trade mark significance. One wonders if the symbol had followed NIRVANA whether Ms Lane would have accepted that this proved use of NIRVANA in a form which does not alter the distinctive character of the mark in the form in which it was registered.

63. NIRVANA NATURAL consists of two words, they are both of seven letters and so balance one another. NIRVANA contains three syllables. NATURAL can be pronounced with two or three syllables; the middle vowel often being lost in speech. There is an alliteration between the two elements. Ms Lane submitted that the addition of NATURAL changed the conceptual meaning of the trade mark. She submitted that in addition to the concept of nirvana or heaven a new and completely different concept is introduced; that of naturalness. According to Ms Lane the two concepts are contrasting, 'other worldly with environmental'. Ms Lane submitted that this changes the overall conceptual impact of the trade mark completely. The use of NIRVANA NATURAL certainly does not have that effect upon me. Ms Lane's submission does not relate the submission to the goods and the nature of the use; the use of the trade mark has to be considered in relation to the goods. I am not convinced that the conceptual significance of NIRVANA will be considered by the average consumer. In comparing trade marks the average consumer may be made aware of the conceptual associations by the act of comparison, or simply discriminate between them as he or she is used to discriminating between words; which is how language works. I am of the view that the average consumer on seeing NIRVANA upon the goods of NN will just think of it as a trade mark. I doubt that he or she is going to consider the philosophy of Buddhism. If I am working on an Apple Mac I neither think that I am going to eat it or wear it. It will be viewed as a trade mark by me. If NIRVANA was being used in relation to Buddhism or rock music it would have a conceptual significance to me; in relation to the goods of NN its significance is that of a trade mark rather than coming freighted with meaning.
64. The nub of the issue in relation to the presence of NATURAL relates to the nature of the goods and the average consumer's perception in relation to such goods. Proof of use cases are about the realities of actual use and how that use justifies or does not justify maintenance upon the register. They are not about theoretic notional and fair use. Consequently, I consider that how NN has marketed the goods and the exact nature of the goods has to be taken into account; rather than a consideration of the goods in the specification without reference to the nature of the use. Ms Lane disagreed with this. She considered that the consideration should be against the goods as registered without reference to how the goods had been marketed and the exact nature of

the goods. I cannot see how this can be correct because the issue is about the average consumer's perception of the trade mark as used and that cannot be divorced from the nature of the use. Average consumers do not consult the trade marks register; specifications, like disclaimers, do not go into the market place.

65. From the inception the natural nature of the goods has been identified and emphasised. This has been done in the publicity, in the statements of the Bouras and in the nature of the goods. The very titles of the goods speak of the natural eg nettle and jasmine, wheat and honey and wild mint. Mr Sherlock has exhibited pages from the NN website. In SNS4 there is a page headed 'Nirvana Natural Hair Product Index'. The goods are divided into two ranges; the Indulgence Range and the 'Nirvana Natural Range'. At SNS5 there are again pages relating to the 'Nirvana Natural Range'; at the side of the page there is the heading 'Natural Range'. If this use was decontextualised it would, in my view, be a knock out blow to NSL's [the applicant's] case; simply quoted I do not believe that anyone would see NATURAL as being anything other than a descriptor. However, this use has to be put in the context of the banners that use NIRVANA NATURAL and these words appearing on the products displayed. What this use does show, however, is how easily it is for NATURAL in the context of the goods to be seen as a descriptor.
66. There may be a consumer who has by constant exposure and purchase of the goods of NN come to see NATURAL as an inherent part of the trade mark and expect it to be there. However, there will be many others who are browsers or occasional purchasers who will not be educated thus. Even the consumer who has been educated by use and exposure could still view NATURAL as a descriptor, taking into account the nature of the product. That customer could still effectively perceive a NIRVANA trade mark.
67. I have considered this matter at great length and debated with myself for sometime. The very fact of their being a case to some extent skews the perspective as one is confronted with a tranche of use of NIRVANA NATURAL and there is almost a reflex reaction in favour of the position of NSL. The average consumer is not going to be in that position. Taking into account the nature of the goods and the nature of the use, I have concluded that the average consumer would see NATURAL as no more than indicating the nature of the products, as a descriptor. Ms Lane accepted that NATURAL was lacking in distinctiveness for the goods although she submitted that it wasn't at the furthest end of the scale for unregistrability. I am of the view that NATURAL for the products is at the extreme end. Mr Boura furnished a Google printout for use of NATURAL with hair care products; the frequency of its occurrence is no surprise. Producers of personal care products wish to associate the idea of the natural with their products. In use it is NIRVANA that is striking and memorable, NATURAL becomes an indication of the products.

- 68. I find that the use shown of NIRVANA NATURAL is use of the trade mark in a form which does not alter the distinctive character of the trade mark as registered....**

The applicant's arguments

23. Counsel for the applicant argued that the hearing officer had made six errors of principle, as follows:
- (1) He ignored the conceptual qualities of the mark NIRVANA NATURAL.
 - (2) He ignored the visual and aural differences between the mark NIRVANA NATURAL and the mark NIRVANA.
 - (3) He failed to make his assessment by reference to the global appreciation of the likely impact of the mark on the consumer.
 - (4) He was wrong to consider whether the word NATURAL was descriptive by reference to the exact nature of the goods in relation to which the mark had actually been used, as opposed to the goods in respect of which the registered trade mark was registered.
 - (5) He failed to consider matters through the eyes of an average consumer who was reasonably well informed and in particular one who was aware of the ranges of goods marketed by the proprietors and the manner in which they were described in the press.
 - (6) His conclusion that the distinctive character of the mark was not altered was inconsistent with his conclusion that the trade mark which been used was NIRVANA NATURAL not NIRVANA and with the reasoning supporting that conclusion.

Analysis

24. Before turning to consider the applicant's arguments, it is convenient to consider the hearing officer's reasoning more broadly. As noted above, the hearing officer found that the mark used by the proprietors during the relevant period was NIRVANA NATURAL and not NIRVANA. That finding has not been challenged by the proprietors. It is implicit in this finding that the hearing officer concluded that what the proprietors had used was not the registered trade mark plus a *separate* descriptive term (the situation considered in the first paragraph I have quoted from §6.2.1.4 of the OHIM Guidelines), but rather a composite trade mark (the situation considered in the last paragraph I have quoted from §6.3 of the OHIM Guidelines). In those circumstances it is obvious that the difference between the composite trade mark used by the proprietors and the registered trade mark is the addition of the word NATURAL. The hearing officer nevertheless concluded that the addition of the word NATURAL did not alter the distinctive character of the trade mark NIRVANA. His essential reason for reaching this conclusion was that the word NATURAL was descriptive and thus lacking in distinctive character in relation to the goods in question, and hence combining that word with the registered trade mark NIRVANA in the composite trade mark did not alter the distinctive character of the registered trade mark: as he put it at [67], "In use [i.e. as part of the composite mark] it is NIRVANA that is striking and memorable, NATURAL becomes an indication of the products."
25. Turning to the applicant's first argument, in my judgment the hearing officer did not ignore the conceptual qualities of the composite mark. On the contrary, the hearing officer considered counsel's submission that the addition of the word NATURAL completely changed the conceptual impact of the registered trade mark and rejected it. He gave two reasons for doing so at [64]. The first was that it did not have that impact upon him as a representative consumer. The second was that the effect of the additional word had to be considered not in the abstract but in relation to the particular goods in question.

26. It is true that he went on to observe that he was not convinced that the conceptual significance of NIRVANA would be considered by the average consumer, but this has to be read in context. In context, I think that what the hearing officer meant was that the average consumer would not analyse the meaning of the words comprising the composite mark in the way that counsel had submitted. Even if one assumes that the average consumer would be aware of the popular meaning of the word NIRVANA (although probably not of its technical meaning in Buddhism), it does not necessarily follow that this meaning would be at the front of their mind when they saw that word used as a trade mark for hair care products; compare, for example, NEXT and PRINCIPLES for clothing. As Lord Walker pointed out in *BUDWEISER*, a trade mark may be striking and memorable even though the average consumer does not pause to analyse its associations. As the hearing officer rightly held, the question that matters is whether, and if so how, the average consumer's (subconscious) perception of the registered trade mark would be altered by the addition of the word NATURAL when used in relation to the goods in question. Even if the average consumer was conscious of the popular meaning of the word NIRVANA, it does not necessarily follow that, when confronted by the composite trade mark on the goods in question, they would be conscious of the conceptual contrast between the meaning of NIRVANA and the meaning of NATURAL postulated by counsel.
27. As to the applicant's second argument, in my view this is without foundation. The hearing officer did consider the visual and aural differences between the composite trade mark and the registered trade mark at [63]. Counsel submitted that this was forgotten in his final analysis, but I see no justification for such a conclusion.
28. I consider that the applicant's third argument is equally without foundation. Counsel submitted that the hearing officer had dissected the composite mark into parts rather than considering it as a whole. I disagree: the hearing officer clearly did consider it as a whole, referring for example to the alliteration between the two elements at [63]. He concentrated on the effect of adding the word NATURAL to the word NIRVANA, but that was precisely what he had

to consider. His approach was the same as that adopted by the Court of First Instance in *Gfk v OHIM* and *Devinlec v OHIM*.

29. So far as the applicant's fourth argument is concerned, in my judgment this rests on a logical fallacy. Counsel submitted that it was immaterial that the word or words which had been added to a registered trade mark were descriptive in relation to the goods marketed by the proprietor if the words or words were not descriptive of the specification as a whole. The reason why I consider this is to be fallacious is that, as the hearing officer rightly held, it is only relation to goods for which use has been shown that it is necessary to consider whether the differences in the mark used alter the distinctive character of the registered trade mark. Counsel submitted that the hearing officer had not restricted the specifications to e.g. "natural hair care preparations", but in my view this submission confuses the question of what goods the mark has actually been used in relation to with the question of what is a fair specification having regard to that use (the latter question is considered below).
30. In any event, however, I cannot see that this point would make any difference on the facts of this case: in my judgment the word NATURAL is equally lacking in distinctive character in relation to the remaining goods in the specifications. As counsel for the applicant accepted, NATURAL would be unregistrable for any of the goods in the specifications.
31. Turning to the applicant's fifth argument, in my judgment the hearing officer was right to proceed on the basis that the average consumer would not be in the position of being confronted by the "tranche of use" contained in the evidence. The average consumer is representative of the relevant public who would have different levels of exposure to the composite trade mark: some repeat buyers, some one-off buyers, some merely potential buyers. Even a repeat purchaser would have been very unlikely to have seen all the materials in the evidence. In any event, however, the hearing officer did consider the impact of the proprietors' marketing materials. Furthermore, he concluded at

[66] that even a consumer would have been educated by exposure could see NATURAL as a descriptor and effectively perceive a NIRVANA trade mark.

32. In my view the applicant's strongest argument is the last one. As counsel pointed out, the hearing officer concluded that the trade mark which the proprietors had used was not NIRVANA but NIRVANA NATURAL. Moreover, he expressly said at [44] that the NATURAL element would not be "subsumed in the consciousness of the average consumer". Counsel submitted that it inevitably followed from this that the addition of the word NATURAL did alter the distinctive character of the registered trade mark. Attractively though this submission was put, I am unable to accept it.
33. In my judgment the submission conflates two distinct questions. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period. Here the hearing officer answered that question by finding that sign presented as the trade mark was NIRVANA NATURAL.
34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all. Here the hearing officer answered the second question by concluding that, although the average consumer would register the presence of NATURAL in the composite trade mark, the average consumer would perceive that element as a descriptor of the goods, and thus the overall impression conveyed to the average consumer by the composite mark would be that of a NIRVANA brand. As a matter of law, the hearing officer's approach is supported by the cases discussed at paragraphs 12-13 and 17-19 above and is consistent with the OHIM Guidelines. As a matter of fact, it is supported by the evidence that

at least on some occasions third parties abbreviated the composite trade mark to NIRVANA.

35. I conclude that it has not been shown that the hearing officer made any error of principle. I would comment that the case is clearly close to the line and that another hearing officer might have reached a different conclusion, but nevertheless I am satisfied that the hearing officer's conclusion was one that he was fully entitled to reach.

Partial revocation

The law

36. Section 46(5) of the 1994 Act implements in the context of applications for revocation Article 13 of the Directive, which provides:

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

Parallel provision is made in the context of applications for declarations of invalidity by section 47(5). No such provision is contained in the sections of the 1994 Act dealing with application, examination and opposition, but those sections can and should be interpreted and applied consistently with Article 13: see *Sensornet Ltd's Trade Mark Application* (O/136/06) and the cases cited therein.

37. The correct approach to partial revocation under section 46(5) has been considered in a number of cases in the High Court and Court of Appeal. So far as I am aware, the first such case was *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767. Neuberger J found that there had been genuine of the trade mark during the relevant period in relation to tea caddies, tea pots, mugs, tea towels, milk jugs, sugar bowls, biscuit barrels, cups, mug trees,

aprons, storage jars, memo boards, teas cosies, trivets, tea pot stands, trays, cafetières and drinking glasses. The first registration in suit was for “hand tools and hand implements, all for domestic use; and cutlery, forks and spoons” and the second registration was for “domestic utensils and containers (none being of precious metal or coated therewith), combs, brushes included in Class 21, sponges and instruments (non-electric) and materials for cleaning; and glassware, porcelain and earthenware none being included in other classes”.

38. Neuberger J said at 808:

Mr Arnold raised the question as to how section 46(5) is to be applied once one concludes, as I have done in relation to the ‘276 Mark, that is has been used in respect of some of the items for which it is registered, but in respect of others. It appears to me that one simply looks at the list of items on the register and asks oneself, in relation to each such item, whether or not the mark has been used ‘in relation to’ or ‘in connection with’ that item during the last five years. If the answer is in the affirmative, then the mark can remain registered in respect of that item; if the answer is in the negative then, subject to any question of discretion, the registration is revoked in respect of that item. One does not dig deeper and, as it were, narrow a particular category of item to reflect the extent of the goods to which the mark has been used. Thus, if the only ‘domestic container’ in connection with which the mark had been used was a red tea caddy, it seems to me that the registration should remain in respect of domestic containers; it should not be cut down to, for instance, containers for food, containers for tea, tea caddies or red tea caddies. First, as a matter of principle, it appears to me that one should take the registration as one finds it. Secondly, as a matter of practice, if the law were otherwise it would lead to uncertainty (as indicated by the example I have just given) and a potential welter of applications for partial revocation.

39. Thus Neuberger J’s approach was to apply a blue pencil to the existing wording of the specification. I cannot forbear from recording that this was not an approach contended for by either party before him, and that for this reason the judgment of Laddie J in the 1938 Act case of *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 was not cited even though it was included in the bundle of authorities prepared for the hearing. I should also record that neither party had advanced an alternative case of partial revocation under section 46(5) in its pleadings.

40. Before considering the later cases, I would point out that there are at least four problems with the blue-pencil approach. The first is that it makes the result of an application for revocation for non-use depend upon the manner in which the specification was drafted when originally registered, which in turn depends on the combined contingencies of the drafting style of the applicant for registration or his trade mark attorney, registry policy as to the drafting of specifications (which can and does change from time to time) and the vigilance of the examiner in the individual case.
41. The second problem is that it fails to recognise that single items in a specification of goods or services can be of enormous breadth covering commercially wholly disparate types of goods, such as the example of “computer software” considered in *Mercury v Mercury* (as to which, now see also *DATASPHERE Trade Mark* [2006] RPC 23).
42. The third problem is that it fails properly to give effect to the policy underlying partial revocation, which is articulated in recital [8] of the Directive in the following terms:

Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation...

This policy must be implemented against the background that a registered trade mark confers rights in respect of the use of identical or similar signs in respect of identical, similar or dissimilar goods, and that such rights are “absolute” (to quote recital [10] of the Directive) in the case of identical signs used in relation to identical goods.

43. The fourth problem is that it gives applicants for registration an incentive to draft their specifications using broad and general terms rather than narrow and specific ones so to try and secure wider rights than they need or can justify having regard to their use.

44. In *MINERVA Trade Mark* [2000] FSR 734 Jacob J found on appeal from the Registrar that there had been genuine use of the trade mark during the relevant period in relation to printed stationery, but that the proprietor had not substantiated a claim to genuine use during the relevant period in relation to books and in particular a collection of poems. The trade mark was registered in respect of “paper and paper articles; cardboard and cardboard articles; printed matter; stationery; artists’ materials (other than colours or varnish); drawing instruments; office requisites other than furniture; ordinary playing cards; all included in class 16”. Jacob J held that printed stationery was “printed matter”, but that the term “printed matter” also embraced goods in relation to which there had been no genuine use, in particular printed literary matter such as books. Having referred to *Premier v Typhoon* and *Mercury v Mercury* he said at 738:

I have no doubt that what Laddie J assumed was right and in this respect I differ from Neuberger J. The problem is that some of the language for specifications of goods is apt to be extremely wide. I think it is inevitable that at times one would have to ‘dig deeper’. Even taking the specification considered by Neuberger J for a ‘domestic container’, one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put inside the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercial nonsense to maintain the registration for all goods caused [sic – I think this should read ‘covered’] by the wide words.

That is not to say that the court will cut the registration right down to things like red tea caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the registration. Thus here I think that, although use in relation to printed stationery is established, stationery is a quite different sort of material from literary publications of the kind put out by Reed [the applicant for revocation] and the specification can be cut down.

45. Accordingly Jacob J revoked the specification in so far as it was registered for printed matter other than stationery. It is not clear to me why the trade mark was not revoked for the other goods in respect of which it was registered, such as artists’ materials and drawing instruments, although it may have been because the applicant for revocation was not concerned about those parts of

the specification. I note that it appears from the report that the argument for partial revocation was only raised by the applicant for revocation on appeal. On this point Jacob J said at 739-740:

Mr Hill [the proprietor, acting in person] also said that he thought the goal posts had been moved in that there was now an attack based upon a limitation as opposed to total revocation of the mark. But it seems to me it was abundantly clear from the outset that he was being challenged to put in as much evidence of use as he could muster. In particular, after the evidence in chief had been filed, if he wanted to put in evidence as to use in relation to printed matter of a literary character that was the time to do it. I do not think there is any unfairness for [sic] proceeding on the basis of a partial revocation application.

46. In *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 17 Pumfrey J found that there had been genuine use of the trade mark during the relevant period in relation to cleaning substances for technical/industrial use. The trade mark was registered in respect of “cleaning and decontaminating substances and preparations; all included in Class 3”, “sanitary substances; disinfectants; sterilising substances and preparations; all included in Class 5” and “cleaning and decontaminating substances and preparations; liquid substances and liquid preparations all for cleaning laboratory equipment, glass and the like, and for removing radio active contaminates from material and products”. Having referred to *Premier v Typhoon*, *Mercury v Mercury* and *MINERVA*, Pumfrey J said:

21. ... The difficulty with Neuberger J’s formulation is that while apt to deal with the case before him, it did not deal in terms with huge classes of goods described by single phrases like ‘computer software’ or ‘cleaning substances and preparations’. I must therefore differ with respect from Neuberger J and agree with what Jacob J said in *MINERVA Trade Mark*. At times, it is inevitable that one is obliged to dig deeper.

22. The problem which is raised in an acute form in this case is how much deeper it is right to dig. It is not possible to draw a list of goods in respect of which the mark has not been used, and it seems to me that the question is the more general one: how should the specification of goods be narrowed to reflect the non-use? ... In my judgment, it would only be right as a matter of principle to divest the proprietor of part of his statutory monopoly if one is satisfied that he ought to have to

demonstrate confusion in fact, or at least be obliged to rely upon section 10(2)... The fact of non-use has in itself nothing to do with the defendant and the defendant's activities, or lack of them, are prima facie irrelevant... It follows it seems to me that the second form of revocation sought by the defendants in the present case is not acceptable, leaving as it does a class of goods defined negatively by reference to the defendants' activities.

23. In my judgment, the task is best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark and assuming further that he will continue that use. Mr Campbell submitted that the specification of goods should in effect be drafted from scratch to encompass only the use which the registered proprietor has made of the mark. I accept that the starting point should be a limitation to the actual field of use. The difficulty lies in deciding on the width of the surviving specification, the correct formulation of which must largely depend on questions of fact and degree. Let me take an example to which Neuberger J refers in *Typhoon*. There the registration was (*inter alia*) for 'domestic containers'. Suppose the proprietor uses the mark only on red tea caddies. How does one limit the registration? Obviously the colour red is irrelevant since it does not define a species of goods. But should the registration be limited to tea caddies? Neuberger J thought not... I would agree wholeheartedly with this statement of the problem, but the answer must, I believe, depend on the facts of the case.
24. I think the correct starting point as a matter of principle consists of the list of articles for which the proprietor has in fact used the mark. In arriving at a fair specification having regard to the proprietor's use, it is also necessary to remember that the effect of section 10(2) and (of 10(3), in limited circumstances) is to give the proprietor protection outside his specification of goods... There is no pressing need, therefore, to confer on the proprietor of a wider protection than his use warrants by unduly broadening the specification of goods. There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.
47. In the result, Pumfrey J partially revoked the registrations by restricting them to "all for non-domestic use". It appears from the report that the defendant in its counterclaim had expressly sought partial revocation of the revocations and advanced two alternative proposals for restriction. It also appears that the restriction adopted by the judge was one proposed by the claimant during closing submissions.
48. In *DaimlerChrysler AG v Alavi* [2001] RPC 42 at [68]-[74] Pumfrey J adhered to the approach he had adopted in *Decon v Fred Baker*, although he observed

that a reference to the European Court of Justice might be necessary. In the result he restricted a registration for “articles of clothing; but not including footwear” to “sweaters, anoraks, polo-shirts, scarves, T-shirts and baseball caps”. It is not clear from the report whether either party had invoked section 46(5) in its pleadings, or whether the restriction imposed by Pumfrey J was one proposed by one of the parties or devised by the judge.

49. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828, [2003] RPC 32, CA the trade mark in suit was registered in respect of “arrangement and booking of travel, tours and cruises; escorting travelers and arranging the escorting of travelers; providing tourist office services; all included in Class 39” and “booking and provision of accommodation, catering services for travelers; providing of day nurseries (other than schools); leasing and rental of computers; all included in Class 42”. It was common ground on the pleadings that there should be partial revocation of the registrations, and in particular that “providing of day nurseries (other than schools); leasing and rental of computers” should be deleted. There was a dispute, however, as to the extent of partial revocation that should be ordered. Aldous LJ (with whom Waller and Scott Baker LJJ agreed), having cited *Premier v Typhoon*, *MINERVA* and *Decon v Fred Baker*, said:

29. I have no doubt that Pumfrey J was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s. 10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods or services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly on the rights of the public... In my view the court is required in the words of Jacob J to ‘dig deeper’. But the crucial question is – how deep?
30. Pumfrey J was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples or Cox’s Orange Pippins?
31. Pumfrey J in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but

the court still has the difficult task of deciding what is fair. In my view 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 the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.

50. Accordingly Aldous LJ held that the specifications should be restricted to “all for package holidays” on the basis that the average consumer would describe the claimant’s services as “package holidays”. This was a different restriction to that imposed by the judge at first instance, and it appears from the report that it was not one proposed by either party except by the claimant as a fall-back position during the course of argument in the Court of Appeal.
51. In *West v Fuller Smith & Turner plc* [2003] EWCA Civ 48, [2003] FSR 44, CA the trade mark in suit was registered for “beer” and it was common ground that there had been genuine use of the mark during the relevant period in relation to bitter. The applicant for revocation sought (in the alternative to a declaration of invalidity) partial revocation of the trade mark so as to restrict it to bitter. This was resisted by the proprietor. Pumfrey J (with whom Arden and Schiemann LJJ agreed) applied the approach laid down by Aldous LJ in *Thomson v Norwegian*, observing at [53]:

The emphasis throughout this judgment is on a fair description which would be used by the average consumer for the products on which the mark has been used by the proprietor.

I note that, when upholding the judge’s decision to restrict the specification to bitter at [58], Pumfrey J considered it important that there was little overlap between bitter drinkers and lager drinkers and that beer drinkers were used to seeing lager and bitter bearing different marks.

52. In *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322, [2003] FSR 51 one of the trade marks in suit was registered in respect of “newspapers for sale in England and Wales only”. Applying *Thomson v Norwegian*, Laddie J declined to restrict registration even on the assumption that it had only used in relation to Sunday newspapers, saying at [62]:

I do not think that is a sufficiently separate category of newspapers from those sold during the week.

53. In *ANIMAL Trade Mark* [2003] EWHC 1589, [2004] FSR 19 the trade mark in suit was registered for “clothing, footwear, headgear, baseball caps, sweatshirts, T-shirts”. It was common ground by the end of the trial that there had been genuine use during the relevant period in relation to T-shirts, jeans, vests, sweatshirts, hoodies, track tops, shorts, jumpers, cardigans, parka jackets, camisoles, strappy sundresses, printed cotton skirts, swimwear, knitted hats, fleece hats, sun hats and casual shoes. The defendant sought partial revocation of the mark so as to restrict the specification to “casual surf type wear for men” and “casual surf type wear for women aged under 30”. Applying *Thomson v Norwegian* and *West v Fuller*, Jacob J declined to restrict the clothing part of the specification, but did restrict “footwear” to “casual footwear” and “headgear” to the three types of hats for which use had been proved. He said:

20. The reason for bringing in the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise, they might choose something too narrow or too wide.... Thus the ‘fair description’ is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection (‘the umbra’) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (‘the penumbra’). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been used for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole

exercise consists in the end of forming a value judgment having regard to the use which has been made.

21. Moreover, trade marks do not normally vanish at the time of purchase. Labels are a constant reminder of the maker. An average consumer would bear this in mind in formulating a fair description. That is a particular answer to Mr Mellor's suggestion that the fair description should be limited to the intended age of the purchase. Today's girl surfer is tomorrow's wearer of elegant ANIMALE [the defendant's trade mark, used for smart casual clothes targeted at middle-aged and older women].
22. Thus I do not accept Mr Mellor's submission that the specification should be limited to exactly the kind (including 'image') of goods for which use has been proved. It follows that I do not accept Mr Mellor's suggestion that the goods of the parties are so far distinct in commercial terms that there can be a sensible revocation confining ANIMAL to surf-type goods. This would not be a meaningful distinction to most members of the public (including some of the witnesses). Nor does it make sense to try to limit the mark to younger adults. This is an exercise in pigeon holing which I do not think the ordinary consumer would undertake if asked to form, for trade mark purposes, a fair description of the goods for which the mark had been used.
23. So, should 'clothing' in the specification be qualified in some other way? The term covers a very wide spectrum of different sorts of garments. But putting aside such specialist things as diving suits, wetsuits, bullet-proof vests and so on, there is a core of goods which are likely to be bought by ordinary consumers for different purposes in their daily wear. The same woman or girl is likely to own T-shirts, jeans, dresses, both formal and informal. Both parties' goods could easily end up in the same wardrobe or drawer. He or she knowing of the range of goods for which use has been proved would, I think, take 'clothing' to be fair as a description. He or she might limit the clothing to 'casual clothing' but I have concluded in the end that 'clothing' is appropriately fair.
- ...
34. I turn to consider the other disputed items in Class 25. First 'footwear'. The dispute is whether 'casual' should qualify this. There has been use for casual shoes. It would seem to me here that it would be appropriate to cut the specification down to 'casual footwear' – there is not the same breadth of use as for items of clothing. Next 'headgear'. The only use has been in relation to knitted hats, fleece hats and sun hats. The claimant wants to retain 'headgear' in all its width, which would include all sort [sic] of headgear, for instance top hats, bowler hats and judges' wigs. Applying the Thomson test and [sic] I think 'headgear' is too wide. The claimant offers no lesser specification and I accordingly

accede to the defendant's suggestion to limit the specification to the three kinds of headgear for which use has been proved.

54. While I appreciate that *ANIMAL* was decided after *Thomson v Norwegian* and *West v Fuller* whereas *DaimlerChrysler* was decided before those cases, it seems to me that there is slight tension between the two which is not resolved by that fact. This is illustrated by the fact that the specification upheld by Jacob J covered, to use his own examples, diving suits, wetsuits and bullet-proof vests, in relation to which there had been no use of the trade mark, whereas the specification upheld by Pumfrey J on not dissimilar facts did not. In reaching his decision Jacob J appears to have been influenced by the fact that it would make no difference to the defendant to restrict the specification so that it no longer covered such items; but I consider that, as Pumfrey J expressly said in *Decon v Fred Baker* at [24] and as Aldous LJ implied in *Thomson v Norwegian* at [29], in deciding what specification is appropriate the tribunal must hold the balance not merely between the proprietor and any defendant to a claim for infringement but also between the proprietor and other traders and the public. (Jacob J's rejection of the defendant's proposals for restriction of the specification is, however, supported by the considerations outlined by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's Trade Mark Application* [2005] RPC 2 at [27]-30] and in *WISI Trade Mark* [2006] RPC 6 at [16].)
55. I am only aware of one decision of the Court of First Instance bearing upon this issue. In Case T-126/03 *Reckitt Benckiser (Espana) SL v Office for Harmonisation of the Internal Market* [2005] ECR II-2861 the applicant sought to register the trade mark ALADIN as a Community trade in respect of various goods including cleaning preparations in Class 3. An opposition was lodged by the proprietor of an earlier Spanish trade mark ALADDIN which was registered in respect of "polish for metals". The applicant required the opponent to furnish proof of use of this mark pursuant to Article 43(2),(3) of the CTM Regulation. The Opposition Division found that the opponent had only used its mark for a specific product, namely a product for polishing metals consisting of cotton impregnated with a polishing agent ("magic

cotton”), and that the opposition was to be assessed on the basis that the opponent’s specification was notionally restricted to this product. On this basis the Opposition Division dismissed the appeal, holding that there was no likelihood of confusion. The opponent’s appeal to the Board of Appeal was dismissed. The Court of First Instance allowed the opponent’s appeal, holding that the opponent should be taken to have proved use of its mark in relation to the goods in respect of which it was registered.

56. The Court held:

42. The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).
43. Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.
44. With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45. It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.
46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.
47. The earlier trade mark was registered solely in respect of 'polish for metals'. That description restricts, with regard to both the function of the goods concerned, polishing, and to their intended purpose, for metals, the category of goods covering, under the Nice Agreement, 'cleaning, polishing, scouring and abrasive preparations'. Furthermore it should be noted that the later category itself falls more broadly within Class 3 of the Nice Agreement, which includes, in addition to cleaning, polishing, scouring and abrasive preparations, the following goods:
- 'bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'.
48. In those circumstances, the earlier mark must be held to have been registered for a collection of goods forming a particularly precise and narrowly-defined sub-category of goods to which it belongs under the Nice Agreement.

49. It follows that, by providing the undisputed proof of genuine use of the mark in respect of a ‘product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)’, which is evidently a ‘polish for metals’ within the meaning of the sub-category of goods to which the earlier mark relates, the applicant has properly established that the mark had been put to use for that sub-category as a whole, it not being necessary to draw any distinction in that regard by reference to the public concerned.

...

51. The provisions of Art. 43 allowing an earlier trade mark to be deemed to be registered only in relation to the part of the goods or services in respect of which genuine use of the mark has been established (i) are a limitation on the rights which the proprietor of the earlier trade mark gains from his registration, so that they cannot be interpreted as broadly as OHIM would have them be, and (ii) must be reconciled with the legitimate interest of the proprietor in being able in the future to extend his range of goods or services, within the confines of the terms describing the goods or services for which the trade mark was registered, by using the protection of the trade mark confers on him. That is particularly so when, as here, the goods and services for which the trade mark has been registered form a sufficiently narrowly-defined category, as has been explained above.

57. It appears to me that the approach adopted by the English courts following *Thomson v Norwegian* is broadly consistent with that adopted by the Court of First Instance in *Reckitt v OHIM*. To the extent that there is a difference in approach, it may be explicable by the different issues that were under consideration by the respective courts: the English courts were considering applications for revocation while the Court of First Instance was considering the requirement for proof of use of an earlier trade mark in opposition proceedings. This may explain, for example, the Court of First Instance’s observations at [51]. The main difference between the two approaches that I perceive is that the Court of First Instance does not articulate any very clear yardstick for determining when a sub-category of goods cannot be further divided, whereas the English courts have firmly adopted the perception of the average consumer of the goods in question as providing a suitable benchmark. To the extent that there is a difference, in my judgment I am bound by the decisions of the English courts rather than that of the Court of First Instance since the former are directly on point whereas the latter is not.

58. I derive the following propositions from the case law reviewed above:
- (1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
 - (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
 - (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
 - (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
 - (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
 - (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].
 - (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties. This is not to say, however, that the tribunal is either obliged or entitled to ignore considerations of procedural justice and efficiency: see the observations of Advocate General Sharpston in Case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* (unreported, 6 July 2006) at [62]-[68]. I shall return to this below.

The hearing officer's decision

60. The hearing officer's findings and reasoning with regard to this issue were as follows:

72. The specifications must fall within the parameters of the original specifications. Shampoos, conditioners, hair sprays, holding sprays and shine sprays, as used, are all hair care products; a term that would certainly be encompassed by the specification for registration no 1384452 and the general term toilet articles in registration no 365200. The term hair care products would seem a fair description of the aforesaid goods and would satisfy the requirements of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd, Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) and Animal Trade Mark*.

73. This is no evidence of use upon certain specifically identified goods. There is no indication that registration no 365200 has been used in respect of perfumes or perfumed soaps. There is no indication that registration no 1384452 has been used in respect of body sprays; soaps; perfumes; essential oils, dentifrices; anti-perspirants; deodorants for use on the person.

74. One is now left with the multiple use items. I am aware of no authorities that cover this situation and counsel were unable to advise me of any. The claimed multiple use is not a manufactured claim. From an early stage certain of the goods have been promoted as having multiple uses and this has also been identified on labels. In the material period I have been able to identify the following additional uses of the goods:

Camomile conditioner	Make-up remover, shaving lotion, hand and body moisturiser
Various shampoos	‘can also be added to bath water to relieve aching muscles’
Nettle and jasmine shampoo	‘can be used in the bath and shower, too, if the skin on the body is also inflamed’ ‘Can also be added to bath or shower to reduce inflammation and itching.’
Rosemary shampoo	‘Adding Rosemary shampoo to bath water relieves headaches, migraine, sprains, aching muscles and PMT.’
White nettle and thyme shampoo	‘...and if added to the bath or shower, will calm and soothe your skin.’
Orange blossom and Camomile conditioner	Hand and body moisturiser or shaving aid.

Ms Lane submitted that the goods were described as various hair care products; that was how the average consumer would perceive them; the multiple uses of certain goods does not change this. It is possible, however, that a customer would purchase the goods because of their multiple functions. The extract from *Time Out* from 1998 exhibited at CB5 comments on the multiple functions of the products and states that because of this they are ‘perfect products for travelling’. This article is before the material date but is indicative of how the goods might be perceived and why they might be purchased e.g. because they are shampoos and bubble baths. It can be easily be envisaged that someone specifically purchases the goods for their multiple purposes. Couples might use the goods for different purposes, one as a conditioner, the other as a moisturiser.

75. In considering this issue of multiple use goods I have found it useful to go back to first principles. The recitals of the Directive state:

‘Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation;’

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 deals with the Community Trade Mark Regulation but it is based upon the same fundamental principle:

‘43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure

more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.’

The purpose of revocation is to remove trade marks or parts of the specifications of trade marks where there has not been use. It is there to serve a purpose in trade; it is the Lipitor that stops the arteries of commerce being blocked with the cholesterol of unused trade marks. The trade mark has certainly been used for multiple purpose goods. There has been genuine use in relation to such goods and so it would seem contrary to the recitals of the Directive to revoke in respect of such goods. Revocation for non-use is to deal with the facts of use, not to sit neatly in some legal formula. I find, therefore, that the multiple use goods should retain protection for their additional functions.

76. It would seem perverse in the extreme to have decided that there has been no use of goods specifically listed in the specifications and then to give them cover in a portmanteau term. There is no use upon perfumes or perfumed soap but these terms would be covered by toilet articles. The case law dictates against over prescription but also against over generalisation in an amended specification. Toilet articles and non-medicated toilet preparations are very wide terms that could subsume all the other goods in the class 3 specification. They are terms that are certainly open to further sub-division as per *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*. Mr Boura claims use upon body lotions, foam baths, shower gels, body soaps, shaving lotions, make-up removers. I have listed above the additional purposes of the goods. **Taking into account the case law and the purposes for which the goods can be used I consider that a fair specification, that is neither pernickety nor overly broad, and which would reflect the perception of the average consumer would be: moisturisers, shower and bath preparations, shaving lotions and make-up removers. I am of the view that such goods would be encompassed by the terms toilet articles (registration no 365200) and non-medicated toilet preparations (registration no 1384452).**

The applicant's arguments

61. Counsel for the applicant argued that the hearing officer had made four errors of principle, as follows:
- (1) He wrongly found that, because the goods could be used for multiple purposes, a fair specification of goods should cover those multiple purposes.

- (2) He wrongly placed reliance upon evidence relating to the marketing of the goods outside the relevant period and which was not produced by the proprietors or with their consent.
- (3) Inconsistently with his decision under section 46(2), he took the proprietors' marketing materials and press usage into account.
- (4) He wrongly adopted narrower wording than that contained in the specifications in the absence of any proposal by the proprietors as to narrower wording.

Analysis

62. Before considering counsel's submissions in support of the first argument, I would observe that, as the hearing officer pointed out, the facts of this case are unusual, in that the evidence demonstrates that it has been a feature of the proprietors' business that they have consistently promoted their products as having multiple uses.
63. Counsel submitted that, applying *Thomson v Norwegian*, the key question was how the average consumer would describe the products. She submitted that the average consumer would describe the products by reference to the *primary descriptions* under which the products had actually been sold, namely "shampoo", "conditioner" etc, and not by reference to *additional uses* which those products were promoted as having, namely as "moisturiser", "make-up remover" etc. In support of this, she pointed out that the products had not been sold as, say, "conditioner/moisturiser". She submitted that the hearing officer had erred in principle because he had failed to ask himself this question, or least had failed to frame the specification having regard to the answer which should be given to it.
64. With some hesitation, I have concluded that I do not accept these submissions, for the following reasons.

65. First, I am not convinced that the hearing officer did fail to ask himself how the average consumer would describe the products. While it might have been more clearly expressed, I believe that he considers this question at [74].
66. Secondly, it seems to me that the test of how the average consumer would describe the goods is less straightforward to apply than counsel's submissions presuppose in a case where the goods have multiple uses. Moreover, I think this is what the hearing officer was getting at when he said that one person might use a product as (and hence describe it as) a conditioner and another person might use a product as (and hence describe it as) a moisturiser. Looking at it another way, if one imagines a customer asking the proprietors during the relevant period "do you sell a moisturiser?", I believe the response would have been "yes", and the customer would have been offered one of the products which were primarily sold as conditioners.
67. Thirdly, I consider that the hearing officer was justified in being guided by the policy underlying revocation as set out by him at [74]. If one asks the question "has there been use of the trade mark in relation to goods which are moisturisers?" the answer is "yes" even though those goods are primarily sold as conditioners.
68. Fourthly, I bear in mind that the exercise in framing a fair specification is value judgment which requires the tribunal to strike a balance between the competing interests. I am not satisfied that the hearing officer has made an error of principle which would justify interfering with his value judgment.
69. I can deal shortly with the applicant's second and third arguments. In my judgment the hearing officer was entitled to consider the marketing materials and press articles in the way that he did. There is no inconsistency with his approach under section 46(2) because he was considering a different question. Moreover, it was immaterial that the *Time Out* article was slightly outside the relevant period (as the hearing officer recognised) since it cast light on the position within that period.

70. The background to the applicant's fourth argument is as follows. In its statements of grounds the applicant sought complete revocation of all three registrations; it did not seek partial revocation in the alternative. Likewise in their counter-statements the proprietors sought rejection of the applications in *toto*; they did not seek partial revocation in the alternative.

71. In each of two witnesses statements made by Shaun Sherlock of the applicant's trade mark attorneys which were filed on behalf of the applicant Mr Sherlock adopted the clear fall-back position that, if (which he disputed) there had been genuine use of the registered trade mark by the proprietors or with their consent during the relevant period, the use proved "would not support a trade mark specification broader than 'hair care products'". The two witness statements made by Mr Boura on behalf of himself and his co-proprietor did not so clearly adopt a fall-back position. Nevertheless he did say in paragraph 10 of his second statement that:

The Mark has therefore been used in respect of shampoos, conditioners, hair sprays, holding sprays, shine sprays, body lotions, foam baths, shower gels, body soaps, shaving lotions, make up removers and moisturising creams.

He made a similar statement in paragraph 14 of the same witness statement.

72. At the hearing before the hearing officer, the applicant's position was as previously indicated by Mr Sherlock. The proprietors' position was summarised in paragraph 27 of the skeleton argument of counsel for the proprietors as follows:

The Applicant, as a fall-back position in the light of the weakness in its grounds, seeks partial revocation. It appears to be uncontested that the mark has been used across the bulk of the specifications. The Proprietors understand it to be accepted that the marks have been used in relation to the goods in Boura II para 10.

73. Mr Hobbs has pointed out in several decisions that it is unsatisfactory in a case where some use of the mark has been made, and therefore there is likely to be an order for partial revocation, for the parties to proceed to the hearing without

putting forward proposals as to how section 46(5) should be applied sufficiently far in advance to avoid taking each other by surprise. To do so risks injustice to one side or the other and is inefficient because disputes take longer to resolve e.g. because it leads to appeals. Most recently, in *Citybond Holdings plc's Trade Mark Application* (O/197/06) Mr Hobbs stated at [17]:

In relation to objections raised adversarially in inter partes proceedings, the Registrar is required to adjudicate fairly and impartially on the matters in issue. He may not act protagonistically towards either side in the dispute: *The President of the State of Equitorial Guinea v The Royal Bank of Scotland International Ltd* [2006] UKPC (27 February 2006). It seems to me that in adversarial proceedings he would be acting antagonistically towards the objector if he intervened of his own motion to defend the contested registration. I therefore consider that he should, in the context of proceedings, strike out objectionable wording without proceeding to adopt narrower wording for the eliminating the objection(s) which he considers to be well-founded unless that is a matter which has been properly and fairly raised for adjudication. It certainly appears to me that sections 46(5) and 47(5) of the Act require the matter to be properly and fairly raised if it is to be a live issue in adversarial proceedings of the kind to which those provisions apply.

74. After I had drawn this decision to the parties' attention, counsel for the applicant submitted in reliance upon the passage I have quoted that the proprietors had not properly and fairly raised a narrower form of wording by way of fall-back position prior to, or even at, the hearing before the hearing officer, and therefore the hearing officer should have struck out the objectionable wording and not have adopted narrower wording himself. I do not accept this submission, for a number of reasons.
75. First, it is a little rich for the applicant to argue that a contention was not properly raised below when this point was not raised at all in its grounds of appeal, or even in its skeleton argument for the hearing before me.
76. Secondly and more importantly, in my judgment this submission is inconsistent with the applicant's case. The applicant's case before the hearing officer was that, if the registrations were not totally revoked, they should be restricted to "hair care products". The term "hair care products" does not

appear in either of the specifications, however. Thus the applicant's own case required the hearing officer to consider the appropriateness of a more narrowly-worded specification.

77. Thirdly and in any event, I consider that the question of what was a fair specification having regard to the use shown had been properly and fairly raised. It had been clearly raised by the applicant. In addition, however, I consider that the proprietors had sufficiently raised it too, albeit that they had not articulated their case as clearly as they should have done. In my view paragraphs 10 and 14 of Mr Boura's second witness statement effectively conceded that the mark had not been used across the full width of the registrations, and set out the specification of goods in respect of which the proprietors contended that the registrations should be maintained. Once that issue had been raised, the hearing officer was not bound by the parties' proposals as to what would constitute a fair specification, but was obliged to form his own judgment. That is precisely what he did.

78. I would add this. Mr Hobbs suggests in *Citybond* at [20] that in some cases a useful course would be for the hearing officer to deliver an interim decision and then invite further submissions as to the framing of the specification. Such a course has a particular advantage in non-use cases, since the question of what is fair specification is much more easily addressed by the parties after the tribunal has made its findings of fact as to the extent of use than before. I note that this is effectively the course adopted by Pumfrey J in *Decon v Fred Baker*: see the final judgment at [4].

Conclusion

79. The appeal is dismissed.

Costs

80. The hearing officer directed each side to bear their own costs. I shall order the applicant to pay the proprietors £1000 as a contribution to their costs of the appeal.

18 September 2006

RICHARD ARNOLD QC

Lindsay Lane, instructed by Marks & Clerk, appeared for the applicant.

Giles Fernando, instructed by Murgitroyd & Co, appeared for the proprietors.