

O-050-08

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION
NOS 1442619, 1442620, 1442621, 1442622 AND 1442623
IN THE NAME OF SHL GROUP LIMITED
OF THE TRADE MARK:**

SAVILLE & HOLDSWORTH

IN CLASSES 9, 16, 35, 41 AND 42

**AND THE CONSOLIDATED APPLICATIONS FOR REVOCATION
THERE TO UNDER NOS 82595, 82596, 82597, 82598 AND 82600
BY SAVILLE CONSULTING GROUP LTD**

Trade Marks Act 1994

**In the matter of registration
nos 1442619, 1442620, 1442621, 1442622 and 1442623
in the name of SHL Group Limited
of the trade mark:
SAVILLE & HOLDSWORTH
in classes 9, 16, 35, 41 and 42
and the consolidated applications for revocation
thereto under nos 82595, 82596, 82597, 82598 and 82600
by Saville Consulting Group Ltd**

Introduction

1) On 21 August 2006 Saville Consulting Group Ltd, which I will refer to as Consulting, filed applications for the revocation of trade mark registration nos 1442619, 1442620, 1442621, 1442622 and 1442623. The registrations are in the name of SHL Group Limited, which I will refer to as Group. They are registered for the following goods and services:

Computer software; data recorded magnetically, optically, electronically or in other machine-readable form; measuring and testing apparatus and instruments; sound and video records; instructional and teaching apparatus and instruments; all relating to business, personnel, vocational testing and guidance, personality testing, psychological examination and career advice; all included in Class 9.

Printed matter; instructional and teaching material; books; periodical publications; leaflets, forms and questionnaires; articles of stationery; office requisites; all relating to business, personnel, vocational testing and guidance, personality testing, psychological examination and career advice; all included in Class 16.

Consultancy and expert services relating to business; business management advice and assistance; personnel management advice; data processing, data verification and data management; commercial and personnel information services; employment and personnel consultancy and management services; arranging and conducting business and commercial conferences and seminars; statistical studies and provision of statistical information, all relating to personnel and recruitment; information and advisory services and preparations of reports, all relating to the foregoing; all included in Class 35.

Educational, instructional and training services, all relating to business, personnel, vocational testing and guidance, personality testing, psychological examination and career advice; arranging and conducting educational and training conferences and seminars; production of sound and video recordings; lease, hire and rental of instructional and teaching materials; information and advisory services, and preparation of reports, all relating to the foregoing; all included in Class 41.

Professional and expert services relating to personnel, vocational testing and guidance; personality testing; psychological examination and career advice; personality and psychological testing services; career and vocational counselling; testing of individuals to determine employment skills; occupational psychology services; catering; computer software design and development; consultancy services relating to the assessment, development and application of human resources; catering services; provision of temporary accommodation; information and advisory services and preparation of reports, relating to all the foregoing; all included in Class 42.

Consulting claims that the trade marks have not been put to genuine use during an uninterrupted period of five years prior to the date of the application for revocation and that there are no proper reasons for non-use. Consulting believes that this uninterrupted period of non-use follows a decision by the Group in the 1980s to trade under the trade mark SHL and not the registered trade mark SAVILLE & HOLDSWORTH. Consulting seeks revocation of the registrations from 21 August 2006 as per section 46(1)(b) of the Trade Marks Act 1994 (the Act).

Evidence

2) Group filed counterstatements in which it denies the grounds of revocation. It claims that it uses the trade mark SAVILLE & HOLDSWORTH extensively and that in particular the trade mark appears on questionnaires, answer sheets, manuals and instruction leaflets. A witness statement by Anne-Claire Guillot was included with the counterstatements. Ms Guillot is the contracts manager of SHL. She states that as part of its business Group sells a wide range of manuals, answer sheets, instruction leaflets, booklets and other materials. She “confirms” that these materials have been distributed and sold by Group within the relevant five year period preceding the applications for revocation. An annex to Ms Guillot’s witness statement includes the exhibits described below (numbers in brackets refer to the numbers given by Ms Guillot):

(1) The front page of OPQ (Occupational Personality Questionnaires) Factor Models questionnaire. This shows use of SHL followed by ®, underneath this appears Saville & Holdsworth Ltd. An invoice (2) is associated with this, it is dated 28 April 2006. The invoice shows no use of the trade mark, all references are to SHL. It is for one OPQ Factor Manual & Ring binder. The details of the charge and recipient have been redacted.

(3) An OPQ Concept 5.2 profile chart. On the front page SHL followed by ® appears, underneath this appears Saville & Holdsworth Ltd and underneath that © Saville & Holdsworth Ltd 1994. SHL and OPQ are described as trade marks of Saville & Holdsworth Ltd. Five pages of the chart are exhibited, at the bottom of each page © Saville & Holdsworth Ltd 1994 appears. Two invoices are associated with this exhibit (4), one is dated 4 April 2006 and the offer 20 April 2006. The invoices show no use of the trade mark, all references are to SHL. Both invoices are redacted so that neither the recipient nor the charge can be seen. The first invoice includes 25 OPQ Concept 5.2 full profile charts. The second invoice includes 100 OPQ Concept 5.2 full profile charts.

Each of these invoices also includes equal numbers of OPQ Concept 5.2 hand score answer sheets, Ms Guillot makes no claim that SAVILLE & HOLDSWORTH appears on these associated goods.

(5) A Personnel Test Battery profile chart. SHL followed by ® appears on the chart, followed by © Saville & Holdsworth Ltd 1992. Two invoices (6) are associated with this, one is dated 1 February 2006 and the other 24 May 2006. Both invoices are redacted so that neither the recipient nor the charge can be seen. Included on the earlier invoice are MGIB practice leaflets, PTB 1.1 practice leaflets, PTB VP5.1/VP5.2 answer sheets, PTB NP6.1/NP6.2 answer sheets. Ms Guillot makes no claims that SAVILLE & HOLDSWORTH has been used in relation to these other products. Included on the later invoice are administration sets, PTBVP5.1 booklets, PTB NP6.1 booklets, PTB CP7.1 booklets, PTB VP5.1/VP5.2 answer sheets, PTB NP6.1/NP6.2 answer sheets, PTB CP 7.1 answer sheets, PTB 1.1 practice leaflet. Ms Guillot makes no claim that the SAVILLE & HOLDSWORTH appears on these goods, including the directly related PTB 1.1 practice leaflets.

(7) An invoice dated 23 September 2005 to SHL (UK) Ltd from Greenwood Press Limited for 2500 PTB 1.1 profile charts. This is for 2,500 PTB 1.1 profile charts. There is a reference back to the Personnel Test Battery personnel profile chart (5). However, there is no clear claim that this chart is the same as the one referred to above, which bears a printer's reference JNP 2.5K 2/00 and so would appear to have been produced in 2000.

(8) Advanced Test Battery Answer Sheet 3. SHL followed by ® appears at the top of the page, underneath this © Saville & Holdsworth Ltd 1980 appears. At the bottom of the page "SHL is a registered trademark of Saville & Holdsworth Ltd" is printed. An invoice (9) dated 7 March 2006 is associated with this. The invoice is redacted so that neither the recipient nor the charge can be seen. The invoice includes 20 ATB VA3 answer sheets. Also included in the invoice are ATB NA4 answer sheets and OPQ 32 N hand score answer sheets; Ms Guillot makes no claim that the SAVILLE & HOLDSWORTH appears on these goods.

(10) Extracts from *Check-A-Board* a booklet written by Deborah Allday. SHL followed by ® appears, beneath this SAVILLE & HOLDSWORTH appears. The publication indicates that it was first published in 1997. There is no indication that the booklet has been republished or that there have been additional print runs. An invoice (11) associated with this publication is exhibited. The invoice is dated 11 April 2006. The invoice shows that one copy of the guide was supplied. The recipient and the sum are redacted. No reference to SEVILLE & HOLDSWORTH appears on the invoice.

(12) Extracts from the annual report and accounts for the year ended 31 December 2005 for SHL Group plc. References in report are to what SHL has done. A list of subsidiary undertakings shows Saville & Holdsworth Group Limited, Saville & Holdsworth Limited, incorporated in the United Kingdom, Saville & Holdsworth Deutschland GmbH, Saville & Holdsworth (UK) Limited and Saville & Holdsworth (South Africa) (Pty) Limited.

3) Peter Saville gives evidence for Consulting by way of a witness statement. Mr Saville is the international chairman of Saville Consulting Limited; he describes this undertaking as the applicant, which it is not.

4) Mr Saville and Roger Holdsworth founded the company Saville & Holdsworth Ltd on 5 September 1977 to deliver products for the application of psychometric assessment in the workplace. The company floated on the London Stock Exchange on 7 October 1997 under the name SHL Group plc. Mr Saville was a director of Saville & Holdsworth Ltd prior to the floatation and served as managing director and chairman of SHL Group plc following the floatation, until both he and Mr Holdsworth resigned from the board in 2002.

5) In 1977 Saville & Holdsworth Ltd was launched in the United Kingdom and initially traded under the trade mark SAVILLE & HOLDSWORTH. He and Mr Holdsworth soon decided that it would be preferable to trade under a trade mark which was more “snappy”, less cumbersome and more up-to-date. Consequently, they started to trade under the trade mark SHL, the initials of Saville & Holdsworth Ltd.

6) From an early stage Saville & Holdsworth Ltd began to sell products outside of the United Kingdom, as well as in the United Kingdom. Mr Saville states that clearly the trade mark SHL is more appropriate to foreign language markets than SAVILLE & HOLDSWORTH. So when starting businesses outside of the United Kingdom the first choice of trade mark was SHL; for example, when Saville & Holdsworth Ltd began trading in Spain in 1980 it used the trade mark SHL and has continued so to do. Saville & Holdsworth Ltd followed the same course in other jurisdictions except where there was concern that a commercial conflict might arise with an existing company in a particular jurisdiction. In Canada, for example, Saville & Holdsworth Ltd wanted to avoid conflict with a Canadian company named Systems House Limited. Saville & Holdsworth Ltd, therefore, set up a company using the name Saville & Holdsworth; subsequently, an agreement was reached with Systems House Limited which enabled Saville & Holdsworth Ltd to use the trade mark SHL.

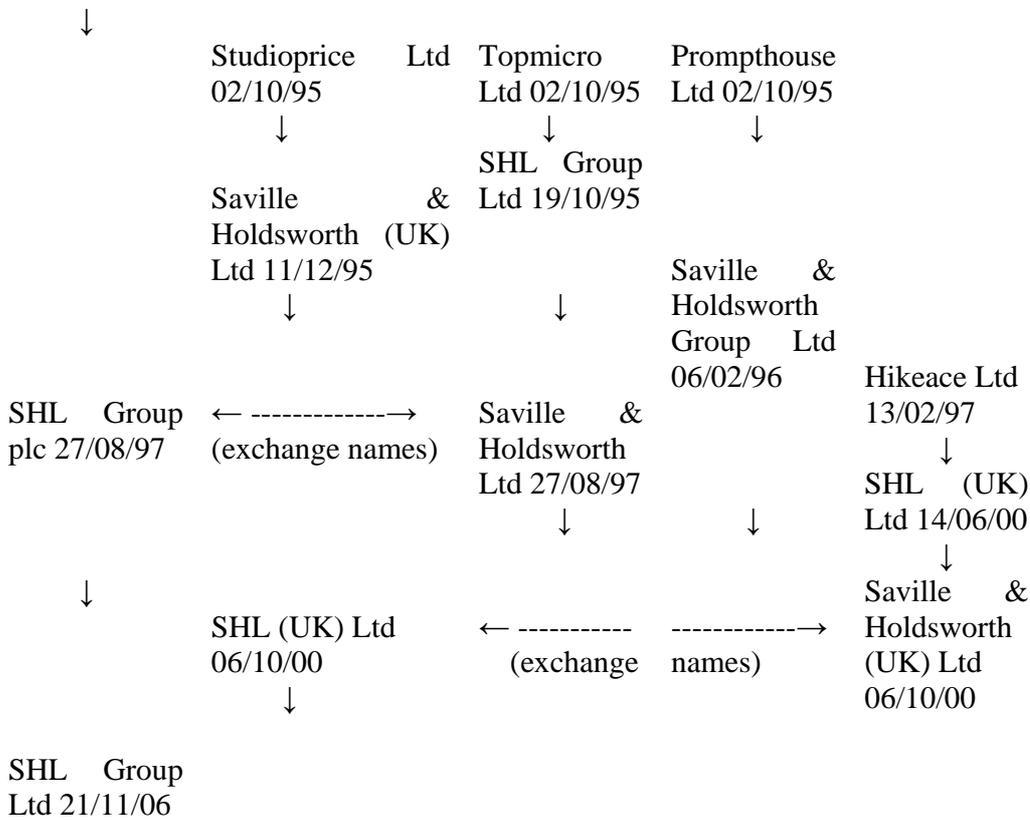
7) Saville & Holdsworth Ltd wished to use the trade mark SHL in the United Kingdom also but was reluctant to cease using the trade mark SAVILLE & HOLDSWORTH immediately and began to use the trade mark SHL on products while still giving some prominence to the company name Saville & Holdsworth Ltd, for the sake of continuity. Mr Saville states that examples of this can be seen in the exhibits to the witness statement of Ms Guillot. The exhibits that carry copyright dates are dated 1980, 1992, 1994 and 1997 (numbers 8, 5, 3 and 10 respectively) and so all of these date from the period before the floatation, when Saville & Holdsworth Ltd was still trading in the United Kingdom. Ms Guillot’s exhibit numbered 1 is undated but is a sheet relating to a product named OPQ Factor Models, this was designed in 1984 and phased out and replaced by updated OPQ products from about 1994. Mr Saville states that Ms Guillot’s exhibits numbered 3, 5 and 8 all include the company name and address of Saville & Holdsworth Ltd, 3 AC Court, High Street, Thames Ditton, Surrey. The company moved away from this address

to SHL Group's current address at The Pavilion, 1 Atwell Place, Thames Ditton, Surrey in about 2000. The copyright notices refer to a company that was named Saville & Holdsworth Ltd in 1980, 1982 and 1994 (company no 01328744). A different company, company no 03109058, which did not come into existence until 1995, is now named Saville & Holdsworth Ltd. Mr Saville states that the products in Ms Guillot's exhibits numbered 3, 5 and 8 refer to a company that had not existed under that name for almost ten years.

8) In the years leading up to the floatation in 1997 Saville & Holdsworth Ltd took steps to prepare the company structure for floatation. Saville & Holdsworth Ltd was trading around the world under the trade mark SHL and Mr Saville states that it was clear that the company name at floatation would be SHL, rather than SAVILLE & HOLDSWORTH. This reflected the extensive and long standing use of the trade mark SHL in the United Kingdom and around the world and also the company's wish not to use the names of the founders of the company in the company name. Mr Saville states that because the newly floated company would be a public company, it would be in its interests, particularly in the long term, to be perceived as independent of its founders.

9) In most countries outside of the United Kingdom local trading companies had been set up to represent Saville & Holdsworth Ltd, with Saville & Holdsworth Ltd in the United Kingdom as a share holder in each of the trading companies. In the United Kingdom Saville & Holdsworth Ltd acted both as the United Kingdom trading company and as a parent company for the foreign trade companies. On floatation it was planned to set up a parent company in the United Kingdom and a subsidiary United Kingdom trading company. The trading companies both in the United Kingdom and in other countries would then report to the parent company. Mr Saville exhibits at PS1 a chart illustrating the changes in the company structure of Saville & Holdsworth Ltd and SHL Group Ltd to date, copies of information from Companies House on each of the companies in the chart, showing changes of name and company accounts, where available, are also included in this exhibit. The details of the chart are shown below:

Saville &
Holdsworth
Ltd 05/09/77



Parent Company	Trading Company Subsidiary of Parent Company	Holding Company Subsidiary of Parent Company	Dormant	Dormant Subsidiary of Trading Company
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10) The directors' reports and financial statements for the year ended 31 December 2005 for Saville & Holdsworth Limited and for SHL (UK) Limited are included in the exhibit. In the former report and financial statement, Saville & Holdsworth Limited is described as a wholly owned subsidiary of SHL Group plc. In the latter report and financial statement, SHL (UK) Limited is described as a wholly owned undertaking of SHL Group plc.

11) Group was set up in October 1995 to reserve the company name for the floatation on 7 October 1997. Saville & Holdsworth Ltd was renamed SHL Group plc and Group was

renamed Saville & Holdsworth Ltd. Thus the parent company became SHL Group plc and the subsidiary holding (non-trading) company became Saville & Holdsworth Ltd.

12) Mr Saville states that the changes in the company structure reflect the long standing intention of the company to trade as SHL rather than SAVILLE & HOLDSWORTH. So of the currently live companies the parent company and the United Kingdom trading company are called SHL and only the non-trading subsidiary holding company and the two dormant companies retain the SAVILLE & HOLDSWORTH name.

13) Saville & Holdsworth Ltd prominently branded its products SHL from as early as 1980, both in the United Kingdom and abroad, but also used the company name Saville & Holdsworth Ltd. In 1996, in anticipation of the floatation, the board of directors of Saville & Holdsworth Ltd took a “more positive decision” to stop using the company name in association with its products and services and to use only the trade mark SHL. Following that decision new products and services displayed only the SHL trade mark but not all existing products and services were updated to remove references to the company name; to reduce costs it was decided to phase out these references over time. Mr Saville states that *Check-A-Board* is a product of the Institute of Management Foundation and not of SHL.

14) Mr Saville exhibits at PS2 prints from the pages of all of Group’s websites throughout the world. Exhibited at PS3 are copies of Group’s product and training catalogue for 2004 and product brochure for 2006. Mr Saville states none of this material appears to make any reference to SAVILLE & HOLDSWORTH.

15) Mr Stewart Spelling, who is bureau manager of Saville Consulting (UK) Limited, gives evidence for Consulting by way of witness statement. He describes Saville Consulting (UK) Limited as the applicant, which it is not. Mr Spelling was employed by Group from August 1995 to November 2006. His last position was that of senior dispatcher, before that he had had a variety of jobs in Group, including in the accounts department. Mr Spelling states that during his employment with Group he does not recall seeing any Group products that were not marked with the trade mark SHL.

16) Mr Spelling states that when he was employed by Group he was told that some old products might still carry the name of Saville & Holdsworth Ltd and that if he came across such products he should draw them to the attention of the company’s design department so that they could be replaced or redesigned to remove any references to Saville & Holdsworth Ltd and replace such references with SHL Group plc. Mr Spelling states that in the summer of 2006 he received new instructions from his employers. Mr Spelling was told that Group needed to keep some “legacy” products carrying the name of Saville & Holdsworth Ltd and that these would neither be replaced nor redesigned for the time being because of a dispute concerning the name. Mr Spelling states that these instructions were in force when he left the employ of Group.

17) Mr Spelling states that some of the material exhibited by Ms Guillot carries markings that indicate when it was printed. The exhibit numbered 5 carries the marking JNP 2.5K

2000; this means that it is one of 2,500 sheets printed by a printer identified as JNP in February 2000. Mr Spelling states that the chart can be identified as PTB 1.2 profile chart because the column headed version at the right hand end of the chart refers to both VP1.1 and VP1.2 (ie it is compatible with versions 1.1 and 1.2). Mr Spelling states that this does not seem to agree with the associated invoice at Exhibit 7, which is an order for PTB version 1.1 profile charts.

18) Mr William Mabey, who was managing director of Saville & Holdsworth Ltd between 1992 and 1995 and chief executive of SHL Group in 1996 and part of 1997, gives evidence for Consulting by way of witness statement. Mr Mabey states that Saville & Holdsworth Ltd used the trade mark SHL from 1980 at the latest. Mr Mabey states that attached to his statement are samples of products developed and sold by Saville & Holdsworth Ltd between 1980 and 1994. Such documents have not been exhibited.

19) Mr Mabey states that from 1986 to 1997 Saville & Holdsworth Ltd built up a substantial worldwide business. It was recognised by the board that the name SHL was more appropriate for a company operating as an international business. Mr Mabey states that this was formalised on floatation when the name was changed to SHL Group plc. He states that the company structure was also changed so that the United Kingdom trading activities were transferred to a new United Kingdom trading company, which was a wholly owned subsidiary of the parent company, SHL Group plc. Mr Mabey states that he believes that at some point the name of the company was changed to SHL (UK) Ltd.

20) Mr Mabey states that Saville & Holdsworth Ltd used the trade mark SHL in both the United Kingdom and abroad. However, there was a potential conflict with Systems House Ltd, a Canadian company which also used the trade mark SHL. Mr Mabey states that an agreement was reached prior to floatation, in which the companies agreed to both use the trade mark SHL in Canada.

21) Ms Elisabeth Lyndsay Cramp, who was an employee of Saville & Holdsworth Ltd between 1980 and 2002 and a director of SHL Group plc between 1997 and 2002, gives evidence for Consulting by way of witness statement. Most of Ms Cramp's witness statement is very similar or identical to that of Mr Mabey. (Ms Cramp also refers to documents that have not been furnished.) However, the fourth paragraph is different. Ms Cramp states that in the early 1990s, after discussion in Saville & Holdsworth Ltd both at board and management level, it was decided to phase out the presentation of the company name Saville & Holdsworth Ltd on products and to trade exclusively under the SHL trade mark. On floatation the company name was changed to SHL Group plc; the company structure was also changed so that the United Kingdom trading activities were transferred to a new United Kingdom trading company, SHL (UK) Ltd, a wholly owned subsidiary of SHL Group plc.

22) Mr Graham Seager, who was group finance director of Saville & Holdsworth Ltd during the floatation in 1997 and worked for SHL Group plc between 1994 and 2002, gives evidence for Consulting by way of witness statement. Mr Seager reiterates what Mr Mabey and Ms Cramp have stated; often in identical words.

23) Ms Alexandra Dawes, who was commercial director of Saville & Holdsworth Ltd and before that managing director of SHL UK, gives evidence for Consulting by way of witness statement. Ms Dawes worked for the companies between February 1982 and August 2002. Ms Dawes reiterates what Mr Mabey and Ms Cramp have stated; often in identical words.

24) Mr Ken Meghani, who is the distribution services manager for Group, by whom he has been employed for 11 years, gives evidence for Group by way of witness statement. Mr Meghani refers to the instructions that Mr Spelling states that he received in relation to the presence of Saville & Holdsworth Ltd on products. Mr Meghani comments that Mr Spelling does not state by whom he was given the instructions. Mr Meghani states that he did not give any such instructions to Mr Spelling. Mr Meghani states that he has spoken to Mr Spelling's two most recent line managers/supervisors whom, he states, do not recall giving such instructions to Mr Spelling. Mr Meghani states that as senior dispatcher Mr Spelling would not have had any responsibility for purchasing or procurement of documents and it would not have been within his remit to liaise with the design department.

25) Mr Meghani exhibits at KM1 a copy of Advanced Test Battery Answer Sheet 3. This bears the trade mark SHL®, underneath this, in small letters, ©Saville & Holdsworth Ltd 1980 appears; at the bottom of the sheet "SHL is a trade mark of SHL Group plc" is written. Mr Meghani states that at the bottom of the document is the code PF1K.05.06; this shows that the document was printed in May 2006. Also exhibited is the purchase order, dated 19 May 2006, and the invoice, dated 25 May 2006. Exhibited at KM2 are copies of foreign language versions of documents. Part of a Polish document, VMG1, is exhibited. At what appears to be the back of the document trade mark SHL® appears, underneath which appears to be Saville & Holdsworth Ltd. The front of the document bears the trade mark SHL®. A screen print for the order of the document is exhibited. This shows that 40 copies of MGIB VMG1.0 question booklet (Polish) were ordered on 2 June 2006. Two other products appear on the screen print: MGIB – combined answer sheets (Polish) and MGIB NMG 1.0 question booklet (Polish). There is no suggestion that these products bear the name Saville & Holdsworth Ltd. A Turkish document MGIB is exhibited. It bears the trade mark SHL, underneath © Saville & Holdsworth Ltd 1986 appears. A screen print of a purchase order is exhibited showing an order for 200 MGIB NMG 1.0 answer sheets (Turkish). A Hungarian document NMG1 is exhibited. This bears the trade mark shl® underneath which appears SHL Hungary Kft and © Saville & Holdsworth Limited 1996. There is various other information which refers to SHL. A screen print is exhibited for a purchase order of 100 MGIB NMG 1.0 answer sheets (Hungarian), dated 15 December 2006. On the screen print orders for MGIB NMG 1.0 question booklets (Hungarian) and MGIB VMG answer sheets (Hungarian) are also displayed. There is no suggestion that these products bear the name Saville & Holdsworth Ltd. A copy of a VMG1 document is exhibited. At the bottom of the page appears: © Alle Rechte bei Saville & Holdsworth Deutschland GmbH, 2004. A copy of a screen print is exhibited for the purchase of 200 MGIB VMG 1.0 answer sheets (German). Also on the screen print orders for MGIB NMG 1.0 question booklets

(German) are shown. There is no suggestion that these products bear the name Saville & Holdsworth Ltd.

26) Mr Steve Phillips, who was employed by SHL between May 1991 and June 2000, gives evidence for Consulting by way of witness statement. His last position was that of print buyer; a position that was filled by Mr Warren Arlow, when Mr Phillips left the undertaking. Mr Arlow reported to Mr Phillips prior to the latter taking up the position of print buyer. Mr Phillips has never been employed by Consulting.

27) Mr Phillips has read the witness statement of Mr Spelling and states that he agrees with Mr Spelling's recollection that employees were requested to bring to the attention of the print buyer any instances where products still carried the name of Saville & Holdsworth Ltd, in order that these references could be replaced with references to SHL Group plc.

28) Mr Warren Arlow, who worked for SHL from March 1996 to March 2006, his final post was that of print buyer, gives evidence for Consulting by way of witness statement. Mr Arlow has never been employed by Consulting. Mr Arlow has read the witness statement of Mr Spelling and agrees with his recollection that employees were requested to bring to the attention of the print buyer any instances where products still carried the name of Saville & Holdsworth Ltd, in order that these references could be replaced with references to SHL Group plc. Mr Arlow received similar instructions from the marketing and accounts departments.

29) Mr Arlow states that the instructions were given to him by the marketing and accounts departments and that he in turn passed these instructions on to Mr Spelling. Mr Spelling was responsible for dispatching products from the warehouse, in which capacity he was in a good position to come across instances of Saville & Holdsworth Ltd printed on products. Mr Arlow states that in the witness statement of Mr Meghani it is stated that the latter did not give these instructions to Mr Spelling, Mr Arlow states that he is not in a position to comment upon this.

Additional evidence

30) In the week prior to the date scheduled for the hearing Group applied to file additional evidence. The request was supported by an explanation as to why it had been decided to seek to file additional evidence. The reason behind the filing of the evidence is given below:

“Upon advice from Counsel instructed to represent my clients at the hearing in this matter. I recently (January 2008) suggested to them that further internal enquiries be carried out to explore whether any further evidence of use of “SAVILLE & HOLDSWORTH” materials could be located.”

31) Initially Consulting objected to the admission of the additional evidence but later agreed to its admission to avoid delays arising from interlocutory issues having to be

addressed. At the hearing I allowed the additional evidence in. I was not swayed by the reasons for the filing of the additional evidence, which, in all honesty, are feeble. However, I was swayed by the fact of the additional evidence. Hearing officers have sometimes looked to the criteria for admission of additional evidence on appeal to decide whether to admit additional evidence. I do not consider that there is a particularly apt analogy to be made to the two sets of circumstances.

32) In admitting the evidence I considered the following factors. Could it possibly have an influence on the outcome of the case? I do not consider that it is necessary that it is a probability that the additional evidence would have an influence, just a possibility. I considered that the additional evidence could have had an influence upon the outcome of the case. Could the filing of the additional evidence be viewed as an abuse of process? It could be that the additional evidence that a party wishes to file has already been shut out by a refusal of an extension of time. It cannot be appropriate to have the extension of time rules circumvented by the filing of additional evidence. In such circumstances the evidence could hardly be described as being additional. It could also be that the filing of the additional evidence is primarily a delaying tactic. I do not consider that there is any hint of an abuse of process being involved in this case. I also took into account that if I shut the evidence out it was quite possible that Group would apply to have it admitted into appeal proceedings, if there were any. So by shutting the evidence out there would be increased uncertainty. In admitting additional evidence the other party can be compensated in terms of costs, if it cannot be compensated in terms of delay and uncertainty. In this case I invited Consulting to file details of the costs incurred by the filing of the additional evidence within two weeks of the date of the hearing. Assuming that the details are filed, I will take the costs involved into account in the final award of costs.

33) The additional evidence consists of a second witness statement by Mr Meghani. Mr Meghani's witness statement brings in further documentation, in exhibits KM3, KM4 and KM5.

34) KM3 includes the following documentation:

OPQ Concept 5.2 profile chart. References to Saville & Holdsworth Ltd, © Saville & Holdsworth Ltd and old address.

Check-A-Board. References to SHL® and Saville & Holdsworth.

Concept 5.2 scoring keys. References to SHL® and Saville & Holdsworth Ltd.

Customer Contact Competency Inventory CCC1. References to SHL® and Saville & Holdsworth Ltd.

Customer Contact Competency Inventory Development Profile. References to SHL® and Saville & Holdsworth Ltd.

OPQ Factor scoring keys. References to SHL® and Saville & Holdsworth Ltd.

General Abilities Profile feedback form. References to SHL® and Saville & Holdsworth Ltd, © Saville & Holdsworth Ltd 1994 and that SHL is a trademark of Saville & Holdsworth Ltd.

General Abilities Profile. References to SHL® and Saville & Holdsworth Ltd.

General Abilities Profile administration instructions series 2. References to SHL® and Saville & Holdsworth Ltd.

General Abilities Profile administration instructions series. References to SHL® and Saville & Holdsworth Ltd. SHL® and Saville & Holdsworth Ltd on frontispiece. Also SHL®, Saville & Holdsworth Ltd 1994, an old address and that SHL is a registered trademark of Saville & Holdsworth Ltd

OPQ Factor models Manual and User's Guide. References to SHL® and Saville & Holdsworth Ltd. SHL® and Saville & Holdsworth Ltd on front and on frontispiece. Also SHL®, Saville & Holdsworth Ltd, © Saville & Holdsworth Ltd 1993 and an old address. It is stated that SHL and OPQ are registered trademarks of Saville & Holdsworth Ltd.

With the exception of *Check-A-Board* the latest consignment to Group from the printers was in 2000, the earliest 1995. *Check-A-Board* was consigned in 2004 but that was consigned to Group by a third party and bears no indication that there has been a second printing since 1997. In the material there is a constant pattern of use of SHL, reference to copyright ownership, the company name Saville & Holdsworth Ltd and use of the old address.

35) KM4 consists of a schedule of the sales during the relevant period of the products exhibited at KM3. By my own rough and ready calculations, excluding negative entries, the total sales value for the period August 2001 to May 2006 (inclusive) was £47,142.10, or approximately £9,500 per annum.

36) KM5 consists of invoices and despatch notes in relation to some of the items exhibited at KM3. The invoices make no reference to SAVILLE & HOLDSWORTH but refer to SHL and, of course, the address is the post 2000 address. The invoices of 18 January 2006, 4 April 2006, 20 April 2006 and 28 July 2006 include products that do not have the old branding. In the case of the 28 July 2006 invoice there are 22 other products on the invoice.

Decision

37) Section 46 of the Act reads as follows:

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

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

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

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from——

(a) the date of the application for revocation, or

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

Consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

38) At the hearing an amount of consensus appeared in relation to the evidence of use furnished by Group; although, not surprisingly, there was a lack of consensus as to what the implications and effects of the evidence were when considered within the parameters of the law. Mr Edenborough did not challenge that Group had supplied the printed matter exhibited during the relevant period, neither did he claim that the printed matter had been supplied with the object of maintaining a trade mark registration ie it was not token or coloured use. There was no dispute about the evidence of Consulting in relation to the use of SHL rather than SAVILLE & HOLDSWORTH. So in the 1980s SHL became the prominent trade mark, but Saville & Holdsworth Ltd was used in conjunction with it. In the early 1990s it was decided to phase out the presentation of the company name, Saville & Holdsworth Ltd, and in 1996, in anticipation of the floatation, the board of directors of Saville & Holdsworth Ltd took a “more positive decision” to stop using the company name in association with its products and services and to use only the trade mark SHL (see the evidence of Mr Saville and Ms Cramp).

39) Following that decision new products and services displayed only the SHL trade mark but not all existing products and services were updated to remove references to the company name; to reduce costs it was decided to phase out these references over time.

Mr Tritton accepted that there was a “watching brief” to identify products still bearing Saville & Holdsworth Ltd. Exhibit KM3 identifies eleven documents that were being sold during the relevant period that bear the name Saville & Holdsworth Ltd, the latest year of consignment to Group is 2000. *Check-A-Board* is also included in the exhibit and has a year of consignment of 2004; however, this relates to consignment from The Institute of Management to Group and not a date of production, there is nothing in the copy of the document supplied that indicates that there was a second print run after first publication in 1997. (*Check-A-Board* is the sole document furnished by Group which bears SAVILLE & HOLDSWORTH rather than Saville & Holdsworth Ltd.) Exhibit KM1 is a copy of an Advanced Test Battery Answer Sheet 3 which was printed in May 2006, this product bears the trade mark SHL® underneath of which appears “© Saville & Holdsworth Ltd 1980. Reproduction of this answer sheet by any means in an infringement of copyright.” At the bottom of the page “SHL is a trademark of SHL Group plc” is written. The document at KM1 identifies who is the owner of the copyright, Saville & Holdsworth Ltd. Borrowing from the language of *Céline SARL v Céline SA* Case C-17/06 the purpose of copyright identification is limited to identifying the ownership of the copyright and such use cannot be considered as being ‘in relation to goods or services’ within the meaning of Article 5(1) of First Council Directive 89/104 (the Directive) of December 21, 1988. Consequently, I do not consider that the form exhibited at KM1 is relevant to a case relating to revocation of a trade mark. The form merely advises who owns the copyright, it is not an indicator of the origin of the form. (Taking into account the evidence of Mr Spelling re the change of policy re documents bearing Saville & Holdsworth Ltd in the summer of 2006 a good deal of caution, anyway, would have had to have been exercised in any conclusions that were drawn in relation to this particular matter.) Consequently, the last print run by Group which used Saville & Holdsworth Ltd, in a non-copyright ownership context, was in 2000.

40) Invoices that are exhibited show that various other products were supplied with documents bearing Saville & Holdsworth Ltd which did not bear the words Saville & Holdsworth Ltd. (None of the invoices that have been furnished have any reference to SAVILLE & HOLDSWORTH, they all refer to SHL.) Taking into account the turnover figures of SHL (UK) Limited and the figures of sales shown in KM4, the legacy use of Saville & Holdsworth Ltd is very small. (I take into account that the turnover figures relate to the business as a whole and not just printed matter, printed matter might represent a relatively small part of the turnover. I have to work on the evidence before me; Group has not supplied any turnover figures in relation to the goods and services upon which it claims to have used the trade mark or particular goods and services at large.)

41) I conclude from the evidence before me that from 2000, at the latest, as documents were reprinted Saville & Holdsworth Ltd was no longer shown upon them; unless, in the one instance identified above, it identified copyright ownership. It was the policy of Group to remove the reference to Saville & Holdsworth Ltd, until the dispute with Consulting arose, when its policy changed, as per the evidence of Mr Spelling. Initially Mr Tritton tried to cast doubt upon the evidence of Mr Spelling. However, if there was to be a challenge to his evidence, Mr Spelling should have been called for cross-

examination. There is nothing in the evidence of Mr Meghani that invalidates the evidence of Mr Spelling. Mr Meghani does not state that Mr Spelling was not given such instructions, what he states is that he did not give such instructions to Mr Spelling and that Mr Spelling's two most recent line managers/supervisors did not give such instructions. If person A gives an instruction, a statement from person B, C or D stating that they did not give the instruction tells one nothing about the original instruction. Mr Tritton in the hearing changed his tack in relation to the evidence of Mr Spelling and interpreted it as simply indicating that Group wished to preserve documents for a case before OHIM. There is no evidence in relation to proceedings before OHIM and so this submission cannot be considered within any parameters. Taking into account all the evidence before me and the consistent, if not quantitatively large, use of Saville & Holdsworth Ltd on legacy documents I do not consider that anything turns upon the change of policy of Group.

42) It is established that in relation to genuine use there is no de minimis limitⁱ. A global appreciation of the use has to be made taking into account, inter alia, the nature of the use, the extent of the use and nature of the marketⁱⁱ. The material supplied to substantiate the claim of use is all printed matter. It relates, with one exception, to psychological profiling and testing for employment purposes. The one exception is the *Check-A-Board* publication which deals with improving the way that boards of directors work.

43) Mr Tritton conceded that there was no proof of use in relation to the class 9 registration. However, he considered that the use on printed matter was evidence of use in relation to the registrations for the services as the printed matter would be always used in relation to the services. It is necessary to show use in relation to the goods or services for which the trade mark is registered, the trade mark must guarantee the origin, in this case, of the services. There is no evidence of use of the trade mark in relation to the services; not one invoice, not one contract. If one looks at page 5 of the General Abilities Folder the sole references to the service provider is to SHL. It is, in my experience, common practice in language teaching, for example, to use a series of text and exercise books; the trade mark on the text and exercise books is for the goods not for the service of teaching. Where does one finish extrapolating from goods to the services in which they are used? The *reductio ad absurdum* would be to consider use of a pencil or pen as proof of use in relation to the services in which they are used. In its counterstatements Group did not even claim that the trade mark had been used in relation to the services of the registrations but in relation to class 16 goods. From the evidence that has been filed and the absence of evidence of use in relation to the services, it is clear to me that the trade mark that has been used in relation to the services is SHL and that neither SAVILLE & HOLDSWORTH nor Saville & Holdsworth Ltd have been used in relation to the services. I specifically asked Mr Tritton if he could direct me to any authority that could be the basis of finding that one could extrapolate from use on goods being proof of use on services; he could not advise me of any. The position in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85, where it was accepted that servicing and supplying spare parts for the fire extinguishers could preserve the registration for fire extinguishers, is not on a par, as in that case the same trade mark was used; in this case another trade mark is being used in relation to the services. The

services are also still available, unlike the goods in *Ajax Brandbeveiliging BV v Ansul BV*, and another trade mark is being used in relation to them; the services are being identified by reference to SHL. It seems to me that the effect of Mr Tritton's submissions is that Group decided long ago to use another trade mark in relation to the services, has been using another trade mark for the services for a long period of time but because some legacy products are used in the performance of the services the registrations for the services should be preserved. I fail to see how the use of some old publications in for the performance of the services establishes that Group is maintaining or creating a market in the services by reference to the trade mark SAVILLE & HOLDSWORTH. In fact Group is maintaining and creating a market by reference to SHL. I cannot see that to allow the registrations to remain on the register would satisfy the ratio legis for the use requirement in First Council Directive 89/104 of December 21, 1988ⁱⁱⁱ.

44) Taking into account Mr Tritton's concession in relation to the class 9 registration, I find that Group has not shown use of the trade mark in relation to the registrations in classes 9, 35, 41 and 42 in the relevant period.

45) This leaves the class 16 registration. There are two questions to be considered here. It is necessary to decide if use of Saville & Holdsworth Ltd is use of SAVILLE & HOLDSWORTH in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. Outwith this consideration, it is necessary to decide if the use is genuine use. I will deal with the latter consideration first. The considerations to be taken into account in relation to genuine use were given by the European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV*:

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

46) The use that has been shown cannot, in my view, be described as being token in the sense of the first sentence of paragraph 36. The scale of use in itself appears to me to be perfectly acceptable and the use is not internal use. However, it does not automatically flow from these findings that there is genuine use for the purposes of the Act. As Mummery LJ in *Laboratoire de la Mer Trade Mark* [2006] FSR 5 stated:

“23 Although token use of a mark is obviously not genuine use, it would be illogical to assert that every case of non-token use qualifies as genuine use. Ansul and the reasoned order in this case are clear that, even if the use is not token, it is still necessary to consider other factors in order to decide whether or not the use of the mark is genuine. For example, internal use by the registered proprietor may not be token or sham, but it will fail to qualify as genuine use because it is internal only.”

The ECJ in *Ajax Brandbeveiliging BV v Ansul BV* held:

“The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings.”

The products which have been exhibited are legacy products; the trade mark SHL is the trade mark under which Group trades. The invoices that are sent out for the products make no reference to SAVILLE & HOLDSWORTH; where an address appears on products bearing the name Saville & Holdsworth Ltd it is one that has not been used since 2000. This is not in itself damning, companies can use a variety of brands as well as their main brand; invoices will often bear the company name rather than a particular brand. However, this is not the case of a brand and use of sub-brand; this is the case of the use of the trade mark SHL for the goods and services of Group and Saville & Holdsworth Ltd or SAVILLE & HOLDSWORTH appearing on legacy printed matter as SHL has not exhausted the stocks of existing material. This is a case where a decision

was made to abandon use of SAVILLE & HOLDSWORTH. This is also not a matter of a few months, the last document printed with Saville & Holdsworth Ltd, not in relation to a claim to copyright, was in 2000. In this case everything tells you that the services in relation to which the printed matter is used are supplied under SHL, and there is nothing to suggest that anything but a few products still bear Saville & Holdsworth Ltd. In such a context Saville & Holdsworth Ltd is not being used to create or preserve an outlet for goods or services under that name, as a matter of financial prudence it simply appears on old literature. The goods are not such that they have a “use by date” and so they could be continued to be used for many years, although all trade is under the trade mark SHL.

47) Mr Tritton referred to the existence of the registered company name Saville & Holdsworth Ltd as a company name to indicate the intention to maintain use of SAVILLE & HOLDSWORTH. The use of the company name is as per *Céline SARL v Céline SA* Case C-17/06, use to designate a business and is not being used ‘in relation to goods or services’ within the meaning of Article 5(1) of the Directive. As Mr Edenborough pointed out from the directors’ report and financial statements for Saville & Holdsworth Ltd (company no 3109058), this is not a company that is active in the market place. The purpose of the company is to invest in companies in the SHL group, its turnover derives from dividends from subsidiaries and it has neither staff nor directors’ costs. I cannot see that the existence of the company and its name adds anything to the case of Group.

48) During the hearing references were made to goodwill and reputation. I cannot see that the goodwill of a business is particularly relevant to the matter. This is a case relating to trade mark law and the criteria relating to genuine use of a trade mark as per the Directive. Once one starts considering goodwill one is looking at different matters and matters governed by common law and not by European law (eg residual goodwill).

49) I consider that the use of Saville & Holdsworth Ltd and SAVILLE & HOLDSWORTH (in the one document) does not amount to genuine use as defined by the ECJ in *Ajax Brandbeveiliging BV v Ansul BV* and that the trade mark registration in class 16 should be revoked in its entirety.

50) In the event that I am wrong in relation to my finding above, I go on to consider if use of Saville & Holdsworth Ltd can be considered to be use of SAVILLE & HOLDSWORTH in a form which does not alter the distinctive character of the mark in the form in which it was registered. The considerations that have to be taken into account in relation to this matter were outlined by Walker LJ in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25. In that judgment Walker LJ stated:

“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?”

The difference is obvious, it is the presence of Ltd. Does that alter the distinctive character of the trade mark? (The issue here is not to be conflated with the issue with which the ECJ was seized in *Céline SARL v Céline SA* Case C-17/06 as to the effects of the use of a company name in relation to goods and services and subsequent infringement of a registered trade mark. I am not here considering the effects of the use of Saville & Holdsworth Ltd in the course of trade but the differences between SAVILLE & HOLDSWORTH and Saville & Holdsworth Ltd and the effects of those differences.)

51) It could be argued that the addition of Ltd does alter the distinctive character of the trade mark as it changes the meaning of it; from that of two surnames to that of a company limited by guarantee. It is something that would be noticed, in my view, by an average consumer. As language is about meaning and the meaning is altered, this would seem a plausible argument. However, the matter of the addition of Ltd was dealt with, in relation to infringement proceedings, by Mr Richard Sheldon QC, sitting as a deputy judge of the High Court, in *Antoni Fields v Klaus Kobec Limited and Michael Cohen* [2006] EWHC 350 (Ch):

“68 As regards the other alleged acts of infringement, I am of the clear view that the point has no merit as regards the use of the company name (Klaus Kobec Limited). The addition of the word "Limited" (in particular to a distinctive name such as "Klaus Kobec") has in my view no trade mark significance and can be ignored (cf *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] R.P.C. 40 at paras 37-40 per Jacob LJ). I would find it surprising if the word "limited" could be ignored for the purposes of the "own name" defence (see below) but not for the purposes of assessing whether use of Klaus Kobec Limited is use of a sign identical to the Mark (cf *Reed* at para 115: "it matters not that the word Ltd or some other indication of incorporation is added".)”

It seems to me that SAVILLE & HOLDSWORTH is a distinctive name. If adding limited to a distinctive name leaves an identical trade mark, for infringement purposes, I cannot see that it can be argued, even if in relation to non-use, that such an addition alters the distinctive character of the trade mark as registered. (In both cases the matter is considered by reference to the average consumer^{iv}.) Consequently, I feel that I am bound to find that use of Saville & Holdsworth Ltd is use of SAVILLE & HOLDSWORTH in a form that does not alter the distinctive character of the trade mark as it was registered.

52) Consequent upon my finding above I consider that, in the event that I am wrong in relation to the genuine use issue, I should give a specification for the class 16 registration. All of the class 16 goods are limited to relating to *business, personnel, vocational testing and guidance, personality testing, psychological examination and career advice*, which seems a fair description of the nature of the goods. There is no evidence of use on *periodical publications articles of stationery; office requisites*. In my view this is a simple blue pencil job. A specification limited to

printed matter; instructional and teaching material; books; leaflets, forms and questionnaires; all relating to business, personnel, vocational testing and guidance, personality testing, psychological examination and career advice; all included in class 16

would properly reflect the nature of the evidence of use before me (if I am wrong in relation to the principal issue of genuine use).

53) All five registrations are to be revoked with effect from 21 August 2006.

54) As I stated above, I have allowed Consulting time to file details of costs that were incurred in relation to the additional evidence. I will issue a supplementary decision in relation to costs when I have received details of these particular costs. For the sake of economy and clarity, the appeal period for this decision and the decision in relation to costs will run from the date of the issue of the decision relating to costs.

Dated this 22nd day of February 2008

**David Landau
For the Registrar
the Comptroller-General**

Mr Guy Tritton, instructed by Clifford Chance, appeared as counsel for Group. Mr Michael Edenborough, instructed by Reddie & Grose, appeared as counsel for Consulting.

ⁱ The point was put clearly and succinctly by the Court of First Instance in *La Mer Technology, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-418/03:

“However, the purpose of that provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (*VITAFRUIT*, cited above at paragraph 51, paragraph 38, and Case T-334/01 *MFE Marienfelde v OHIM – Vétouquinol (HIPOVITON)* [2004] ECR II-2787, paragraph 32).”

ⁱⁱ In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-234/06 P the European Court of Justice stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).”

ⁱⁱⁱ “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; whereas it is necessary to provide that a trade mark cannot be invalidated on the basis of the existence of a non-used earlier trade mark, while the Member States remain free to apply the same principle in respect of the registration of a trade mark or to provide that a trade mark may not be successfully invoked in infringement proceedings if it is established as a result of a plea that the trade mark could be revoked; whereas in all these cases it is up to the Member States to establish the applicable rules of procedure;”

^{iv} *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25:

“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.”

LTJ Diffusion SA v Sadas Vertbaudet SA Case C-291/00:

“Article 5(1)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”