

O-113-05

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION  
No 81100  
BY IDEAL HOME LIMITED  
FOR REVOCATION OF TRADE MARK No 1260437  
**IDEAL HOME**  
STANDING IN THE NAME OF  
IPC MEDIA LIMITED

## BACKGROUND

1) The following trade mark was registered as of 8 April 1988 in the name of IPC Media Limited

Mark	Number	Effective Date	Class	Specification
IDEAL HOME	1260437	14.02.86	16	Printed publications and periodicals.

2) By an application dated 18 December 2002, Ideal Home Limited applied for the revocation of the registration under the provisions of Section 46(1)(a) & (b). The grounds stated that there had been no use of the trade mark in suit in the five years following registration, or in the alternative that use may have been suspended for an uninterrupted period of five years and there are no proper reasons for non-use. The applicant states that the mark has “been used in relation to a magazine published for [sic] time to time. The magazine relates only to interior decoration for homes”. They also request that the trade mark registration be partially revoked in accordance with Section 46(5) in respect of those goods for which the trade mark has not been used for a continuous period of five years.

3) On 7 July 2003 the registered proprietor filed a counterstatement denying the above grounds.

4) Only the registered proprietor filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 16 February 2005 when the applicant for revocation was represented by Ms Ennison of Ideal Home Ltd, and the registered proprietor by Mr Malynicz of Counsel instructed by Messrs f J Cleveland.

## REGISTERED PROPRIETOR’S EVIDENCE

5) The registered proprietor filed a witness statement, dated 4 July 2003, by Yvonne Ramsden the Publishing Director of the IDEAL HOME publication owned by IPC Media Ltd, a position she has held since March 1999. She notes that the applicant accepts that the mark in suit has been used in relation to a magazine published “from time to time” and also notes their request to reduce the specification. She states that in her view the specification is not unduly wide and is appropriate. She also disputes that the magazine is restricted, as claimed, to interior decoration stating that it covers cooking, gardening, travel, products for the home and garden, retail information and consumer advice. She states that the magazine, IDEAL HOME, has “enjoyed status as market leader in the “home interest” sector”.

6) Ms Ramsden states that although principally a magazine title the trade mark in suit is used on all publicity material, advertising and merchandising. She states that: “The “home interest” sector is one of the most competitive in the magazine business, yet the Registered Proprietors’ IDEAL HOME publication has been [the] market leader for many years”. She provides circulation figures within her statement and at exhibits YR2 & 3 which show the following:

Year	Revenue £ million	Magazine sales UK
1996	5.4	404,515
1997	6.7	392,777

1998	4.6	363,368
1999	6.4	435,847
2000	7.1	421,490
2001	8.1	427,128
2002	9.5	464,981

7) At exhibit YR1 she provides copies of pages from IDEAL HOME magazine which show use of the mark in suit during the period December 1997-June 2000 and shows articles on the diverse topics referred to in paragraph 6 above. At exhibit YR4 Ms Ramsden provides examples of the advertising that the registered proprietor undertakes to promote the IDEAL HOME magazine. This includes advertising in trade press, advertising aimed at the reader, money off promotions and special supplements under the mark in suit for national newspapers.

8) Lastly, at exhibit YR5 she provides copies of covers of two books both of which feature the mark in suit and which deal with entertaining (which has its emphasis on cooking) and kitchen planning.

9) That concludes my review of the evidence. I now turn to the decision.

## **DECISION**

10) At the hearing the applicant made it clear that the main thrust of the attack was to reduce the specification and that the complete revocation should be considered under 46(1)(b). The relevant part of Section 46 reads as follows:

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

(a)...

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

(c)....

(d)....

(2) For the 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.”

11) The applicant alleges that the mark has not been used in the five years prior to the date of the application for revocation. Under Section 46(1)(b) the period in question is, therefore, 18 December 1997 – 17 December 2002.

12) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. It reads:

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

13) In considering this matter I look to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] ETMR 34. This was an appeal against a decision by the Registrar. In that case the question of whether a very limited amount of use in this country can be regarded as sufficient to be “genuine” was considered. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

14) I also take into account the judgement in Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-39:

“35. Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks ‘must actually be used, or, if not used, be subject to revocation’. ‘Genuine use’ therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

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 origin of goods or services to the consumer or the 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 *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, 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 for 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 services 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 services concerned on the corresponding market.”

15) On the question of onus of proof I note the comments from the *NODOZ* case [1962] RPC 1, in which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, .....

16) The relevant facts before me are as follows:

- The registered proprietor has shown use at exhibit YR1 of the mark in suit on a monthly magazine during the period December 1997- June 2000.
- Revenue figures averaging £7 million per annum and magazine sales averaging over 420,000 per annum have been provided.
- Copies of pages from two books which show the mark have been exhibited.

17) The applicant did not contest that the usage shown was not genuine. To my mind the mark in suit has clearly been genuinely used on books and magazines during the relevant period 18 December 1997 – 17 December 2002.

18) The applicant also sought to reduce the specification down to “magazines relating to interior decorating for the home”. In determining this issue I look to the comments of Jacob J in the case of *Pomaco Ltd v Reed Consumer Books Ltd* [2000] FSR 734 where he said:

“Neuberger J’s attention was not drawn to the decision of Laddie J in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J was concerned with a very wide specification of goods: “computer programs”. In rejecting an application for summary judgement, he took the view that the wide specification could be cut down by a non use attack. In other words, that “computer programs” could be limited to computer programs of a particular part.

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. Indeed, “printed matter” in this case is 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 in 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 commercially nonsense to maintain the registration for all goods caused by the wide words.

That is not to say 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 specification.”

19) In a more recent case, Aldous LJ in *Thompson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 stated:

“In my view that 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.”

20) It is clear from these cases that there is no need for excessive detail in the description of goods/services and that a reasonable degree of generality can be tolerated. I have to consider how the reasonably well-informed and reasonably observant and circumspect consumer would describe the use that the registered proprietor has shown in its evidence. I must also bear in mind that the European Court of Justice (ECJ) has stressed the need for legal certainty and sound administration on several occasions , for example in Case C-273/00, *Sieckmann* [2002] ECR I-11737, paragraphs 37 and 46-55 in relation to representations, Case C-363/99, *Koninklijke KPN Nederland NV*, 12 February 2004, paragraphs 114-115, regarding limitations and most recently in the Opinion of A.G. Leger in Case C4-418/02, *Praktiker Bau-und*

*Heimwerkermarkte AG*, 13 January 2005, paragraphs 62-67, concerning specifications of goods and services.

21) Undoubtedly the magazine produced by the registered proprietor is fundamentally concerned with the home. However, from the evidence filed it is clear that the magazine covers a range of topics which include such as gardening, travel, cookery, retail information and consumer advice. The mark in suit has also been shown to be used on books. In my view restricting the specification to “magazines relating to interior decorating for the home” would not meet the dual requirements of legal certainty and sound administration. The request to limit the specification fails.

22) The application for revocation fails. I have taken into account the fact that this case was one of three where the evidence was very similar and a single hearing took place. I order the applicant to pay the proprietor the sum of £1000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 25<sup>th</sup> day of April 2005

George W Salthouse  
For the Registrar  
The Comptroller-General