

O-337-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2351479  
IN THE NAME OF EQUINOX PUBLISHING (ASIA) PTE LTD  
OF THE TRADE MARK:**

**EQUINOX**

**IN CLASSES 16 AND 41**

**AND**

**THE APPLICATION FOR A DECLARATION  
OF INVALIDITY THERETO  
UNDER NO 82335  
BY EQUINOX PUBLISHING LIMITED**

## **Trade Marks Act 1994**

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in the name of Equinox Publishing (Asia) Pte Ltd  
of the trade mark:  
EQUINOX  
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and the application for a declaration of invalidity  
thereto under no 82335  
by Equinox Publishing Limited**

### **Introduction**

1) On 28 November 2005 Equinox Publishing Limited, which I will refer to as EPL, made an application for the invalidation of registration no 2351479. The application for registration, under no 2351479, was made on 17 December 2003 and the registration procedure was completed on 19 August 2005. The registration is for the trade mark EQUINOX. The trade mark is in the name of Equinox Publishing (Asia) Pte Ltd, which I will refer to as Asia. The trade mark is registered for:

*printed matter; printed publications; books; magazines; newspapers; photographs; posters and prints; postcards; albums; folders; diaries, journals, address books, calendars, telephone indices; all the aforesaid relating to travel information;*

*publication services; publication of books and printed matter; publication of electronic books and journals and other reading matter online; electronic desktop publishing; photography; all the aforesaid relating to travel information.*

The above goods and services are in classes 16 and 41 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) EPL initially relied upon various rights to support its application, however, in its written submissions it limited the basis of its application to one trade mark registration and one basis for opposition. EPL bases its case upon Community trade mark registration no 3495827, which is owned by Equinox Viaggi Srl. The registration is for the trade mark:

**EQUINOXE**  
**V I A G G I**

The application for registration of the trade mark was made on 31 October 2003 and the registration procedure was completed on 2 June 2005. The trade mark is registered for the following services:

*representation of companies operating in the field of tourism (business and administrative management); administrative and business management of holiday villages, holiday apartments and camping sites;*

*warehousing, travel agencies, travel arrangement for individuals, travel arrangement for groups, rental of vehicles for transport by land, rental of vehicles for transport by water, rental of vehicles for transport by air, rental of boats, arranging of tours, transport;*

*dance halls, music halls, entertainment for individuals, providing recreation facilities, organisation of sports courses, publication of texts;*

*hotels, hotel reservations, services for providing food and drink.*

The above services are in classes 35, 39, 41 and 43 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The trade mark is described in the following terms:

“The trade mark consists of the word VIAGGI between two horizontal lines beneath the word EQUINOXE, all in special , upper-case, block letters.”

3) It is EPL’s claim that Equinoxe Viaggi Srl’s trade mark is similar to Asia’s trade mark and is registered for similar or identical services. Consequently, the trade mark of Asia was registered contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Asia denies the grounds for invalidation.

5)The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; EPL submitted written submissions with an amended statement of grounds. (The amendment to the statement of grounds struck out various bases for the opposition and so there was no need for an amended counterstatement. Indeed, EPL could have just abandoned the other bases for its application in its submissions.)

6) EPL furnished evidence but none of it has any bearing upon the outcome of the case. Included in the evidence was without prejudice correspondence, not all of which was marked without prejudice. In correspondence to the Registry Asia also included without prejudice correspondence. As the without prejudice correspondence has no effect upon the outcome of the application I see no need to recuse myself from deciding upon it.

### **The statute law**

7) Applications for the invalidation of a trade mark registration are governed by section 47 of the Act<sup>1</sup>. Section 47 of the Act allows an application for invalidation to be based

upon section 5(2)(b) of the Act. According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The trade mark the subject of registration no 3495827 is an earlier trade mark as per section 6(1)(a) of the Act<sup>ii</sup>. At the time of the filing of the application for invalidation there was no requirement for the applicant to be the owner or licensee of the trade mark registration upon which it relied<sup>iii</sup>. Owing to its date of registration, the earlier trade mark is not subject to the proof of use regulations.

### **Material date(s)**

8) In decision BL O/214/06 I dealt with the issue of material dates in relation to applications for invalidation based on relative grounds<sup>iv</sup>. In that decision I decided that in an invalidation action on relative grounds there are two material dates: the date of the application for registration and the date of the hearing; the grounds for invalidation had to exist at both material dates for an applicant for invalidation to be successful. I am not aware of any judgments since I wrote that decision which lead me to question my findings re the material dates. Indeed, the judgment of the CFI in *MIP METRO Group Intellectual Property GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/04* strengthens my view that there are two material dates. So, EPL has to establish the grounds for invalidation under section 5(2)(b) of the Act at the date of the application for registration and at the date of the writing of this decision, there having been no hearing. The earlier registration is valid as of the date of the writing of this decision. In the absence of any evidence that has a bearing upon this decision, I cannot see that the position of Asia can be any different at the date of the writing of this decision to that at the date of the filing of its application for registration of its trade mark. Consequently, I do not consider that in this case the existence of two material dates makes any difference.

### **Average consumer and nature of purchasing decision**

9) The class 16 goods of Asia's registration are goods that are bought by the public at large. They could be of high or low cost. Calendars, books etc are primarily purchased for their contents, consequently, it is unlikely that a great deal of attention will be paid to the trade mark under which they are sold. Consequently, in relation to such goods the potential effects of imperfect recollection are increased.

10) *Publication services; publication of books and printed matter* will include the specialist services of a publisher which will involve an author and/or his/her agent working with the publisher, usually through an editor of the publisher. Such services will be very specialist and the relevant public very limited. However, these services will also

include *publication of electronic books and journals and other reading matter online*; these services represent the electronic form of the hard copy. The average consumer for such services will be the public at large. The contents, subject and title of the works that are published are likely to be of key importance to the mind to of the average consumer, rather than the trade mark that is used in relation to them. Consequently, again, the potential effects of imperfect recollection are increased.

11) *Photography* services can be supplied both at a general level and a specialist level; they include taking wedding photos and taking photos for newspapers. At least in relation to the former type of activity the average consumer will be the public at large. In using photography services the public at large is likely to make a reasonably careful and educated decision. Such services are unlikely to be purchased on the spur of the moment. The nature of the purchasing decision means that the potential effects of imperfect recollection are decreased.

12) *Electronic desktop publishing* raises problems in the absence of any evidence in relation to the nature of the service. I have had great difficulty in envisaging exactly what the class 41 service in relation to this activity is, in the absence of any reference to instruction or education, which would firmly bring the services into class 41. The technical services in relation to *desktop publishing* will be akin to computer services and in class 42. The most common usage of the term *desktop publishing* is, in my experience, in relation to software for use on a personal computer. *Desktop publishing* is used to create works on the computer and the publisher may well use *desktop publishing* as a tool in the goods and services that it provides, however, this does not equate to a *desktop publishing* service any more than it would mean that the use of a pen could be classed as a *publishing service*. The only possible meaning that I can see that the term can have within the class is for a service where an author sends a work to a third party for that third party to use desktop publishing software to format the work in the appropriate manner. I do not know if such services actually exist, however, assuming that the term has some meaning in class 41, I cannot see that it can mean anything else. The user of such (possibly theoretical) services would be likely to make a careful and reasoned purchasing decision.

13) I note that all of the goods and services are related to travel information. I cannot see that this limitation will necessarily affect the nature of the average consumer and the nature of the purchasing decision. Although I accept it could be argued that the nature of the limitation means that the average consumer will even be more interested in the contents than the supplier of the contents.

## Comparison of trade marks

14) The trade marks to be compared are:

**Earlier trade mark:**

**Asia's trade mark:**

**EQUINOXE**  
V I A G G I

**EQUINOX**

15) The description of the earlier trade mark has no effect upon the rights which are engendered.

16) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details<sup>v</sup>. The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components<sup>vi</sup>. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind but he/she is deemed to be reasonably well informed and reasonably circumspect and observant<sup>vii</sup>. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public<sup>viii</sup>.

17) In terms of its size EQUINOXE dominates the earlier trade mark. It does not appear to have any descriptive meaning in relation to the services for which it is registered. I consider that EQUINOXE is the dominant component of the earlier trade mark, it is also a distinctive component. EPL submits that in relation to publishing I should take it as a matter of judicial notice that those involved are highly educated and will be familiar with the main European language. It also wishes me to take it as a matter of judicial notice that there are many native Italian speakers and also that many English speakers will know that EQUINOXE VIAGGI means equinox travels. EPL is asking me to assume on the basis of judicial notice that the average consumer will identify EQUINOXE VIAGGI as being Italian and knowing what the words mean. I consider that owing to its proximity to the word equinox the average consumer, if he or she knows what equinox means, will assume the EQUINOXE has the same or a similar meaning. There is nothing to suggest to me that the average consumer, even if a highly educated one, will know that viaggi is the Italian for travels. (I have no evidence before me to tell me that this is even the case.) There is no evidence of the number of native Italian speakers in the United Kingdom, I do not consider that whatever the number is, that they can be considered to constitute the average consumer. I do not accept that the meaning of VIAGGI will be known to the average consumer in the United Kingdom. Consequently, I consider that VIAGGI is a distinctive element of the earlier trade mark, if owing to its size and position and the distinctiveness of EQUINOXE, not the dominant element.

18) I don't consider that it requires a forensic analysis to reach the conclusion that EQUINOXE and EQUINOX are visually and phonetically very similar. Equinox is not, in my experience, a commonly used word. It is not a word that I have ever needed to use prior to writing this decision. I know of the word but have no clear idea of its meaning; although I assume that it derives from the Latin *aequus* and *nox* and so has a meaning in some way connected to equal and night. The conceptual association of a trade mark only has effect if the meaning is clear and grasped immediately<sup>ix</sup>. I do not consider that this is the case with EQUINOX, in the absence of evidence to this effect, for the average consumer for either the goods or the services of Asia's registration. Consequently, I consider that in relation to conceptual association the position is neutral; there is neither conceptual similarity or dissimilarity. Owing to the visual and phonetic similarities between EQUINOXE and EQUINOX nothing greatly turns upon this.

19) In comparing the two trade marks I have to consider them in their entireties. The two lines and VIAGGI are alien to Asia's trade mark. As I have stated above I consider that VIAGGI, in the United Kingdom, is a distinctive element. However, owing to its size and position I do not consider that it can be described as the dominant element. There is a great deal of phonetic and visual similarity between EQUINOXE and EQUINOX and I consider that the effects of these similarities is such that the respective trade marks must be considered to be highly similar.

#### **Comparison of goods and services**

20) In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose<sup>x</sup>, their method of use and whether they are in competition with each other or are complementary<sup>xi</sup>. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J also gave guidance as to how similarity should be assessed<sup>xii</sup>.

21) In "construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade"<sup>xiii</sup>. Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning<sup>xiv</sup>. The class of the goods in which they are placed is relevant in determining the nature of the goods<sup>xv</sup>. Consideration should be given as to how the average consumer would view the goods<sup>xvi</sup>. Specifications for services should not be given an over wide construction<sup>xvii</sup>.

22) In considering the similarity of the goods and services I have to consider the individual goods and services specified, unless the same ground of refusal is given for a category or group of goods or services, then I can use a general reasoning for all of the goods or services concerned<sup>xviii</sup>.

23) In my view the closest services of the earlier registration to those of Asia's registration are: *publication of texts*. *Publication of texts* cannot be unduly restricted and so must, in my view, include the electronic publication of texts. *Publication services; publication of books and printed matter; publication of electronic books and journals and*

*other reading matter online; all the aforesaid relating to travel information* will all include *publication of texts*. Goods or services can be considered to be identical when the goods or services of an earlier trade mark are included in a more general category in the specification of a later application<sup>xix</sup>. **Consequently, publication services; publication of books and printed matter; publication of electronic books and journals and other reading matter online; all the aforesaid relating to travel information must be deemed to be identical to publication of texts.**

24) I must base my view of *electronic desktop publishing* upon the basis of the only meaning that I consider it can have in class 41, as per paragraph 12. **As the service will be to put a work into publishable form I cannot see but that this term must be closely allied to publication of texts and I consider that it is, therefore, similar to a high degree to such services.**

25) *Photography* in class 41 relates to the services of a photographer, in this case the services will relate to travel information. Photographs might appear in a text but I cannot see that that makes the services that a photographer provide intersect, on the basis of the relevant legal tests, with the services of the earlier registration. In my view there is no real and concrete relationship between *photography* and the services of the earlier registration. **I consider that photography is not similar to the services of the earlier registration.**

26) The result of the publication of texts is that a hard or electronic copy appears. Without the services of the publisher the texts will not appear in print, without the text appearing in print (or electronically) the publisher's services have no purpose. There is a mutually dependent and symbiotic relationship between the publishing service and the result of the publishing service. Some complementary relationships can be so strained that the goods or services cannot be considered to be similar<sup>xx</sup>. The complementary relationship of the goods and services in this case is at the very other end of the spectrum. I take into account that publishing services normally use their own imprints upon the goods that they publish. **Owing to the nature of the complementary nature of the goods and services I am of the view that there is a high degree of similarity between publication of texts and the goods that could be the end result of the publication activity ie: printed matter; printed publications; books; magazines; newspapers; diaries, journals, address books, telephone indices; all the aforesaid relating to travel information.** In making this assessment I have born in mind that the services of the earlier registration are limited to the *publication of texts* and so in a normal and fair reading cannot be considered to cover the publication of *photographs; posters and prints; postcards; albums; folders; calendars, all the aforesaid relating to travel information*. In relation to the aforesaid goods I cannot see that there is any intersection in relation to the appropriate legal tests with the services of the earlier registration. I do not consider that the relationship with travel creates any meaningful intersection. **I consider that photographs; posters and prints; postcards; albums; folders; calendars, all the aforesaid relating to travel information are not similar to the services of the earlier registration.**



### **Likelihood of confusion – conclusion**

27) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa<sup>xxi</sup>. In this case I consider that there is a high degree of similarity between the respective trade marks. Some of the goods and services are not similar and so there cannot be a likelihood of confusion in relation to these. However, the other goods and services are either identical or highly similar and so both sides of the equation are in favour of EPL.

28) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion<sup>xxii</sup>. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public<sup>xxiii</sup>. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings<sup>xxiv</sup>. The earlier trade mark as a whole does not allude, at least in the United Kingdom, to the services for which it is registered. I consider that it has a high capacity to distinguish the services of Equinox Viaggi Srl from the goods and services of other undertakings and so enjoys a good deal of inherent distinctiveness.

29) Owing to the high degree of similarity between the trade marks and the identity or high degree of similarity between the respective goods, I do not consider that any amount of care in the purchasing decision is likely to obviate confusion. The likelihood of confusion is likely to be further increased by the effects of imperfect recollection. I have no hesitation in coming to the conclusion that in relation to the goods and services that are identical or similar that there is a likelihood of confusion.

**30) Under section 47(2)(a) of the Act I find that registration no 2351479 is invalid in respect of:**

*printed matter; printed publications; books; magazines; newspapers; diaries, journals, address books, telephone indices; all the aforesaid relating to travel information;*

*publication services; publication of books and printed matter; publication of electronic books and journals and other reading matter online; electronic desktop publishing; all the aforesaid relating to travel information*

**on the ground that it was registered in breach of section 5(2)(b) of the Act. The registration is to be cancelled in respect of the above goods and services. In accordance with section 47(6) the registration, in respect of these goods and**

services, is deemed never to have been made. This means that the residual specification will read as follows:

*photographs; posters and prints; postcards; albums; folders; calendars; all the aforesaid relating to travel information;*

*photography, all relating to travel information.*

## Costs

31) EPL having been successful is entitled to a contribution towards its costs. The evidence that it has filed has had no effect upon the outcome of the case, the section 5(2)(b) case was settled on a mark to mark and goods and services to services analysis. Consequently, I do not consider that EPL should receive a contribution towards the cost of the evidence that it has filed.

I award costs on the following basis:

Application for invalidation fee:	£200
Statement of grounds:	£300
Considering statement of case in reply:	£200
Written submissions:	£50

Total £750

I order Equinox Publishing (Asia) Pte Ltd to pay Equinox Publishing Limited the sum of £750. This sum is 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 13<sup>th</sup> day of November 2007**

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

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<sup>i</sup> “47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground -

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- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
  - (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A) But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless -

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,
- (b) the registration procedure for the earlier trade mark was not completed before that date, or
- (c) the use conditions are met.

(2B) The use conditions are met if -

- (a) within the period of five years ending with the date of the application for the declaration the earlier trade mark has 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, or
- (b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes -

- (a) 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
- (b) 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.

(2D) In relation to a Community trade mark, any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(3) An application for a declaration of invalidity 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.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

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(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

<sup>ii</sup> Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”.

<sup>iii</sup> See The Trade Marks (Relative Grounds) Order 2007 article 6(2).

<sup>iv</sup> “9) Having received the skeleton arguments, I notified counsel that I considered that it would be helpful to receive submissions in relation to what the material date(s) was. I drew their attention to the comments of Professor Annand, sitting as the appointed person, in BL O/227/05:

“My own view is that the starting point for assessing relative invalidity under section 47(2) is the date of the application for registration of the attacked mark. This is because Article 4 of the Directive: (i) defines “earlier trade marks” for the purposes of relative invalidity as trade marks with a date of application for registration which is earlier than the date of application for registration of the attacked mark; and (ii) requires other earlier rights to have been acquired before the date of the application for registration of the attacked mark. However, I believe the wording of Article 4 (section 47(2)) may allow the tribunal to take into account at the date when invalidation is sought, matters subsequently affecting the earlier trade mark or other earlier right, such as, revocation for some or all of the goods or services, or loss of distinctiveness or reputation. I do not find the fact that the Directive specifically provides for defences to invalidation of non-use, consent and acquiescence indicative either way. A further question concerns the cut-off date for taking into account subsequent events. Is this the date of the application for a declaration of invalidity or the date when the invalidity action or any appeal is heard? The Opinion of Advocate General Colomer in Joined Cases C-456/01 P and C-457/01P *Procter & Gamble v. OHIM*, 6 November 2003, paragraphs 43 – 44, and the Court of First Instance decision in Case T-308/01 *Henkel KGaA v. OHIM (KLEENCARE)*, 23 September 2003, paragraph 26, although concerned with registrability and opposition respectively, indicate the latter. There are indications that timing issues under the harmonised European trade marks law are beginning to be brought to the attention of the ECJ (see, for example, the questions referred in Case C-145/05 *Levi Strauss & Co. v. Casucci SPA*).”

I also asked them to consider the findings of the European Court of Justice (ECJ) in *Levi Strauss & Co v Casucci SpA* Case C-145/05. In that case the ECJ stated:

“17 The proprietor’s right to protection of his mark from infringement is neither genuine nor effective if account may not be taken of the perception of the public concerned at the time when the sign, the use of which infringes the mark in question, began to be used.

18 If the likelihood of confusion were assessed at a time after the sign in question began to be used, the user of that sign might take undue advantage of his own unlawful behaviour by alleging that the product had become less renowned, a matter for which he himself was responsible or to which he himself contributed.

19 Article 12(2)(a) of Directive 89/104 provides that a trade mark is liable to revocation if, after the date on which it was registered, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered. Thus, by balancing the interests of the proprietor against those of his competitors in the availability of signs, the legislator considered, in adopting this provision, that the loss of that mark’s distinctive character can be relied on

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against the proprietor thereof only where that loss is due to his action or inaction. Therefore, as long as this is not the case, and particularly when the loss of the distinctive character is linked to the activity of a third party using a sign which infringes the mark, the proprietor must continue to enjoy protection.

20 In the light of all the foregoing, the answer to the first and second questions must be that Article 5(1) of Directive 89/104 must be interpreted as meaning that, in order to determine the scope of protection of a trade mark which has been lawfully acquired on the basis of its distinctive character, the national court must take into account the perception of the public concerned at the time when the sign, the use of which infringes that trade mark, began to be used.

36 Accordingly, after revocation in the particular case has been established, the competent national court cannot order cessation of the use of the sign in question, even if, at the time when that sign began to be used, there was a likelihood of confusion between the sign and the mark concerned.

37 Consequently, the answer to the fourth question must be that it is not appropriate to order cessation of the use of the sign in question if it has been established that the trade mark has lost its distinctive character, in consequence of acts or inactivity of the proprietor, so that it has become a common name within the meaning of Article 12(2) of Directive 89/104 and the trade mark has therefore been revoked.”

Subsequently, counsel produced supplementary skeleton arguments and addressed this matter.

10) Under Article 4.4 (b) the rights must have been acquired prior to the date of application for registration. That right is also qualified as being a right that would confer upon the proprietor the right to prohibit the use of a subsequent trade mark. So one material date is clearly set out in the Directive. UK has to establish that by the date of application for registration, 18 December 1992, it could prevent the use of the trade mark under the law of passing-off. If it cannot do this its case is lost. It is well established that the material date for passing-off is the date of the behaviour complained of (see *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9). Owing to Article 4.4 (b) the date for establishing the preventive right cannot be later than the date of application, but passing-off is about the behaviour complained of. So one could look to a date earlier than the date of application if the behaviour complained of arose before the date of application. In this case the behaviour complained of is the use of the trade mark in relation to the goods of the registration. There is no evidence of any such use prior to 18 December 1992. So the first material date is the date of application.

11) Article 4.4 (b) of the Directive and section 47(2)(b) of the Act use the present tense. Too much can be easily read into the use of the present tense, it is the natural tense to use in legislative texts; which are not drafted by committees of philologists. The comments of Professor Annand and the judgment of the ECJ in *Levi Strauss & Co v Casucci SpA* suggest that a later date may also need to be considered; so that an applicant will not only have to succeed in its claim at the date of application but also at a later date. This is clearly the position in relation to grounds relating to the distinctiveness of a trade mark. The proviso to section 47(1) of the Act, derived from Article 3.3 of the Directive, states that a trade mark registered in breach of subsection (3)(1)(b), (c) or (d) of the Act shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered. So the Act recognises, at least in relation to certain grounds, that where the grounds no longer exist a trade mark shall not be declared invalid.

12) One can consider certain situations in relation to applications for invalidation on relative grounds. A registration is attacked on the basis of the law of passing-off. The registration was filed twenty years earlier. At the time that attacker could succeed, however, its goodwill has dissipated and the registered proprietor has built up its own goodwill. So the attacker would not have been able to succeed in a passing-off case for fifteen years. It would seem odd that such an attacker could succeed. A trade mark registration may have lapsed after the date of application for a registration and after it was registered. The attacker could prove use within the relevant period although it no longer had a trade mark registration. Again it would seem odd that a registration should be invalidated because of a trade mark registration that no longer existed. In *Levi Strauss & Co v Casucci SpA* the ECJ clearly considered that matters after registration of a

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trade mark had to be taken into account in an infringement action and will have a bearing on the remedies of the action.

13) It is difficult to see the purpose of invalidating a trade mark when the basis for the invalidation no longer exists. In these circumstances, I consider that the use of the present tense does have weight and effect; it is intrinsic to the purpose of the Directive and the Act. It is a position that is, in my view, recognised by the ECJ in *Levi Strauss & Co v Casucci SpA*. Consequently, there is a second later date that has to be considered in an invalidation action. What is that date? Ms Clark submitted:

“I think the same must apply here because otherwise you have an open-ended enquiry and it is difficult to see how you could ever complete the rounds of evidence. As a purely practical matter, I would tend towards saying that you are looking at the date of the application for a declaration of invalidity because I cannot see otherwise how you conclude your rounds of evidence or end up at a decision. Supposing you go up on appeal. Fresh evidence as to what has happened since the hearing below. Is it the case that when the rounds of evidence finish as in some cases happen in 2003 and then the parties talk for four years you get to 2007 and they say, "Oh, hang on a minute, things have moved on, Registry.”

So she adopted a pragmatic approach, which gave the second date as that of the date of application for invalidation. It is certainly a pragmatic approach that would be to the administrative convenience of the Registry. However, such an approach could be to the distinct inconvenience of a registered proprietor. The fundamental principle has to be, in my view, should the trade mark be declared invalid with all the evidence in and considered. In *Scandecor Development AB v Scandecor Marketing AB* [2002] FSR 7 Lord Nicholls stated:

“49 The claim in these proceedings is that, in consequence of the use made of the marks by Scandecor Marketing and Scandecor Ltd with the consent of Scandecor International, the marks are "liable to mislead the public". That is essentially a question of fact. That question of fact must be answered having regard to matters as they now are, not as they were at some time in the past. In deciding this issue of fact the court must have due regard, as I have been at pains to emphasise, to the message which a trade mark conveys. But since the question is whether the marks are currently liable to mislead, the message which is relevant is the message which use of the marks conveys today, not the message it would have conveyed to the public in the past.”

So he was looking at the date of trial as the date at which the question had to be considered. This was a case dealing with section 46(1)(d) of the Act, revoking a trade mark registration on the basis that in the consequence of the use made of it, it is liable to mislead the public. The principle seems good for an invalidation action on relative grounds. If at the date of the trial/hearing there is no longer a basis to invalidate a trade mark, should it be invalidated for administrative convenience. If one is attaching one self to the date of application for invalidation, does one ignore evidence filed in the evidence rounds dealing with matters after the date of application? The latter course of action would seem to be untenable. Taking the date of hearing as the second material date may give rise to administrative problems at times but administrative convenience should not override the purpose of the law. If late evidence is filed, there can always be compensation in costs for the other side. I consider that the second material date has to be the date of the hearing.

**14) So the first material date is the date of application for registration and there is a second material date, the date of the hearing. So for UK to succeed it has to establish that it could have prevented use of the trade mark as of 18 December 1992 and that it could also have prevented use of the trade mark on 6 June 2006. It has to succeed on both dates; if it fails in relation to the first material date, its case fails.”**

<sup>v</sup> *Sabel BV v Puma AG* [1998] RPC 199.

<sup>vi</sup> *Sabel BV v Puma AG* [1998] RPC 199.

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<sup>vii</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

<sup>viii</sup> *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

<sup>ix</sup> *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04.

<sup>x</sup> The earlier incorrect translation of ‘Verwendungszweck’ in the English version of the judgment has now been corrected.

<sup>xi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>xii</sup> He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

<sup>xiii</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

<sup>xiv</sup> *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

<sup>xv</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

<sup>xvi</sup> *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“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.”

<sup>xvii</sup> *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

<sup>xviii</sup> *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* C- 239/05.

<sup>xix</sup> *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05.



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<sup>xx</sup> As per the judgment of the CFI in *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-105/05:

“34 Lastly, it should be stated that there is a degree of complementarity between some articles of glassware, in particular wine glasses, carafes and decanters, on the one hand, and wine, on the other, in so far as the first group of products is intended to be used for drinking wine. However, in so far as wine may be drunk from other vessels and the articles of glassware mentioned above can be used for other purposes, that complementarity is not sufficiently pronounced for it to be accepted that, from the consumer’s point of view, the goods in question are similar within the terms of Article 8(1)(b) of Regulation No 40/94.

35 Having regard to all of the foregoing, it must be held that articles of glassware and wine are not similar goods. Consequently, there can be no likelihood of confusion between the conflicting marks and the applicant’s second plea must therefore be accepted.”

<sup>xxi</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

<sup>xxii</sup> *Sabel BV v Puma AG* [1999] RPC 199.

<sup>xxiii</sup> *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

<sup>xxiv</sup> *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.