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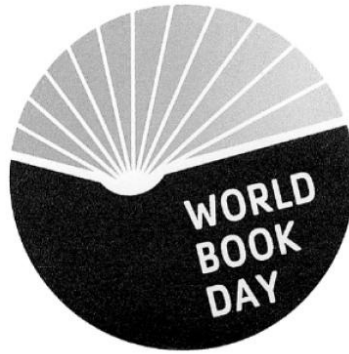
TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2497889

BY

WORLD BOOK DAY LTD

TO REGISTER THE TRADE MARK:



IN CLASSES 16 AND 41

AND

THE OPPOSITION THERETO

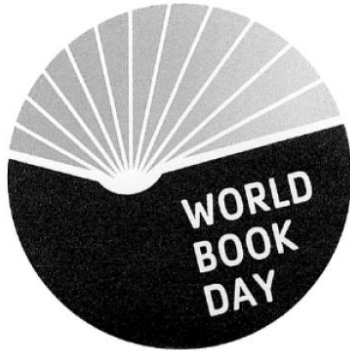
UNDER NO 99664

BY

WORLD BOOK, INC

Trade Marks Act 1994

**In the matter of application no 2497889
by World Book Day Ltd
to register the trade mark:**



**in classes 16 and 41
and the opposition thereto
under no 99664
by World Book, Inc**

1) On 17 September 2008 World Book Day Ltd (WBD) filed an application to register the above trade mark. The application was published for opposition purposes on 17 July 2009. The current specification of the application is:

paper, cardboard and goods made from these materials; printed matter; stationery; printed publications, not including encyclopaedias and reference works;

education; entertainment; on-line entertainment; cultural activities.

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) On 19 October 2009 World Book, Inc (Inc) filed a notice of opposition to the registration of the application. It bases its opposition upon section 5(2)(b) of the Trade Marks Act 1994 (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.”

3) Inc relies upon two trade mark registrations:

- United Kingdom registration no 2025177 of the trade mark WORLD BOOK. The application for registration was filed on 27 June 1995 and the registration procedure was completed on 11 July 1997. The trade mark is registered for:

encyclopedias and books, all on CD-Roms or in electronic form.

The above goods are in class 9 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. Inc claims that in the five year period ending with the publication of WBD's trade mark, 17 July 2009, it had used the trade mark in respect of all of the goods of the registration.

- Community trade mark registration no 103846 of the trade mark WORLD BOOK. The application for registration was filed on 1 April 1996 and the registration procedure was completed on 8 May 2000. The trade mark is registered for:

data bearing media; pre-recorded CD-ROMS, video cassettes, computer discs and diskettes, electronic games; encyclopedias, books and publications in electronic form;

encyclopedias, books and publications;

providing on-line publications in the nature of encyclopedias, books and other reference works through a global computer network.

The above goods and services are in classes 9, 16 and 42 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. Inc claims that in the five year period ending with the publication of WBD's trade mark, 17 July 2009, it had used the trade mark in respect of:

"At least date (sic) bearing media CD Roms, encylopedias, books and particularly including in electronic form and providing online publications in the nature of encylopedias, books and other reference works."

4) Section 6A of the Act reads:

"(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(4) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) 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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Under Section 100 of the Act the onus is upon the proprietor of the earlier trade mark(s) to show genuine use:

“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.”

5) As the trade marks had been registered for more than five years at the date of the publication of WBD’s application, they are subject to proof of use. WBD has required proof of use of the earlier trade marks. The application was published on 17 July 2009, so Inc must establish genuine use of its trade mark during the period 18 July 2004 to 17 July 2009 (inclusive).

6) Inc adduced into the proceedings, as an exhibit to a witness statement, a statutory declaration made by Denis Bertie Manning. The declaration was made on 18 June 1999 in relation to the application for the Community trade mark. None of the exhibits to the declaration are reproduced. He refers to sales of CD-ROMs from 1990 to 1994. The declaration cannot have a direct bearing upon establishing genuine use for the material period in these proceedings. At the hearing Mr Dunlop, for Inc, relied upon the declaration as a way of contextualising a statutory declaration made by Donald D Keller. Mr Keller is the interim president of Inc. Mr Keller states that Inc publishes reference and educational materials. Mr Keller states that Inc is a major international publisher of reference and educational materials. Mr Keller states that United Kingdom trade mark registration no 2025177 is registered for “ ‘Encyclopedias’ and books’ and ‘Encyclopedias and books, all on CD-Roms or in electronic form’”. This is not correct. The registration is solely for the latter goods. Mr Keller states that Inc’s turnover, including exports, in the United Kingdom for goods bearing the trade mark from 1988 to 1994 was around £39 million. He states that this figure comes from a declaration made by Mr Manning in relation to the United Kingdom registration; this declaration has not been adduced into the proceedings. Mr Keller gives “wholesale figures for articles that carry the World Book mark” from 2003 to 2009. However, there is no indication in the following paragraph as to which jurisdiction the figures relate. The figures are given in US\$; this is not significant, United States undertakings will often convert figures into their own currency as European undertakings convert figures into euros. Mr Dunlop submitted that, as in the previous paragraph Mr Keller refers to United Kingdom sales, it should be inferred that the wholesale figures refer to the United Kingdom. Mr Keller does refer to “[t]he more up to date wholesale figures for articles that carry the World Book mark”. However, it is an enormous jump to assume that Mr Keller is referring only to the United Kingdom. There is no clear sequential link between the paragraphs. It would have been easy enough for Mr Keller to identify the jurisdiction(s) to which the figures relate. The figures are

divided by “format” into “print”, “online” and “annuals”. There is no indication of the exact nature of these “articles”, as Mr Keller describes them. Mr Dunlop submitted that the articles should be considered by reference to the declaration of Mr Manning. However, there is a large gap in time between the declaration of Mr Manning and the period to which he refers and to the material period in these proceedings. Businesses constantly change their products, a matter that has been accelerated by the presence of the e-market in all areas of commerce. To adopt the approach of Mr Dunlop would be to indulge in conjecture and speculation. There is no indication, for instance, that any of the “articles” are CD-ROMs and none of the descriptions would naturally fit into this category. There is no indication as to what is meant by “annuals” or the nature of the “print” or the nature of the “online” content. Mr Keller states that “World Book, Inc produced the following number of different articles, which include different print products exported to the UK and online subscriptions”. The number of “different Articles” for the period 2003 – 2009 is listed. There is no indication as to the nature of the articles, of the “different print products”. There is no indication as to the nature of the online subscriptions and from where the subscribers emanate. Mr Keller states that:

“World Book, Inc’s trade mark appears on the spine, cover, title page and copyright page of each of the print publications and on the insert and disc of each CD and DVD as well as within the electronic copy”.

Mr Dunlop submitted that this statement indicated the nature of the goods to which Mr Keller is referring. However, there is nothing to indicate the nature of the content of the products, many of which are defined by their content. There is still also the question of jurisdiction hanging over the matter. Mr Keller refers to online subscriptions, again there is no indication as to the content of what is being subscribed to. One would expect a publisher to have records of publications, records that would be readily available and could be adduced into proceedings to show the nature of the goods upon which it is claimed that the trade mark has been used.

7) Ms Berkeley in her skeleton argument summarised what she considered the deficiencies in the evidence in the following terms:

“Some examples of the detailed points that can be made about the failure of the Opponent’s provided evidence to prove use of the mark ‘WORLD BOOK’, in relation to the relied upon specification of either trade mark, or in the required period, are as follows:

- (a) At paragraph 7 Mr Keller provides some figures which he describes as: “*wholesale figures for articles that carry the World Book mark*”. The geographical region to which these figure apply is not specified. Therefore immediately this evidence is of no relevance.

- (b) Further it is not clear what these “wholesale figures” actually designate - what are the acts that have taken place in relation to these goods? Therefore again these figures are of no assistance when trying to determine whether the necessary acts required to prove genuine use have taken place under the required mark, under the required goods. It should be noted that the figures given are in US Dollars which suggests that the acts in issue may well not take place in the UK or even in Europe.
- (c) Even if it is assumed that the figures provided at paragraph 7 are for a relevant region, or relate to relevant acts, the figures provided are “wholesale figures for articles”. The term ‘articles’ covers practically any goods in any class. Therefore no evidence has been provided in relation to the specification relied upon in the two earlier trade marks of the Opponent.
- (d) A little more detail is provided in the table under paragraph 7, under the heading ‘format’ the following words appear “print”, “online” and “annuals” however again these terms are very general and cover many different kinds of goods, and in particular cover many goods which do not form part of the specifications relied upon by the Opponent (or indeed as registered at all) in relation to the two earlier trade marks. For example ‘articles’ in ‘print format’ include posters. Neither of the specifications relied upon cover posters. Therefore the evidence provided does not show use in relation to the specified goods of the registration relied upon by the Opponent.
- (e) The evidence provided at paragraph 8 again is not relevant evidence. Here Mr Keller has provided some figures which list by year the number of different “*articles which include different print products exported to the UK and online subscriptions*”. Again the evidence provided does not relate to the relied upon specification of the earlier trade marks in issue. The evidence provided is with regards ‘articles which include different print products’, so appears to relate to other products as well as print products. Further ‘print products’ cover e.g. ‘posters’ and ‘stationery’ goods, which are not covered by the relied specification in either of the Opponent’s earlier trade marks.
- (f) The reference to ‘online subscriptions’ in paragraph 8 is not region specific nor are acts relating to ‘online subscriptions’ specified but in any event ‘online subscriptions’ is a very wide term and covers online subscriptions which relate to all subject matters. There is no mention of subscription services in the specifications of earlier trade marks in issue. All that is specified in the CTM in issue is “providing online publications in the nature of encyclopedias, books and other reference works through a global computer network”. Therefore no genuine use has been proved in relation to the actual services found in specification of the trade marks in issue.

- (g) No evidence is provided that the 'print products' and 'online subscriptions' referred to in paragraph 8 are sold under the WORLD BOOK trade mark in the UK .
- (h) The evidence given at paragraph 9 is again non region specific and is non date specific. All it does is give some evidence about prices of various "print articles".
- (i) The evidence given at paragraph 10 is again non region specific and non date specific. It certainly cannot be assumed that the evidence given in this paragraph, the marking of certain goods with 'World Book, Inc's trade mark' is meant to relate to print products exported to the UK (as mentioned in paragraph 8 of Mr Keller's Statutory declaration). In particular this cannot be right as the evidence at paragraph 10 is given in relation to "print publications" and "CD's and 'DVD's" which are different to the items described in paragraph 8. Also "print publications" and "CD's and 'DVD's" are very wide general specifications of goods which cover many other additional goods that are not included in the specifications of the two earlier trade marks relied upon in the TM7. Therefore again the evidence required to prove genuine use in relation to the specific specification of the earlier trade marks relied upon has not been provided.
- (j) Paragraph 11 simply provides evidence that representatives from World Book Inc attend the London Book fair (again not date specific). This provides no evidence of any use of the earlier trade marks in issue and no evidence of the goods or services to which such use of the mark is alleged to relate to."

8) There is not one example of the trade mark in use. A decision upon whether there has been genuine use of a trade mark is predicated upon the basis of seeing the trade mark in use. Mr Keller's concept of the trade mark being used and that of the decision maker or other parties may well be very different (decision BL O/069/11 shows how this perception of what is use of a trade mark can differ). In order for the decision maker to reach a decision as to whether there has been of the trade mark as registered (or within the parameters of section 6A(4)(a)) it is necessary for examples of the use to be adduced. What the proprietor considers use cannot be determinative and decisive. It would substitute the view of the proprietor for that of the decision maker, in fact make the proprietor the decision maker. It also does not allow the other party the ability to consider the nature of the use and so deprives the other party of its right to fair legal proceedings. There may be circumstances where the nature of the use cannot be demonstrated eg all the records of the company have been destroyed and no other records available. This, in the days of the Internet, is an unlikely event as a proprietor can use the Wayback Machine to access old Internet pages. The proprietor will also be able to access old press articles through various databases. The proprietor can also file evidence from third parties to describe the nature of the use. In this case there is no claim by Inc that it has no access to records. What is to be noted is that it has not put in one

exhibit showing use of the trade mark. Mr Keller refers to the use of the trade mark on the publications and electronic media and then fails to submit one exhibit to show the nature of the use. It is to be presumed that a publisher would be able readily to submit examples of use; books and electronic media stay in circulation for many years after the date of publication. At the worst, current examples of the use could have been given and Mr Keller could have stated that this was how the trade mark was used during the material period. Inc knew that the onus was upon it to establish genuine use.

9) In *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07* the General Court (GC) stated:

“105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).”

In *Laboratories Goemar SA's Trade Mark* [2002] ETMR 34 Jacob J stated:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye, to ensure that use is actually proved, and for the goods or services of the mark in question. All the ‘t’s should be crossed and all the ‘i’s dotted. In the present cases there was a difference between the total sales figures and relevant sales. Mr Mellor, for the applicants for revocation, told me that sorting out the wheat from the chaff involved a lot of work. In the end, however, he accepts that some very small potentially relevant sales under the marks were proved.”

Mr Dunlop’s submissions demand that genuine use is proved by reason of conjecture, rather than even by supposition, in respect of both the goods and services in relation to which use is claimed and the trade mark that has been used. (There is also a lack of clarity in relation to jurisdiction.)

10) In *Tripp Limited v Pan World Brands Limited* BL O/161/07 Mr Richard Arnold QC, sitting as the appointed person, stated:

“33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the evidence should not be accepted on

that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phipson* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence."

11) Mr Keller has made a declaration and it is accepted that what he states in the statement is what he believes to be the truth. However, the contents of the statement do not allow a clear identification of the goods and services in relation to which use has been claimed. As stated above, Mr Keller's view of how the trade mark has been used is one based on his perception and, in the absence of any exhibits, it is not possible for the decision maker or the other party to know if their perception is the same. It should not be difficult to identify the goods and service in relation to which use of the trade mark is claimed; this is a matter

readily in the hands of Inc. It should not be difficult to file exhibits showing how the trade mark is used and, after all, this is a sine qua non in relation to establishing use. If it is difficult or impossible to exhibit such use, an explanation should be provided as to the absence of the evidence. This is not a matter of doubting the declaration, this is a matter of where the deficiencies in the declaration are such that it is not possible to draw a conclusion in favour of Inc.

12) The evidence of Inc does not show how the trade mark has been used, it does not allow for the identification of the goods and services in relation to which use has been claimed. (There is also a lack of clarity in Mr Keller’s statement as to the jurisdiction(s) in relation to which his declaration relates.) As Inc has not established use of its trade mark, for either registration, in the material period, the ground of opposition under section 5(2)(b) of the Act, the sole ground, must be dismissed.

THE DEFENCE OF WBD

13) Mr Dunlop submitted that as WBD had denied that there was a likelihood of confusion but has not pleaded any basis for this denial, that the pleadings are not fully framed and fail to constitute any form of defence to the submissions made on form TM7, the notice of opposition. He submitted that the opposition should be granted on the grounds that no substantive defence had been made to it. In the notice of opposition Inc gives no basis for the claim that the respective goods and services are similar. It simply states that they are similar, it does not even identify any goods or services as being identical. It gives the same basis for both registrations upon which it relies, despite their encompassing different goods and services and the claim to use being different. It is difficult to see what distinguishes a simple claim of similarity to a simple claim of an absence of similarity. The analysis of the similarity of the trade marks is not extensive:

“The dominant part of the Application is WORLD BOOK – device of a book is common place and non-distinctive – and identical with the earlier right.”

Inc has given virtually nothing upon which WBD can comment. Although it is noted that the device is hardly common place, indeed, it is difficult to see it as a book. If Inc considered that the basis of the defence was deficient it had plenty of time to make this claim after the filing of the defence, 22 January 2010. WBD made its denial and requested proof of use of the trade marks of Inc. Mr Dunlop made reference to the Civil Procedure Rules, the Civil Procedure Rules do not apply to proceedings before the registrar¹. He also referred to TPN 4/2000. In that notice the registrar states:

“5. If, however, it is the preliminary view of the Registry that the statement of case is not adequately particularised, then the Registrar will adopt the following practice under the provisions of Rule 57 of the Trade Marks Rules 2000:

- i. The Registry will write to the opponent/applicant setting out the areas of the statement of case where it believes that the statement of case has not been adequately particularised and invite the opponent/applicant to file an amended statement of case.....
- v. The same practice will apply on receipt of any counter-statement. The Registry will scrutinise the document to ensure that any defence is adequately particularised. Any deficiencies will be raised with the party filing the document and copied to the other side.”

The contents of the counterstatement were not queried either by the registrar or the opponent, consequently, at the time of the filing there was a tacit acceptance of the validity of the counterstatement. It is far too late to object to the defence at the date of the hearing. (If the defence is not valid, it is difficult to see how the actual attack is valid owing to the lack of particularisation in relation to the similarity of goods.)

COSTS

14) WBD having been successful is entitled to a contribution towards its costs. Taylor Wessing LLP acted on a pro bono basis for WBD in these proceedings and so no costs accrue from its actions. The sole costs arise from the attendance of Ms Berkeley, who acted on a reduced fee of £1,500 (ex VAT); so any award of cost cannot exceed this sum. Taking into account the normal scale of costs it is considered appropriate to make an award of £500 for preparation for and attendance at the hearing.

15) World Book, Inc is ordered to pay World Book Day Ltd the sum of £500. 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 24 day of March 2011

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

A hearing took place on 17 March 2011.
Ms Iona Berkeley, instructed by Taylor Wessing LLP, appeared as counsel for WBD.
Mr Brian Dunlop of Wynne-Jones, Lainé & James LLP appeared for Inc.

ⁱ *Rhone-Poulenc Rorer International Holdings Inc and Imclone Systems Inc v Yeda Research and Development Co Ltd v The Comptroller of Patents Designs and Trade Marks* [2006] EHW 160 (Ch) Lewison J:

“43. Rorer's case was argued before the Hearing Officer on the footing that the criteria in CPR 17.4 should be applied to the hearing before him. In my judgment it is clear that the CPR do not apply to proceedings in the Patent Office. There is no power under the Civil Procedure Act 1997 to make rules for the Patent Office. Moreover, proceedings in the Patent Office are governed by their own rules; made under a different rule making power, and by a different rule making authority. Sometimes a separate procedural code will incorporate the CPR (see, for example, Insolvency Rules 1986 rule 17.51). But that is not the position under the Patents Rules.”

This finding was not found erroneous when the case was appealed to the Court of Appeal and the House of Lords.