

O-164-13

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATIONS 1383448 & 1383439
IN THE NAME OF VIRGIN ENTERPRISES LIMITED OF THE MARKS:

VIRGIN
&

A handwritten signature of the word "Virgin" in a cursive, black ink style. The letter 'V' is large and stylized, with a long vertical stroke that curves at the top. The rest of the word is written in a fluid, connected script.

AND

APPLICATIONS FOR REVOCATION THEREOF (NOS. 84358/9)
BY THE BODY SHOP INTERNATIONAL PLC

The background and the pleadings

1) Virgin Enterprises Limited (“Vel”) is the proprietor of the two trade mark registrations identified above, both of which were filed on 5 May 1989 and both of which completed their registration procedures on 5 July 1991. Both are registered in respect of the following goods in class 3:

Soaps, shampoos, perfumes, eau-de-cologne, toilet waters, essential oils, shaving preparations, after-shave lotions, shaving foams, non-medicated toilet preparations, non-medicated bath salts and bath oils; anti-perspirants, deodorants for use on the person, depilatories, dentifrices, mouth washes; cosmetics, suntanning and suncreening preparations; preparations for the hair, hair lotions, hair sprays; non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; talcum powders; nail varnishes and nail varnish removers, nail preparations, artificial nails and adhesives therefor, preparations for repairing artificial nails; artificial eyelashes and adhesives therefor; all included in Class 3; but not including Virgin oils.

2) The Body Shop International Limited (“Body Shop”) seeks revocation of the registrations on grounds of non-use under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). Vel filed a counterstatement denying the claims. No reference is made to there being proper reasons for non-use, therefore, the defence rests on there being genuine use of the marks. Only Vel filed evidence. The matter was heard before me on 13 March 2013 at which only Vel attended (being represented by Mr Julius Stobbs of Stobbs IP). Body Shop filed submissions earlier in the proceedings which have been borne in mind.

3) The relevant time periods relating to Body Shop’s claims are:

- i) Under section 46(1)(a): 6 July 1991 to 5 July 1996.
- ii) Under section 46(1)(b): 29 September 2005 to 28 September 2010.

Revocation is sought with effect from either 6 July 1996 or 29 September 2010, depending on the outcome of the claims.

Legislation and case-law

4) The relevant parts of section 46 of the Act read:

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

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his

consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c)

(d)

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made: Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

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

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

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

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

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

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

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

5) Section 100 is also relevant, which reads:

“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.”

6) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarised by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

Vel's evidence

Witness statement of Victoria Wisener

7) Ms Wisener is a trade mark attorney who works for Vel. Her evidence is from her own knowledge or from Vel's records. Much of her evidence focuses on the Virgin group of companies and its activities. I do not intend to summarise this evidence in detail. The question before the tribunal is whether the two registered trade marks the subject of this dispute have been genuinely used in relation to certain goods in class 3. My summary of the evidence will focus upon this. I note that Ms Wisener states that all of the businesses in the Virgin group use both the VIRGIN mark and the VIRGIN signature mark. She gives an example from the website of VIRGIN ACTIVE (a health club). I consider this to be a generalisation. I must consider the evidence put forward in relation to the class 3 goods.

8) In relation to the class 3 goods, Ms Wisener states that Virgin Cosmetics was formed in 1997 to provide cosmetics and beauty services through nearly 10,000 consultants and 16 stores in the UK. It is stated that cosmetics formed a significant proportion of its sales. She provides sales information of the “[b]randed products including cosmetics, toiletries, beauty products sold by the business”. In the years 2003-2008 the figures range from £42 million to £67 million. In Exhibit VW3, Ms Wisener provides a number of website prints from virgincosmetics.com. In Exhibit VW4 she provides “Virgin VIE” catalogues for the years 2006-2009. The prints/catalogues are as follows:

- i) A print from the website www.virgincosmetics.com. The dated year can only be partially read, it reads: 15/04/2. It is headed "THE VIRGIN COSMETICS COMPANY"; the word VIRGIN is stylised in a script as per registration 1383439. It is not possible to make out any of the products shown on the website (let alone what signs are used on them). There is small print at the bottom highlighting that VIRGIN (and other marks) are the trade marks of Vel.
- ii) A similar print to that above with the same partial date. It is headed THE VIRGIN COSMETICS COMPANY; the word VIRGIN is stylised in a script as per registration 1383439. It additionally contains a further image with the word VIRGIN (stylised in a script as per registration 1383439) with the words virgin.com below. The print contains a menu on the left hand side, one option is "Our Products" another is "Virgin Spa".
- iii) Another print with the same partial date. It is similarly headed and has the same additional image. It provides a form to be completed by someone wishing to become a "Virgin Vie Consultant". There are other uses of Virgin Vie on the print.
- iv) Another print with the same partial date. It is similarly headed and has the same additional image. It is headed "OUR PHILOSOPHY" and gives "THE STORY BEHIND THE DEVELOPMENT". There are a number of references to Virgin Vie.
- v) Another print with the same partial date, although the year can now be seen as 20??. It is similarly headed and has the same additional image. It refers to the same philosophy running through every "Virgin company". It refers to the Virgin business ethos. There appears to be a cosmetic product depicted on the page. It is not particularly clear, but clear enough, when later evidence is considered, to work out that it contains a stylised V device and the words VIRGIN VIE.
- vi) Another print with the same partial date. It is similarly headed and has the same additional image. It has a welcome "[t]o the Virgin Vie Shop" message. The print shows a lipstick, a cosmetic serum, a moisturizing serum/tonic, but the prints are so bad that any trade marks on the products cannot be read. The page also features jewellery.
- vii) Another print with the same partial date. It is similarly headed and has the same additional image. Amongst other elements, it has an entry for "colour" (with what appear to be lipsticks) and another for "skin care". But, again, the quality of the prints is too bad to identify any trade marks on the products.

- viii) Another print with the same partial date. It is similarly headed and has the same additional image. There is a reference to becoming a host of a “[V]irgin Vie party” where “our award winning cosmetic products” can be bought.
- ix) Another print with the same partial date. It is similarly headed and has the same additional image. There is a list of 23 of “our unique shops”. Some are identified as additionally having a VIRGIN Spa.
- x) A catalogue from 2006 headed “VIRGIN VIE at home”, as per the following image:



There are various cosmetic products on the front of the catalogue and also throughout it. Some feature a stylised V device and some feature the words VIRGIN VIE (some goods feature both). The VIRGIN VIE aspect is most commonly presented as follows:



The catalogue also contains jewellery. There is a reference to VIRGIN VALUE TIME which relates to a promotion whereby two items of jewellery may be purchased together for a cost saving. A similarly named promotion is in place for the purchase of three eye cosmetic products, and a further promotion for skin cosmetics. The catalogue also contains information about hosting a VIRGIN VIE party and becoming a VIRGIN Vie consultant. One such page is headed “Become a “Virgin””. The same page includes the company name “The Virgin Cosmetics Company Limited” and a reference to the webpage www.virgin.com/cosmetics.

- xi) A similar brochure from Christmas 2007. It has the same heading as above. It contains a welcome message making reference to Virgin Vie At Home and how to become a party host. A range of cosmetics are offered. There are references to VIE offers. There is further information on becoming a party host/consultant with reference to VIRGIN VIE AT

HOME. The word VIRGIN does not appear on the products which now either have a stylised letter V and/or the word VIE

xii) A similar brochure from Autumn/Winter 2008. It has the same heading as above and is of a similar nature – the products themselves do not have VIRGIN on them. A further brochure from 2009 is provided of a similar nature.

9) Ms Wisener provides information about Virgin Active, a fitness and health club business. As this relates to services, such as beauty treatments, it is not really pertinent to the question as to whether the marks have been used in relation to the class 3 goods. I will not summarise this evidence, or the rest of her evidence which returns, again, to the group as a whole.

Witness statement of Louise Goodsell

10) Ms Goodsell is a trade mark attorney representing Vel. Her evidence is to admit into the proceedings an investigation report produced for the purposes of opposition proceedings before OHIM relating to CTM 009326398. She notes that the report “clearly evidences that the VIRGIN and VIRGIN signature marks have been put to genuine use in the UK in relation to the contested class 3 goods since 29 September 2005.” In terms of the report, it focuses on the change from VIRGIN VIE AT HOME to VIE AT HOME which apparently took place in 2009. The investigator spoke to someone at VIE AT HOME who confirmed that they had previously sold goods under the VIRGIN brand when they traded as VIRGIN COSMETICS but they no longer had any association. Speaking to someone at Vel, it was confirmed that the cosmetics business left the [Virgin] group in December 2008 and they have had no cosmetics division since then. The executive summary of the report states that Virgin Cosmetics was set up in 1996 and was rebranded in 2005 as Virgin Vie At Home (there is an inconsistency in the latter date because elsewhere in the report the rebranding is said to have occurred in 2006). The subsequent change (leaving the Virgin group) is then discussed; there is again some date inconsistency – the executive summary reports this as December 2007 but later references refer to early 2009 and another to December 2008.

What forms of use can be relied upon?

11) Mr Stobbs focused his submissions on the period under section 46(1)(b) of the Act, namely: 29 September 2005 to 28 September 2010. This is sensible because if the registration survives the attack here, the period under section 46(1)(a) is academic. He considered that the use shown in Exhibit VW3 (points i-ix above) could be relied upon because even though it was not possible to see the dates on these prints, it could be inferred that the website looked like this for at least a part of the relevant period. He considered that this exemplified Vel’s use up to the point in time when THE VIRGIN COSMETICS COMPANY changed

its branding to VIRGIN VIE AT HOME. He also highlighted that the prints, although still carrying THE VIRGIN COSMETICS COMPANY branding, also included references to Virgin Vie, so being indicative that these prints were from around the time of the re-branding.

12) I do not consider that the material in Exhibit VW3 may be relied upon. It is undated. The witness provides little by way of commentary from which any form of inference may reliably be taken. In terms of the points raised by Mr Stobbs, websites and forms of use do change, and without better information it would not be right to assume that the website looked like this during the relevant period. In terms of the inclusion of references to VIRGIN VIE, I am far from satisfied as to the exact date that the rebranding took place. Furthermore, Vel may have begun making references to VIRGIN VIE before the rebranding took place, it would be wrong to infer that the prints emanate from within the relevant period. The simple answer is I do not know, nor does the witness profess to know, when these prints were live. This evidence is not reliable in terms of assessing use in the period 29 September 2005 to 28 September 2010.

13) The evidence in VM4 is, on the other hand, reliable. It consists of various brochures all of which fall within the relevant period. There are three distinct forms of use in these catalogues. There is i) the main VIRGIN VIE AT HOME heading (presented on the front page of the catalogues), ii) the use of VIRGIN VIE on the actual goods (although this is relevant to the 2006 catalogue only as subsequent to this the goods were marked only with VIE), and iii) the use of the words VIRGIN VIE/AT HOME as part of expressions such as becoming a Virgin Vie host.

Acceptable forms of use?

14) Section 47(2) of the Act provides that 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...". The Court of Appeal dealt with what I will describe as the use of a "variant mark" in *Bud/Budweiser Budbrau* [2003] RPC 25. Of relevance are the statements of Lord Walker of Gestingthorpe where he stated:

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

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with

Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of 'whose eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a 'global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I- 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

Also of relevance are the comments of Sir Martin Nourse; he stated at paragraph 12:

"Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements...."

15) I also take note of the comments of Mr Arnold QC (sitting as the Appointed Person) in *NIRVANA Trade Mark* (O/262/06) and in *REMUS trade mark* (O/061/08). In these cases Mr Arnold undertook a thorough analysis of the relevant case law, including judgments of the CJEU and the GC, and he then put forward the following questions, the answers to which will assist in determining whether a variant form of use represents an acceptable variant (the text is from *NIRVANA* but it is also adopted in *REMUS*):

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the subquestions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b)

alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all....”

16) I also note that Ms Anna Carboni (sitting as the Appointed Person) in *Orient Express* (BL O/299/08) considered that the question as to whether an element of a composite mark was an independent and distinctive element was an unnecessary addition to the variant mark test – she stated:

“71. But I do not regard his comment about the words maintaining an “independent distinctive role” within the composite mark as being a necessary step in the process. It seems to me that, whether or not the word element of a composite mark has an “independent distinctive role” may be relevant to the question of whether section 46(2) needs to be considered at all, but it is superfluous to the test laid down in *BUD* or the guidance given in *NIRVANA* and *REMUS*.”

17) However, she added that such a question may have relevance on the basis that an independent and distinctive element could, depending on the facts, be use of that element per se. Ms Carboni stated:

“78. If there is a place for the concept of one trade mark having “an independent distinctive role” within another, this is where it belongs. The essence of the argument is that there are some “composite marks” in which one or more elements within them have an independent distinctive role and therefore that use of the composite mark should be considered use of the element within it as well. In the context of section 46, there would be no need to resort to sub-section 46(2) in such a case, as use of the composite mark would include use of the registered element *per se*.

79. The term “composite mark” in this context is perhaps misleading. Most people would not describe the repeated words BUD-BUDVAR-BUDWEISER as a composite mark, but would see them – as the Court of Appeal said – as separate marks presented adjacent to each other. Similarly, the CFI in Case T-29/04 *Castellblanch SA v OHIM* [2005] ECR II-5309 spoke of “joint affixing of separate marks or indications on the same product”, giving the example in the context of wine products of the name of the winery and the name of the product, and said that “joint use of those elements on the same bottle does not undermine the function of [one of them] as a means of identifying the products in issue”.

80. In *Nestlé*, the ECJ concluded that an inherently non-distinctive trade mark could acquire distinctive character through use under article 3(3) of the Directive, whether it was used (i) on its own, or (ii) “as part of a registered trade mark”, or (iii) “as part ... of a component of a registered trade mark”, or (iv) as “a separate mark in conjunction with a registered

trade mark”. The only question of importance was whether, as a result of the use in each case, the relevant class of persons actually perceive the relevant goods or services as originating from a given undertaking.

81. The underlying issue in that case was whether the use of HAVE A BREAK ...HAVE A KIT KAT could have resulted in the element HAVE A BREAK acquiring distinctive character. The question in a non-use context would be whether the use of HAVE A BREAK ... HAVE A KIT KAT would amount to use of the registered trade mark HAVE A BREAK for the purpose of defending a revocation action.

82. I would expect the answer to be that it could do so in theory, but subject to proof on the facts that consumers perceive HAVE A BREAK to be used as an indication of origin, irrespective of the appearance of the additional words. It would be for the proprietor to overcome the practical difficulties of proving this state of affairs. I do not see why the theory should be any different in the case of a logo that contains both words and graphical elements, though the practical difficulties would be at least as great.

83. This is a difficult area, and one which has already been discussed in some detail by Richard Arnold QC in *REMUS*. Luckily, I do not need to take the argument any further in this case because it is too far from a situation where the submission could be made good on the facts. It is clear from my analysis in paragraph 74 above that I do not agree with the proprietor’s contention that the words ORIENT EXPRESS would be perceived as being used independently within the Logo. Additional evidence might have persuaded me of that, but none was available. The Hearing Officer was thus right to treat the case as one to which section 46(2) applied, and I have already made my decision in relation to that.

18) In its submissions, Body Shop argues that Vel’s use is not of its marks as registered and that any use that has been made is not of an acceptable variant. Mr Stobbs argued that the registered marks had simply be jointly affixed (he referred to the *Castellblanch* judgment which is mentioned in the extract from *Orient Express* above) with other matter and, as such, the use supports the registrations. He further submitted that if he was wrong on that, the form of actual use did not alter the distinctive character of the marks as registered.

19) I will consider firstly the signature form of use as follows:



The VIRGIN signature mark is registered in the following form:



20) In the form as used, the VIRGIN signature is presented in different script from the words VIE AT HOME. The signature is larger than the rest of the words. VIE AT HOME are words which are tied together, but the word VIRGIN is not clearly tied to it in a holistic way, the whole does not naturally hang together. The VIRGIN signature plays an independent role within the composite presentation and, in my view, the use counts as use of the VIRGIN signature per se. I note that the signature itself in the form as used is slightly different from the signature as registered. However, such differences are so small that they do nothing to alter the distinctive character of the mark as registered. In view of these findings the above use supports the use of the registered VIRGIN signature mark (registration 1383439) and may be considered in the assessment of genuine use. A secondary question may arise as to whether the above form of use also supports the VIRGIN word only mark; I will come back to this only if it is necessary to do so.

21) I next consider the following form of use:



The mark is registered as the plain word VIRGIN.

22) Again, the words VIRGIN and VIE do not hang together. The sizes of the respective elements differ. It could be argued that the presentation ties the elements together, but I nevertheless consider that the use made is of two marks simply brought together in a common presentation. The use smacks of house mark/sub mark. The use of VIRGIN in the above form supports the use of the word mark VIRGIN (registration 1383439) and may be considered in the assessment of genuine use. The corollary of the point I highlighted above also applies here as to whether the use of the plain word in the form above also supports the VIRGIN signature registration; again, I will only come back to this if it is necessary to do.

23) The final form(s) of use relates to the words VIRGIN VIE used more generally in the catalogues, often when referring to VIRGIN VIE consultants/hosts etc. Consistent with my finding in the previous paragraph, I consider that such use can be taken as use of the word mark VIRGIN per se. I add that my decisions are based squarely on the jointly affixing type of use (as

per *Orient Express* and *Castellblanch*) as opposed to the strict variant mark use which I no longer need to consider. I add that I am aware that the Court of Appeal has posed certain questions to the CJEU concerning jointly affixing use in case *International Healthcare Ltd, Specsavers BV, Specsavers Optical Group Ltd and Specsavers Optical Superstores Ltd v Asda Stores Ltd* [2012] EWCA Civ 24. However, the nature of the questions and their specifics do not, in my view, require that my decision be stayed pending the guidance that the CJEU may offer.

Have the marks been genuinely used?

24) In its written submissions, Body Shop criticises the evidence of Ms Wisener on the basis that the turnover figures are not clearly attributable to particular goods, no breakdowns being provided. However, I agree with Mr Stobbs that such criticism is not overly significant. Quite significant turnover figures (albeit not for the whole of the relevant period) have been provided. Catalogues have been supplied showing a wide range of goods being sold. It is not as though the use is primarily of a single product with other products providing an ancillary or less frequent role. I come to the firm view that, subject to the marks being used as trade marks in relation to the goods, the scale, frequency and quantum of use is more than sufficient for the purposes of maintaining or creating a share of the relevant market.

25) The VIRGIN signature mark is used on the front cover of the catalogues not on the actual goods themselves. However, it is clear from the catalogues that no third party brands are sold and that whilst the catalogue could be said to bring the goods contained therein together, the mark on the front cover will still be perceived as an overarching badge of origin for everything in the catalogues. Such use is therefore genuine use of the VIRGIN signature mark in relation to the catalogue goods.

26) The use of VIRGIN VIE on the products themselves (which I have said supports use of VIRGIN per se) is only really made in the 2006 catalogue. Again, the mark is used on a large breadth of goods. Although the frequency is less (because only use in the 2006 catalogue is relevant), the turnover, as already stated, is significant. I consider that this should also be considered as genuine use of the plain word VIRGIN for the goods in the catalogue. I should add that the plain words VIRGIN VIE in the context of hosts etc is also something which I consider, in the overall context of the evidence, to represent genuine use in relation to the goods - it will clearly be taken as an indication that the host etc is selling VIRGIN goods. In view of the above, both registrations have been genuinely used in the relevant period.

A fair specification

27) In terms of deciding upon a fair description, the description must not be over-*pernickety*². It is necessary to consider how the relevant public would likely describe the goods³. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladin”)* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

28) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

29) The catalogues provided in the evidence demonstrate use against a broad range of various cosmetic/personal care products. The breadth of use is sufficiently wide that broad categories of goods (such as cosmetics) may fairly be retained. However, if individual goods listed in the specification have not been used then such terms must be blue-lined. After the hearing, Mr Stobbs provided a list of goods which were sold in the catalogues; I have borne this in mind. Taking all of this into account, the following deletions should be made to the specification:

Soaps, shampoos, perfumes, eau-de-cologne, toilet waters, essential oils, shaving preparations, after-shave lotions, shaving foams, non-medicated toilet preparations, non-medicated bath salts and bath oils; anti-

perspirants, deodorants for use on the person, ~~depilatories, dentifrices, mouth washes~~; cosmetics, suntanning and suncreening preparations; preparations for the hair, hair lotions, ~~hair sprays~~; non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; ~~talcum powders~~; nail varnishes and nail varnish removers, nail preparations, ~~artificial nails and adhesives therefor, preparations for repairing artificial nails; artificial eyelashes and adhesives therefor~~; all included in Class 3; but not including Virgin oils.

30) The goods so deleted were not included in the list provided by Mr Stobbs. I do not see them in any of the catalogues. Such goods are hereby revoked from the registration with effect from 6 July 1996.

Costs

31) Vel has been largely successful and is entitled to a contribution towards its costs. I hereby order The Body Shop International Plc to pay Virgin Enterprises Limited the sum of £1800. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Filing evidence - £800

Preparing for and attending the hearing- £700

32) The above sum should 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 25th day of April 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**