

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTERED TRADE MARK No. 2102178 IN THE NAME OF TAKE-TWO INTERACTIVE SOFTWARE, INC.

AND IN THE MATTER OF THE APPLICATION FOR REVOCATION No. 84401 THERETO BY MITJA KRZISNIK

DECISION

Introduction

1. This is an appeal from the decision of Mrs Judi Pike, acting for the Registrar, dated 4 June 2013 (O-233-13), in which she partially allowed the application for revocation brought by Mr Mitja Krzisnik (*‘the Respondent’*) against a trade mark registration in the name of Take-Two Interactive, Software, Inc. (*‘the Appellant’*).
2. Trade Mark Registration No. 2102178 was filed on 7 June 1996. The Registration is for a series of 2 marks:

ROCKSTAR

ROCK
STAR

3. The registration covered the following goods in Class 25:

Articles of clothing; articles of leisure wear; t-shirts; jeans;
articles of denim clothing; headgear; footwear.
4. The registration procedure was completed on 20 December 1996.
5. On 24 April 2012 the Respondent filed an application for revocation of the registration in full under Sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (*‘the 1994 Act’*). The Respondent claimed that no use had been made of the marks in the forms as registered, for the goods as registered:

(1) In the five year period following registration of the mark i.e. from 21 December 1996 to 20 December 2001; and/or

(2) In the five year period 21 January 2001 to 20 January 2006.

Accordingly the Respondent claimed that the effective date for revocation of the trade mark was 21 December 2001 pursuant to Section 46(1)(a) of the 1994 Act; and/or 21 January 2006 pursuant to Section 46(1)(b) of the 1994 Act.

6. The Appellant filed a counterstatement which defended its registration by stating that the trade marks had been, and continued to be, put to genuine use in the United Kingdom, with respect to the goods specified.
7. Subsequently, the Appellant filed evidence of use in the form of a witness statement from John Falco, Director of Online Commerce of the Appellant.
8. On 27 December 2012, D Young & Co, the trade mark attorneys filed written observations on behalf of the Respondent. No evidence was filed on behalf of the Respondent.
9. On 23 April 2013 the hearing of the application for revocation took place before the Hearing Officer. At that hearing the Appellant was represented by Mr Mark Holah of Field Fisher Waterhouse LLP. The Respondent did not attend and was not represented.
10. Before the Hearing Officer, as is recorded in paragraphs 23 and 24 of her Decision, it was accepted in the skeleton of argument filed on behalf of the Appellant that:
 - (1) There had been no use of the second mark in the series; and
 - (2) There had been no use of the first mark in the series in relation to ‘*jeans*’, ‘*articles of denim clothing*’ or ‘*footwear*’ and that there was no objection to such items being deleted from the specification of the registered mark.

The Hearing Officer’s Decision

11. At paragraph 26 of her Decision the Hearing Officer found that in relation to the use of the first mark in the series ‘*the clothing which had been shown in the evidence is on a limited range – t-shirts, shirts, tops and baseball caps*’.
12. On the basis of the concessions made on behalf of the Appellant and those findings the Hearing Officer partially allowed the application for revocation pursuant to Section 46(1)(a) of the 1994 Act and held at paragraph 28 of her Decision that:

- (1) The second mark in the series was to be revoked from 21 December 2001;
 - (2) The first mark in the series ROCKSTAR was to remain registered;
 - (3) The registration for the first mark in the series ROCKSTAR would remain registered for '*Tops and baseball caps*'; and
 - (4) The registration for the first mark in the series ROCKSTAR would be revoked in respect of all other goods from 21 December 2001.
13. On the basis that each side had had a roughly equal measure of success the Hearing Officer made no order as to costs.

The appeal

14. On 2 July 2013, the Appellant filed a Notice of Appeal to the Appointed Person under Section 76 of the 1994 Act. There was no cross-appeal or Respondent's Notice filed on behalf of the Respondent.
15. In paragraph 7 of the Grounds of Appeal to the Appointed Person, it was stated that the Appellant did not contest the findings by the Hearing Officer regarding:
- (1) the proviso to Section 46(3) of the 1994 Act in paragraph 19 of the Decision;
 - (2) the relevant market in paragraph 21 of the Decision; and
 - (3) the genuine use of the Registered trade mark in paragraph 22 of the Decision.
16. In addition there was no statement in either the Grounds of Appeal, the skeleton of argument or in the course of the oral submissions that the Hearing Officer's finding of use of the first mark in the series in relation to '*t-shirts, shirts, tops and baseball caps*' in paragraph 26 of her Decision was incorrect on the basis of the evidence that was before her.

Standard of review

17. This appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.

The Grounds of Appeal

18. The Grounds of Appeal contend in substance, as was confirmed by the written and oral arguments on behalf of the Appellant that when making her findings in regard to the fair specification, as set out in paragraphs 24 to 26 of the Decision, the Hearing Officer omitted a number of factors which should have been taken into account.
19. In particular, it was contended on behalf of the Appellant that the Hearing Officer had not considered: (1) the *'circumstances of the trade and consumer perceptions, and activity, in relation to that trade'*; and/or (2) the balance between the interests of the proprietor of the mark, other traders and the public. In support of those arguments it was also said on behalf of the Appellant that *'Tops'* was not a suitable term for the specification because it was vague and not a term which *'consumers of clothing expect to see used to distinguish the range of goods of a particular business'*.
20. On the basis of these errors it was submitted on behalf of the Appellant that:
 - (1) *'t-shirts'* should not have been deleted from the specification;
 - (2) *'articles of clothing'* should not have been deleted from the specification; alternatively the term should have been amended to *'articles of casual clothing'*;
 - (3) *'articles of leisure wear'* should not have been deleted from the specification;
 - (4) *'headgear'* should not have been deleted from the specification; alternatively the term should have been amended to *'casual and sports headgear'*.
21. In paragraph 23 of the Grounds of Appeal (and confirmed in paragraph 7.1 of the skeleton of argument on behalf of the Appellant) it was maintained that the Hearing Officer should at a minimum have retained a specification in the following form *'articles of casual clothing; articles of leisure wear, tops; t-shirts; casual and sports headgear'*.

Part cancellation

22. Section 46(5) of the 1994 Act states: *'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'*. It is clear that the power provided by Section 46(5) of the 1994 Act must be exercised so as to give effect to Article 13 of Directive 2008/95 of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks which provides:

**Grounds for refusal or revocation or invalidity relating to
only some of the goods or services**

Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.

23. The current law on part cancellation for non-use was summarised by Arnold J. in Stichting BDO v. BDO Unibank, Inc [2013] FSR 35 at paragraphs [53] to [58]:

53. *Partial revocation: substantive aspects.* It is often the case that the trade mark proprietor has made genuine use of the trade mark in relation to some goods or services covered by the specification, but not others. In these circumstances art.51(2) of the Regulation (corresponding to art.13 of the Directive) requires the competent authority only to revoke the trade mark to the extent that it has not been genuinely used. This can lead to difficulties where the trade mark is registered in respect of a broad class of goods or services, but the proprietor has only established use of a narrower sub-class within that broad class.

54. As the Court of First Instance (now the General Court) held in Reckitt Benckiser (España) SL v OHIM (ALADIN) (T-126/03) [2005] E.C.R. II-2861; [2006] E.T.M.R. 50 :

“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 sub-categories to which the goods or services for which the trade mark has actually been used 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 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.”

55. In NIRVANA Trade Mark (BL O/262/06), when sitting as the Appointed Person, I reviewed the decisions of the English courts in MINERVA Trade Mark [2000] F.S.R. 734; [2001] E.T.M.R. 92 ; Decon Laboratories Ltd v Fred Baker Scientific Ltd [2001] R.P.C. 17; [2001] E.T.M.R. 46 ; DaimlerChrysler AG v Alavi [2001] R.P.C. 42; [2001] E.T.M.R. 98 ; Thomson Holidays Ltd v Norwegian Cruise Line Ltd [2002] EWCA Civ 1828; [2003] R.P.C. 32 ; West (t/a Eastenders) v Fuller Smith & Turner Plc [2003] EWCA Civ 48; [2003] F.S.R. 44 ; Associated Newspapers Ltd v Express Newspapers [2003] EWHC 1322 (Ch); [2003] F.S.R. 51 and ANIMAL Trade Mark [2003] EWHC 1589 (Ch); [2004] F.S.R. 19 . I concluded at [57] that these were broadly consistent with ALADIN, but that to the extent there was a difference I was bound by the English authorities. I went on:

“I derive the following propositions from the case law reviewed above:

(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: Decon v Fred Baker at [24]; Thomson v Norwegian at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: Decon v Fred Baker at [23]; Thomson v Norwegian at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: MINERVA at 738; Decon v Fred Baker at [21]; Thomson v Norwegian at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark:

Decon v Fred Baker at [24]; Thomson v Norwegian at [29]; ANIMAL at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: Thomson v Norwegian at [31]; West v Fuller at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: ANIMAL at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: West v Fuller at [58]; ANIMAL at [20].

(8) The exercise of framing a fair specification is a value judgment: ANIMAL at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties. This is not to say, however, that the tribunal is either obliged or entitled to ignore considerations of procedural justice and efficiency: see the observations of Advocate General Sharpston in BVBA Management, Training en Consultancy v Benelux-Merkenbureau (C-239/05) [2006] E.C.R. I-1458 at [62]–[68] ...”

56. In Pan World Brands Ltd v Tripp Ltd (EXTREME Trade Mark) [2008] R.P.C. 2 , again sitting as the Appointed Person, I considered the decision of the CFI in Mundipharma AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) (T-256/04) [2007] E.C.R. II-449 and continued as follows:

“54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in NIRVANA, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of Mundipharma indicates that the matter is to be approached from the consumer’s perspective.

55. To the extent that there is a difference between them, I remain of the view expressed in NIRVANA that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. Mundipharma suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in ANIMAL Trade Mark [2004] F.S.R. 19 is to be preferred to the slightly less generous approach of Pumfrey J. in Daimler Chrysler AG v Alavi [2001] R.P.C. 42.”

57. In Daimler AG v Sany Group Co Ltd [2009] EWHC 1003 (Ch); [2009] E.T.M.R. 58 Geoffrey Hobbs QC sitting as a Deputy High Court Judge summarised the correct approach at [10] as follows:

“... the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify. ...”

58. As Mr Hobbs added when sitting as the Appointed Person in Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd (BL O/345/10) at 11:

“For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

24. In paragraph 25 of her Decision the Hearing Officer identified the legal approach to deciding upon a fair specification, in circumstances in which Section 46(5) of the 1994 Act apply. She did so on the basis of: (1) Animal Trade Mark [2004] FSR 19; (2) Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd [2003] RPC 32; and (3) Euro Gida Sanayi Ve Ticaret Limited v. Gima (UK) Limited (BL O-345-10)(Geoffrey Hobbs Q.C.). It seems to me that the approach identified by the Hearing Officer is entirely consistent with the approach set out in the Judgment of Arnold J. in Stichting BDO v. BDO Unibank, Inc (above) and the approach of HHJ Birss Q.C. (as he then was) in Redd Solicitors LLP v. Red Legal Ltd [2012] EWPC 54 which was referred to in the course of argument before me.

Decision

25. In essence on appeal I have been invited to accept that use in relation to goods of species X was sufficient to enable a trade mark proprietor to maintain a registration for goods broadly described as the genus to which species X belonged, with the test for identification of the genus being one of consumer perception based on conceptions of nearness and relatedness derived from the way in which such goods are manufactured and retailed.

26. This argument was encapsulated in the skeleton of argument on behalf of the Appellant as follows:

5.5 Common knowledge suggests that clothing is not generally subdivided for the purposes of trade into “tops” and “bottoms”. A visit to any shopping centre or high street will reveal a large number of different retail outlets. There is generally a degree of sub-division among these outlets; however, that division is not usually on the basis of the part of the body covered. It is usually on the basis of whether clothes are for men or women or children, under wear, outerwear, casual or smart, low budget or upmarket and so forth.

5.6 The same categories tend to be found in terms of clothing manufacturers. A brand may be known for smart womanswear or for causal unisex clothing. With a few exceptions such as denim jeans, where there are well known specialist brands, it is unusual for a brand to be demarcated known [sic] in relation to a specific item of clothing.

...

5.8 It is submitted that “*tops*” is not a term which general consumers of clothing expect to see used to distinguish the range of goods of a particular business. Such consumers would, however, expect to see the use of a term such as “*casual clothing*”.

...

6.3 The average consumer, when purchasing a baseball cap, would usually find other types of “*casual and sports headgear*” including knitted hats, sunhats and beanies, in the same retail space, but would not find bowler hats or top hats. In this way, it is appropriate to consider “*casual and sports headgear*” as collectively forming a sub-category of headgear.

27. I do not accept that the approach for which the Appellant contends represents the correct way of determining the degree of particularity with which an order reducing the scope of the specification of goods or services under Section 46(5) of the 1994 Act should identify and define the goods for which the trade mark is to remain registered.

28. In this connection the observations of Geoffrey Hobbs Q.C. in Euro Gida Sanayi Ve Ticaret Limited v. Gima (UK) Limited (BL O-345-10) with which I agree are apposite:

. . . I consider that what the registered proprietor is seeking to do on this appeal is to enlarge the concept of fair protection so as to relate it far too closely to the test for assessing whether goods or services are “similar” to those specified in the registration of a protected mark under sections 5(2) and 10(2) of the Act.

The latter test generally calls for the overall pattern of trade to be considered in terms of the factors identified by Jacob J. in the British Sugar case: uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation.

However, that approach is adopted for the substantially different purpose of deciding how far the protection conferred by registration may extend beyond the situation of double identity, that is to say identity of marks and identity of goods or services covered by sections 5(1) and 10(1) of the 1994 Act

The scheme of the legislation is such that the test for assessing similarity of goods and services should not be collapsed back into the prior question of what the basic specification of the registration should be in the context of a successful application for part cancellation on the ground of non-use.

The test for assessing whether there is similarity sufficient to give rise to the existence of a likelihood of confusion does not, in my view, provide the test for determining what the basic specification should itself be.

The focus of attention under section 46(5) must be the umbra - - not the penumbra - - of protection which the registered proprietor can legitimately claim on the basis of the genuine use he has made of his mark.

29. In my view the Appellant in this appeal is likewise seeking to enlarge the concept of fair protection beyond what it can legitimately claim on the basis of the genuine use it has made of the mark.
30. It is also my view that when the Decision below is considered from the correct perspective it is clear that the Hearing Officer applied the law to the facts of the present case within the latitude allowed by the value judgment that she was required to make.

31. With specific regard to the Hearing Officer's use of the word '*Tops*' in the specification, I consider that everyone knows what a top is – a garment for the upper body. In my view its meaning is sufficiently clear and precise to satisfy the requirements for clarity and precision that is required of specifications in general. Moreover, as set out above, on this appeal the Appellant itself sought to have the word '*tops*' included in the specification. In those circumstances, it seems to me that the inclusion of the word '*tops*' in the specification is sufficiently clear and fairly balances the interest of the Appellant, its competitors and consumers.
32. For completeness, I should also make clear that I consider '*t-shirts*' are already covered by the word '*Tops*' in the specification and therefore there was no need for the Hearing Officer to separately include '*t-shirts*' within the specification.

Conclusion

33. In my judgment the specification which the Hearing Officer arrived at was one that she was entitled to come to. In the result the appeal fails.
34. I have no reason to believe that the Respondent to this appeal has incurred any or any appreciable costs or expenses in connection with this appeal. The appeal will therefore be dismissed with no order as to costs.

Emma Himsworth Q.C.

27 May 2014

Mr Hastings Guise (of Field Fisher Waterhouse LLP) appeared on behalf of Take-Two Interactive Software, Inc

Mr Mitja Krzisnik was not represented at the hearing and took no part in the Appeal

The Registrar was not represented at the hearing and took no part in the Appeal