

TRADE MARKS ACT 1994

IN THE MATTER OF Registration No 2190968

in the name of Phonenames Ltd

AND

IN THE MATTER OF An application under No 12171 by Airtours Plc

for the invalidation of the registration

Background

1. The trade mark 800 FLY CHEAP has been registered since 20TH August 1999 under registration number 2190968 in the name of Phonenames Ltd. It is registered in respect of:

Transportation of passengers by air; arranging of air travel, and of holidays, tours and trips consisting of air travel; air travel agency services and airline reservation services.

2. By an application dated 8th January 2001, Airtours Plc applied under Section 47(1) of the Trade Marks Act 1994 for the registration to be declared invalid. The ground upon which the applicant seeks its declaration is that:

The proprietor of Registered Trade Mark 2190968 made the application for registration of the sign 800 FLY CHEAP without any bona fide intention to make use of the sign as a trade mark within the meaning of the Trade Marks Act 1994 for the services in respect of which the registration was sought or any of them. The application was therefore made contrary to s3(6) of the Act.

3. The registered proprietor did not file a counterstatement and as such did not seek to defend the application for their registration to be declared invalid.

4. Evidence was filed by the applicant. The evidence accompanied the statement of grounds filed on 8th January 2001.

5. Acting on behalf of the Registrar and after a careful study of all the information before me I give this decision.

Decision

6. Despite having been notified of the application for the registration to be declared invalid, this action is uncontested by the registered proprietor. It does not follow however that the uncontested nature of this action will automatically mean success for the applicant and failure for the registered proprietor. The onus in these circumstances is on the applicant to prove why it is that the registration should be declared invalid.

7. I am mindful of the decision in the **Firetrace** case (BL 0/278/01) where the Hearing Officer states:

“It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to

such a request, I do not think that it necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

8. With the above in mind, I turn now to consider whether the evidence provided by the applicant is sufficient, in the prima facie case, to make good the ground pleaded.

9. The sole ground pleaded by the applicants is under Section 3(6); this states:

3(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

10. The particularisation of the applicant’s claim is that bad faith is alleged because the registered proprietor, at the time of filing the application for registration, had no bona fide intention to make use of the mark for the services listed. This relates to Section 32(3) of the Act which requires an applicant for registration to state that the mark is being used by him or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used. Consequently, the allegation of bad faith is based upon the fact that the Section 32(3) statement was made when there was in fact no intention to make a bona fide use of the mark for the listed services.

11. The applicants filed two pieces of evidence to support their request. The first, exhibit A to the applicant’s statement of grounds, is a list of trade mark applications/registrations standing in the name of the registered proprietor. It contains details of approximately 450 marks. I do not take much stock from this evidence except from the obvious fact that the registered proprietors are engaged in a pattern of making numerous applications to register trade marks. The applicant states that this evidence illustrates that the registered proprietor has developed a strategy of seeking to indirectly protect as trade marks, the alpha/numeric telephone codes utilised in the business activities of the registered proprietor. This may be so, but there is not evidence before me to make a finding on this issue. I do however take some cognisance from the fact that the applications/registrations listed in this evidence must cover a broad range of goods and services, some 23 classes are covered by this list. It seems unlikely to me that any single company will trade across such a breadth of goods and services as those detailed in these marks.

12. The second piece of evidence, exhibit B to the applicant’s statement of grounds, consists of pages taken from the web-site under the control of the registered proprietors. The pages appear to have been printed from the web-site on 2 January 2001. This seeks to demonstrate the normal day to day business activity of the registered proprietors. From perusing the evidence, the day to day business of the registered proprietor seems to be a service by which they provide to their customers an alpha/numeric telephone code and equivalent domain name. As the registered proprietor has taken no part in these proceedings, there is no evidence to the contrary to suggest that the registered proprietors have a more diverse trade than this.

13. It must be borne in mind that what we are dealing with here is not a question of the use the mark has been put to, but an allegation that at the time of filing there was no intention to make use of the mark for the services applied for. A registered proprietor is entitled under the framework of the Act to a grace period of five years, commencing from the date that the

registration process is completed, in which to make use of the mark. To interfere with this normal allowance can only be entertained if I am content that the registered proprietors had no intention to make use of the mark for the services sought when the mark was applied for. This is particularly important given the fact that the evidence filed to demonstrate the business activities of the registered proprietor was obtained in January 2001, rather than August 1999 which is when the application for registration was filed.

14. Furthermore, the past or indeed the present trading activities of a trader must be treated with caution when questions as to their future intentions are raised. These factors can be no more than an indicator as to their future trading intentions. Brand extension is a relevant circumstance to consider. Many traders operating in today's commercial world often seek out new markets and new product/service ranges and as such it is difficult for anyone to second guess what the future trading intentions of a particular trader may be.

15. The applicant's evidence leads me to accept that according to the registered proprietor's web-site there is no trade being carried out in relation to the services detailed in the application. I am therefore asked to some extent to infer from this that the registered proprietor will not have had the intention to trade in the services listed in the application for registration. The applicant's position would have been strengthened if they had furnished direct evidence to demonstrate that the registered proprietor is not trading in the services detailed rather than the somewhat circumstantial evidence filed. Although, as mentioned earlier in this decision, I do take note of the breadth of goods and services that will be covered by the list of trade mark applications/registrations filed by the registered proprietor and the resultant unlikelihood that any single company will trade across the width of goods and services detailed.

16. However, I am somewhat led in the circumstances of this case by a simple perusal of the type of services in question. There is an immense state of incongruity between the type of services detailed in the registered proprietor's web-pages compared to that of the services detailed in the registration in suit. I accept that the registered proprietor is a service provider in the field of the provision of alpha/numeric telephone codes but I can not accept that they would be likely to extend trade to the provision of air travel and air travel agency services. This is not an obvious extension of trade, in my view.

17. In view of the foregoing and with no defence having been filed by the registered proprietors, I am of the opinion that the applicant has made out a prima facie case and that the registered proprietors did not have a bona fide intention to use the mark for the services applied for; accordingly the ground pleaded under Section 3(6) is successful.

18. As the applicant has been successful in their request for invalidation, I declare the mark to be invalid and I direct that it be removed from the Register, and deemed never to have been made.

Dated this 29 Day of October 2001

**Oliver Morris
For the Registrar
the Comptroller General**