

O-311-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION UNDER No.80121  
BY SIEMENS NIXDORF INFORMATIONSSYSTEME AG  
FOR THE REVOCATION OF TRADE MARK No. 1235377  
IN THE NAME OF IMPERIAL CHEMICAL INDUSTRIES PLC  
(INTERVENORS ABB LIMITED)**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF an Application under No. 80121 by Siemens Nixdorf Informationssysteme AG for the Revocation of Trade Mark No. 1235377 in the name of Imperial Chemical Industries Plc (Intervenors ABB Limited)**

#### **BACKGROUND**

1. Trade mark registration No. 1235377 is in respect of the mark PROVUE and is registered in Class 9 for:

“Computer programmes recorded on paper, card, tape or disc.CANCELLED IN  
RESPECT OF : Computer programs being adapted for use in industrial process control  
apparatus.”

2. The mark was registered on 21 August 1986 with registration effective from 8 February 1985.

3. By an application dated 24 October 2001 Siemens Nixdorf Informationssysteme AG applied for the registration to be revoked by virtue of Section 46(1)(a) or Section 46(1)(b) of the Act on the grounds that the mark in suit has not been used by the registered proprietor or with his consent in the UK in relation to computer programmes recorded on paper, card, tape or disc, either within the period of five years following the date of completion of the registration procedure and there has been no subsequent commencement of use or for an uninterrupted period of five years prior to the filing of the revocation request and there are no proper reasons for non-use.

4. The registered proprietor filed a Counterstatement denying the grounds of revocation stating that PROVUE is the trade mark of a product that comprises a windows based database computer programme for the production of datasheets, equipment lists and production stream lists, adding that the database is in use by both the current beneficial owner (ABB Limited) both for its own internal use and as a product licensed extensively to third parties supported by a user helpdesk service.

5. By way of further explanation it is stated in the counterstatement that the relationship between the registered proprietor and the PROVUE users is considered material as it explains the route to the use of PROVUE as due to various sale and restructuring activities, beneficial ownership in PROVUE has changed on a number of occasions. The following clarification is provided –

“(i) Following its inception and registration as a trade mark, PROVUE was used by Imperial Chemical Industries Plc through several of its business units and subsidiaries. Technical maintenance, support and ongoing development was undertaken by ICI Technology, its in house engineering capability. Use by

Imperial Chemical Industries Plc included the controlled use by divested businesses and use by external contractors acting on its behalf in carrying out services and projects for its various businesses.

- (ii) As part of its business restructuring, in January 1999, the expertise in the use of PROVUE together with sole rights to licence PROVUE to third parties was transferred to Eutech Engineering Solutions Limited, a wholly owned subsidiary. Eutech continued to provide a service within ICI but also licensed PROVUE to third parties. Since Eutech Engineering Solutions Limited was a wholly owned subsidiary, the registered proprietor of the PROVUE mark remained Imperial Chemical Industries Plc.
- (iii) In January 2001, Imperial Chemical Industries Plc sold its 100% shareholding in Eutech Engineering Solutions Limited to ABB. Through the contract of sale and subsequent completion documentation, beneficial ownership in the PROVUE Trade Mark passed to Eutech Engineering Solutions Limited. Following the purchase, the name of the company was changed to ABB Eutech Limited. However ABB were undergoing a re-structuring of their UK companies and therefore assignment of the name of the Registered Proprietor was not undertaken until the future of ABB Eutech Limited was known. In January 2002 ABB Limited was set up as a single legal entity. This now sets the path for the assignment of the registration from Imperial Chemical Industries Plc to ABB Limited.”

6. Evidence of use of the mark was filed on behalf of the registered proprietor under Rule 31(2) and both sides asked for an award of costs in their favour. Neither party filed further evidence. The parties were content for a decision to be taken without recourse to a hearing and no written submissions were forwarded for the Hearing Officer’s attention.

#### **RULE 31(2) EVIDENCE**

7. This consists of a statutory declaration by Malcolm Pass who is the PEL Business Development Manager of ABB Limited (the intervenors in these proceedings).

8. Mr Pass explains that ABB Limited, as part of its business, markets, sells and services the PROVUE product as part of a suit of software products known collectively as PEL software. He adds that he has been employed in the technical support and the development of PEL products, including PROVUE, since 1982 and that the support team and the products transferred from Imperial Chemical Industries Plc to Eutech Engineering Solutions Limited in January 1999 and then in January 2001 through ABB Eutech Limited to the current beneficial owner, ABB Limited in January 2002.

9. Mr Pass states that the PROVUE trade mark in the form registered has been in continuous use in the UK during the last five years. He refers to Exhibit 1 to his declaration which comprises a list of some 32 licensees with the dates when their current licenses were taken out, the earliest date being 1 January 1998. Next Mr Pass refers to Exhibit 2 to his declaration which consists of

a “flyer” relating to a product and support service description for the ABB PEL suit of software packages which contains reference to “ProvueDB” as a key component. Mr Pass goes on to state that PROVUE is also marketed as a standalone package and he draws attention to Exhibit 3 to his declaration which comprises a “flyer” relating to a “PROVUE DB” “Provue DB”, or “ProvueDB” tool for creating and managing process datasheets.

10. Mr Pass explains that PROVUE is supplied in response to a User Requirement Specification being agreed with a customer and all output from the PROVUE system, both on screen and on printed statements, contains the PROVUE name.

11. This completes my summary of the evidence filed and I now turn to the decision.

## **DECISION**

12. Section 46 of the Act states:

“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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes 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.”

13. In addition Section 100 of the Act is relevant. It reads:

“100. 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.”

14. The applicant’s grounds refer to Section 46(1)(a) and Section 46(1)(b) of the Act. Once this application for revocation was made, the effect of Section 100 was to place the onus on the registered proprietor to show the extent and nature of the use made by it of the mark.

15. Firstly, I should note that the registered proprietor of the mark, as shown on the register, is not the current beneficial owner of the mark as ownership has rested with the intervenor, ABB Limited since January 2002 and its predecessor in title since January 2001. The official notification of the assignment to the Registrar is pending. However, during the relevant periods to which this revocation action relates, the intervenor states that, in addition to ABB, the registered proprietor (Imperial Chemical Industries Plc) used the mark and licensed the mark to

third parties and that the mark was later used and licensed out by a wholly owned subsidiary of the registered proprietor with the registered proprietor's consent. While the background to the ownership of the mark in suit is a little complex I do not believe that it effects the overall position in relation to these proceedings.

16. The registered proprietor/intervenor must show genuine use of the mark within the relevant period if the registration is to be successfully defended (there being no claim that there are proper reasons for non-use).

17. The concept of "serious/genuine use" was considered in the Opinion of Advocate General Colomer given on 2 July 2002 in Case C40/01, *Ansul BV v Ajaz Brandbeveiliging BV* in which, at paragraphs 56 to 58, the Advocate General stated the following:

"56. The concept of the trade mark and the characteristic functions of this form of industrial property also require public and external use, directed at the outside world. It is necessary, through its exploitation, for the trade mark to be present on the market for the goods or services which it represents. Consequently, we may speak of genuine use if goods are sold or services are supplied, but also where the mark is used for advertising purposes, in order to introduce the goods or services to the market.

57. On the contrary, private use, which does not extend beyond the proprietor's internal sphere, is irrelevant, in so far as it is not aimed at winning a share of the market. In this way, measures taken in preparation for marketing goods and services or storage and warehousing without leaving the company premises cannot constitute "adequate" and "genuine use". The use consisting of affixing the mark to goods or to their packaging for export purposes is considered relevant only as an exception. This exception is justified by the need to protect firms whose business is concentrated on exports and which, through no exploiting a trade mark on the internal market, run the risk of losing it through disuse.

58. To sum up, we can only speak of genuine use where the trade mark, in the form in which it was registered, is used publicly and with external relevance, to open up a niche in the market for the goods or services which it represents."

18. Where does the registered proprietor/intervenor stand in light of the above? The evidence of use comes from three exhibits attached to Mr Pass' statutory declaration of 12 February 2002 – Exhibit 1 which comprises a list of licensees with the dates when their current licenses were taken out; and Exhibits 2 and 3 which consists of promotional "flyers" which refer to the "PROVUE DB", "ProvUE DB" or "ProvUEDB" software product, a tool for creating and managing process datasheets.

19. Turning to a consideration of the above evidence, Exhibit 1 is not, conclusive as to "genuine use" of the mark in suit as it merely shows a list of licensees or users of the product and does not show use of the mark itself on or in relation to goods. While the licensing activity falls within the relevant period and in my view would amount to public and external use in its fundamental nature and extent, there is no detail to show use of the mark in relation to the licenses.

20. I now go to Exhibits 2 and 3 which are undated, although the reference codes for the flyers ie. “FLY 106a/0301/01” and “Fly 142a/0600/01” could infer by virtue of the “/01” element that they were circulated in 2001, bearing in mind that any use of the mark after the date of application for revocation (24 October 2001) must be disregarded. Furthermore, neither Exhibit 2, nor Exhibit 3, show use of the mark as registered ie. the mere word PROVUE, as in all instances of use within these exhibits, the mark is used with the additional letters DB following the word, either as “PROVUE DB”, “Provue DB” or “ProvueDB”.

21. Section 46(2) of the Act is relevant and it reads as follows:

“46.(2) For the purposes 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.”

22. From the above it follows that if the addition of the letters DB alters the distinctive character of the mark in the form in which it was registered, there will have been no use of the mark for the purposes of Section 46(1) of the Act.

23. In my considerations in relation to the distinctive character of the mark I am guided by the following comments of Lord Walker of Gestingthorpe who in the recent Court of Appeal decisions in *Budejovicky Budvar Narodni Podnik v Aneuser Busch Inc* (A3/2002/0048. A3/2002/0049), stated at paragraphs 43 to 45:

“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 judgment, 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 paragraph 26 of the judgment of the Court of Justice in *Lloyd Schufabrik v Klijsen Handel* [1999] ECR I – 3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

24. It seems to me that the addition of the letters “DB” to the word mark registered has a significant visual, aural and conceptual impact. The letters are readily visible, are likely to be spoken in aural use and have an obvious impact upon the customer so much so that the mark, shown in the evidence of use is in totality, different from the registered mark. There is no evidence to the effect that the letters DB are descriptive or non-distinctive in relation to the goods e.g. as an acronym, or that they are used in a non trade mark manner by the proprietor e.g. as a catalogue reference. Indeed, the “flyers” exhibited as Exhibits 2 and 3 to Mr Pass’ declaration, infer that “PROVUE DB”/“Provue DB”, or “ProvueDB” is used, in its totality as a trade mark.

25. Taking into account the visual, aural and conceptual impact of the additional element (the letters “DB”) to the registered mark and the consequential totality and taking into account the evidence of how the mark has been used in relation to the relevant goods, on a global appreciation I believe the mark used by the proprietor intervenor possesses a different distinctive character from the mark in the form in which it is registered.

26. Consequent to my decision that the mark shown to be used is in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered, the application for revocation under Section 46(1) of the Act must succeed. In accordance with Section 46(6)(a) the rights of the proprietor shall be deemed to have ceased as from the date of the application for revocation.

## **COSTS**

27. As the application for revocation has been successful, the applicant is entitled to a contribution towards costs. I therefore order the proprietor/intervenor to pay the applicant the sum of £700 which takes into account that no hearing took place on this case and that only Rule 31(2) evidence was filed. This sum is to be paid within seven days of the expiry of the period allowed for appeal or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of October 2003**

**JOHN MACGILLIVRAY**  
**For the Registrar**  
**the Comptroller General**