

O-059-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 1339408  
IN THE NAME OF CONTINENTAL SHELF 128 LIMITED  
OF THE TRADE MARK:**

**EINSTEIN**

**AND THE APPLICATION FOR REVOCATION THERETO  
UNDER NO 81880  
BY THE HEBREW UNIVERSITY OF JERUSALEM**

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in the name of Continental Shelf 128 Limited  
of the trade mark:  
EINSTEIN  
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thereto under no 81880  
by The Hebrew University of Jerusalem**

### **BACKGROUND**

1) Trade mark registration no 1339408 stands in the name of Continental Shelf 128 Limited, to whom it was assigned on 31 August 2000; the application to record the assignment was received by the Trade Marks Registry on 26 February 2002. It is for the word only trade mark EINSTEIN. The registration process was completed upon 10 August 1990. The trade mark is registered for:

*articles of clothing included in class 25.*

I will refer to Continental Shelf 128 Limited as Shelf.

2) On 5 October 2004 The Hebrew University of Jerusalem, which I will refer to as University, filed an application to revoke the registration. University states that investigations into the use of the trade mark have established no incidences of use by Shelf or with Shelf's consent in the United Kingdom for the five year period between 19 July 1999 and 19 July 2004. University states that, consequently, registration of the trade mark is contrary to section 46(1)(b) of the Trade Marks Act 1994 (the Act). University states that if Shelf is able to show some use of the trade mark in the relevant period the specification should be restricted in accordance with the provisions of section 46(5) of the Act. University requests that revocation takes effect from 19 July 2004. University seeks an award of costs.

3) A counterstatement, which includes evidence to show use of the trade mark, was filed; I shall deal with the evidence below. It is stated that the trade mark has been put to genuine use within the previous five years by Shelf or with Shelf's consent. It is stated that the evidence shows that the trade mark has been used in respect of various articles of clothing. It is stated that, consequently, there is no basis for a restriction of the specification. Dismissal of the application and an award of costs are sought.

4) The only evidence filed in this case was that filed with the counterstatement.

5) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing. Both sides filed written submissions. Consequently, this decision is made from the evidence and written submissions before me.

## EVIDENCE

6) This consists of a witness statement by Lalji Khimji. Mr Khimji states that he is the sales executive of Hornby Street Limited, which I will refer to as Hornby. He states that Hornby is a sister company of Shelf. He has held his position for ten years. Mr Khimji exhibits various material at exhibit A. He also states that the trade mark has been used in respect of all of the goods of the specification by Hornby with the consent of Shelf.

7) The exhibit includes four invoices. All of them emanate from Hornby. For some reason the customer and delivery names and addresses, with the exception of the counties, have been blacked out. However, I can still make out the customer's name. All of the invoices are made out to Jeevika International Limited. Included with the invoices are sheets bearing style numbers and representations of the goods. The sheets all bear the word EINSTEIN with the first letter written over a square of a contrasting shade or colour. The prices have also been blacked out. The details of the invoices are as follows:

- Invoice dated 21 February 2002. The invoice states that it is for 1500 "MENS T/S". The product code S007056C is used in relation to the goods. The accompanying sheet shows the same code and shows goods that are described as "MENS PIQUE POLO SHIRT". They are in five colours. All of them show the word EINSTEIN over the breast, the first letter of EINSTEIN is written over a square of a contrasting shade or colour. Sow in labels can be seen inside the necks of the representations; EINSTEIN is written in white and the first letter is written over a square of red. Also blanked out on the invoice, below "HORNBY STREET LTD." is the word Slazenger.
- Invoice dated 6 March 2002. The invoice is for two lots of 720 each of "MENS SHORT". The two lots have different product codes. The accompanying sheet shows the shorts of one of the product codes, S009019C. The shorts shown are the sort that are worn for external wear. The shorts are shown with the word EINSTEIN in a flesh colour, the first letter is written over a red square. Below "HORNBY STREET LTD." on the invoice is the word Slazenger
- Invoice dated 4 October 2002. The invoice is for two lots of 250 each of "MENS TOP25". The only difference between the lots is colour. The product code L404307RP is used in relation to both products. The accompanying sheet shows the same code and shows goods that are described as "REPUBLIC KEITH RIB ROLL NECK JUMPER", from the roll necks hangs a swing tag. The swing tag is rectangular in shape, the bottom half is black with the formula  $e=mc^2$  in dotted print at the bottom right hand corner. The top of the label is in grey except for a square of red to the extreme left, over which the first letter of EINSTEIN (which is written in light grey) is written. Below "HORNBY STREET LTD." on the invoice are the words The Juice Corporation.
- Invoice dated 4 October 2002. The invoice is for two lots of 360 each of "MENS TOP". The product codes L406324C and L406338C are used in relation to the goods. The accompanying sheet shows the code L406338C and shows goods that are described as "RAGLAN SLEEVE CREW NECK LONG SLEEVE T-SHIRT". The garment is shown in three colourways; on the front

is written South Kings in a curve, underneath Einstein is written in a slightly stylised script. From the necks hangs a swing tag. The swing tag is rectangular in shape, the bottom half is black with the formula  $e=mc^2$  in dotted print at the bottom right hand corner. The top of the label is in grey except for a square of red to the extreme left, over which the first letter of EINSTEIN (which is written in light grey) is written. Sew-in labels can be seen inside the necks of the representations; EINSTEIN is written in white and the first letter is written over a square of red. Below "HORNBY STREET LTD." on the invoice are the words The Juice Corporation.

8) Two sew-in labels and one swing tag are exhibited. The swing tag is rectangular in shape, the bottom half is black with the formula  $e=mc^2$  in dotted print at the bottom right hand corner. The top of the label is in grey except for a square of red to the extreme left, over which the first letter of EINSTEIN (which is written in light grey) is written. One sew-in label shows EINSTEIN in light grey, the first letter is written over a red square. The label is in black and this form of EINSTEIN and device is repeated four times. The other label shows EINSTEIN in the same form, with the red square. Some distance below this a reversed form of  $e=mc^2$  picket out in red can be seen.

## **DECISION**

9) Section 46 of the Act reads as follows:

“(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.”

Consideration has to be taken, also, of section 100 of the Act which states:

“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.”

### **Submissions upon behalf of Shelf**

10) It is submitted that applying the principles established in *Ansul BV v. Ajax Brandbeveiliging BV [FNI]* Case C-40/01 [2003] RPC 40 that use of the trade mark by the registered proprietor is genuine use of the trade mark. It is claimed that the trade mark is usually displayed in block lettering in text; on the labels, on swing tickets and on clothing. Occasionally it appears in a stylised form. It is submitted that this use is use of the trade mark. It is claimed that the stylisation of the trade mark as shown on some of the items of clothing does not alter the distinctive character of the trade mark in the form in which it is registered and, therefore, also constitutes use as per section 46(2) of the Act. It is claimed that the registered proprietor has used the

trade mark during the relevant period and/or has given its consent to a third party so to do. It is submitted that the scope of goods in respect of which the trade mark has been used is very wide as shown by the exhibits to the statement of Mr Khimji.

### **Submissions upon behalf of University**

11) It is submitted that the witness statement is given by an employee, not an officer, of Hornby. There is no direct evidence of any connection between Shelf and Hornby and there is nothing to show that the use is with the proprietor's consent. There is no direct evidence from the proprietor. It is submitted that the labels exhibited do not bear any date so it is impossible to tell whether these were used in the relevant period. It is also submitted that there is nothing to show that they were used on articles of clothing, and if they were, which articles of clothing. It is submitted that there is no reference to the trade mark on the invoices. The representations do not bear any date so it is not certain that the invoices relate to the particular goods shown. It is submitted that by refusing to disclose any details of the alleged purchaser, Mr Khimji brings into question the validity of the invoices and has deprived University of the opportunity to verify the validity of the documents, which could have been done by establishing the existence of the customer at the relevant dates. The appropriate way to have dealt with issues of confidentiality would have been to ask the registrar to keep the contents of the exhibit confidential rather than to erase what is quite important information. It is submitted that the registration should be revoked in its entirety. However, if this is not the decision, it is quite clear that the trade mark has been used on very few types of garments. If the registrar were minded to accept that there has been evidence of some use of the trade mark then it is quite clear that such use is limited. It is submitted that all of the invoices submitted refer to items for men, so the specification ought to be limited to clothing for men. The goods shown on the various representations are items of casual wear: a roll neck jumper, shorts, a long sleeved t-shirt and a polo shirt. It is submitted that, at the very best, the registration should be restricted to these specific goods. It is emphasised that the first proposition is that the registration should be revoked in its entirety.

### **Consent**

12) University submits that it has not been established that any use that there has been of the trade mark has been with the consent of the proprietor. No evidence has been filed by the proprietor. The evidence filed has been by Mr Khimji of Hornby. Rule 31(3) of the Trade Mark Rules (2000) as amended states:

“The proprietor shall, within three months of the date on which he was sent a copy of Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, and be accompanied by –

(a) two copies of evidence of use of the mark; or

(b) reasons for non-use of the mark, otherwise the registrar may treat him as not opposing the application.”

It is for the proprietor to file the evidence. The proprietor has not filed any evidence. I doubt that Hornby was in a position to file evidence without applying to be an intervener as per rule 35:

“(1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under rule 31, rule 32, rule 33 or rule 34 may file an application to the registrar on Form TM27 for leave to intervene, stating the nature of his interest and the registrar may, after hearing the parties concerned if so required, refuse such leave or grant leave upon such terms and conditions (including any undertaking as to costs) as she thinks fit.

(2) Any person granted leave to intervene (the intervener) shall, subject to any terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings for the purposes of the application of the provisions of rules 31 to 31B, rules 32 to 32B, rules 33 to 33B or rule 34 (as appropriate).”

So it is possible that account should not be taken of the evidence filed by Hornby. This has not been argued by University and so I will base my decision upon the premise that the evidence of Hornby could be accepted into the proceedings without a request for intervention.

13) Mr Khimji states that Hornby is a “sister company” of Shelf. I assume he means that there is a relationship between the companies but he does not explain what that relationship is. There is no evidence as to the relationship between the companies. There is nothing to indicate or suggest, for example, that Shelf has effective control of Hornby or vice versa. Laddie J commented on the meaning of effective control in *Sanofi-Synthelabo SpA v 3M Healthcare Ltd* [2003] ETMR 45:

“26 It seems to me that the words "effective control" in the supply agreement have much the same meaning. A company can be considered to be in the control of that person or those persons who can make or unmake its officers and dictate their conduct mediately or immediately. This does not mean that the controller will be involved in the day to day running of the company. He may never need to exert his control. His power may remain sheathed because the company is always run to his satisfaction. But he has control if, when necessary, he can directly or indirectly make the company to his bidding. That is the sense in which that word is used in clause 11.2:3. If that is so, then what is added by the word "effective"? It could be said that it adds nothing to "control" since control which is not effective is not control. In my view it adds little, save to emphasise that control may be indirect.”

14) It may be argued that Mr Khimji’s statement should be taken at proof of use with the consent of the proprietor as the application was served on Shelf but Hornby replied. I don’t consider that is the case. This is a matter of fact that has to be established by evidence and not a matter of conjecture and speculation. Shelf may look to the judgment of the Court of First Instance (CFI) *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) T-203/02 in support of such a proposition. However, I don’t think that that case can assist it. In that case the evidence was furnished by the proprietor/opponent. The

issue of consent was raised neither with the Opposition Division nor the Board of Appeal (case nos B41196 and R 1046/2000-1). So it was not a matter with which the CFI was seized. I note that the CFI stated in that decision:

“25 As to the truth of what that implies, it is evident that, if the use of the earlier trade mark, as shown by the invoices produced to OHIM, was without the proprietor’s consent and consequently in breach of the proprietor’s trade-mark right, it would have been in Industrias Espadafor SA’s interests, in the normal course of events, not to disclose evidence of such use to the proprietor of the trade mark in question. Consequently, it seems unlikely that the proprietor of a trade mark would be in a position to submit proof that the mark had been used against his wishes.”

I would suggest that in this statement the CFI has not addressed the question; it is not a matter of whether a trade mark has been used against the wishes of the proprietor but whether it has been used with his consent. Otherwise, acquiescence becomes synonymous with consent. It may be that the use of a trade mark exceeds any consent that has been granted. In BL O/090/05 the claim to use with the consent of the proprietor was rejected on the basis of a break in the chain of title to the licensees. The matter turned upon the absence of an establishment of a chain of consent, not on acquiescence or ignorance.

15) Under section 100 of the Act the onus is upon the proprietor. In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-39/01 the CFI at paragraph 47 held:

“In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

Jacob J in *Laboratoire De La Mer Trade Marks* [2002] FSR 51 stated:

“In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

I am of the view that requirements in relation to the evidence of use apply equally to the issue of consent, which can be fundamental to the maintenance of a registration. The issue of consent cannot be left to probabilities or suppositions; if the proprietor wishes to maintain the registration it needs to cross the ts and dot the is to establish the consent. In this case the proprietor has been silent. There is a statement that Shelf and Hornby are sister companies but no elucidation as to what this means. There is no evidence to the nature of the consent. If one accepted a statement by a third party with no supporting explanation or evidence, there would be a premium in not putting in evidence; all would be left to speculation and conjecture. There is nothing against which to test the claim. Shelf or Hornby had time to put in evidence to substantiate the claim of consent. Additional time was requested to file further evidence. No further evidence was filed, the opportunity was not taken to support the claim of



consent. It would have seemed easy enough to file evidence about the relationship between Hornby and Shelf, to put in evidence as to the exact nature of the consent.

**16) The onus is upon Shelf. It has filed no evidence. The evidence that has been filed by a third party does not go anywhere in establishing consent to use of the trade mark.**

17) I have made the above finding on the basis that consent does not require control, what may be described as the bare licence approach. I am not sure that such an approach is correct. Article 10 (3) of the First Council Directive 89/104 of December 21, 1988 (the Directive) states:

“Use of the trade mark with the consent of the proprietor or by any person who has authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.”

Article 19 (2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS):

“2. When subject to the control of its owner, use of a trademark by another person shall be recognized as use of the trademark for the purpose of maintaining the registration.”

(Both the French and Castellano versions also refer to control:

" 2.Lorsqu'il se fera sous le contrôle du titulaire, l'usage d'une marque de fabrique ou de commerce par une autre personne sera considéré comme un usage de la marque aux fins du maintien de l'enregistrement. "

“2.Cuando esté controlada por el titular, se considerará que la utilización de una marca de fábrica o de comercio por otra persona constituye uso de la marca a los efectos de mantener el registro.”)

TRIPS talks about control rather than mere consent. In *Heidelberger Bauchemie GmbH* Case C-49/02 [2004] ETMR 99 the European Court of Justice stated:

“20 Since the Community is a party to the TRIPS Agreement, it is required to interpret its legislation on trade marks so far as possible in the light of the wording and purpose of that Agreement (see, to that effect, Case C-53/96 *Hermès* [1998] ECR I-3603, paragraph 28).”

It appears to me that the *Heidelberger Bauchemie GmbH* principle should be applied to the meaning of consent. The requirement for control seems to be in keeping with the European Court of Justice’s (ECJ) statements as to the purpose of a trade mark. This has been reiterated by the ECJ on a good number of occasions. A recent example is in *The Gillette Company, Gillette Group Finland OY v LA-Laboratories Ltd OY* C-228/03 [2005] ETMR 67:

“26 In that context, the essential function of a trade mark is to guarantee the identity of origin of the marked 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. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (see, in particular, Case 102/77 *Hoffman-La Roche* [1978] ECR 1139, paragraph 7, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 30, and *Arsenal Football Club*, paragraph 48).”

It is difficult to envisage how a trade mark can serve its purpose, as defined by the ECJ, without control; the bare licence is not enough. Taking account Article 19(2) of TRIPS and the pronouncements of the ECJ it seems to me that control has to be established rather than mere consent. There is nothing to indicate Shelf’s control in the use of the trade mark by Hornby. If consent should be read as control, the case for maintaining the registration is even weaker. I have deliberately written “the case for maintaining the registration” rather than Shelf’s case as, of course, Shelf has made no case. It has put in no evidence.

**18) Owing to the failure to establish consent the application for revocation succeeds.**

#### **Goods upon which trade mark has been used and consequent specification**

19) In the event that I am wrong in relation to the issue of consent I will consider upon which goods, if any, the trade mark has been used (on the premise that it has been used or used in a form which does not alter the distinctive character of the mark in the form in which it was registered) and the consequent appropriate specification.

20) The nature of the evidence gives rise to concern. The parts of the invoices identifying the purchaser have been blacked out. I was able to discern the names on my copies of the evidence, however, this does not mean that the copies supplied to University allowed the details to be seen. It was clearly Hornby’s intention to deprive University of this information. University is quite correct when it states that if there was a need for confidentiality, an order for confidentiality should have been requested. By removing the details of the purchaser University is deprived of the ability to contact the purchaser and to ascertain if there is any relationship between the purchaser and Hornby, which may have implications as to internal use. University is deprived of the ability to dig deeper and investigate. Hornby made the unilateral decision that it would deprive University of this fundamental information, it decided how far the investigations of University could go. It is difficult to understand why in the normal course of events the purchaser’s details should be erased. I have never come across this before; invoices are the bread and butter of non-use cases. The invoices also have an oddity that they also bear the name The Juice Corporation or Slazenger. What significance do these references have? I also note that Mr Khimji makes the statement that the trade mark has been used on all the goods covered by the specification. Taking into account the broad specification this would in the normal course of events be a surprising statement; a trade mark that is used for every type of outer and under clothing for babies, children, men and women. On the basis of the evidence furnished the claim is particularly surprising.

21) The redactions of the invoices raise issues as to what weight should be given to them; University was deprived of the ability to investigate further. However, University could have objected to the nature of the evidence furnished; it could have requested disclosure of the redacted parts of the invoices. It did not do so. It only raised the issue in its submissions. I will consider the invoices on the basis that they are in an acceptable format.

22) University criticises the representations of the clothing as not bearing any date. However, the representations of the shorts bears the words Spring/Summer 2002 and the representation of the Raglan sleeve t-shirts bears the words Autumn/Winter 2002/03. University submits that the way that the evidence has been presented would suggest that the invoices were sent out with the representations of the garments. I do not consider that there was any such suggestion. Invoices with product codes were submitted, in order to show to what goods the codes relate, representations of the goods were submitted. This is good practice. It links a product identified with a code with the goods and shows a representation of the goods. Without these representations the invoices would be meaningless. The whole point of product codes is that they are unique, purchasers will be somewhat frustrated if a product code encompasses more than one item. It would make the supplier's job somewhat difficult also. I accept that the representations show the goods supplied under the various product codes on the invoices. University comments that the labels displayed do not bear a date. Labels do not normally bear dates. The swing label can be seen in the representations of the roll neck jumper. Sew-in labels can be seen upon the representations of the long sleeve t-shirts and the polo shirts. So identical or highly similar labels can be identified with goods supplied during the relevant period.

23) The amounts of products sold are certainly not de minimis. The invoices only cover part of 2002 but a continuity of use is not a requirement to establish genuine use. There is nothing coloured or false about the use. I consider that the evidence establishes genuine use as per the requirements of *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85.

24) In its submissions University appears to adopt two contradictory positions as to the appropriate specification, if use is accepted. At one point it states that the specification should be limited to clothing for men; two lines later it submits that the specification should be limited to the specific goods shown: a roll neck jumper, shorts, a long sleeved t-shirt and a polo shirt. I consider that this is an exact description of the goods shown. However, such a specification would be out of kilter with the case law as to what would represent a fair specification. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 Aldous LJ stated:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a

user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the CFI stated:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

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 sub-categories 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 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.”

In *Animal Trade Mark* [2004] FSR 19 Jacob J held:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

25) All of the goods shown are for men, they are all outer garments, they are all garments that would normally be described as casual wear. Taking these factors into account I consider that a fair description of the goods, that was neither pernickety nor overly broad, would be: *casual outer clothing for men in class 25*. (This finding is only relevant, of course, if I am wrong in relation to the consent issue.)

### **Use of the trade mark**

26) University has not argued that the use shown is use in a form which alters the distinctive character of the mark in the form in which it was registered. I must assume, therefore, that University accepts that the use shown is use which is covered by section 46(2) of the Act.

## **Conclusion**

**27) Consequent to my findings in relation to consent, the registration must be revoked in its entirety. As per the request from University, the registration is to be revoked from 19 July 2004.**

## **COSTS**

**28) The Hebrew University of Jerusalem having been successful is entitled to a contribution towards its costs. I order Continental Shelf 128 Limited to pay The Hebrew University of Jerusalem the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 7<sup>th</sup> day of March 2006**

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