

O-188-11

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION Nos. 2160489 AND 2208166
IN THE NAME OF REGUS NO2 SARL
FOR TRADE MARKS REGISTERED IN CLASS 35**

2160489

*easy*OFFICE

2208166



AND

**CONSOLIDATED APPLICATIONS FOR REVOCATION
UNDER NOS. 83583 AND 83584 IN THE NAME OF EASYGROUP IP LICENSING
LIMITED**

Trade Marks Act 1994

**IN THE MATTER OF Registration Nos. 2160489 and 2208166
in the name of Regus No2 SARL
for the trade mark EASYOFFICE
registered in Class 35**

And

**Consolidated Applications for revocation
under Nos. 83583 and 83584 in the name of
easyGroup IP Licensing Limited**

BACKGROUND

1. Registration No 2160489 was applied for on 10 March 1998 and registration No 2208166 was applied for on 9 September 1999. Both now stand in the name of Regus No2 SARL having been originally filed in the name of BAA Limited and later subject to an assignment to Nuclei Ltd. The relevant trade marks are as follows

2160489

*easy*OFFICE

2208166



2. Application No. 2160489 was registered on 4 January 1999, with application No. 2208166 being registered on 23 June 2000.

3. Both are registered in Class 35 for a specification reading: "Provision of office facilities, rental of office equipment".
4. On 21 September 2009 easyGroup IP Licensing Limited filed applications for revocation of both registrations based on grounds under Sections 46(1)(a) and 46(1)(b) of the Act. The applications seek revocation of registration No. 2208166 with effect from 24 June 2005 and 21 September 2009 and revocation of registration No. 2160489 with effect from 5 January 2004 and 21 September 2009.
5. In respect of the ground under subsection (b), the applicants assert that the registrations have not been put into genuine use in the period 21 September 2004 to 20 September 2009.
6. The registered proprietor filed Counterstatements in which they deny that there has been no genuine use of the marks.
7. Only the registered proprietor filed evidence and the proceedings have been consolidated. Insofar as this evidence may be relevant I have summarised it below. The matter came to be heard on 14 October 2010, when the applicants were represented by Kirsten Docherty. The registered proprietors were represented by Mark Holah of Field Fisher Waterhouse LLP, their attorneys.

EVIDENCE

Registered Proprietor's evidence

8. This consists of four Witness Statements. There are two substantially identical statements from Mark Holah, a partner in the firm of Field Fisher Waterhouse and which were filed prior to consolidation of the proceedings. There is also a witness statement from Tim Regan, a solicitor and Group Legal & Commercial Director of Regus Group Plc and another from Hastings Guise, a solicitor at Field Fisher Waterhouse LLP.
9. Mr Holah's Witness Statements are both dated 22 March 2010. As they differ only in respect of one of the exhibits, I will only make one summary. His witness statement merely introduces a number of exhibits. Exhibit A refers to and exhibits a Counterstatement dated 3 December 2007 along with four Annexes, all of which were filed in previous revocation proceedings involving the registrations now under consideration. Mr Holah says that these documents are relevant as there is an overlap in the relevant periods. The body of the Counterstatement exhibited reads as follows:

"1. BAA Limited is the proprietor of UK trade mark registration number 2208166 ("the Registration") for [the mark]. The Proprietor was granted the Registration of the Mark on 23 June 2000, The Registration covers "provision of office facilities, rental of office equipment'. The proprietor is the operator of 7 UK airports Heathrow, Gatwick, Stanstead, Glasgow, Edinburgh, Aberdeen and Southampton. The Proprietor's property portfolio is very diverse including offices, airside support facilities, airline lounges, business centres, warehouses, airline check-in desks, ground handling accommodation, fuel facilities, crew reporting centres and aircraft hangars. At Gatwick the Proprietor provides serviced office facilities and equipment under and by reference to the Mark.

2. The Applicant has alleged that the Proprietor has not made genuine use of the Mark either in the 5 years after registration (between 24 June 2000 and 23 June 2005) or in the 5 years prior to the application to revoke the registered Mark (from 30 August 2002) being made.

3. The Proprietor has now forwarded evidence of use to the Applicant by a letter dated 5 November 2007 a copy of which is attached at Annex 1.

4. The Proprietor has made genuine use of the Mark for all services for which it is registered in class 35. Attached and marked Annex 2 are various Easyoffice Occupation Agreements with licence periods commencing from 26 April 1999 to 1 August 2007. These are black and white copies of colour documents which have been redacted to remove commercially sensitive information. Attached at Annex 3 is an example of the Occupation Agreement showing the proprietor's Mark in colour. Further, attached at Annex 4 is sample marketing literature advertising the Proprietor's services dated and in use from May 1999.

5. All units on the Proprietor's premises are currently, and have consistently been, occupied and it has thus been unnecessary to engage in any further advertising or marketing campaign. However, the Proprietor's services have at all material times been branded with and by reference to the Mark continue to be so branded.

6. The proprietor therefore requests that the Applicant's request that the Registration be revoked under section 46(1)(a) of the Act on the basis that within the period of five years from the date of registration of the mark (between 24 June 2000 and 23 June 2005) the Mark has not been put to genuine use in the UK by the Proprietor or with its consent be refused.

7. The Proprietor further requests that the Applicant's request that the Registration be revoked under section 46(1)(b) of the Act on the basis the Mark has not been put to genuine use in the UK in relation to services for which it is registered within an uninterrupted period of five years be refused.

8”

10. The Annexes referred to in the Counterstatement are as follows:

Annex 1 Letter dated 5 November 2007 from Blake Laphorn Tarlo Lyons to McDermot Will & Emery sent on behalf of BAA Limited, enclosing sample marketing materials and copy occupation agreements for Easy Office Units. The letter states that these units are presently fully occupied so there is no need for BAA actively to market the facility.

Annex 2 Copies of easyoffice Occupation Agreements, numbered from 1 to number 41 though numbers 9-20 and 22-24 are not included. The earliest was signed on 19 April 1999 and relates to the provision of office facilities by Gatwick Airport Limited, including some furniture and car parking for the period 26 April 1999 to 25 April 2000. The later Agreements refer to the letting of office facilities through to 29 February 2002. Whilst no other facilities apart from an occasional parking space appear to have been supplied, the Agreements list

personal computers, printers, fax machines and “other” facilities as being available. The information about the customer has been redacted although it is possible to ascertain from the signatures that some are repeat bookings and also that the Agreements have been taken out by a number of consumers.

Annex 3 Copy of an easyoffice Occupation Agreement for the period 1 April 2007 to
(as included 30 September 2007.
on the witness
statement filed
on 83583)

Annex 4 Copy of an easyoffice marketing brochure dated May 1999 advertising the
(annex 3 availability of serviced offices, marketing and training facilities, and
83584) additional office and display equipment and car parking.

11. The next Witness Statement is dated 19 March 2010 and comes from Tim Regan, a solicitor and the Group Legal & Commercial Director of Regus Plc of which, he states, Regus No2 SARL is a subsidiary. Mr Regan gives details of the assignment history of the two registrations.

12. Mr Regan says that Nuclei Limited had been acquired by Regus Group in 2007 at which time they had already traded under the mark EASYOFFICES. He says that prior to the acquisition, a due diligence search was carried out which revealed that BAA owned the registrations for EASYOFFICE. As it was not known whether the marks were being used by BAA, the revocation actions were launched. Mr Regan says that after the filing of the revocations, he established that the marks were used in relation to a set of serviced offices in Atlantic House at Gatwick Airport. He recounts having visited these premises in July 2007, finding that the building was occupied by a variety of different businesses, including EasyOffice, who had rooms on the first and second floor of the main building. He says that the signage for EasyOffice featured the trade mark as protected by registration No. 2208166.

13. Mr Regan says that from his visit it was clear that the EasyOffice brand was in use and so negotiations to purchase the registrations commenced with BAA, part of which would be a license for BAA to continue to use the marks. Mr Regan says that he also saw evidence filed by BAA in earlier revocation proceedings which confirmed the use that he saw during his visit.

14. The final Witness Statement is dated 19 March 2010 and comes from Hastings Guise who is a solicitor with Field Fisher Waterhouse LLP.

15. Mr Guise says that on 15 March 2010 he carried out searches on the internet, the results of which he provides as Exhibits HG1 to HG5. Exhibit HG1 consists of a print from the BAA Gatwick website headed "Rental Guidelines from April 2009" and includes price lists for the majority of the office and industrial accommodation available for rent at the Gatwick site as at April 2009. EasyOffice is shown as the only supplier of “serviced offices”, providing a telephone for enquiries.

16. Exhibit HG2 to HG5 consist of prints from various property and business advice websites advertising the availability of premises at Atlantic House, Gatwick Airport, each stating that the

property "benefits from easymeeting and easyoffice facilities" and that "the easyoffice product includes a suite of furnished offices suitable for immediate occupancy".

17. That concludes my review of the evidence insofar as it may be relevant to these proceedings.

DECISION

18. Section 46 reads as follows:

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

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

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

(c)

(d)

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

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4).....

(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.”

19. Section 100 of the Act is also relevant and reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20. Consequent upon this the onus is upon the registered proprietor to prove that it has made use of the trade mark in suit. The proviso relating to “proper reasons for non-use” is not relied upon so I do not need to give this consideration.

21. The leading cases on genuine use are well known: *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] ETMR 85 (“*Ansul*”), *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 and [2005] ETMR 114 (“*La Mer*”), *The Sunrider Corp v OHIM*, Case C-416/04P (“*Sunrider*”). A helpful summary of the essence of these cases and several more recent ones has been provided by Anna Carboni sitting as the Appointed Person in *Pasticceria E Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (Sant Ambroeus Trade Mark) [2010] R.P.C. 28

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR 28 (*Silberquelle*) where relevant:

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

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

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

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

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

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

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

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

22. The applicants advance four lines of argument. They say that insofar as the evidence may show use of the mark this is in respect of services other than those for which the marks are registered. In the alternative, they say that if it does show use, this is minimal and for a “narrow and discrete sub-sector” of such services. But, in any event, they say the use shown in the evidence is not of the mark as registered, the mark shown being in a form “which differs distinctively”.

23. The applicants referred me to the decision of Anna Carboni sitting as the Appointed Person in *Bread Talk* BL O-070-10, and specifically paragraphs 27 to 34 of that decision which quote *Ansul* and *Silberquelle* as follows:

“31. None of these uses of the Mark are designed to fulfil the essential function of guaranteeing the identity of the origin of the bread or other food or drinks that are to be discussed on Mr Gilfillan’s website. Nor do they or will they in future amount to real commercial exploitation of the Mark on the market for such goods. The ECJ’s guidance is clear on this point: to be genuine use, the exploitation of a trade mark must be aimed at maintaining or creating an outlet for the goods or services for which the mark is registered, or a share in the market for such goods or services: *Ansul*, [37]-[38]; *Silberquelle*, [18].”

24. From this the applicants say that it is first necessary to ascertain the scope of the services in respect of which the marks have been registered and then to enquire whether there has been genuine use in relation to those services. In answering the first part, they quote the decision of Jacob J in *British Sugar v James Robertson* [1996] RPC 281, pages 288 to 290 from which they say that “in interpreting or construing the words used in the specification...

one is concerned with how the product or service is, as a practical matter, regarded for the purposes of trade or the meaning of the words of the specification as a matter of ordinary language”. To this they add Jacob J’s comments in *Avent v Isoact* [1998] FSR 16 in which he says that specifications should be scrutinised carefully and should not be given a wide construction but should instead be confined to the substance or core of the possible meanings. They further cite the relevance of the number of the class of the Nice Classification in which the application (or services) have been registered in interpreting their scope as set out in *Altechnic’s Application* [2002] RPC 34 and later in the *Galileo* decision BL O-177-10 and as given by Arnold J. in *Omega Engineering Ic v Omega SA* [2010] FSR 26 paragraphs 4 to 23.

25. The specifications for which the marks are registered fall into two areas: “Provision of office facilities” and “rental of office equipment” in Class 35. As a matter of plain language the scope of the service provided in the rental of office equipment is no more and no less the rental of any equipment that may be used in an office. However, whilst the Nice Classification contains the specific entry “Rental (Office machines and equipment —)*” showing this service to be in Class 35, the asterisk indicates that the rental of machines and equipment that may be used in an office can also be found in other classes. The Nice Classification lists the rental of photocopiers as proper to class 35. However, further entries list the rental of facsimile apparatus, modems and telephones are in Class 39, “Computer rental” is in Class 42 and the rental of furniture such as chairs and tables belongs to Class 43, so the subject registrations cannot cover these services. I would add that the rental of printers would also fall in Class 42 as a computer peripheral.

26. An office “facility” can be anything that facilitates the functioning of an office, which in Class 35 can be a physical item (within the scope set out in the previous paragraph) or a human endeavour such as secretarial and typing services, data processing and document reproduction, etc.

27. An “office” in terms of a place at which to do something would not, in normal parlance be referred to as “equipment”, being more rather a “facility”, but that does not mean such a service falls within the description “Provision of office facilities” in Class 35. The applicants drew my attention to the Nice Classification, in particular, the explanatory notes for Class 35, and the entry “Rental of offices [real estate]” listed as being proper to Class 36. There is also an entry “Rental of meeting rooms” showing this service to be proper to Class 43 along with the provision of temporary accommodation that is for more short-term use. As the subject registrations are registered in Class 35 the registrations cannot encompass the service of renting office accommodation.

28. Having ascertained the scope of the specifications for which the subject marks are registered, I need to assess whether there has been any use of the marks in respect such services. As the applicants highlight, the evidence in this case is not extensive, consisting primarily of a collection of occupation agreements numbered from 1 to 41, although, as I indicated above, not all Agreements within this number run have been provided. The Agreements relate to the provision of office facilities by Gatwick Airport Limited at “Easy Office premises at Gatwick Airport”. The first Agreement was signed on 19 April 1999 and relates to the provision of office No 118a for the period 26 April 1999 to 25 April 2000. Under “Additional facilities” can be seen that this included the provision of a “one desk and one chair”, a “small table” and two “easy chairs”. The Agreements list “Additional facilities” as being available, including “stand alone” and “networked” personal computers, printers, fax machines and “other”. Car parking is also available to order. The latest of the Agreements

relates to the letting of office No. 119b for the period 1 August 2007 to 29 February 2008. Apart from 2003 there is an agreement for each intervening year, with most activity taking place in 2006 and 2007. Whilst the information relating to the customer's details has been redacted, it is possible to see from the signatures that some Agreements are repeat bookings.

29. The subject registrations contain five versions of EASYOFFICE marks. The first, belonging to registration No. 2160489, has the word "easy" in an italicised font conjoined to the word "OFFICE" in an upper case plain lettering with no defined background. The other marks belonging to registration No. 2208166 are a series of four, each with the word "easyoffice" in lower case, with "easy" in a different font to the word "office". In this case the words are represented in white lettering placed within a background of either a red lozenge (one with rounded ends and one with a flat end to the left) or monochrome versions of these. To my mind any stylisation, be it in the use of the fonts or the addition of the backgrounds, does not distinctively add anything to the marks; they are all "easyoffice" marks.

30. All but one of the Agreements is a photocopy done in black and white. These are headed "easyoffice" with the "easy" prefix being in a slightly different typeface to "office", and, in my view, the same fonts as used in the series registration. On some copies it is possible to see that the word is being used on a lozenge background although not clearly which shape. The one colour version of an Agreement shows the "easyoffice" heading to be in white lettering encapsulated within a red lozenge, seemingly with the flat end but this may well have been caused by the photocopying. "Easy Office" is also used in plain font as the heading of a section of the form to insert the location of the premises. To my mind the colour version of the Agreement and the leaflet at Annex 4 both show use of a mark that is identical to the third mark in the series. It is also possible to ascertain that the monochrome Agreements show use of the first mark in the series. But notwithstanding the difference in the use of colour and/or the shape of the background, it is my view that the remaining marks in the series of four do not differ materially in their distinctive make-up. Likewise, I do not consider that the combination of commonplace fonts, in different cases, creates a distinctive identity beyond the word "EasyOFFICE", such that the mark registered under 2160489 is different to the use on the Agreements or leaflet.

31. The Agreements also have a menu item of "other". It could be argued that this is use in respect of the rental of office equipment, however, the registered proprietors have listed items of office equipment that they had available for rent, none of which fall within the scope of Class 35 and therefore the specifications of the subject registrations. These "other" facilities may, or may not, involve the provision of equipment or facilities that would be proper to Class 35 but it cannot be right simply to surmise that "other" means "anything possible". None of the Agreements shows anything has been provided that would fall within the scope of the registered specifications.

32. The leaflet provided as Annex 4 to Exhibit A says that "Easyoffice provides", beneath which it lists various items including "Air conditioned offices furnished with chairs, lockable desks and cupboards", "Your own telephone lines with phones supplied", "Access to photocopying facilities", "Cleaning and maintenance services" and "A menu of optional extras". These "extras are listed on the following page as "additional furniture", "telephones and telephone lines", "meeting rooms" and "fax machines and fax machine lines". As I have already said, out of these "facilities" only the "photocopying" falls within the scope of the registered specifications. The use of "access" casts some doubt on whether this is a facility

provided by Easyoffice itself, particularly as the Easyoffice serviced offices are within a building shared by other businesses. “Easyoffice” is a service that provides the physical space of an office with facilities and equipment provided as an adjunct; listed as an option available only to those renting their office space rather than a general service.

33. Where I have some difficulty is in gauging the extent of the use that has been made of the marks. Apart from knowing that the services have been offered and provided under the marks since 1999, and potentially, that 41 agreements were concluded, there is nothing that informs me about the extent of any commercial exploitation, be that in sales on the market concerned, or in promotional activities. Whilst the use need not be quantitatively significant for it to be deemed genuine, the fewer the instances, the more conclusive the evidence must be. The Agreements are “conclusive” instances that there has been use and, in combination with the leaflet, show this to have extended to providing access to photocopying facilities under the mark. So, notwithstanding the lack of detail, I consider there is sufficient from which to infer that there has been real (and not token) use, which is consistent with the essential function of a trade mark, in respect of the provision of the rental of office space. Part of this has involved the provision of “office facilities” but as I have highlighted, this has been as adjunct to the office rental to those renting their office space rather than a general service. As such, this does not amount to “real commercial exploitation of the Mark on the market for such [services]... “aimed at maintaining or creating an outlet for the goods or services for which the mark is registered, or a share in the market for such goods or services” *Ansul*, [37]-[38]; *Silberquelle*, [18].

34. Having found there to be no genuine use that falls within the scope of the registered specifications, the registrations should be revoked in their entirety. Registration No. 2208166 shall be revoked with effect from 24 June 2005 and registration No. 2160489 with effect from 5 January 2004.

35. The application for revocation having been successful, the applicants are entitled to a contribution towards their costs. Taking account of the fact that the applications were consolidated at an early stage I order that the registered proprietor pay the applicants the sum of £2600. 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 6 day of June 2011

**Mike Foley
for the Registrar
the Comptroller-General**