

O-340-19

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS 2475818, 2162140 & 2146670
IN THE NAME OF ITV STUDIOS LIMITED**

FOR THE TRADE MARK:

CARRY ON

AND

**APPLICATIONS FOR REVOCATION
UNDER NOS 502047, 502048 & 502049
BY BRIAN BAKER**

Background and pleadings

1. On 25 April 2018, Brian Baker (“the applicant”) applied to revoke three trade marks in the name of ITV Studios Limited (“the proprietor”). The grounds for revocation are based upon ss. 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”). The applicant claims non-use in the five-year period following the dates on which the marks were registered, as well as non-use in the five-year periods following registration, outlined below. Taking account of the partial surrender of some of the goods and services in the contested specifications, filed shortly before the hearing, the contested marks and the scope of the applications for revocation are now as follows:

(i) UK trade mark number 2475818 **CARRY ON**

Date of registration: 15 August 2008

Class 16: Books; printed matter; photographs; calendars; posters; greetings cards.

Class 21: Household or kitchen utensils and containers (not of precious metal or coated therewith); mugs; cups.

Class 41: Entertainment; entertainment services; entertainment services in the form of television programmes, radio, cable, satellite and Internet programmes; production and presentation of television programmes, shows, films, videos and DVDs; production and presentation of television, radio, cable, satellite and Internet programmes; production, presentation, distribution of films and DVDs; amusement game services; gaming services; gambling services; betting services; casino services; the provision of any of the aforesaid services to mobile telephones, via a mobile network, by communications satellite, by microwave or other electronic, digital and analogue media, live, electronically, via a computer network, via the Internet, via extranets, on-line and through the medium of television.

Revocation is sought for all goods and services except “production of films”; “production, distribution of films” in class 41.

Claimed periods of non-use:

s. 46(1)(a): 16 August 2008 to 15 August 2013;

s. 46(1)(b): 24 April 2013 to 23 April 2018.

Requested dates of revocation: 16 August 2013 or 24 April 2018.

(ii) UK trade mark number 2162140 **CARRY ON**

Date of registration: 19 March 1999. The applicant is recorded as licensee.

Class 9: Video recordings in the form of discs and tapes; cinematographic films; television films, programmes and advertisements; computer games; coin or counterfreed games; amusement machines.

Class 16: Printed matter, printed publications, books, photographs; posters; bags; calendars, greeting cards.

Class 41: Video, radio, television and film entertainment; television and cinema entertainment; production, distribution and provision of film, photographs.

Revocation is sought for all goods and services except “production, distribution of film” in class 41.

Claimed periods of non-use:

s. 46(1)(a): 20 March 1999 to 19 March 2004;

s. 46(1)(b): 10 March 2004 to 9 March 2009; 5 March 2009 to 4 March 2014; 24 April 2013 to 23 April 2018.

Requested dates of revocation: 20 March 2004, or 10 March 2009, or 5 March 2014, or 24 April 2018.

(iii) UK trade mark number 2146670 **CARRY ON**

Date of registration: 16 October 1998. The applicant is recorded as licensee.

Class 9: Audio, video and cinematographic recordings; arcade games and coin feed apparatus; all aforesaid goods relating to popular music; none of the aforesaid goods relating to electrical apparatus and appliances designed as hand or carry on luggage.

Class 25: T-shirts

Class 41: Entertainment services; radio and television entertainment services; production and direction of video and cinematographic recordings; all the aforesaid services relating to popular music.

Revocation is sought for all of the goods and services in the registration.

Claimed periods of non-use:

s. 46(1)(a): 17 October 1998 to 16 October 2003;

s. 46(1)(b): 2 October 2002 to 1 October 2007; 6 September 2007 to 5 September 2012; 31 August 2012 to 30 August 2017.

Requested dates of revocation: 17 October 2003, or 2 October 2007,¹ or 6 September 2012, or 31 August 2017.

2. The proprietor filed counterstatements defending its registrations for all of the contested goods and services. It denied that the marks were not put to genuine use. It also denied that there were no proper reasons for non-use, though it did not offer any proper reasons.

3. Both parties filed evidence. The matter came to be heard before me, by videoconference, on 5 April 2019. The proprietor was represented by Georgina

¹ The TM26(N) (application for revocation) gives the date as 2 June 2007. That date bears no relation to any of the other dates claimed and I proceed on the basis that this is a typographical error. Regarding the form TM26(N), see paragraph 4, below.

Messenger of counsel, instructed by Boulton Wade Tennant LLP. The applicant was represented by Tom Moody-Stuart Q.C., instructed by Stevens Hewlett & Perkins.

Preliminary issue

4. In her skeleton argument, Ms Messenger raised an issue regarding the clarity of the pleadings in revocation 502049 against trade mark 2146670. The day before the hearing I wrote to the parties to advise them that there had been an error in the service of the form TM26(N) in respect of this trade mark. I asked the applicant's representative to provide a copy of what it considered to be the correct form to the proprietor and to the tribunal, and I requested that the parties be prepared to give submissions at the hearing as to whether the case could proceed. Ms Messenger indicated at the hearing that, despite the differences in the contested goods and services and in the dates on the form TM26(N) provided to the tribunal on 4 April 2019 from the form originally served on the proprietor, the proprietor did not seek to file any additional evidence and was content to proceed. This decision is made on that basis.

Evidence

Proprietor's evidence

5. This consists of the witness statement of Alexander Papakyriacou, who is the Acting Head for Legal and Business Affairs for ITV International Studios. He indicates that he is employed by ITV Global Entertainment Limited (a wholly-owned subsidiary of the proprietor) and provides evidence obtained from the records of ITV or from his own knowledge.²

6. Mr Papakyriacou explains the relationship between the various entities under the umbrella of ITV Plc, of which the proprietor is one, and the licensing of the trade marks

² §§1, 7.

between the various companies.³ He states that the proprietor and other ITV companies primarily make use of the marks in relation to goods and services in classes 9 and 41 through airing “Carry On” films on television and sales of the films on recorded media; the use on other goods is carried out under licence by third parties.⁴ Save in relation to books, no point is taken as to whether the use was by the proprietor or with consent and I need say no more about this issue.

Classes 9 and 41

7. Mr Papakyriacou explains that 31 “CARRY ON” films and television specials were released between 1958 and 1992, and that the franchise contains the largest number of films of any British series.⁵ The films are sold as single DVDs, as themed box sets and as a complete box set entitled “CARRY ON: THE ULTIMATE COLLECTION”, with each DVD bearing the mark CARRY ON.⁶ These generated revenue in excess of £6 million between 2007 and “the present date” (the statement is dated September 2018).

8. Mr Papakyriacou states that the proprietor has invested significantly in promotion of DVDs under the marks, pointing to £250,000 spent on a 2014 advertising campaign which included the “CARRY ON: THE ULTIMATE COLLECTION” box set.⁷ Copies of advertisements from the 2014 campaign are provided.⁸ The reproductions are not particularly clear but it is just about possible to see that the publications include the *Daily Mirror*, *Metro*, the *Sun* and *What’s On TV*. The advertisements variously indicate that the DVD set is available at Sainsbury’s, amazon.co.uk, ASDA and hmv. The mark is visible as shown below on DVDs; whilst not all of the images are particularly clear, it appears to be the same use throughout (the banner is unclear in the reproduction below but reads “THE ULTIMATE COLLECTION”):

³ §§6-11.

⁴ §13.

⁵ §3.

⁶ §15.

⁷ §16.

⁸ Exhibit AP1.



9. Mr Papakyriacou states that “CARRY ON” films were available for rental and purchase via iTunes and Amazon.⁹ UK revenue through iTunes is given as \$151,503 for the period 1 April 2003 to 21 November 2017. It is said that in the period June 2015 to September 2017 “Amazon has logged some 5125 transactions to UK customers relating to Carry On films using its transactional video on demand service”, and generated income totalling £13,956.46.¹⁰

10. Part of an internal, and confidential, report regarding the licensing of “Carry On” films is provided.¹¹ Mr Papakyriacou states that over the period 1970 to 30 November 2016 over £9 million was made from licensing.¹² The film titles are shown but there is no evidence to show how the marks were used. Neither Mr Papakyriacou’s statement nor the exhibit breaks the figure down to specify revenue generated in the UK. [REDACTED]

[REDACTED]

[REDACTED]

11. A list of the broadcast dates and viewing share of films between 2002 and November 2017 is provided.¹³ I note that the major UK terrestrial TV channels are among the broadcasters. Various titles are visible, such as “carry on spying”, “carry on cleo”, “carry on camping”, “carry on regardless”, “carry on up the jungle” and “Carry on follow that camel”.

12. A number of confidential license agreements are exhibited. The first is an agreement between ITV Broadcasting Limited and Cashcade Limited dated 27

⁹ §17.

¹⁰ §18.

¹¹ Confidential exhibit AP2.

¹² §19.

¹³ AP3.

December 2012.¹⁴ It concerns the licensing of the contested marks for use in two online casino games between 1 April 2012 and 1 April 2014. [REDACTED]

[IMAGE REDACTED]

13. There is also a licence agreement between Granada Ventures Limited and Deluxe Digital Studios in respect of iPhone games said to be based upon a number of the “CARRY ON” film titles, for the period 1 February 2010 to 31 January 2012.¹⁵

14. Mr Papakyriacou provides a copy of a licence agreement between Granada Ventures Limited and Koninkijke Jumbo BV regarding a license for jigsaw puzzles. As these goods are proper to class 28, it is not relevant.

15. A further licence agreement, between ITV Ventures and Storm Games Limited, under which Storm is said to be “licensed to use CARRY ON, Carry On Camping, and Carry on Doctor [...] in respect of the use on “pay-for-play reel based games of skill and games of chance for the opportunity to win cash prizes” at static terminals and handheld terminals, and mobile games”.¹⁶ The licence period is 1 October 2015 to 30 September 2019. The exhibit bears out these statements. [REDACTED]

16. Mr Papakyriacou adduces evidence of games developed under the agreement with Storm Games. The first is a game entitled “Carry On Camping” which is said to be available at www.meccabingo.com and through handheld terminals at Mecca Bingo

¹⁴ Confidential exhibit AP4.

¹⁵ §23 and confidential exhibit AP5.

¹⁶ Confidential exhibit AP7 and §25.

venues.¹⁷ A print of the website is provided, which shows “Carry On Camping” at the top of the page, with a description which states “[t]he game mirrors the film perfectly”.¹⁸ The page bears a printing date of 11 February 2017. The following image is shown:



17. There is also an article, dated 2 May 2017 from www.bingoport.co.uk, which promotes the “Carry on Camping” game on Mecca Bingo.¹⁹ The image is obscured but appears to be the same as that from the Mecca Bingo site, shown above. The game is described as a “5-reel, 20-playline slot based on the 1969 film”.

18. There is a print from itunes.apple.com/gb which shows “Carry On Camping- The Real Pub Fruit Machine” application available for download.²⁰ The printing date is 2 November 2017 but the print indicates that the page was updated on 16 January 2017. “CARRY ON CAMPING” is just visible on screenshots from the game. Although not identical to the stylised use shown at AP8 (paragraph 16, above), there is similar positioning of the words, typeface and use of colour. A further example is provided of a “standard 5 reel slot game with 20 winlines” from Sky Vegas Online Casino, with a copyright notice dated 2016.²¹ “CARRY ON CAMPING”/ “Carry On Camping” are visible in plain text and the following image is shown:



¹⁷ §26.

¹⁸ AP8.

¹⁹ AP9.

²⁰ AP10.

²¹ AP11.

The same image, as well as plain text use, is shown on a print from the Sky Bet website, said to be from December 2016.²²

19. “Carry On Camping” (word only) is also mentioned in promotional material from Storm Games regarding their products.²³ It bears a copyright notice of 2016 and was printed in November 2017. Mr Papakyriacou states that the “CARRY ON” games were promoted by Storm Gaming at the ICE Totally Gaming Exhibition in London in 2015.²⁴ It is said that AP13 contains images of the marks in use at that event but I cannot see any images which are both clearly of the event and show the contested marks.

Class 16

20. There are prints from www.amazon.co.uk which show two books for sale. The first is “The Complete A-Z of Everything Carry On”, published in 2005.²⁵ The book is described as “The complete guide to everyone’s favourite films”; the web page bears a printing date of 16 November 2017. The second book shown is entitled “The Carry On Story”.²⁶ The edition advertised is from 2008, though it appears that the work was first published in 2005. The print is dated 21 November 2017.

21. A copy of a licensing agreement between Granada Ventures Limited and Hallmark Cards Plc is exhibited, covering the period 1 October 2010 to 31 July 2011.²⁷ Mr Papakyriacou explains that Hallmark was licensed to use “CARRY ON” on three greetings cards for retail by Marks & Spencer. The exhibit bears out these claims. [REDACTED]

[REDACTED] An agreement extending this contract until 31 October 2013 is also included.²⁸ [REDACTED]

²² AP12.

²³ AP13.

²⁴ §28.

²⁵ AP14.

²⁶ AP15.

²⁷ Confidential exhibit AP16.

²⁸ Confidential exhibit AP17.

[REDACTED]

22. Mr Papakyriacou states that the trade marks are used in relation to photographs under a licence agreement between Classic Stills LLC and ITV Ventures Limited, which covers the period September 2017 to December 2022.²⁹ Prints from classicstills.co.uk are provided, which show a range of still photographs from “Carry On” films.³⁰ It appears to be possible to filter or browse results for “Carry On”, given the breadcrumb trail visible on many of the pages. I also note that many of the pages are headed “CARRY ON FINE ART PHOTOGRAPH”. The use under licence is highlighted, the photographs are said to be from the ITV archives and they all have a certificate of authenticity. However, the copyright notice is 2018 and the printing date 13 September 2018.

23. There is produced a photograph of a bag featuring an image of Barbara Windsor, which Mr Papakyriacou states “was apparently available in Topshop [...] in 2008”.³¹ It appears to be made of fabric. The following swing tag is visible:



24. In addition, there is a photograph of “the official calendar 2005”, showing the mark as follows:³²



²⁹ §32.

³⁰ AP18.

³¹ AP19 and §33.

³² AP20.

In relation to the bag and calendar, Mr Papakyriacou states, “[w]hilst I have not been able to locate licence agreements in relation to these products they were found at the Proprietor’s premises and I believe it is therefore likely that they were produced under licensing agreements”.³³

Class 21

25. Mr Papakyriacou provides photographs of various items of tableware which carry images from the films.³⁴ He is not able to provide the details of any licence agreements.³⁵ Mugs, which Mr Papakyriacou states are production samples, dated 14 February 2008 are shown.³⁶ I note that the words “CARRY ON” are visible on the various items, as shown below.³⁷ On the inside of the mugs:



26. Swing tags, which describe the product as a “Carry On Mug”, along with the following stylised version of the mark, are visible:



27. Photographs of salad tongs are provided, whose swing tags show the same stylised “CARRY ON” mark as that on the tags for the mugs, reproduced above. The copyright date given for these is, however, 2010.

³³ §33.

³⁴ AP21.

³⁵ §35.

³⁶ §34.1.

³⁷ AP21.

28. The same exhibit includes evidence of plastic tumblers and bowls which bear labels showing a copyright date of 2010 (Mr Papakyriacou indicates that the box containing the tumblers was dated 6 April).³⁸ The labels show that the goods were produced under licence from Granada Ventures Ltd and bear the words “CARRY ON” in the following form:



Class 25

29. Photographs of t-shirts and one vest are exhibited, which show stills from the films or cartoons referencing particular films.³⁹ The words “CARRY ON” are visible on swing tags or on labels sewn into the garments in the forms shown below:



30. Mr Papakyriacou states that some of these garments were available in high street stores TopShop and River Island; these store names are visible on tags/labels in the

³⁸ §34.2.

³⁹ AP22

exhibit but no further details are provided.⁴⁰ Where the products are dated, the dates are June 2009, August 2009, October 2009 and January 2010.⁴¹

⁴⁰ §36.

⁴¹ Respectively: pp. 311-312, 317; pp. 315-316; p. 321; p. 319.

Applicant's evidence

31. This consists of the witness statement of Brian Baker. The content of Mr Baker's witness statement is submission rather than evidence. Consequently, whilst I bear his comments in mind and will refer to them as appropriate in this decision, there is no need to summarise them here.

32. That concludes my summary of the evidence, insofar as I consider it necessary.

Decision

33. Section 46(1) of the Act states that:

“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) An application for revocation may be made by any person, and may be made 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”.

34. Section 100 is also relevant, which 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”.

35. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J updated his previous summary of the law relating to genuine use (in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52 (Ch)) as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.

36. The burden of proving use falls on the proprietor. In *Awareness Limited v Plymouth City Council*, BL O/236/13, Daniel Alexander Q.C., sitting as the Appointed Person, stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public”.

37. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person, stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence

and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use”.

Form of the mark

38. The marks are registered as word marks. Although the proprietor refers to the trade marks in their word form, and the licensing of the marks to third parties is on that basis, the evidence shows that the marks have appeared on goods and services in the following forms:



(i)



(ii)



(iii)



(iv)



and

39. It is settled law that “use” of a trade mark encompasses its independent use and use as part of another mark, provided that the trade mark continues to be perceived as indicating the origin of the goods and/or services at issue: *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, at [31]-[35].

40. As regards use in a different form, in *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under s. 46(2) of the Act as follows:

“33. [...] The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period [...]

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all".

41. Although this case was decided before the judgment of the Court of Justice of the European Union ("CJEU") in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered but as part of a composite mark.

42. The different typefaces and colours in which the marks have been used at (i) to (iv), above, do not, in my view, alter the distinctive character of the marks as registered. The marks at (i) and (ii), whilst shown with additional matter, are qualifying use under the criteria elaborated by the CJEU in *Colloseum*. The use shown at (iv) is somewhat different. The arrangement of the words vertically rather than horizontally has no effect, whilst the addition of a device in the second of these marks is acceptable under *Colloseum*. However, the mark forms part of the phrase "CARRY ON CAMPING". Nonetheless, the presentation of the words "CARRY ON" in a different colour and larger font than the word "CAMPING" serves to distinguish the words "CARRY ON" in the mark. I am prepared to accept that such use qualifies as use in an acceptable variant form.

Genuine use/use as a trade mark

43. Ms Messenger submitted that, because the applicant has not challenged the production and distribution of film services, it follows that it has accepted that genuine

use has been made of those services.⁴² Further, she submitted that it must follow that genuine use has been made in respect of goods provided as part those services, such as video recordings, as well as certain other services in class 41.⁴³ I do not accept that submission. The purpose of pleadings is to make a party's case clear. It would be a step too far to infer that, because certain goods and services are not under attack, other related—but not identical—goods and services are exempt from challenge: even if the decision not to challenge certain services were an acceptance of genuine use, and I do not say that it is, it does not follow that such an acceptance extends to different goods and services. I agree with Mr Moody-Stuart's submission that use must be proved except where revocation is explicitly not sought, though I will return to this issue when considering a fair specification.

44. Ms Messenger accepted at the hearing that there has been no use in relation to trade mark 2146670 insofar as the goods and services are related to popular music. She submitted, however, that the limitation applied to classes 9 and 41 of that trade mark did not apply to all of the goods and services in those classes. I do not agree. The limitation is separated from the preceding goods and services by a semi-colon. This punctuation means that the limitation applies to all of the preceding goods or services, as set out, for example, at section 2.17 of the Trade Marks Manual: Classification Desk Instructions.

45. In the alternative, Ms Messenger submitted that the limitation may be amended and an alternative limitation applied to the specification instead. I have no power to do this. It is trite law that, once a trade mark application has been made, no broadening of the specification is permitted. Alteration of registered trade marks is governed by s. 44 of the Act, which allows only for changes to the proprietor's name and address, provided that this does not substantially affect the identity of the trade mark. Surrender or partial surrender of goods and services is permitted under s. 45. I am not aware of any provision of the Act or Rules or of any other authority—none being cited to me— which

⁴² Skeleton, §13.

⁴³ Skeleton, §§

would allow me to widen the specification. As removal of the existing limitation would inevitably broaden the specification, it is impermissible: any amendment would have to be in addition to, rather than in place of, the existing limitation.

Class 9

46. There is no evidence of films on any medium other than DVD. There is no evidence of other types of recording, apart from a reference to television specials which is too vague to be of material assistance. Nor is there any evidence which shows “CARRY ON” being used on advertisements, other than in the context of advertisements for DVDs which bear the mark. Mr Papakyriacou has given evidence that DVDs sold by the proprietor have generated £6 million in the period 2007 to the present (his statement being dated September 2018). There is no breakdown by year. It is, therefore, impossible for me to determine what level of sales there may have been in the periods at issue and whether the sales volume in each of those periods is enough to cross the (fairly low) threshold for genuine use. I have not overlooked the evidence that some revenue has been generated on iTunes and Amazon. However, the iTunes evidence does not show how much of the revenue was due to the sale of physical media or how much was, for example, via streaming or download, which of course are not within the scope of class 9; the reference to “transactional video on demand” for Amazon suggests a service proper to class 41. There is nothing to suggest that the evidence regarding the licensing of films at confidential exhibit AP2, even if it were possible to ascertain UK figures from the document, amounts to the licensing for use on physical media rather than a license to broadcast or stream.

47. However, it is said that £250,000 was spent on the 2014 advertising campaign, and I note that the outlets are major UK retailers, though the “CARRY ON” collection was only one of several titles included. Whilst I bear in mind that other titles formed part of the advertising campaign, I also note that the advertisements appeared in national publications and that the retailers are national retailers of scale. The nature of the

advertising suggests a serious attempt to secure customers for the DVD. The level of use is, while modest, adequate (just) to establish sufficiency of use in relation to DVDS.

48. The thornier question is whether the use has been use as a trade mark. The essential function of a trade mark was described by the CJEU in *Philips Electronics NV v Remington Consumer Products Limited* [2003] RPC 14 as follows:

“30. [...] the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality”.

49. A number of authorities were cited to me at the hearing. In *Danjac LLC v OHIM*, Case T-435/05, the General Court said:

“24. [...] Dr. No is the title of the first film in the ‘James Bond’ series and also the name of one of the main characters in the film. Theoretically, those facts cannot prevent the use of the signs Dr. No and Dr. NO as trade marks in order to identify the commercial origin of the films or DVDs.

25. However, in the present case, an examination of the documents submitted by the applicant shows that the signs Dr. No and Dr. NO do not indicate the commercial origin of the films, but rather their artistic origin. For the average consumer, the signs in question, affixed to the covers of the video cassettes or to the DVDs, help to distinguish that film from other films in the ‘James Bond’ series. The commercial origin of the film is indicated by other signs, such as ‘007’ or ‘James Bond’, which are affixed to the covers of

the video cassettes or to the DVDs, and which show that its commercial origin is the company producing the films in the ‘James Bond’ series. [...]”.⁴⁴

50. Ms Messenger also drew my attention to a previous decision of this tribunal, in which the hearing officer proceeded on the assumption that “THE LORD OF THE RINGS” was used as a trade mark for DVDs, given that “after three different films/DVDs containing that name it seems plausible (I put it no higher than that) that the public would have expected the same undertaking to be responsible for further DVDs including that name”.⁴⁵ The hearing officer also found that both “THE LORD OF THE RINGS” and “THE TWO TOWERS” had been used for various other goods in class 9, including computer and video game software.

51. A more recent case of relevance is *Hearst Holdings Inc & Fleischer Studios Inc v AVELA Inc & Ors* [2014] ETMR 34, an infringement case in which “BETTY BOOP” was held to denote origin. Birss J outlined the problem in relation to merchandising as follows:

“69. The essential problem in all of these cases is one of fact. The question is always concerned with what the relevant sign signifies to the average consumer (or equivalent in a passing off case). When famous names or images are applied to merchandise they are not necessarily being used as indicators of origin of the goods at all”.

He went on:

“105. [...] The appearance of a well known character (real or fictional) on a product may very well not have origin significance. Without many years of education, the public might well regard the appearance of a famous character on a t-shirt or in a poster as conveying no origin information at all. It may be

⁴⁴ The EUIPO followed this reasoning in Case R 526/2008-4 regarding the mark “Octopussy”.

⁴⁵ *THE TWO TOWERS Trade Mark*, BL O/468/13, at [54].

very difficult for a trader to educate the public to see things in any other way but whether or not that has taken place depends on the evidence.

106. There are some forms of merchandise for which it is clear the public do not believe that it derives from a single source. Pictures of famous people by no means necessarily denote trade origin. The evidence showed that there are many sources of pictures of Marilyn Monroe and other famous celebrities. As I said in *Fenty v Arcadia* (at [2]) there is today in England no such thing as a free standing general right by a famous person (or anyone else) to control the reproduction of their image.

107. However, Betty Boop is not a real person. There is no law which provides that invented characters have stronger rights than real people in this regard but it does seem to me that it is probably easier to educate the public to believe that goods relating to an invented character derive from a single official source than it might be for a real person, not least because copyright law may give the inventor the ability to control the reproduction of the character for a very long time”.

52. In that case, Birss J held that the efforts of the claimant in promoting the mark had resulted in recognition among the public that there was a single source for “Betty Boop” merchandise and that the use was, therefore, use as a trade mark.

53. It is common ground that “CARRY ON” is the name of a well-known series of films. There appears to be no disagreement over whether “CARRY ON” is inherently capable of functioning as a trade mark for any of the goods and services. I see no reason why it would not be inherently distinctive for any of the goods or services at issue. However, there is an obvious difficulty in the proposition that the name of a film or, in this case, a recurring phrase in a film’s title, will be seen not only as the name of the film but also as indicating the origin of the goods and services.

54. The proprietor's unchallenged evidence is that thirty-one "CARRY ON" films, plus television specials, were released between 1958 and 1992. Whilst Mr Papakyriacou claims that each DVD bears the mark "CARRY ON", the only documentary evidence is the advertising, in 2014, of DVDs as a box set entitled "CARRY ON: THE ULTIMATE COLLECTION". Mr Moody-Stuart drew my attention to the images of the DVDs in the advertisements, emphasising the presence of ITV Studios and Amazon trade marks which, in his submission, served as indicators of product origin and retail origin, respectively. The use of "CARRY ON", he submitted, is titular and, therefore, descriptive use. Ms Messenger submitted that, notwithstanding the use as part of the title, the consumer will see the mark as a trade mark, which will indicate the origin of the film or the DVD containing the film. It would, in her submission, be bizarre for consumers to perceive the mark as indicating the production company but not the producer of the DVD.

55. I bear in mind that the "CARRY ON" films are an invented series subject to copyright law which allows the creator to control use of the copyrighted material. It seems plausible that the average consumer will appreciate that the copyrighted material is reproduced under licence. There is also the fact that there is a very large number of films in the series. The use which has been shown on DVDs is of "CARRY ON: THE ULTIMATE COLLECTION", not simply of the title of the films. There is, therefore, an argument that "CARRY ON" has a similar function to that of "007" or "James Bond" in the *Dr No* and *Octopussy* cases. I also acknowledge that it was considered "plausible" for "The Lord of the Rings" to have a trade mark function on DVDs, though I note that this was not a firmly decided point. However, whilst I consider that the consumer is likely to expect the same production company to stand behind the creation of the films, I am not persuaded that the consumer will have the same expectation in relation to DVDs carrying the marks at issue. Even in the case of "CARRY ON: THE ULTIMATE COLLECTION", the mark is likely to be viewed as no more than an indication of the content. It is true that trade mark and descriptive significance are not mutually exclusive. However, the evidence filed by the proprietor is not sufficient, in my view, to establish that the public will perceive DVDs bearing the "CARRY ON" marks as being the

responsibility of a single undertaking. Although £6 million appears a substantial sum, it spans a period of 11 years. I also tend to agree with Mr Moody-Stuart that the use which has been shown points towards ITV studios indicating the trade origin of the DVDs. At the bottom left of the advertisements in evidence, the ITV Studios logo is fairly prominently displayed. The ITV logo is not clearly visible on the spine of the “CARRY ON” DVD, though that would be consistent with the use which is legible on the DVD which appears next to it. The presence of a second mark does not preclude “CARRY ON” from functioning as a trade mark and I note that the licensing arrangements are included in the advertisements, in small print. Yet I am not persuaded that the sales and advertising efforts, whether in relation only to these goods or on merchandise across the board, have been shown to be on such a scale, or that the nature of the use of the marks has been such as to create in the public’s mind an expectation that DVDs bearing the words “CARRY ON” would be the responsibility of a single trade source.

56. In terms of games, several licence agreements are exhibited, which provide for varying amounts of royalty income and relate not only to online and mobile games but also to games on static and handheld terminals. What is lacking is any evidence of royalties actually paid under these licences or confirmation that the terms of the licence, such as installation of games terminals, were complied with, or when or how. There is some evidence that there was a “CARRY ON CAMPING” game developed and offered to the public during 2016 and 2017, via Mecca Bingo, Sky Vegas Online Casino, Sky Bet and iTunes but, again, there is no evidence to show the level of income, if any, generated by these games. The deficiency in showing levels of actual sales in the UK, and thereby providing clear evidence that the use was warranted in the sector, is not remedied in this case by sufficient evidence of advertising or promotion to the UK consumer. Whilst the sites on which the games were present do not appear to be particularly obscure, the evidence goes no further than showing that the games appeared on the sites and that there was one promotional article on bingoport.co.uk. As to the use itself, while the title “CARRY ON CAMPING” is not purely descriptive of the content of the game, the evidence shows that the games are devised around the characters in the “Carry On” films. The consumer is, therefore, unlikely to perceive the

words “CARRY ON” as indicating a trade source. The insubstantial promotion of the game, the absence of any actual sales or royalty income and the absence of any other games which might through education disturb the initial perception of the mark by the average consumer (there is no evidence that, apart from the “CARRY ON CAMPING” game, any other games bearing the words “CARRY ON” were developed) lead me to conclude that there has been no genuine use of the mark in relation to the remaining goods in class 9.

Class 16

57. The use in relation to books can be briefly dealt with: not only is the use shown purely descriptive but there is a total absence of sales or advertising information. There has been no genuine use in relation to books.

58. There is some evidence of photographs being sold as “CARRY ON FINE ART PHOTOGRAPH”, under a licence which began in September 2017. I note that the use under licence is underscored on the prints provided. However, given that all of the photographs are stills from “Carry On” films, and notwithstanding that it is possible for a mark to indicate both content and trade origin, including on photographs and posters, the consumer is likely to perceive the words “CARRY ON” as descriptive of the content. The prints from classicstills.co.uk have a printing date of September 2018, which postdates not only the relevant periods but the filing date of the applications for revocation. There is no other evidence to show that the proprietor sold, directly or under licence, any photographs under the mark prior to the date of revocation, there being no evidence of licensing income in relation to these goods. The instant case is plainly not on all fours with the circumstances in *Hearst v AVELA*, where there had been consistent and longstanding use. The proprietor has not shown genuine use in relation to photographs. I should also point out that, even if the photographs in evidence can be regarded as posters, the use is insufficient for genuine use, for the same reasons.

59. There is one image of a bag bearing a swing tag with the words “CARRY ON”. The interpretation of words in specifications has been subject to judicial consideration several times, most recently in *Pathway IP Sarl v Easygroup Ltd.*⁴⁶ After considering the judgements of the Court of Appeal in *Altecnic Ltd’s Application*,⁴⁷ of Arnold J in *Omega 1* and *Omega 2*,⁴⁸ and the CJEU’s judgment in *IP Translator*,⁴⁹ Carr J said:

“79. I have reached the provisional view, in the light of the respondent’s arguments, that it is appropriate to use class number as an aid to interpretation of the specification where the words used in the specification lack clarity and precision. This applies to granted registrations as well as to applications, and therefore applies in the context of infringement actions and revocation claims. My reasons for reaching this conclusion are set out below.

80. Of course, in many cases, it will be unnecessary to use the class number in this way, as the words chosen in the specification will be sufficiently clear and precise. Indeed, in the present case, I consider that the disputed phrase “provision of office facilities” is sufficiently clear and precise, so that its ordinary and natural meaning can be ascertained without reference to the class number”.

60. It is important to note that:

(i) the judge’s decision was ‘provisional’ indicating that he did not think that the matter was clear cut;

(ii) the guidance is to consider the class number only where the meaning of the disputed term is not sufficiently clear and precise;

⁴⁶ [2018] EWHC 3608 (Ch)

⁴⁷ [2001] EWCA Civ 1928

⁴⁸ [2010] EWHC 1211 (Ch) and [2012] EWHC 3440 (Ch), respectively.

⁴⁹ Case C-307/10

(iii) where a term is sufficiently clear and precise on its face, the fact that the term covers goods/services that may also (or should have been) registered in other classes is irrelevant to the scope of protection afforded to the term, or to questions of use of the mark in relation to those goods/services;

(iv) Where the term is not sufficiently clear and precise, the class number may be relied on to construe the scope of protection, i.e. to narrow the meaning of the term to goods/services in the class concerned.

61. “Bags” is a term covering bags made of many different materials, such as paper or fabric, for many purposes. It includes bags adapted for a specific purpose (vacuum bags, sports bags, toiletry bags, body bags) and goods such as handbags and holdalls, which are all very different products. The term “bags” is, therefore, insufficiently clear and precise to identify a specific category or sub-category of commercial products and it is necessary to rely on the class number to construe the specification. Fabric bags are not proper to class 16, which covers bags made of plastic or paper. The possible use on a fabric bag is, consequently, of no assistance to the proprietor in establishing that there has been genuine use in relation to bags in class 16, despite the use on a swing tag lending itself more readily to genuine trade mark use. Even if the bag could be considered in relation to class 16, Mr Papakyriacou’s evidence is that the bag “was apparently available in Topshop” and that “it is likely [it was] produced under licensing agreements”. The absence of any clear sales or advertising information would defeat the claim to genuine use.

62. In relation to calendars, the evidence of sales is equally vague. There is one possible example, dating from 2005. Given that the calendar appears to feature images of characters from the films and there is no other evidence of use on these goods, my view is that the consumer is unlikely to perceive the mark as having any origin significance. However, the absence of any sales or promotional data means that the use, even if it were use as a trade mark, cannot be sufficient to qualify as genuine use.

63. There is a licence agreement for the use of the marks on cards, along with an amendment to that agreement. However, there is no evidence to show how the marks were ultimately used by the licensee. Moreover, the minimum amounts payable to the licensor under the agreements are very small. Even if the use of the marks was use as a trade mark—as to which there is no evidence—and even if the guaranteed sums were paid (which seems likely at least for the first licence, given the extension), the use shown is insufficient to be warranted in the economic sector.

Class 21

64. There is limited evidence of the marks in relation to various items of tableware. I note that the words “CARRY ON” are accompanied by the “™” symbol, though I have some reservations as to its impact on the consumer. Whilst the use serves to indicate certain characteristics of the goods, the evidence is somewhat more convincing that the nature of the use is genuine trade mark use, particularly given that a range of items are shown. That said, there is no evidence whatsoever that any of these items made it to the marketplace. The proprietor has therefore failed to show genuine use for any of the goods in class 21.

Class 25

65. There is some evidence of use in relation to t-shirts. Whilst the garments bear images from the films, the labels and swing tags show use of the words “CARRY ON”, the nature of which is more plausible trade mark use. However, there is no evidence of any efforts to secure customers, the exhibits being apparently production samples only and there being no evidence of any sales. The evidence does not establish genuine use of the marks in relation to t-shirts.

Class 41

66. Mr Papakyriacou's evidence is that "Carry On" films were available for rental and purchase via iTunes and Amazon. As I have discussed above, the evidence regarding iTunes is imprecise, so that I cannot be certain whether this related to physical media, download or streaming, or of the revenue's distribution over the fourteen-year period covered. The evidence relating to Amazon specifies that income of almost £14,000 was generated between June 2015 and September 2017 for UK customers using its "transactional video on demand service". This service appears to be proper to class 41. There is also evidence that the proprietor generated in excess of £9 million over a forty-six-year period through licensing its films, though the portion of this revenue attributable to use in the UK is not given. Importantly, however, it is far from clear how the marks were used under any of these agreements. Indeed, it seems likely that the services were in fact offered under marks such as iTunes and Amazon, and that "CARRY ON" was used exclusively to describe the film which the consumer might view. The evidence does not make it clear either way. I acknowledge, of course, that the proprietor's films have regularly appeared on the main terrestrial television channels over many years and that they continue to do so. However, that does not establish that there has been use of the marks, by the proprietor or under licence, for the contested services. Permitting a television channel to broadcast one's film is not use of the mark in relation to entertainment, presentation or networking services; nor would the status of a film as the subject of a syndication agreement mean that the mark itself had been used on or in relation to those services. The same applies to the gaming/gambling services at issue. Whilst there is some evidence that the proprietor allowed its marks to be used as part of games (although as to whether that use was trade mark use, see above), the evidence does not establish that the use was in relation to the services themselves, which were offered under marks such as Sky Bet or Mecca Bingo. There is no evidence that the marks were used in order to offer the contested services in class 41 to third parties, and there is no evidence of other types of recording other than films (e.g. sound recordings). I find that the proprietor has not made genuine use of the marks for any of the contested services in class 41.

Fair specification

67. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law relating to a fair specification as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

68. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46".

69. Ms Messenger submitted that, as the applicant had not challenged certain services in the specifications, the assessment of a fair specification must include an assessment of what was fair to the proprietor. As I understood it, the point was that, if the proprietor is allowed to use the marks in relation to production and distribution of films, it should also be allowed to retain in its specification connected goods and services in order to avoid conflict if another trader used the marks on those goods and services. That is not an argument I can accept. The protection of rights relative to another party's rights is the purview of s. 5. The only question under s. 46 is how the use which has been shown would fairly be described by the relevant consumer. In this case, no use has been

shown. In class 41, production and distribution of film services have not been challenged. These would, in my view, be regarded as distinct subcategories by the average consumer. There is, thus, no need for me to consider the question further.

Conclusion

70. The application has been successful. Subject to appeal, the marks will be revoked from the earliest date sought, as follows:

- (i) Trade mark number 2475818 will be revoked from 16 August 2013 for all goods and services except “production of films”; “production, distribution of films” in class 41, for which it will remain registered;
- (ii) Trade mark number 2162140 will be revoked from 20 March 2004 for all goods and services except “production, distribution of film” in class 41, for which the mark will remain registered;
- (i) Trade mark number 2146670 will be revoked for all goods and services from 17 October 2003.

Costs

71. The applicant has been successful and is entitled to an award of costs. An award is sought on the scale set out in Tribunal Practice Notice 2/2016. Mr Moody-Stuart submitted that, as the surrender of large parts of the contested specifications had been made only a matter of days before the substantive hearing and the case had largely been conducted on the basis of the entire specifications, that ought to be taken into account. I will take into account that much of the case was litigated on the basis of the whole specification. However, I also bear in mind that the applicant’s evidence was minimal and that the evidence filed by the proprietor, although ultimately insufficient, was not obviously irrelevant. I make the following award of costs to the applicant:

Official fee (x3):	£600
Preparing a statement and considering the counterstatement (x3):	£500
Filing evidence and considering the other party's evidence:	£700
Preparing for and attending a hearing:	£800
Total:	£2,600

72. I order ITV Studios Limited to pay Brian Baker the sum of **£2,600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of June 2019

**Heather Harrison
For the Registrar
The Comptroller-General**