

## **TRADE MARKS ACT 1994**

**IN THE MATTER of Trade Mark No 1209017  
in the name of Les Editions Albert Rene**

**and**

**IN THE MATTER of an application for  
revocation No 11232 by CWB Systems Services plc**

### **Background**

1. On 13 December 1983 Les Editions Albert Rene, of Paris, applied for the trade mark ASTERIX. The application was accepted, published and proceeded to registration on 31 October 1986. The specification of goods reads:

Class 9

Electronic amusement apparatus adapted for use with television receivers; coin-freed amusement apparatus (other than coin-operated billiard tables); computing apparatus; computer programmes and cartridges for use therewith.

2. On 16 November 1999, CWB Systems Services Plc, filed an application for revocation on the grounds of non-use. The application was made on Form TM26, together with the appropriate fee. The statement of grounds accompanying the Form TM26 set out two grounds of revocation. Following an amendment to the statement of grounds made on 9 January 2001, it sets out the following grounds:

(a) under section 46(1)(a) in that the mark has not been put to genuine use by the proprietor or with his consent in relation to the goods for which the mark is registered within the period of five years following the date of completion of the registration procedure and that there are no proper reasons for non use;

(b) under section 46(1)(b) in that the mark has not been put to genuine use for an uninterrupted period of five years and there are no proper reasons for non use; and

(c) further, if the mark is shown to have been used on some of the goods of the specification, the applicants request that under the provisions of section 46(5)(b), the specification of the mark be limited to only those goods on which use is shown. In particular, that the registrar, limits the term “computer software” to the type of software upon which use has been made.

3. On 8 March 2000, the registered proprietors filed a counter-statement and notice of the same on Form TM8 denying the grounds of revocation. Following amendment of the statement of grounds, the registered proprietors filed an amended counter-statement on 9 January 2001. In accordance with the requirements of rule 31(3) of the Trade Mark Rules 1994, if the registered proprietors intended to defend their registration they were required to

file evidence of use of the trade mark. The registered proprietors filed a statutory declaration and exhibits dated 3 March 2000, by Keith Richard Havelock a Trade Mark Attorney and Partner in D Young & Co. This is summarised below.

4. Following an exchange of correspondence regarding the evidence filed under rule 31(3), the agents representing the applicants for revocation asked whether the registrar was prepared to accept that evidence. The registry issued a letter dated 31 July 2000 expressing a preliminary view that the evidence filed by the proprietors did not show genuine use of the mark within the relevant period. An interlocutory hearing was appointed and took place on 16 November 2000, to determine the matter. At the hearing, both parties were represented. I was the Hearing Officer and I determined that whilst many of the applicants' criticisms of the evidence were justified there was enough for the proprietors to have an arguable case and so the matter should go forward for a full hearing after further rounds of evidence.

5. On completion of those evidence rounds, a hearing was appointed and was due to take place before me on 17 July 2002. However, shortly before the hearing, both parties informed the Office that they did not intend to attend the hearing and were content for a decision to be taken on the basis of the evidence on file. Both parties chose to file written submissions in lieu of their attendance at the main hearing. These were received under cover of letters dated 16 July 2002 .

6. Therefore, acting on behalf of the registrar and after a careful study of the papers, evidence and submissions made by the parties, I give my decision.

## **Evidence**

### Registered Proprietors' Evidence filed under rule 31(3)

7. As noted above, the registered proprietors filed a statutory declaration by Mr Keith Richard Havelock, dated 3 March 2000, in support of the registration. Mr Havelock also filed a further witness statement dated 27 November 2000. In his statutory declaration he states that he has conducted these proceedings on behalf of his firm's clients, Les Editions Albert Rene. He says that the mark ASTERIX is a famous mark being the name of a well known character syndicated around the world and used in relation to publications, recordings and a wide range of other goods and services.

8. Mr Havelock makes the statement that the mark ASTERIX has been widely used in the United Kingdom in relation to the goods covered by the trade mark 1209017 under licence agreements with different companies, including Gauselmann AG, Eurotalk Limited, Sega Enterprises Limited and Atari. At KRH-1 he exhibits copies of licence agreements with the above companies together with copies of the turnover made between 1983 and the present time in respect of the relevant goods. I will look at each of these in turn:

#### Licence between Les Editions Albert Rene and Gauselmann AG

9. This is in French, it is dated 24 July 1995. The agreement appears to cover the EEC and covers the period 1.10.95 – 31.3.97. There is a second licence with this company dated 20 July 1999. The licence covers 1.7.99 – 31.12.2001. In this bundle of documents there is a copy of a facsimile dated 31 January 2000. It is not clear who this letter is from or to whom it

is addressed. However, the letter heading shows Hans Werner Fuchs. They are shown as “d’Agent du Concedant” on the licence. The letter confirms that Gauselmann is “our licensee in England too as per agreement approved by you last year already”. Of interest is a second facsimile letter dated 14 October 1999 also on Hans Werner Fuchs paper. This states: “As regards classical games, GAUSELMANN would also be interested in England. There, however, with regard to their competitive prices they cannot exceed a royalty of 50DEM per piece. Forecast is for 500 games to be sold (ie total 25,0000 DEM). Please check whether you wish to accept this proposal.”

#### Licence between Les Editions Albert Rene and Sega Enterprises Ltd

10. This is in French, it is dated 30 June 1992. It covers the EEC and the period 1.6.92 – 30.6.94. There are appendices to the agreement. One shows UK & Eire 15% for 1993. I do not know whether this represents a target or predicted sales. In any event it is before the relevant date for section 46(1)(b). There is also a document headed, “Invoice ASTERIX Royalty payment for licensing agreement ASTERIX II for the above mentioned property for period ending 31 December 1993.” The figure listed is £9,823.91. The attached breakdown for the period ending December 1993 shows the quantity of sales as 25,818. A further sheet for the last quarter of 1993 shows a large number of sales for UK broken down presumably by the type of product listed. Sales are 86,750 and 67,903, together with two smaller amounts.

#### A Licence between Les Editions Albert Rene and Sega Enterprises Ltd

11. This is in French, it is dated December 1991. It covers the EEC and is for the period 1.10.91 – 31.12.94. The last month of this agreement falls within the relevant period for section 46(1)(b). There are documents concerning royalty payments. They cover 1992, 1993 and 1994. The evidence from these is all before the relevant date for section 46(1)(b). It is also not very clear to which territories they relate. For example, the one dated July 1994 shows sales for Brazil.

#### A Licence between Les Editions Albert Rene and Eurotalk Limited

12. This is in French and is dated 20 March 1992. It covers the UK and is for the period 1.4.91 – 31.12.93. Again, before the relevant period for section 46(1)(b). The same is true of all the “Sales and Royalty Declarations” enclosed with the licence which cover 1992 and 1993. In any event, similar evidence is provided with later agreements and is summarised and commented upon below.

#### A Licence between Les Editions Albert Rene and Eurotalk Limited

13. This is dated December 1993 and covers the UK for the period 31.12.93 – 31.12.96. It is for a ‘CD-ROM language for foreign speakers and talking titles in local languages’. Sales to the UK & Eire appear to be at 30%. The sales and royalty declarations cover March, September, and December 1994, March, June, September, and December 1995, and March, June and September 1996. There is a further document for 1 January – 31 March 1997. These show the following geographical breakdown of sales under the heading ASTERIX with the descriptions such as “Learn English A & Son/1” and “Learn English A & sec Weapon D1”. Others equate to the first title in French and Spanish, “Apprenez le fr – Fils d’

A A/1” and “Apren’ Espanol – Hijo d’ Ast D1”. All of the descriptors refer to learning languages. The UK figures are given as

	UNITS
1.10 - 31.12.94	323
1.4. - 30.6.95	177
1.7 - 30.9.95	377
1.10 - 31.12.95	1,182
1.1 - 31.3.96	1,207
1.4. - 30.6.96	380
1.7. - 30.9.96	206
1.10 - 30.12.96	246
1.1 - 31.3.97	-113
1.4. - 30.6.97	-11

#### A Licence between Les Editions Albert Rene and Eurotalk Limited

14. This is dated August 1997 and again covers the UK but for the period 1.7.97 – 31.12.99. It is for a ‘CD-Rom Language learning for Foreign Speakers and Talking titles in local languages’ – taken from the books Asterix & Son, Asterix and the Black Gold, Asterix and the Secret Weapon.
15. The Royalty statements cover the period of the agreement and show the following UK sales under the heading ASTERIX. With the same descriptors as above but with some new titles such as ASTERIX Latin, ASTERIX French, titles go on in the same manner for Spanish, German, Italian and English.

	UNITS
1.7 – 30.9.97	33
1.4. – 30.6.98	320
1.7. – 30.9.98	244
1.10 – 31.12.98	111
1.1 – 31.3.99	464

#### A Licence between Les Editions Albert Rene and Atari Inc

16. This is dated 1 August 1983 it covers a number of territories including the UK. There is a letter together with a receipt showing a purchase of the “Atari Asterix Game” in February 1987 and some royalty statements which do not show the relevant territory to which they relate.

17. As will be noted from my summary of the evidence, most of the licence agreements are in French. Following correspondence on this point and my indication to Mr Havelock at the interlocutory hearing, he filed a witness statement. The purpose of this witness statement is to introduce into the proceedings translations of the licence agreements. Mr Havelock exhibits sworn English translations of two of the licence agreements. He goes on to state that the licences are in common form, differing only in the names of the licensee companies and in some of the specific terms of the licence.

### The Applicants' Evidence

18. The applicants did not file evidence in the proceedings.

### The Registered Proprietors' Evidence under rule 31(6).

19. This consists of three witness statements. The first by Ms Dawn Moodie is dated 6 December 2001. Ms Moodie is a Trade Mark Attorney and freelance Trade Mark Consultant, currently working at the offices of Messrs D Young & Co. She also acted on behalf of the registered proprietors during Mr Havelock's absence from the office.

20. Ms Moodie states that she is aware of the background to the application. At DM1 she exhibits a copy of a CD ROM bearing the trade mark ASTERIX and a copy of an invoice relating to the purchase of such CD ROM (the receipt itself does not list the CD ROM). She states that she can confirm that the CD ROM was included in a package of software provided with a Packard Bell computer purchased by her husband Gordon Moodie and herself, on 10 November 1996 from Dixons, Kingston, Surrey. She notes that the CD-ROM indicates a copyright date of 1995. The CD-ROM has the title "Language Learning with ASTERIX", "ASTERIX and SON". It shows copyright 'EuroTalk 1995'.

21. The second witness statement is by Jane Harlow and is dated 7 December 2001. Ms Harlow is a Trade Mark Attorney and Associate of D Young & Co. At JH1, she exhibits a video game which she states was sold by Infogrames in the United Kingdom, together with a copy of a CD ROM and three duplicate invoices concerning sales of these products in the United Kingdom. She states that these materials were obtained and forwarded to them by their instructing principals from the lay client. The exhibit includes a photocopy of packaging headed "NINTENDO GAMEBOY COLOUR", "SEARCH FOR DOGMATIX ASTERIX". The rear of the packaging shows that it is distributed in the UK by INFOGRAMES UK of Manchester. There is also a photocopy of a packaging for a PC CD-ROM for the game "ASTERIX THE GALLIC WAR". The dates shown on the invoice are 25 August 2000, 30 May 2000, and 28 September 2000. All after the relevant date.

22. Finally, there is the witness statement of Adam Carroll dated 16 January 2002. He is a Solicitor and Head of Legal Affairs of Infogrames UK Ltd. Prior to that he states he was European Head of Legal Affairs for GT Interactive Software (Europe) Ltd, a company acquired by Infogrames UK Ltd in December 1999.

23. Mr Carroll confirms that his company distributes ASTERIX computer games software within the United Kingdom under licence from Les Editions Albert Rene and that his company has done so since 1995. He states that various types of software are distributed by his company for example, software suitable for use with Nintendo Gameboy and Colour Gameboy, the Sony Playstation console and software for use with PCs. At AC1, he exhibits a PC CD Rom example together with colour photocopies of packaging for a Sony Playstation version and another PC CD ROM of the computer software which he states is and has been distributed by his company in the United Kingdom. There are no dates as to when these products were on sale, however, I note that all the copyright dates on the packaging are 2000 or 2001. He states that the ASTERIX software is distributed by his company to retail outlets such as Dixons, Electronic Boutique, Game, Woolworths, HMV and Virgin Megastores.

24. The applicants did not file any evidence in reply. That therefore, concludes my review of the evidence.

### **Decision**

25. The relevant parts of section 46 of the Trade Marks Act 1994 read 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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

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

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

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the

court, the application must be made to the court; and

- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from -

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

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

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

27. The applicants’ grounds of attack go to sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994. Once this application was made, the effect of section 100 was to place the onus on the registered proprietors to show the extent and nature of the use made by them of the mark; see comments of Mr Clarke Q.C., sitting as the Appointed Person in *FLORIS* [2001] R.P.C. 19. The registered proprietors counter-statement does not rely on any proper reasons for non-use, and so I need not consider this point further.

28. The issue of applications for revocation on the grounds of non-use have been the subject of judicial comment in a High Court decision. Mr Justice Jacob in, *Laboratories Goemar SA v. La Mer Technology Inc* (19 December 2001) stated at paragraph 19:

“19...what amount and kind of use will suffice to prove that a mark has been *put to genuine use* within the meaning of Art.10 [of the Directive - section 46(1) of the Trade Marks Act 1994]? It is worth stating in some detail why the question is so important. There are a number of reasons:

- a) There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.
- b) The 8<sup>th</sup> recital of the Directive gives express recognition of that public interest. It says: “Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to

require that registered trade mark must actually be used or, if not used, be subject to revocation.....”

29. Earlier in the same case, Mr Justice Jacob, commenting on the provisions of section 100 set out above stated at paragraph 9:

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

30. With these comments in mind, I go on to consider the evidence submitted by the registered proprietors in support of the claim to use of the trade mark.

#### Relevant dates

31. As the application relates to both sections 46(1)(a) and (b) two five year periods have to be considered. They are:

46(1)(a)	Five years following registration	31/10/86 – 31/10/91
46(1)(b)	Five years preceding date of application	16/11/94 – 16/11/99

#### Two main questions

32. The two main questions that fall to be considered are:

- (1) Has the proprietor shown genuine use of the mark in the United Kingdom?
- (2) Has use been shown “in relation to the goods or services for which it is registered.....”?

(1) Has the proprietor shown genuine use of the mark in the United Kingdom?

33. The registered proprietors in their evidence and in their written submissions argue that the evidence filed, in particular the licence agreements and the royalty statements, do show use of the mark in relation to the goods for which the mark is licensed. They argue that the licensed goods are language learning CD-ROMs for foreign speakers and talking titles in local languages (the Eurotalk licence) and software for games consoles (the Sega Enterprises licence). Further, they make reference to the evidence of Mr Carroll who they say is an independent witness giving evidence as to the use of the mark on computer games.

34. Going on to consider whether the use shown can amount to genuine use, the registered proprietors refer to the comments of Mr Justice Jacob in *La Mer Technology*. Mr Justice Jacob made a reference to the ECJ in this case which I understand is still pending. However, he expressed his view that provided there was nothing artificial about a transaction under a trade mark then it will amount to genuine use. In his view, there was no lower limit of negligible. I am also aware of the recent opinion of the Advocate-General in the *Ansul BV v. Ajax Brandbeveiliging BV* (C-40/01), a case currently before the ECJ. It appears from the Opinion of the AG that he favours a slightly different test of whether use amounts to “genuine use”.



35. The applicants in their submissions argue that the registered proprietors have not shown any use of the trade mark ASTERIX in relation to any of the products contained in their specification. Their written submissions only refer to the period 15 November 1994 – 15 November 1999, the period under section 46(1)(b). They make the following comments on the registered proprietors' evidence:

36. Referring to the evidence of Mr Havelock they suggest that the licensing contracts filed with Mr Havelock's statutory declaration relate to licensing agreements on an almost global basis. They argue that they do not constitute evidence of use of the mark in the United Kingdom. They state that there is no confirmation in these documents that any manufacturing or sales took place of products bearing the mark ASTERIX in the United Kingdom. They submit that a world-wide licence agreement cannot show that the mark was ever placed on products in the United Kingdom. Further, the applicants state their view that as Mr Havelock is not employed by the registered proprietors he cannot state that sales took place under those licences.

37. With regard to the other evidence filed by the registered proprietors, they note that the receipt accompanying exhibit DM1 to Ms Moodie's witness statement does not show that the CD shown on the exhibit was enclosed with the package purchased. They question in any event whether such use could be classed as genuine use. The purchase of the computer having nothing to do with the presence of the ASTERIX CD and therefore the CD was not actually purchased but provided free. Referring to the evidence of Ms Harlow they note that the packaging enclosed with her statement is not dated and that the invoices are all after the relevant date. Turning to Mr Carroll's statement, they comment that there is no proof that sales took place and that the packaging is in a number of languages and that there is no proof that any sales took place in the United Kingdom. They argue that no invoices, turnover figures etc have been provided in evidence.

38. The applicants' submissions go on to argue in the alternative, that if the evidence does show some genuine use then the specification for the mark should be limited accordingly. This is dealt with at (2) below.

39. Before considering the substance of the registered proprietors' case, I note from the applicants' written submissions, that the applicants' comments all refer to section 46(1)(b). However, their grounds of revocation also refer to section 46(1)(a). This represents a different five year period. For reasons that will become apparent, I do not think that this has any bearing on the case. It seems to me that the proprietors can be in no better position than if I address myself to the later period, that under section 46(1)(b). If they have not shown use on the goods within that period then the applicants' case is made out and the mark should be revoked. I turn therefore to consider whether there is evidence to support a claim of genuine use of the mark within the United Kingdom? The relevant period is 16 November 1994 – 16 November 1999.

40. On reviewing the registered proprietors' evidence, I find myself in agreement with many of applicants' criticisms. Firstly, in my view, the mere fact that the proprietor has licensed another to use the trade mark on goods within the specification is of itself meaningless. As noted by the applicants, many of the licences cover a number of territories, a licence does not show that a single product was manufactured or a single sale or advertisement for sale took place within the relevant period and more importantly within the relevant jurisdiction, in this case, the United Kingdom.

41. Secondly, statements made by an individual only go so far to supporting a claim to use of the trade mark. In his first declaration, Mr Havelock makes the bold statement that, "The trade mark ASTERIX has been widely used in the United Kingdom in relation to the goods covered by...". This of itself, does not in my view enable me to find that the proprietors have shown use of their mark in relation to the full range of goods for which the mark is registered, something more is required. It seems to me that the registered proprietors must come forward with evidence showing the use that has been made of the mark, the extent and nature of that use. In an ideal case, the claim to use will be supported by for example, turnover figures, advertising expenditure, together with examples of the use and any advertisements that have appeared in the press or on the television. Whilst the provisions of rule 22 of the Commission Regulation (EC) No 268/95 implementing Council Regulation (EC) no 40/94 on the Community Trade Mark relate to proof of use in opposition proceedings before the OHIM, it seems to me that they provide a good guide to the sort of evidence that a tribunal would expect a proprietor to file in order to show use of the mark. The rule lists items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing.

42. Given my comments, I can also in my view give little weight to the statement made in Mr Carroll's evidence. The registered proprietors in their written submissions state that this is evidence from an independent party. I cannot agree. Mr Carroll states that he represents one of the proprietors' licensees, Infogrames. Regardless of this, what does his evidence show. He makes a claim that the mark has been used since 1995. However, as noted by the applicants, he provides no breakdown of figures showing the number of such sales and the exhibits attached to his declaration are all after the relevant date. In my view this does not show use of the mark within the relevant period within the United Kingdom. The same is true of the evidence of Ms Harlow. This evidence again relates to use by Infogrames but all the use shown on invoices and the copyright dates on the packaging are all after the relevant date and are therefore irrelevant.

43. Thirdly, many of the licence agreements relate to a period of time before November 1994 and are therefore irrelevant in considering the question under section 46(1)(b). Given that in my view the statement made in the registered proprietors' evidence and the licences are not sufficient to maintain the registration, I must go on and consider other documents filed with the licences to see whether they provide evidence of use of the trade mark.

44. The documents contained with the licence relating to Gauselmann AG, do not in my view show use of the trade mark in the United Kingdom. They consist of copies of two facsimile letters. Neither in my view show evidence of sales in the United Kingdom of any products under the trade mark ASTERIX. One confirms that Gauselmann is the licensee in the UK and the other that they would like to market there but there is a problem with the royalty fee. There is a forecast of 500 games but no indication as to whether any were actually sold.

45. There are two licences filed relating to Sega Enterprises. The first is before the date for section 46(1)(b). An invoice appears to show a royalty payment for ASTERIX II. A further sheet for the last quarter of 1993 shows a large number of sales for the UK. On the basis of this evidence, I am prepared to find that the mark ASTERIX was used in relation to games software in the period 1993. The second licence with Sega expires one month into the relevant period. The royalty payment details are all before November 1994 and in any event, it is unclear to which territories they relate. One dated July 1994 clearly relates to Brazil. This evidence does not support a claim of use of the mark ASTERIX on games software within the period under section 46(1)(b).

46. There are several licences with Eurotalk submitted in evidence. A large number of supporting documents were enclosed with these licences. They appear to relate to “CD ROM language for foreign speakers and talking titles in local languages”. The royalty statements are not entirely clear but in my view, they do show products bearing the titles “Learn English A & Son/1” and Apprenez le fr – Fils d’ A A1” and “French Asterix”. These products are all listed under the title ASTERIX and the figures are broken down by country. They show in my view a steady turnover in volume of products across a period from 1994 – 1999. In some quarters the quantity listed is small, for example 33 in the third quarter of 1997, but in others the quantity is more substantial, 1,207 in the first quarter of 1996. On any view, it seems to me that the quantities concerned cannot be dismissed as insignificant. I have mentioned the interpretations of the word “genuine” as set out by Mr Justice Jacobs and AG Colomer above. Applying either test, I believe the use shown here would amount to genuine use.

47. One problem with this evidence is it does not show how the mark has been used on the product. However, taken together with the evidence of Ms Moody showing use of the mark on one of the products in question, I think that it is enough to show use of the mark. As can be seen from my comments, the evidence here is not without its imperfections. There are various titles listed and one is left to speculate that titles such as “Learn English A & Son” would not be the top selling title in the UK but that titles such as “Apprenez le fr – Fils D’A” and “ASTERIX SPANISH” would be the main products sold in the UK. That said, I am satisfied on the basis of this evidence that some use has been made of the trade mark ASTERIX.

48. The registered proprietors’ written submissions claimed that this evidence showed use of the mark in relation to language learning CD-ROMs and talking titles. Whilst on the basis of the evidence before me I find that use has been shown in relation to language learning CD-ROMs, the same is not true in my view of their claim to use on talking titles. None of the royalty statements exhibited refer to talking titles. They all make reference to learning in various languages using a number of Asterix titles.

49. The evidence relating to the Atari licence does not in my view assist. The licence relates to games software, it covers the UK but there are no royalty statements showing the number of sales in the UK. There is evidence of one sale in the United Kingdom in February 1987. This might be relevant for a consideration of the case under section 46(1)(a) but not for the case under section 46(1)(b).

#### Conclusions under section 46(1)(b)

**50. Having regard to the totality of the registered proprietors’ evidence, I find that it shows use of the trade mark ASTERIX on language learning CD-ROMS within the period 11 November 1994 – 11 November 1999. The proprietors have not in my view shown use within this period on: Electronic amusement apparatus adapted for use with television receivers; coin-freed amusement apparatus (other than coin-operated billiard tables); computing apparatus; or on the full range of computer programmes or on cartridges for use therewith.**

#### Section 46(1)(a)

51. As noted above, the applicants did not refer to this ground in their written submissions and in my view, the proprietors can be no better off if I consider the case under this section. They have in my view shown use on games software within this period, however, as the

applicants have pleaded and argued section 46(1)(b) then the use on games software is outside this period and I need not consider the point any further.

2. Has the use been shown in relation to the goods for which the mark is registered?

52. The provisions of section 46(5) make it clear that where grounds for revocation exist in respect of only some of the goods for which the mark is registered then revocation shall relate to those goods only. Taking into account my findings above, what specification should I leave for the proprietors? It seems clear to me that no use has been shown on the following goods and the mark is revoked with effect from the date of application for revocation for:

Electronic amusement apparatus adapted for use with television receivers; coin-freed amusement apparatus (other than coin-operated billiard tables); computing apparatus; cartridges for use therewith.

53. The proprietors' specification also includes the words "computer programmes". The applicants ask in their statement of grounds for this term to be restricted to the goods on which it has been used. The applicants' submissions note that much of the registered proprietors' evidence seeks to claim use on games software and so they suggest that this would be an appropriate limitation if I found that the evidence did show use of the mark. However, on the evidence before me I have not found that it showed use on games software within the relevant period but that use was shown on language learning CD-ROMs.

54. Should I restrict the specification or should I leave them with the broad term "computer programmes". The applicants refer me to the comments of Mr Justice Laddie in *Mercury Communications Limited v. Mercury Interactive (UK) Limited* [1985] F.S.R. 805 where he stated:

"At the beginning of this judgment I set out the specification of goods in respect of which the plaintiff's mark is registered. In fact the plaintiff only uses it and, I understand, only ever intended to use it in relation to its telecommunications business. The defendant argues that the registration, in so far as it covers computer software, should be restricted as follows: "All for use in or with telecommunications systems."

The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to Mr Silverleaf that the registration of a mark for "computer software" would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff's type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable. In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for "computer software" will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a

flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

55. The opponents referred me to the judgment of Mr Justice Neuberger in *Premier Brands UK Limited v. Typhoon Europe Limited* [2000] F.S.R. 767. However, I am also aware of the judgments given in *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] R.P.C. 17 page 293 and *Daimler Chrysler AG v Javid Alavi (t/a MERC)* [2001] R.P.C. 42 page 813. Both were decisions of Mr Justice Pumfrey. In the Decon case he considered the construction to be placed on Section 46(5) and reviewed a number of existing authorities (including *Premier Brands*) which, on the facts and circumstances of the cases concerned, had produced somewhat different approaches to the matter. His conclusions, which he adopts as his starting point in the later case (MERC), were as follows:

“24. I think that the correct starting point as a matter of principle consists of the list of articles for which the proprietor has in fact used the mark. In arriving at a fair specification having regard to the proprietor's use, it is also necessary to remember that the effect of section 10(2) (and of 10(3), in limited circumstances) is to give the proprietor protection outside his specification of goods but in areas where he can demonstrate a likelihood of deception in the wide sense, that is, deception as to trade origin leading to association among the relevant public. There is no pressing need, therefore, to confer on the proprietor [of] a wider protection than his use warrants by unduly broadening the specification of goods. There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.”

56. I note also Headnote 10 in the Decon case, this conveniently summarises the conflicting positions that Pumfrey J was trying to resolve in reaching a specification that legitimately reflected the proprietors' use:

“(10) The defendants' first proposed specification of goods was open to the objection that the words "general purpose" were ambiguous in that they could cover products such as detergents for domestic use. However, limitation of the mark by the inclusion of the words "all for laboratory use" was too narrow and did not reflect the use actually made of the mark, which included industrial use. The specification would therefore be limited by the inclusion of the words "all for non-domestic use". (paras 25 and 26).”

57. It seems to me that given the narrow scope of the proprietors' use as shown in their evidence, it does not support a claim to use on “computer programmes” at large. Taking into account the comments made in the cases referred to above, it seems clear to me that I should restrict their specification. This raises a further question as to the extent of specification that they should retain. It could be said that I should leave them with “computer programmes relating to education” or perhaps “being language training programmes”. Alternatively, it could be argued that as the use shown is on “language learning CD-ROMs” then this is what

they should have. I have not found this aspect of the case easy to determine. One could argue that, consistent with the approach adopted in *Decon*, the correct starting point must be the actual goods for which the proprietors have used their mark. In this particular case the evidence shows that ASTERIX has only be used on a language learning CD-ROM.

58. That said, I note the comments of Mr Justice Laddie in *Mercury*, that, “the defining characteristic of a piece of computer software is not the medium on which it is recorded”. The registered proprietors’ product has been sold on a CD-ROM but could be sold by other means and on other media. In all the circumstances and taking the best view I can of the matter, I think that I should leave the registered proprietors with the specification set out below.

### **Conclusions**

**59. Accordingly the outcome of the action under Section 46(1)(b) is that the registration will be revoked with effect from the date of application for revocation (16 November 1999), for all goods except:**

**“Computer programmes namely language training programmes.”**

### **Costs**

60. The applicants for revocation have to a large extent been successful and are entitled to a contribution towards their costs. I order that the registered proprietors pay the applicants the sum of £735-00. In making this award, I have taken into account the earlier interlocutory hearing at which the applicants objected to the registered proprietors’ evidence of use. I have not made any award in respect of that hearing. Whist at the interlocutory hearing I found that the registered proprietors’ evidence was sufficient to allow the proceedings to continue, I agreed with many of the criticisms of the evidence made by the applicants and required proper translations of the evidence to be filed. As such, it seems to me that the interlocutory hearing could be described as a “score draw” and so I make no award in respect of it.

61. The sum of £735-00 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 27th day of November 2002**

**S P ROWAN  
For the Registrar  
the Comptroller General**