

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 12482
BY MILES SAMARATNE
FOR REVOCATION OF TRADE MARK NO 1305616
IN THE NAME OF PARAMOUNT PICTURES CORPORATION**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 12482
By Miles Samaratne
For Revocation of Trade Mark No 1305616
in the name of Paramount Pictures Corporation**

DECISION

1. Trade mark number 1305616 is for the mark CHEERS, and is registered in respect of:

Menus, napkins, coasters; posters; printed matter; all included in Class 16.

The registration stands in the name of Paramount Pictures Corporation.

2. By an application dated 27 April 2001, Miles Samaratne applied for this registration to be revoked under the provisions of Section 46(1)(b) on the grounds that:

there has been no use of the trade mark for an uninterrupted period of 5 years, by the proprietor, Paramount Pictures Corporation, or with its consent in relation to the goods for which the mark has been registered and there are no proper reasons for such non-use.

3. The registered proprietors filed a counterstatement in which they deny the allegation. Both sides ask for an award of costs to be made in their favour.

4. Both sides have filed evidence in these proceedings. The matter came to be heard on 13 August 2002, when the applicants were represented by Ms Catherine Wolfe of Page White & Farrer, their Trade Mark Attorneys, the registered proprietors by Mr Ian Wilkes of RGC Jenkins & Co, their trade mark attorneys.

Registered Proprietor's evidence

5. This consists of two Witness Statements. The first is dated 7 August 2001 and comes from Ian Wilkes of RGC Jenkins & Co, the registered proprietor's representatives in these proceedings.

6. Mr Wilkes states that the registered proprietors have used, and currently use the trade mark CHEERS in the United Kingdom, in respect of menus. He refers to exhibit A which consists of examples of menus showing use of the word CHEERS, in block capitals in relation to specific foodstuffs and in a claim to trade mark rights, although it is primarily used in an italicised script, some having the word LONDON underneath. The menus claim trade mark and copyright rights dating from 1999, although it is not clear whether this relates to the "Paramount" logo, "CHEERS" or both. Whilst these rights may have existed at that date, there is nothing that shows that the menus were actually available to customers within the relevant period.

7. The second Witness Statement is dated 3 August 2001 and comes from Michelena Hallie, Vice President of Paramount Pictures Corporation, a position she has held since 1993.

8. Ms Hallie states that her company has used the trade mark CHEERS in the United Kingdom in respect of menus, napkins, coasters, posters and printed matter. She refers to exhibit A which consists of photographs of similar types of menus to those shown as exhibit A to the Statement by Ian Wilkes, the exception being the inclusion of a paper carrier bag. The mark is shown in the same style as previously described. None can be dated as having been available in the relevant period.

Applicant's evidence

9. This consists of two Witness Statements. The first is dated 7 December 2001 and comes from Catherine Ann Wolfe of Page White & Farrer, the applicant's representatives in these proceedings.

10. Ms Wolfe refers to the evidence filed by the registered proprietors, saying that this only shows use of the word CHEERS in block capitals in relation to a number of foodstuffs, which supports use of the mark in relation to prepared foodstuffs, but not menus. She notes that the proprietors have not claimed that the menu itself is the subject of trade; the evidence indicating that it is the bar or restaurant that is operating under a stylised mark, and that the menus are only for the purpose of listing the items available. Ms Wolfe also notes that there is no indication that the paper carrier bag shown in the proprietor's evidence is available for purchase

11. Ms Wolfe states that apart from the instances of use in relation to items of foodstuffs, all use has been in a stylised form, not just the word alone, and is therefore not the mark as registered. She says that the proprietors have not claimed this stylisation to be a variant of the block capital presentation in which the mark is registered, a reference to Section 46(2) of the Act which allows use of a mark not differing in its material particulars to be deemed to be use in the registered form. She provides an extract from Chapter 6 of the Registry Work Manual (exhibit CAW1) relating to series marks, from which she concludes that as the stylised version shown in the evidence and the block capital form in which it is registered would not be acceptable as a series, then it cannot fall within the provisions of Section 46(2).

12. The second Witness Statement is dated 5 December 2001, and comes from Miles Samaratne, the applicant for revocation.

13. Mr Samaratne refers to exhibit MS1, which consists of an extract from the UK trade marks register which shows that the mark in suit is registered in block capitals, and to exhibit MS2 which shows the registered proprietor's use to be in a stylised form, namely, a prominent and stylised letter C, an italicised presentation in lower case letters, and an underlining flourish attached to a stylised last letter. He reiterates that the only use of CHEERS in block capitals is as a mention in relation to foodstuffs, not for the menus itself.

Registered Proprietor's evidence

14. This consists of further Witness Statements by Ian Wilkes, dated 4 March 2002, and Michelena Hallie dated 12 February 2002.

15. Mr Wilkes refutes Ms Wolfe's assertions that the mark as registered and the italicised form used would not be viewed as a series. He says that both are clearly the word CHEERS, are orally and aurally identical, and that exhibit A which consists of examples of series of marks accepted by the registrar all support his position that the stylised use is sufficient to invoke the provisions of Section 46(2).

16. Ms Hallie's Statement is primarily a rebuttal of the assertions made by Ms Wolfe and apart from highlighting the use of CHEERS in block capitals in the claim to trade mark rights, adds nothing further to these proceedings.

Applicant's evidence

17. This consists of a second Witness Statement from Catherine Wolfe, this being dated 27 May 2002.

18. Ms Wolfe comments that the use of CHEERS referred to by Ms Hallie (the statement of trade mark rights) is in extremely small lettering, but that use of a trade mark notice on a menu is not use of the trade mark in the course of trade.

19. Ms Wolfe turns to the Witness Statement by Ian Wilkes, noting that he only argues that the marks as used and as registered are "materially the same". She asserts that his analysis based on the "series" argument is an issue relating to Section 41(2), and as was shown in the *ELLE* and *Second Skin* trade mark cases, copies of which are shown as exhibits CAW1 and CAW2, is a materially different consideration to that under Section 46(2).

That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

20. I turn to consider the respective grounds upon which the application for revocation has been brought. These are found in Section 46(1)(b) of the Act, which reads as follows:

- “46-(1) The registration of a trade mark may be revoked on any of the following grounds:
- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
 - (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use.”

The attack is made under (b) of the above, but I have included (a) because it tells us what "such use" means.

21. Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. In this case the proprietors claim that there has been use in the form as registered, but also in a form that qualifies under the provisions of Section 46(2), which reads:

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

22. The mark as registered consists of the word CHEERS in plain block capitals. There is some use of the word in that form, but only in conjunction with menu items and in the statement of trade mark rights, neither of which support a trade in any goods in Class 16. Most use is in a stylised form, and in my view, if the word is clearly still the word and nothing but the word, then such use should properly be considered to be use in the form in which it is registered. Or to put it another way, if what has been added or done to the word has distinctiveness in its own right, or alters the way in which a word will be perceived, for example, the addition of “limited” would change CHEERS into a company name rather than a simple word, then what has been done will have altered the distinctive character.

23. As a means of illustrating that the mark in THE italicised form shown in the evidence is no different in its material particulars to the word CHEERS in block capitals, Mr Wilkes argues that the two are orally and aurally identical, and that they would be accepted as constituting a series. Ms Wolfe referring to the decisions in *ELLE* [1997] FSR 529 and *SECOND SKIN* [2000] RPC 17, rightly considered this argument to be ill founded. In *SECOND SKIN*, the Hearing Officer stated that “The provisions of Section 46(1)(a) require that a trade mark has been put into genuine use...it seems to me that the provisions would not be satisfied merely by customers using the trade mark.” Likewise, the mere fact that words in two different forms may be orally and aurally identical would not satisfy the provisions. This argument invites the consideration to disregard all other matter present, regardless of its distinctiveness which must be wrong. In the *ELLE* case, Mr Justice Lloyd considered that drawing an analogy between Section 46(2) (which is derived from the Trade Marks Directive) with Section 41 (which is not) to be an unhelpful way of determining a question under Section 46(2).

24. To use the applicant’s own analysis. The word in the form shown in the registered proprietor’s evidence is in an “italicised script”, a commonplace font which hardly changes it in a material way. They go on to say that it has a “prominent stylised letter C” and an “underlining flourish attached to the very stylised last letter” which I consider to be overstating the case, but in any event, both are nonetheless still clearly the letters. In short, I see the mark as shown in the evidence as the word CHEERS and that any stylisation has not altered the distinctive character of the word from the form in which it is registered.

25. As I have said, the proprietors evidence of use shows the word CHEERS being used in connection with the provision of food and drink, the use on menus being ancillary to this trade. There is nothing that establishes that the menus were in use within the United Kingdom in the relevant period. I therefore find the revocation to be successful, and that the registration is revoked in respect of all goods with effect from 27 April 2001.

26. The application having been successful, the applicants for revocation are entitled to a contribution towards their costs. I therefore order the registered proprietors to pay the applicants the sum of £600 within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

Dated this 03 Day of February 2003

**Mike Foley
For the Registrar**