

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 12484  
BY MILES SAMARATNE  
FOR REVOCATION OF TRADE MARK NO 1305618  
IN THE NAME OF PARAMOUNT PICTURES CORPORATION**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 12484  
By Miles Samaratne  
For Revocation of Trade Mark No 1305618  
in the name of Paramount Pictures Corporation**

### **DECISION**

1. Trade mark number 1305618 is for the mark CHEERS, and is registered in respect of:

Jackets, sweaters, aprons, T-shirts, sweatshirts, hats, all included in Class 25.

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 a variety of clothing articles. He refers to exhibit A, which consists of photographs of T-shirts, sweatshirts, a jacket and various sew-in tags. All bear the word CHEERS represented in an italicised script, most having, inter alia, the word LONDON underneath. In the case of the clothing the word appears either on the tag, as a large logo on the chest, or in the position where a breast-pocket would be. Two examples of a sew-in tab bear a claim to trade mark rights and copyright although it is not clear whether this relates to the "Paramount" logo, "CHEERS" or both. One dates from 2001, the other from 1997. The best that can be said about this evidence is that it claims trade mark rights dating from within the relevant period but does not establish use of the mark in respect of any goods in that 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 jackets, sweaters, aprons, T-shirts, sweatshirts and hats. She refers to exhibit A which consists of photographs of some of the articles of clothing shown in exhibit A to Ian Wilkes Statement, the exception being the inclusion of a baseball cap. 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 a composite stylised mark that resembles a logo, referring in particular to "an elaborate letter C, a highly cursive final letter conjoined to an underlining flourish and the block capitals LONDON.", which is not the mark as registered. Ms Wolfe states 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 the stylised version shown in the evidence and the block capital form in which it is registered would not be acceptable as a series, and consequently, it cannot fall within the provisions of Section 46(2).

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

12. 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.

### **Registered Proprietor's evidence**

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

14. Mr Wilkes refutes the assertions that the mark in the form as it is registered, and the italicised form in which it is used would not be viewed as a series, saying that they are both clearly the word CHEERS and orally and aurally identical. He says 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).

15. Ms Hallie's Statement is a simple rebuttal of the assertions made by Ms Wolfe and adds nothing further to these proceedings.

### **Applicant's evidence**

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

17. Ms Wolfe's Statement is primarily a comment on the substance of the evidence adduced by Mr Wilkes and Ms Hallie, referring to the *ELLE* and *SECOND SKIN* trade mark cases, copies of which are shown as exhibits CAW1 and CAW2. Ms Wolfe says that Mr Wilkes admits that there is a difference between the mark as registered and as purported to have been used, and submits that his analysis based on the "series" argument is an issue relating to Section 41(2), and as shown in the two cases, 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**

18. 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.

19. 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 there has been no use of the mark in the form in which it is registered, but the proprietors say that the stylised form in which it has been used 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.”

20. The mark as registered consists of the word CHEERS in plain block capitals. In my view, if the word is represented in a stylised form, but 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.

21. As a means of illustrating that the mark in the 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 the 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).

22. 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.

23. The proprietor’s evidence of use shows the word CHEERS being used in connection with T-shirts, sweatshirts and a blouson type jacket. The word is shown on sew-in tags, as a large logo on the chest or a small representation where a breast-pocket would be. Although most have the word LONDON underneath I do not consider that this materially affects the consideration. Only two pieces of evidence, two sew-in labels, can be dated, although as I have already said, it is not clear whether this relates to the Paramount logo and/or CHEERS. The first bears a claim to trade mark rights and copyright dating from 2001, which given that the relevant period dates back from January 2001 (taking into account the 3 month disregard in Section 46(3)) does not establish use within the requisite period, the other label is noted as claiming the same rights from 1997. The best that can be said about this evidence is that whilst it claims rights in the mark dating from within the relevant period, it does not establish any use, in the United Kingdom in that 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.

24. 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**