O-310-04

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 80006
BY DORLING KINDERSLEY LIMITED
FOR REVOCATION OF REGISTRATION No. 1470598
STANDING IN THE NAME OF
INTERACTIVE TELEVISION ENTERTAINMENT APS

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 80006 by Dorling Kindersley Limited for Revocation of Registration No. 1470598 standing in the name of Interactive Television Entertainment ApS

Background

1. Trade Mark No. 1470598 is registered in the name of Interactive Television Entertainment ApS for:

> "Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; data processing apparatus and instruments; parts and fittings for all the aforesaid goods; all included in Class 9."

The mark itself is as follows:

2. On 25 July 2001 Dorling Kindersley Limited applied for this registration to be revoked under the provisions of Section 46(1)(b) on the basis of non-use (and no proper reasons for non-use) for an uninterrupted period of five years in relation to the goods for which it is registered.

3. The registered proprietor filed a counterstatement denying the above ground.

4. Both sides ask for an award of costs in their favour.

5. Only the registered proprietor filed evidence. Neither side has asked to be heard. Written submissions have been received from fj Cleveland, the applicant's professional representatives in this matter. Acting on behalf of the Registrar and with this material in mind I give this decision.

The Law

6. Sections 46 reads:

> "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 to 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."

7. Section 100 is also relevant and 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."

Decision

8. The registered proprietor has not suggested that there are proper reasons for non-use of its mark. The matter, therefore, falls to be determined on the basis of whether the registered proprietor has shown genuine use of its mark. The European Court of Justice (ECJ) has given guidance on what constitutes genuine use of a trade mark in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40.

"36. 'Genuine use' must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services 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.

37. It follows that 'genuine use' of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d'etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

> 38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.
>
> 39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.
>
> 40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available."

9. I also bear in mind that the English Courts have emphasised the need for registered proprietors to prove their case with great care particularly where a few items or small amounts of use are relied on (see *Philosophy Di Alberta Ferretti Trade Mark* [2003] RPC 15 and *Laboratoires Goemar SA's Trade Marks* [2002] ETMR 34).

10. This case also gives rise to an issue under Section 46(2) as to whether the use shown has been "in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered". In *Budejovicky Budvar Narodni Podnik and Anheuser-Busch Inc* [2003] RPC 25 Lord Walker of Gestingthorpe approached this matter by posing the following question:

> "The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

In answering these questions he said:

> "The Hearing Officer uses his skill and experience to analyse and assess the likely impact of the mark on the average consumer although the latter probably does not himself engage in any analysis of that sort."

Lord Walker added that:

> "It is of course correct that the 'central message' of a mark is not the statutory test, and it is not always helpful to paraphrase a statutory test before applying it. But as the Court of Justice observed in Lloyd Schuhfabrik, the average consumer normally perceives a mark as a whole, so that 'central message' may not be too bad a paraphrase, so long as it is understood as comprehending the essential 'visual, aural and conceptual' qualities which combine to give a mark its distinctive character."

11. I note that the mark at issue in this case is a device of a figure which I infer is intended to be a troll with the words HUGO THE TV TROLL set above the figure. The troll device is in what I might call a line drawing format. I regard both the words and device as contributing to, and being essential elements of, the distinctive character of the mark.

The relevant dates

12. The attack is under Section 46(1)(b). As no earlier date has been requested I take the relevant period to be the five years preceding the filing date of the application, that is to say 25 July 1996 to 24 July 2001.

The evidence

13. The proprietor's evidence comes in the form of a statutory declaration by Michael Arthur Lynd, a registered trade mark attorney and partner in the firm of Edward Evans Baker, the proprietor's professional representatives at the time. He says that the facts contained in his statutory declaration comprise information known personally to him and/or supplied by the licensee of the registered proprietor. He says that the trade mark is licensed for use by a Danish company, Interactive Television Entertainment ApS (ITE). In fact the registration now stands in the name of that company. It is not clear when ITE acquired the registration. Mr Lynd's evidence is the product of various internet searches he conducted.

14. The applicant for revocation's submissions focus on two areas of the evidence thus supplied. The primary submission is that the use shown is not of the mark as registered or in a form which would bring the proprietor within Section 46(2). In the alternative, if I am not with it on the first point, the applicant says that the specification should be cut down to 'computer games' and be revoked in respect of the remaining items in the specification.

15. With these points in mind I turn to Mr Lynd's declaration and the Exhibits attached thereto. I propose to consider and comment on them individually.

MAL1 - is a page taken from the proprietor's website (www.ite.dk). Mr Lynd observes that there are several references to games featuring the word HUGO. The proprietor is a Danish company and the website is a Danish website. No doubt it is accessible in the UK but whether it can be said to target UK customers is not clear from the single page exhibit (see *Euromarket Designs Inc v Peters* [2000] ETMR 1025 for judicial comment on the nature of internet usage). There are various references to Hugo such as 'Hugo-Black Diamond Fever', 'Hugo goes Venezuelan' and 'Hugo-Frog fighter'. There is also a picture of what I take to be an animated version of the Hugo character. The web page refers to a 3D Festival 2001 Copenhagen from 23-26 October. This exhibit, therefore, shows neither qualifying use of the mark (that is to say in the form registered or with immaterial variation), nor use within the relevant period, nor so far as I can tell UK use.

MAL2 - is a page from the website www.consolegaming.com/sony/Hugo/home.asp. In common with most if not all of the website exhibits the page appears to have been taken on 18 October

2001. However, Mr Lynd notes that there is a copyright date of 1997-2000. The copyright reference refers to Game Depot and, although the position is not entirely clear, may relate to the owners of the site rather than the HUGO character. The two page exhibit describes a PlayStation game which is said to be "based on Hugo the TV Troll (the highly popular Danish Interactive gameshow) ….". Although the computer game may be based on the TV show it is generally described purely as HUGO. There is a still photograph of what may be the packaging for the game but the detail is indistinct. I can find no reference to the mark as registered or in a form that would qualify under Section 46(2).

MAL3 - is a further page from the proprietor's (Danish) website. Mr Lynd observes that it states:

> "Following the international success of the Hugo series for PlayStation, the always charming and energetic troll, Hugo, is at it again with the dramatic new action-game Hugo-The Black Diamond Fever – also released on PC CD-ROM and Gameboy Color".

Again, this is neither UK use (or at least not obviously so), nor is it use of the mark as registered (or in an acceptable variant form) and is not clearly within the relevant period.

MAL4 - is a page from the website www.docos.com. It appears to be a film/television industry news site. Mr Lynd notes that:

> "…. this material is identified as Issue 32A – 17 July 2000. On page 2 there is a reference to *"Interactive wildlife meets animation in Danish/Turkish deal"*, and further information is set out on page 13. The passage on page 13 refers to Hugo the TV Troll and states that this was developed by ITE in 1990 and became a leading interactive gameshow, and subsequently migrated to platforms such as PC, PlayStation and Gameboy."

Apart from giving an indication as to when the character was conceived this material does not advance the claim that the mark has been used in the UK. There is also no reference to the mark itself (that is with the device).

MAL5 - is a copy of an article dated 27 September 1999 to be found at www.findarticles.com. My attention has been drawn to the following in an article entitled 'Euros plug into interactive':

> "In Europe, upstart companies such as Interactive Television Entertainment (ITE) and old hands like the BBC are at the forefront of developments. ITE has four interactive formats being developed, including the world's first interactive gameshow, "Hugo the TV Troll", which has sold to more than 25 countries".

The above extract makes no reference to the UK. It emerges later in Mr Lynd's declaration that the gameshow has never been broadcast in the UK (see below). This is not, therefore, evidence of use of the composite mark in relation to the goods of the registration in this country.

MAL6 - is another page taken from the proprietor's website referring to the game HUGO GOLD. Again there is difficulty in establishing whether this Danish website is directed at the UK. Furthermore, there is no use of the composite mark that is registered in the UK as well as difficulty in dating the material.

MAL7 - is a cached webpage found at www.egmont.com. The page is dated 13 June 2001 which places it within the relevant period. Mr Lynd notes the following entry:

> "**Games. Hugo the TV Troll has been sold**. Change in owners of the Danish world-famed figure: ITE Aps, who owned the TV-troll, has been taken over by Olicom for approximately EUR 1.34 million. This happens to make use of the new possibilities with for instance broadband and the mobile internet. Hugo now has many brothers and sisters in interactive TV games and in computer games".

That passage is concerned with publicising a change of ownership. It tells me nothing about use of the composite mark HUGO THE TV TROLL and troll device in the UK.

MAL8 - is a page from www.itvdictionary.com which discusses an interactive television programme called Hugo Safari issued in 1999 and a further interactive game called Hugo Jungle also issued in 1999. None of this satisfies the onus on the proprietor to show use of the registered mark HUGO THE TV TROLL and device in the UK.

MAL9 - is a further page from the proprietor's website. There are references to Hugo but not to the mark that is the subject of this action. The webpage does, however, give the name of Michael Grossman as the Area Sales Manager for, inter alia, the UK. Mr Lynd says that he telephoned Mr Grossman and asked him whether the trade mark HUGO THE TV TROLL had been used in the United Kingdom during the period 31 July 1996 to 31 July 2001 (this period approximates to the relevant period in this action). Mr Lynd records that:

> "Specifically, I asked him whether the interactive television gameshows had been broadcast to the United Kingdom during that period, and he told me that they had not been. He did, however, tell me that games bearing the trade mark HUGO THE TV TROLL have been sold in the United Kingdom "for many years" both for the Sony PlayStation and on CD-ROM for playing on PCs."

I observe that this is hearsay evidence. Although it is not necessarily to be excluded on that account, the fact that it is hearsay may affect the weight to be accorded such evidence. Given the potential importance of Mr Grossman's claim and the onus that is placed on the proprietor by Section 100 of the Act I consider that I can give little weight to what amounts to an assertion that cannot be substantiated by reference to other material. There is a further problem with this evidence. Mr Lynd says that he telephoned Mr Grossman. It is unlikely in the circumstances that the mark, which has a device as a strong visual element, would have been described with sufficient precision that Mr Grossman could have confidently asserted use of the mark in the form in which it is registered (or a mark with immaterial variation). More likely, it seems to me, that Mr Grossman was commenting purely on use of the words HUGO THE TV TROLL. I might also say in passing that I find it somewhat surprising, if Mr Grossman had firsthand

knowledge about use of the mark in the UK, that he did not file evidence of his own rather than leaving the proprietor's trade mark attorney to do the best he could from internet searches.

MAL10 - contains the results of a search using the Lycos search engine. Mr Lynd says that he used LYCOS because it is possible to limit the results to those websites having a .co.uk suffix thus implying that they are directed at this country. Mr Lynd says that he searched on the words "Hugo", "PC" and "game" and found 421 results. He supplies the first two pages which relate to games offered for sale by ITE by reference to HUGO THE TV TROLL. He also refers to a reference on the fourth page, but that page has not been included in the exhibit. The references on the first two pages are to "Hugo 2 Video Game" and "Video Games Hugo Jungle Island Limited Edition PC Games" and "hugo pc game". There is no reference to the mark of the registration.

MAL11 - is the result of a similar search on Lycos based on the search terms "Hugo" and "Playstation". Mr Lynd says that 104 sites were found and draws my attention to the second entry that reads:

> "Hugo 2 PlayStation". Entertainment games for all ages, tried and tested fun. Let your children play in this safe arena. Hugo the Troll takes you on many journeys, non-violent, stress free fun. ITE are b…"

Again, therefore, there is no reference to the composite mark and, as with some of the other exhibits, no means of reliably dating the material.

16. The most that can be said of this material, taken collectively, is that it suggests there has been some advertising of the availability of games involving the HUGO character on websites that are directed at UK consumers. There is no evidence of actual sales but that may not in itself be fatal to the registered proprietor's case if there were sufficient material to satisfy me that the use shown was within the terms of the guidance laid down in the *Ansul* case (in particular paragraph 37 thereof). However, it seems to me that the proprietor has clearly failed to show use of the mark in the form in which it is registered or in a form that would bring it within Section 46(2). In this respect I take the view that, the words and device each contribute to the distinctive character of the mark. Use of the words HUGO THE TV TROLL (of which there is some) but omitting the device must be held to be use in a form which does alter the distinctive character of the mark in the form in which it was registered. There are other deficiencies in the evidence in terms of establishing use in the UK within the relevant period as identified in my consideration of the individual exhibits but the failure to show use of the mark is in my view sufficient to dispose of this case. I do not, therefore, need to go on to consider the applicant's alternative position.

17. Accordingly, the registration falls to be revoked in relation to all the goods for which it is registered. As the applicant has not asked for an earlier date the registration will be revoked with effect from the date of the application for revocation, that is to say 25 July 2001.

18. The applicant is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 13th day of October 2004

M REYNOLDS
For the Registrar
the Comptroller-General