

O-002-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 80831  
FOR THE REVOCATION OF TRADE MARK No. 810576  
IN THE NAME OF WILHELM SIHN JR. K.G.**

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### **IN THE MATTER OF an Application under No. 80831 for the Revocation of Trade Mark No. 810576 in the name of Wilhelm Sihh Jr. K.G.**

#### **BACKGROUND**

1. Registration No. 810576 is in respect of the trade mark WISI which is registered in Class 9 for a specification of “Electrical and electronic apparatus and instruments included in Class 9”.
2. The mark was registered with effect from 10 September 1960 and the registration stands in the name of Wilhelm Sihh Jr. K.G.
3. By an application dated 15 May 2002 Wi-Fi Alliance (previously Wireless Ethernet Compatibility Alliance Inc) filed for revocation on the following grounds:
  - (i) Under Section 46(1)(a) of the Act in 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 for which it is registered, and there are no proper reasons for non-use; or
  - (ii) Under Section 46(1)(b) of the Act because such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
4. The applicant requested that the registration be revoked in respect of all goods covered by the registration, or partially revoked in respect of goods for which use is not shown by the registered proprietor in accordance with Section 46(5) of the Act.
5. The registered proprietor filed a Counterstatement denying the grounds of revocation.
6. Both parties have filed evidence and ask for an award of costs in their favour. The parties did not require a hearing and the applicant forwarded brief written submissions for the Hearing Officer’s attention.

#### **REGISTERED PROPRIETOR’S EVIDENCE UNDER RULE 31(2)**

7. This consists of a witness statement by Reinhold Schweizer dated 9 August 2002. Mr Schweizer is an Executive Officer of Wilhelm Sihh Jr. K.G. (the registered proprietor).
8. Mr Schweizer states that his company has used the mark in suit in the UK continuously since at least 1960 in relation to “electrical and electronic apparatus and instruments” and that this use has continued during the last five years.
9. To illustrate use of the mark, Mr Schweizer attaches Exhibit RS1 to his statement, which contains the following:

- (i) An inlay card from the Company's 2000 catalogue on CD-ROM, together with a printout from the 2000 CD-ROM catalogue;
- (ii) Seven specimen product brochures entitled "SO FAR – SO GOOD", "Perfect Connections", "PRODUCT-INFORMATION", "VALUE FOR MONEY", "Precision measuring", "When it comes to secure connection" and "Technically German";
- (iii) Three specimen invoices dated 13 January 1998, 13 September 2000 and 21 June 2001, relating to sales of goods under the trade mark in the UK.

10. Mr Schweizer explains that although the CD catalogue is dated 2000, it was first issued in 1999 and is still being issued to customers and prospective customers in the UK. He adds that the product brochures have also been made available to the company's customers and prospective customers in the UK.

11. Mr Schweizer states that the mark in suit is registered in capital letters and has been used consistently in that form, sometimes on its own and sometimes against a background device.

#### **APPLICANT'S EVIDENCE UNDER RULE 31(4)**

12. This consists of a witness statement by Christopher Stephen Parry dated 19 February 2003. Mr Parry is a Trade Mark Attorney and partner in the firm Saunders & Dolleymore, the applicant's professional advisors in these proceedings.

13. Mr Parry states that the registered proprietor has not demonstrated use on the whole range of goods covered by the specification but only in relation to "Television transmission and reception apparatus".

#### **REGISTERED PROPRIETOR'S EVIDENCE UNDER RULE 31(6)**

14. This comprises a second witness statement by Reinhold Schweizer. It is dated 25 February 2004.

15. Mr Schweizer denies that the registered proprietor has used the mark in suit only in the field of TV transmission and reception and in support he attaches as Exhibit RS2 to his statement, a copy of his company's brochure "Signals", which, he adds, has been distributed in Great Britain since at least 1995 and outlines his company's business field and its history.

16. Mr Schweizer makes the following points in relation to the "Signals" brochure:

- (i) in the "Innovation and Technology" section, the last paragraph of the relevant page states that his company's business was the reception and distribution of signals and today the business is providing technology for the key areas of future communication;
- (ii) in the "Pioneers for Generations" section, his company was the first to establish a microwave laboratory for DBS satellites and for the terrestrial reception of microwave signals in the year 1950 and is still doing research in this field;

(iii) the registered proprietor's products, especially its antennas, are used in GSM navigation systems;

(iv) in the "Global Connections" section, it is stated that the registered proprietor produces and sells networking products and offers corresponding services e.g. the world's largest multi-media digital services system in Hong Kong in 1994;

(v) in the "Success has a Background" section, it is stated that solutions by WIS1 are an important part of many advanced communication systems which extend from interactive multimedia cable networks through satellite reception systems, in particular for mobile telecommunications systems.

17. Mr Schweizer goes on to state that his company is also in the business of broadband reception ie. multimedia networks enabling bidirectional communication enabling interactive services such as internet, video on demand, virtual private networks or telephony. He adds that mobile radio is also an important business and the car antennas produced by his company are not only capable of receiving ordinary radio signals, but telephony, digital communication signals and navigation signals.

18. Mr Schweizer states that the catalogue which forms part of Exhibit RS1 to his earlier witness statement shows that the mark in suit has been used on a wide range of goods including antennae, cable connectors and cabling accessories, cables, amplifiers and modulators for receiving and transmitting radio frequency signals, including multimedia and broadband signals. He claims that these goods are shown in sections 1, 3, 4 and 5 of the catalogue and they are used to receive and transmit audio, data and video signals, as well as television signals. Mr Schweizer goes on to say that the mark has also been used in relation to other relevant goods, including satellite receiving systems (shown in Section 7 of the catalogue), directional audio and video transmission systems for monitoring and security purposes (as shown in Section 8 of the catalogue) and fibre optic transmission and receiving apparatus and instruments for use in telecommunications (as shown in Section 9 of the catalogue).

19. Mr Schweizer next refers to Exhibit RS3 to his statement which is a specimen of the company's CD-ROM Catalogue 2003 and a copy of a printout of the introductory and contents pages of the 2003 catalogue.

20. Finally, Mr Schweizer provides the following figures, representing turnover from sales in the United Kingdom of the goods shown in the catalogue constituting Exhibit RS1 to his first statement:

<b>"Year</b>	<b>Euros</b>	<b>Sterling *</b>
1997	69.575,13	50.125,99
1998	101.773,50	73.218,34
1999	318.416,87	229.076,88
2000	358.049,51	257.589,57
2001	698.927,14	502.825,28
2002	216.532,74	155.778,94 "

\* Sterling calculated at exchange rates operating February 2004.

## **APPLICANT'S WRITTEN SUBMISSIONS**

21. The applicant's written submissions are contained in a letter dated 12 October 2004 from Saunders & Dolleymore, the applicant's professional advisors in these proceedings.

22. In the above letter, the applicant submits that the subject registration should be revoked for all goods except:

“Television transmission and reception apparatus”.

23. The applicant contends that the revocation should take effect from the date five years following the date of the completion of the registration procedure, or in the alternative a date prior to 18 April 2001, this being the date of publication of UK trade marks Nos. 2209133 and 2209134 which have been opposed on the grounds of earlier rights in the subject registration.

24. This completes my summary of the evidence and submissions filed in this case. I turn now to the decision.

## **DECISION**

25. Section 46 of the Act 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;
- (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 applicant has informed me that the application for revocation is not being pursued in relation to the registration in its totality and has conceded use of the mark by the registered proprietor in relation to “Television transmission and reception apparatus” – see paragraphs 13 and 22 of this decision. Accordingly, Section 41(5) is relevant.

28. No proper reasons for non-use have been advanced and the use of a variant pursuant to Section 46(2) of the Act is not relevant to this case. The issue before me is whether there has been genuine use of the mark in relation to all goods for which it is registered during the relevant period. As mentioned above, the applicant has conceded use of the mark in relation to a limited range of goods within the specification for which the mark is registered. I must decide whether the registered proprietor’s use justifies the specification “Electrical and electronic apparatus and instruments included in Class 9”.

29. The meaning of “genuine use” was considered by the European Court of Justice in Case C-40/01 *Ansul BV v Ajax Brandbeveiling BV* [2003] RPC 717, in particular paragraphs 35 to 39 and paragraph 43 of that discussion, which reads as follows:

“35 Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks “must actually be used or, if not used, be subject to revocation.”

“Genuine use” therefore means actual use of the mark. That approach is confirmed, “*inter alia*” by the Dutch version of the Directive, which uses in the eighth recital the words “*werkelijk wordt gebruikt*”, and by other language versions such as the Spanish (“*uso efectivo*”), Italian (“*uso effettivo*”), and English (“genuine use”).

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 the 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 in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for 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 Art.10(3) of the Directive, by a third party with the 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 service 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.

.....

43. In light of the foregoing considerations the reply to the first question must be that Art.12(1) of the directive must be interpreted as meaning that there is “genuine use” of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conserved by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly 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, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark is not used for goods newly available on the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

30. I now turn to a consideration of the registered proprietor’s evidence filed to support its claim to genuine use of the mark in suit. This consists of the following exhibits to Mr Schweizer’s witness statements:

- (i) Exhibit RS1 comprising
  - (a) an inlay card from the registered proprietor’s 2000 catalogue on CD-ROM and a print-out thereof;
  - (b) seven specimen product brochures;
  - (c) three specimen invoices;
- (ii) Exhibit RS2 comprising a copy of the registered proprietor’s “Signals” brochure, distributed in the UK since 1995; and
- (iii) Exhibit RS3 comprising a specimen of the registered proprietor’s CD-ROM catalogue for 2003, a period which falls after the relevant date for these proceedings.

31. I will consider each of the relevant exhibits (RS1 and RS2) in turn and then go on to an appreciation of their global or overall impact in relation to “genuine use” of the mark across the width of the specification for which it is registered.

32. Firstly, Exhibit RS1. The registered proprietor’s 2000 catalogue is trilingual (German, English and French) and it contains the following statement:

“In the WISI catalogue are listed the current products used for the reception and distribution of TV signals. Additionally, WISI keeps at your disposal special catalogues for.”

33. There are no details, after the word “for” above as to the special catalogues. The catalogue goes on to list products available under “Electrical accessories”, “Amplifiers”, “Program Processing, Power supplies”, “Measuring instruments”, “Satellite receiving systems” and “Optical transmission technology”. The registered proprietor contends that the goods listed in this catalogue are for a wide variety of applications. It is clear from the catalogue that the description “products used for the reception and distribution of TV signals “ – see paragraph 32 above- is somewhat simplistic, in light of the products offered. The goods included within the catalogue contain numerous products for the use in the reception and distribution of radio frequency signals, also satellite receiving systems, fibre optical transmission and receiving apparatus and directional video and audio systems for monitoring and security purposes.



34. Now, the seven product brochures at Exhibit RS1. These brochures, available to UK customers, relate to:

- (i) “DISTRIBUTION AMPLIFIER AND OPTICAL RECEIVER” with a reference to “the dependability that CATV networks should possess”;
- (ii) “F-Crimp Connectors”, with a reference to “Properly mounted crimp connectors yield excellent return loss and reliable screening for broadcast and data applications”;
- (iii) “DO 53 triple individual outlet socket” and “DO 54 triple SMATV outlet socket”, with a reference to “Separation of TV, FM and SAT – IF signals” i.e. the outlet socket can separate signals received by a satellite dish for e.g. television and FM radio;
- (iv) “VALUE FOR MONEY” the detailed information for which is in the German language, but which appears to relate to a range of amplifiers;
- (v) “WA 60 B universal measuring receiver” – an “all-in-one-device” for use in the installation, expansion, and testing of “terrestrial, cable and Sat-TV and radio programmes”;
- (vi) “wall outlet sockets” – DB Antennae outlets featuring a “screen protector” mechanism, ensuring maximum screen .....;
- (vii) a combined output amplifier and input signal splitter.

35. Once again, it seems to me that while the goods being marketed primarily relate to use for the reception and distribution of TV signals, there is also clear reference and relevance in relation to goods used in the reception and distribution of radio frequency signals and also to satellite receiving systems.

36. Next, the three invoices at exhibit RS1 which relate to UK orders. The products I am able to identify are for goods for use in relation to television and radio signal reception and distribution e.g. “TV MODULATOR”, TV CHANNEL CONVERTER”, and “FM CONVERTER”.

37. I now turn to exhibit RS2 – the “Signals” brochure. Much of this brochure is devoted to the history and background of the registered proprietor and its global activities. This is of no real assistance as to whether there has been “genuine use” of the registered mark in the UK across the full width of the specification for which it is registered. It provides no direct evidence on the issue before me. Certainly it does not demonstrate any tangible use of the mark in the UK on a wider range of goods from those I have previously identified and considered.

38. The registered proprietor’s turnover from recent sales in the UK of the goods shown in the catalogue exhibits at RS1 have been provided – see paragraph 20 of this decision. Those sales are by no means insignificant and in the light of the evidence and submissions I have no hesitation in concluding that there is nothing fake or sham about the registered proprietor’s activities in relation to the mark.

39. The applicant has conceded that on the registered proprietor’s Rule 31(2) evidence – its main evidence – there is genuine use of the mark in relation to “television transmission and reception apparatus” and on the basis of the evidence, it is my view that there has been genuine use of the mark in relation to the following goods:-

“Apparatus and instruments for receiving and transmitting television signals, apparatus and instruments for receiving and transmitting radio frequency signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes.”

40. I now go on to consider, in light of the above finding, whether registration of the mark can be justified for the specification of “Electrical and electronic apparatus included in Class 9”, at large.

41. The approach to be adopted in determining any appropriate restriction of specifications pursuant to a revocation is encapsulated in the following passage from the Court of Appeal’s judgements in *Thompson Holidays Limited and Norwegian Cruise Line Limited* [2003] RPC 32.

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgement is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor cycles. In my view the court is required in the words of Jacob J. to “dig deeper”. But the crucial question is-how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the Court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself

of the nature of trade and then decide how the national consumer would describe such use.”

42. I have no doubt that the term “Electrical and electronic apparatus and instruments” is very wide and would be perceived as such. It would encompass all goods within Class 9 of an electrical or electronic nature, no matter what their purpose, function or application. In my view there is no case for not removing those items upon which the registered proprietor has not used its mark from its specification, by limiting the registered proprietor’s specification to those goods upon which its use has been shown – see paragraph 39 of this decision above.

43. I therefore order the registration the subject of these proceedings, Number 810576 to be revoked in part under Section 46(5) of the Act, by the removal of the specification “Electrical and electronic apparatus” because the registered proprietor has not shown use on all of these goods. The specification will be limited to the following, upon which use has been shown:

“Apparatus and instruments for receiving and transmitting television signals, apparatus and instruments for receiving and transmitting radio signals; apparatus and instruments for satellite receiving systems; fibre optical transmission and receiving apparatus; directional video and audio systems for monitoring and security purposes.”

44. The registration has been attacked under Section 46(1)(a) and (b) and the applicants contends that the revocation should take effect from the date of five years following the date of completion of the registration procedure or, in the alternative, a date prior to 18 March 2001.

45. Section 46(6) is relevant. It reads as follows:

“(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.”

46. As the date of the application for revocation is 15 May 2002, the applicant is seeking the application of 46(6)(b).

47. I have found that the registered proprietor has not shown use of its mark across the full width of the specification for which the mark was registered, either in relation to Section 46(1)(a) or Section 46(1)(b) and that Section 46(5) applies. Its specification was limited accordingly. In light of my earlier findings it seems to me reasonable that my order under Section 46(5) – see paragraph 43 (above) should take effect from the date of five years following the date of completion of the registration procedure for the mark in suit.

48. It is my decision therefore, that the registration should be partially revoked with effect from 25 April 1966, the date of five years following of completion of the registration procedure.

## **COSTS**

49. The applicant for revocation has succeeded in its action and is entitled to a contribution towards its costs. I order the registered proprietor to pay the applicant for revocation the sum of £1000 which takes into account that no hearing took place on this case. 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 4<sup>th</sup> day of January 2005**

**JOHN MACGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**