

O-291-07

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO. 82474
BY THE COCA-COLA COMPANY
TO REVOKE REGISTRATION NO. 2222144
IN THE NAME OF JAYDONE LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF an application
under No. 82474 by The Coca-Cola
Company to revoke registration
No. 2222144 in the name of
Jaydone Limited

Background

1. Registration No. 2222144 is for the trade mark RELENTLESS. The registration procedure was completed on 1 December 2000. The registration stands in the name of Jaydone Limited and is registered in respect of:

Class 9

*Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; **records, discs, tapes, cassettes, cartridges, cards and other carriers, all bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information;** sound records, video records, cinematographic films, photographic films; interactive entertainment software; memory carriers; interactive compact discs; CD-ROMs; encoded telephone cards; magnets; photographic transparencies; frames for photographic transparencies; computer generated images; mouse pads and wrist pads, all being accessories for keyboards; luminous signs; **parts and fittings for all the aforesaid goods.***

Class 16

Printed matter; printed publications; printed musical publications; books; music books; booklets; pamphlets; printed guides; magazines; music magazines; printed music; music in sheet form; musical scores; photographs; stationery; posters; cards; postcards; greetings cards; calendars; photograph frames; photograph albums; prints and framed prints; note pads; pens, pencils and crayons; diaries; coasters of card or paper; stickers; transfers (decalcomanias); stamps; ring binders; folders; personal organisers; address books; telephone books; note books; desk mats; pen and pencil cases; pen and pencil boxes; pen and pencil holders; rulers; erasers.

Class 18

Articles of leather and imitation leather; bags; handbags; rucksacks; backpacks; school bags; satchels; purses; cases; wallets; clutchbags; tote bags; backpacks; shopping bags; shoulder bags; record bags; mobile phone cases; carriers for portable compact disc players, mini disc players and radios; belt bags; billfolds; key fobs; key cases; cheque book covers; card cases; briefcases; attaché cases; luggage; travelling bags; suitcases; trunks; umbrellas.

Class 25

Clothing; footwear; headgear.

Class 41

*Entertainment; musical entertainment; interactive entertainment; entertainment by means of television and radio; production, presentation, distribution, exhibition and rental of motion pictures, films, sound recordings, video recordings and multimedia entertainments; organisation, production and presentation of shows, road shows, live performances and entertainment events; concert services; orchestra services; live band performances; discothèque services; club entertainment services; night club services; organisation of musical events; booking and reservation of tickets for entertainment; recording studio services; provision and rental of recording studio, apparatus and facilities; sound and video recording modifying and editing services; publishing; publication of printed matter, books, periodical publications, magazines and printed music; provision of entertainment for access by computer or communications networks; providing entertainment on the global computer network; publication of multimedia recordings, interactive compact discs and CD-ROMs; **management and agency services for performing artists**; provision of information relating to any of the aforesaid services.*

2. By an application received on 7 April 2006, The Coca-Cola Company applied for the registration to be revoked in respect of all goods and services other than those shown in bold above. The application is made under the provisions of sections 46(1)(a) and (b) of the Act on the basis that the mark has not been used at any time since it was registered in respect of those goods and services for which revocation is sought.

3. The registered proprietor filed a counter-statement denying the claims made and seeking dismissal of the revocation action.

4. Only the registered proprietor filed evidence in these proceedings. In accordance with usual practice, the parties were advised of their right to a hearing and were informed that if neither requested to be heard, a decision would be taken from the papers and any written submissions filed. Neither party requested to be heard but both filed written submissions. After a careful study of all the papers and submissions, I give this decision.

Registered proprietor's evidence under rule 31(3)

5. This consists of a statutory declaration of Mark Furman dated 7 July 2006. Mr Furman is a director of Jaydone Limited, a position he has held since April 2003.

6. Mr Furman explains that since 1999, the trade mark RELENTLESS has been used in the UK as a record label and has appeared on all audio and audio/visual recordings of artists signed to the label. This includes vinyl records, CDs, DVDs and music downloads. At MF 1 he exhibits a list of some recordings on the RELENTLESS label along with their release dates. At MF2, Mr Furman exhibits examples of those releases. This takes the form of photocopies of CD and records and their covers.

7. Mr Furman estimates that during the alleged non-use period (there are in fact two periods of non-use alleged) his company has sold over four million units of audio and audio/visual recordings bearing the RELENTLESS trade mark in the UK. He gives no

explanation of the source of this estimate, which is said to include vinyl records, CDs, DVDs and music downloads.

8. Mr Furman goes on to say that his company has operated mailing lists on behalf of its artists during the alleged non-use period. At MF 3 he exhibits photocopies of cards included within the packaging of his company's CDs and which invite the consumer to join the mailing list.

9. Mr Furman explains that having joined a mailing list, those on it will receive information about the artist. At MF 4 he exhibits an example of what he calls an ecard sent via the mailing list.

10. Mr Furman states the trade mark has also been used in relation to concerts. At MF 5 and MF 6 he exhibits copies of promotional material relating to concerts.

Registered proprietor's evidence under rule 31A(4)

11. This consists of a witness statement of Paul Franklyn and is dated 23 April 2007. Mr Franklyn is co-founder and co-managing director of the Relentless Records record label. He confirms the statement is made from his personal knowledge and the records of his label and that he is authorised to make the statement.

12. Mr Franklyn explains that Relentless Records was set up in 1999 by him and Shabs Jobanputra. Since that time it has launched a number of artistes. At PF 1 he exhibits a brief history of the label. This indicates that it released its first single in November 2000.

13. Mr Franklyn states that as a record label, the Relentless trade mark indicates the source of the recordings of artists signed to that label. The trade marks appears on and in relation to all audio and audio/visual recordings released by the label.

14. Referring to Mr Furman's earlier statutory declaration, Mr Franklyn confirms that over 4 million units bearing the trade mark were sold in the UK during the alleged period of non-use. At PF 2 he exhibits a breakdown of this figure as follows:

Financial Year	Unit sales UK
2003/4	356,255
2004/5	2,176,099
2005/6	1,775,673

15. Mr Franklyn goes on to confirm that invitations to join mailing lists have been included in the packing of his label's CDs since 2003. He says that approximately 50,000 people are now on the mailing list, "the majority of which are UK based".

16. At PF 3, Mr Franklyn exhibits various promotional cards and at PF 4 a copy of DVD packaging. The DVD is said to have been released in July 2005, selling over 17000 units in the UK up to March 2006.

17. Mr Franklyn states that the RELENTLESS trade mark is used on all advertising and promotional materials relating to concerts and concert tours by the label's artists. At PF 5 he exhibits a copy of a tour poster and related review.

18. Mr Franklyn states that the trade mark is also used in relation to recordings of concerts and at PF 6 he exhibits a copy of packaging from a DVD recorded in September 2004 in New York City. He states that over 10,000 units of the DVD were sold in the UK between April 2004 and May 2005.

19. At PF 7 Mr Franklyn exhibits an article published in the Liverpool Daily Echo on 2 May 2003 which he says refers to a talent contest the company was to hold. The article does not refer to any talent contest but instead indicates that the record label were planning to hold auditions for new talent later that month.

20. No further evidence was filed in these proceedings.

Decision

21. The relevant statutory provision in relation to an application for revocation of a registered trade mark can be found in Section 46. This states:

“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.

(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 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 exist at an earlier date, that date.”

22. The onus of showing that the trade mark in question has been used within the relevant period or that proper reasons exist for its non-use, rests with the proprietor. This is set out in Section 100 of the Act which states:

“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.”

23. The Act refers to “genuine use” having been made of the trade mark though it does not set out what constitutes such use. The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85:

“1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks 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 conferred 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 the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that 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.”

24. In *La Mer Technology Inc v Laboratoires Goemar SA* Case C-259/02 the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor of the mark.”

25. In *Laboratoires Goemar v La Mer Technology Inc* [2005] ETMR 114 Mummery LJ held that a quantitative and qualitative test for market use and market share could not be erected when considering genuine use:

“32 Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of consumers and end-users of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share

which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end-user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.”

26. Neuberger LJ in the same judgment held the following:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.”

27. In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-416/04 P the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

28. As set out above, the application for revocation is not directed against all of the goods and services for which registration has been granted. The registered proprietor has not sought to defend itself against the attack against its registration in respect of any of the goods covered by classes 18 and 25. To that extent the application for revocation succeeds in respect of these goods.

29. The application also seeks revocation of the trade mark in relation to various goods and services for which the mark is registered in classes 9, 16 and 41. Much of the registered proprietor's evidence is directed to goods and services which are not subject to the application for revocation. In respect of the majority of the goods and services falling in these classes, the registered proprietor has remained silent however it claims to have used the mark in relation to the following goods and services, which I go on to consider in further detail.

- Class 9: Cards bearing sound recordings, video recordings or information.

In support of its claim to have used the mark on these goods the registered proprietor refers to exhibit MF 4 attached to Mr Furman's evidence. This exhibit is referred to as being an ecard. It takes the form of an email. There is no evidence provided to show to whom the email was sent, i.e. whether it was sent by the sender to an internal or external address or where, geographically, any receiver was located. Neither is there any evidence of when it was sent. At most it appears to be nothing more than promotional material. In any event, I am of the opinion that an email is just that-an email-it is not evidence of use of a card.

- Class 16: Printed matter providing information about artists, new releases and tour dates.

The registered proprietor's evidence of use in respect to these goods consists of copies of cards said to have been sent to people whose names appear on mailing lists. No evidence is provided to show exactly when these may have been sent nor is there any evidence of where, geographically, the intended recipient may have been located. Again, it appears that the cards are no more than promotional material. There is no evidence the average consumer would consider use of a trade mark on such items as an indication of origin in relation to printed matter.

- Class 16: Posters.

The registered proprietor claims to have used the mark in relation to posters. Parts of its evidence of use in this regard are what appear to be promotional posters of the sort commonly pasted to advertising boards or appearing in music stores. There is no evidence that these posters were sold whether or not to consumers in the UK. The remaining part of the evidence in relation to use of the mark on posters is a copy of a promotional poster included in a DVD issued in July 2005. Over 17,000 copies of the DVD are said to have been sold in the UK in the twelve months to March 2006. From the copy of the cover of the DVD which forms exhibit PF4, it is clear that the poster was included free with the DVD. I do not accept that a poster included free within a DVD package is use of the mark in relation to a trade in posters per se. Giving away a poster etc. is a common marketing tool and again there is no evidence the average consumer would consider use of a trade mark on such items as an indication of origin in relation to posters.

- Class 41: Concerts/live performances

Evidence at MF 5 shows an advertising poster bearing a list of tour dates for a particular artist. At PF 5 is a review of one of concerts listed at MF 5. Whilst the review makes no reference to the trade mark, the advertising poster does. The exhibit suggests that a number of companies were responsible for providing these services “by arrangement with” the registered proprietor and another. There is no indication of what is meant by the term “by arrangement with”. I accept the artist concerned is signed to the Relentless record label and the label may well have had an association with the event but the evidence is insufficient to show use of the mark in relation to the provision of the relevant services by the registered proprietor.

- Class 41: Production, presentation and distribution of sound recordings and video recordings

The registered proprietor claims its evidence shows use in relation to each of these services however I am unable to agree. That the registered proprietor is a record label is not in dispute. Neither is it disputed that CDs etc. have been released by the registered proprietor but the evidence does not show use of these disputed services within the relevant periods, in the UK and by the registered proprietor.

- Class 41: Talent competitions

The registered proprietor contends that a talent competition took place in 2003. Exhibit PF 7, which it files in support of this claim, refers only to the planning of auditions. There is no evidence whether or not these auditions took place as planned but even if they did, without evidence on the point, I am not persuaded that an audition is the same thing as a talent competition.

30. In *Laboratoire De La Mer Trade Marks* [2002] FSR 51 Jacob J held:

9. In the present cases, 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 and services of the mark in question. All the t’s should be crossed and all the I’s dotted...”

31. Furthermore, in *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01* [2003] ETMR 98 the Court of First Instance stated:

“47. In that regard it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.”

32. On the basis of the evidence before me, I am unable to be satisfied that the registered proprietor has made any use of the mark in relation to any of the goods or services for which the mark is registered and which are subject to this application for revocation.

33. Accordingly, the application for revocation succeeds in its entirety. The application has succeeded under both sections 46(1)(a) and (b). In accordance with section 46(6)(b), the rights of the proprietor will be deemed to have ceased from the earlier date, that is, with effect from 2 December 2005.

34. The effect of this decision is that the trade mark registration will be revoked for all goods and services except:

Class 9

Records, discs, tapes, cassettes, all bearing or for use in bearing sound recordings, video recordings, data, images, games, graphics, text, programs or information; sound records; parts and fittings for all the aforesaid goods.

Class 41

Management and agency services for performing artists.

Costs

35. The application for revocation having succeeded, the applicant is entitled to an award of costs. I take into account that the evidence filed by the registered proprietor was minimal with none having been filed by the applicant and that the decision was reached without a hearing taking place. In all the circumstances, I order the registered proprietor to pay the applicant the sum of £1000 as a contribution towards its costs. 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 2nd day of October 2007

**Ann Corbett
For the Registrar
The Comptroller-General**