

O/115/09

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NOS 1046742 AND 1372485
IN THE NAME OF MFI GROUP LIMITED
OF THE TRADE MARK:**

SCHREIBER

IN CLASS 20

**AND THE APPLICATIONS FOR REVOCATION
THERE TO UNDER NOS 82771 AND 82772
BY GENERAL TRADERS LIMITED**

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Introduction.

1) Section 46 of the Trade Marks Act 1994 (the Act) reads as follows:

“(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.”

Section 100 of the Act 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.”

Consequent upon section 100, in revocation for non-use proceedings the onus is upon the registered proprietor to prove that it has made genuine use of a trade mark, or that there are proper reasons for non-use.

2) On 9 February 2007 General Traders Limited (GTL) filed applications for the revocation of registration nos 1046742 and 1372485, both of which are for the trade mark SCHREIBER. The registrations are in the name of MFI Group Limited (MFI), to whom they were assigned on 23 January 2009 from MFI Retail Limited (MRL). Registration no 1046742 is registered for the following goods in class 20:

articles of domestic furniture.

The date of the completion of the registration process was the date of the publication of the registration in *Trade Marks Journal* 5186, 18 January 1978¹. Registration no 1372485 is registered for the following goods:

bedding, bins, ornaments and figurines, towel dispensers, picture frames, mirrors, letterboxes, magazine racks, mattresses, curtain rings, curtain and stair-rods, parts and fittings for furniture; all included in Class 20.

The date of the completion of the registration process was 19 April 1991.

3) GTL claims that the trade mark has not been used in relation to the goods of the registrations. It requests that the registrations are revoked under section 46(1)(a) of the Act or, in the alternative, under section 46(1)(b) of the Act. Under section 46(1)(b) of the Act GTL claims that the trade mark has not been used for the period 9 February 2002 to 8 February 2007 and seeks revocation of both registrations from 9 February 2007. Under section 46(1)(a) of the Act GTL seeks revocation of registration no 1372485 from 20 April 1996. Under section 46(1)(a) of the Act GTL seeks revocation of registration no 1046742 from 31 December 1982. The earliest date from which there could be revocation of registration no 1046742 is 19 January 1983, five years having expired from the completion of the registration process. At the hearing the parties did not object to 19 January 1983 being substituted as the date from which revocation is sought under section 46(1)(a) of the Act.

4) In the skeleton argument for MFI it was conceded that in relation to registration no 1372485 it could not prove genuine use in relation to *ornaments and figurines, picture frames, letterboxes, magazine racks, curtain rings, curtain and stair-rods*. This leaves a specification of:

bedding, bins, towel dispensers, mirrors, mattresses, parts and fittings for furniture; all included in Class 20.

5) A hearing was held on 23 April 2009. MFI was represented by Mr Paul Harris of Speechly Bircham LLP. GTL was represented by Ms Helyn Mensah of counsel, instructed by Olswang.

¹ *Wi-Fi Alliance v Wilhelm Sihh Jr* KG BL O/251/05 Mr Hobbs QC, sitting as the appointed person stated:

"2. The trade mark was registered in the name of Wilhelm Sihh Jr. KG ('the Proprietor') with effect from 10 September 1960. In an Official Notice entitled 'Date on which a mark is actually entered in the Register' printed at pp. 1536, 1527 of Issue No. 5725 of the Trade Marks Journal published on 1 June 1988 it was confirmed that, prior to June 1986, the date of the Trade Marks Journal in which the fact of registration was recorded in the list of 'Trade Marks Registered' was the date of actual registration"

Evidence of MFI.

6) This consists of witness statements by Mr David George Purvis and Mr Michael Greenhalgh. Mr Purvis is In Store Communications Manager at MRL. Mr Purvis has held his current position for five years and has been with MRL for twenty eight years. Mr Greenhalgh is Marketing Director of MRL, a position which he has held for twenty one months.

7) Mr Purvis states that MRL has been offering goods for sale branded with the trade mark SCHREIBER in the United Kingdom since around 1987/88, when MRL bought Schreiber Furniture Limited (SFL), the high street retailers. He states that SFL had used the trade mark for some years before that. Consequently, the trade mark is often used with the strap line "Established 1946". Mr Purvis states that SCHREIBER is one of the brands of furniture, electrical appliances and interiors exclusively available from MRL. He states that the trade mark has been used in relation to articles of furniture and parts, fittings and accessories therefor for throughout the home but in particular in kitchens and bedrooms. Exhibited at DGP-1 are the following:

- ❖ A memorandum to all SCHREIBER stores dated 2 December 1988 from Mr Purvis. It relates to point of sales materials for a pre-Christmas promotion by SCHREIBER. It requires the replacement of existing point of sales material for SCHREIBER kitchens. The material consists of two window posters per store, two horizontal posters per store and three strutted A4 show cards. Representations of the material are shown, all of which prominently carries the trade mark SCHREIBER.
- ❖ Information relating to point of sales material for a SCHREIBER kitchen and bedroom promotion for the period 1 March 1990 to 11 April 1990. The material consists of window posters, horizontal banners and show cards. Representations of the material bear the SCHREIBER trade mark and relate to kitchens and bedrooms.
- ❖ Information relating to a SCHREIBER warehouse clearance, the sheet bears the legend "UPDATED 2/3/89". The material consists of window posters, horizontal banners and show cards. Representations of the material bear the SCHREIBER trade mark. The instructions for the strutted show cards require that they are displayed on four prominent kitchen worktops and four prominent bedroom worktops.
- ❖ A leaflet bears the trade mark SCHREIBER in title case, through which a curved line runs. The leaflet was published in October 1999. The leaflet relates to the KINGSLAND free standing bedroom range. It states, inter alia:

“Schreiber are proud to introduce Kingsland, a bedroom range of smooth sophistication...”

The products shown are wardrobes, chests with drawers, a dressing table, a bedroom stool and a mirror.

- ❖ A page from the corporate display manual. It indicates that it was updated on 17 August 2001, it relates to bedroom product panels. A representation of the panel shows that it relates to HYGENA and SCHREIBER bedrooms.
- ❖ A galley proof relating to appliance brands for kitchens, it bears a date of 26 September 2002. It refers to the full range of appliances for kitchens. The ranges listed are HYGENA, SCHREIBER, WHIRLPOOL, SIEMENS, DIPLOMAT, BOSCH, SMEG, SERVIS and RANGEMASTER.
- ❖ Pages from a publication of MFI published in March 2003. It refers to the SCHREIBER kitchen and bedroom ranges. Underneath SCHREIBER appears “ESTABLISHED 1946”. The reader is advised that purchases can be made on-line at mfi.co.uk.
- ❖ Three other exhibits appear, two bearing the name SCHREIBER and one the picture of an aeroplane and ESTD. 1946”.

8) Exhibited at DGP-2 is a catalogue for SCHREIBER rigid kitchens. It was published in October 1992 and includes the following on the last page:

“Product information was accurate at the time of going to press in October 1992. We reserve the right to change prices and specifications in this brochure.”

In relation to appliances the following appears:

“At Schreiber, we’re always developing new ideas to make sure you get the most out of your kitchen. So as well as our outstanding range of beautiful kitchens we have also designed a range of beautiful built-in kitchen appliances to complement them.”

As can be intimated from the title rigid kitchens the catalogue is for fitted kitchen furniture. Included in the accessories part of the catalogue are, inter alia, towel rails, bottle racks, cutlery trays, wire baskets, hinge packs, door hinges and bins. Such things as plinths, worktop lipping, cornice rails and light pelmets are also shown. Prices are given and our details of a fitting service. A variety of SCHREIBER product ranges are shown in the catalogue.

9) Exhibited at DGP-3 is an MFI catalogue for winter 2002. It is entitled: *Choosing bedrooms... a bedroom to sleep easily in from MFI*. The back cover of the catalogue states that the product information was correct at the time of

publication, November 2001. Pages 2 and 3 of the catalogue have indices for HYGENA and SCHREIBER products. The SCHREIBER products contain a number of ranges: SOHO, MILAN, CONTINENTAL WHITE, CONTINENTAL CHERRY, VICENZA, HARVARD CHERRY, HARVARD MAPLE, BOSTON, WILLOW, VENICE, FLORENCE, SORRENTO IVORY, SORRENTO WHITE, LOIRE, COLLINGHAM and VERSAILLES IVORY/WHITE. Each odd numbered page of the SCHREIBER part of the catalogue bears the name SCHREIBER in title case, through which a curved line runs. There are references to SCHREIBER in the body of the text. Some of the furniture shown is fitted, some is free standing; some ranges, such as FLORENCE and VENICE have both fitted and free standing versions. A large variety of bedroom furniture can be seen, including wardrobes, chests of drawers, bed side cabinets, mirrors, dressing tables and bedroom stools. Some of the goods pictured, such as the stools and some of the mirrors, appear on the accessories page. These accessories are not identified by reference to HYGENA or SCHREIBER, however four products, two plinths and two cornices, are identified as being applicable to SCHREIBER and/or HYGENA. The COLLINGHAM and BOSTON stools and mirrors appear in the accessories page as well as on the pages relating to these SCHREIBER ranges. Beds and bedding appear in the pages but it is not clear if these form part of the ranges. In the page related to the SOHO range the CAMARGUE bed is identified, in the pages related to CONTINENTAL CHERRY the LE MANS bed is identified; these beds also appear on the pages devoted to beds. As these beds do not bear the name of a SCHREIBER range I do not consider that it can be assumed that the SCHREIBER trade mark is being used in relation to them. It would be surprising that in photographs of bedrooms beds did not appear, so the presence of beds in the photographs does not of itself indicate that the trade mark SCHREIBER is being used in relation to them; something more is needed, the something more that I deal with in paragraphs 32 et seq. The accessories pages also include soffits, downlighters, dimmers, tie racks and mirrors.

10) Exhibited at DGP-4 is an MFI price list for a sale, the price list is valid until 25 September 2002. The kitchen products on pages 4 and 5 of the price list are identified as being SCHREIBER products. SCHREIBER in title case, through which a curved line runs, appears at the top and bottom of page 4. SCHREIBER in title case also appears at the bottom of page 4. The goods are identified by the range to which they belong. The goods shown are components of fitted kitchens. Included on the page is a metallised continuous plinth. At the bottom of page 4 the following appears:

“Cornice/pelmet rails, continuous plinths, décor panels/rails, are available as optional extras on selected ranges.”

On pages 5 and 6 SCHREIBER in title case, through which a curved line runs appears. The following goods by reference to this trade mark are, inter alia, shown: cornice, pelmet light rail, return plinth, continuous plinth, cornice/pelmet, gable and light pelmet block. The presence of SCHREIBER at the top of page 7 appears to be a “balance” to the presence of HYGENA at the top of page 6. It is

not clear that the products on page 7 are being identified as being SCHREIBER products, certain of the products are identified by reference to other trade marks eg FRANKE. On page 8 of the price list there appears a long list of kitchen accessories. Some of the products are identified by reference to HYGENA or SCHREIBER, SCHREIBER products include cutlery trays, wire carousels. A large number of the goods are not identified by a specific trade mark, these include waste bins, towel holders and towel rails. The catalogue includes various appliances, these include HYGENA appliances but no SCHREIBER appliances.

11) Pages 16-19 inclusive of the price list boldly bear the name SCHREIBER. Shown on these pages are wardrobes, fitted chests of various kinds, including tallboys and dressing table, bedside cabinets, bed end chests, headboards for beds, ottomans, dressing tables, panels, stools, soffits, corbels, end panels and mirrors. On page 20 bedroom accessories are listed, these include tie bars, tie racks and hanging rails. Many of the products are not identified by trade mark. COLLINGHAM shelf packs appear on the list (COLLINGHAM is a range of SCHREIBER furniture). The price list includes various mattresses, none of which bear a reference to SCHREIBER.

12) Exhibited at DGP-5 is an MFI catalogue, *Kitchens...sinks, taps, tops & storage*. It is stated in the catalogue that the product information was correct at the time of going to publication, November 2004. The index on page 4 lists a number of SCHREIBER ranges. On page 7 the question "WHY SCHREIBER" is asked. The text advises that "To complete the look, cladding and end panels and colour co-ordinated with your choice of door". Products in the SCHREIBER range are identified by the presence of SCHREIBER on a brown background at the bottom of various of the pages devoted to the goods. The ARGYLE range appears on page 33, this range includes dining table and chairs. On page 52 of the catalogue the ARGYLE extending dining table and dining chairs appears on a page headed "Dining". From page 42 to page 46 a range of goods for use with kitchen furniture; these goods include bins and towel racks; neither of these products is identified by a trade mark.

13) Exhibited at DPG-6 is an MFI catalogue for kitchens of summer 2007. It is stated in the catalogue that the product information was correct at the time of going to publication, May 2007 (after the material dates). The bulk of the catalogue is divided between the SCHREIBER and HYGENA brands. The products shown are fitted kitchen furniture. From pages 56 – 62 accessories for fitted kitchens are shown. Included in these accessories are a stainless steel hanging roll holder (for a roll of kitchen paper) and a variety of bins; these items are not identified by a trade mark.

14) Mr Purvis states that there are a wide range of items which are featured in the brochures which may emanate from other suppliers but are sold under the SCHREIBER trade mark by virtue of their being available for sale and being ultimately supplied together with the SCHREIBER design and installation. In this statement Mr Purvis is venturing into a jury question, it is for me to decide if the nature of the use is such that it can be considered to be genuine use.

15) Mr Purvis states that MRL has used the SCHREIBER trade mark in relation to the full range of interiors and accessories as depicted in the catalogues. He identifies use of the trade mark for specific goods:

- ❖ Bins – exhibit DGP-2 page 33, exhibit DGP-4 page 8 and exhibit DGP-5 page 46.
- ❖ Towel dispensers – exhibit DGP-2 page 33 and exhibit DGP-5 pages 44 and 45.
- ❖ Mirrors – exhibit DGP-3 page 49 and exhibit DGP-4 page 19.
- ❖ Parts and fittings for furniture – exhibit DGP-2 pages 33 and 35, exhibit DGP-4 page 15 and exhibit DGP-6 pages 56-62.

16) Mr Greenhalgh states that total annual sales of goods bearing the trade mark SCHREIBER in 2007 was £140.8 million; out of total sales by MRL of £511.2 million. He states that £80 million of this sum is attributable to sales of SCHREIBER bedroom furniture and £60.8 million is attributed to sales of SCHREIBER kitchen furniture. Mr Greenhalgh states that while exact sales figures are not available for 2001-2006 at the time of writing, he can state that significant sales took place during these years. However, at Exhibit MG-1 turnover figures relating to the order value of SCHREIBER bedroom furniture from February 2001 to January 2008 (and beyond) are given. These show annual turnover figures are follows:

February 2001 to January 2002	£72,245,828
February 2002 to January 2003	£80,075,408
February 2003 to January 2004	£73,189,366
February 2004 to January 2005	£72,355,368
February 2005 to January 2006	£70,994,458
February 2006 to January 2007	£72,187,825
February 2007 to January 2008	£82,096,780

The turnover figures are divided in terms of the product ranges. Of particular relevance, taking into account the submissions at the hearing, are the sales figures for the following ranges of SCHREIBER bedroom furniture:

	Feb 01 – Jan 02	Feb 02 – Jan 03	Feb 03 – Jan 04	Feb 04 – Jan 05	Feb 05 – Jan 06	Feb 06 – Jan 07	Feb 07 – Jan 08
JAVA DARK		53,858	2,167,490	5,712,604	4,337,043	2,365,490	874,888

LOIRE	4,767,187	5,016,251	3,888,386	3,348,086	2,478,087	2,055,707	848,390
VICENZA	3,447,837	6,329,105	5,028,508	3,718,186	3,199,256	2,105,838	913,143
WILLOW	754,974	4,273,568	5,369,497	4,793,073	2,696,982	1,472,383	252

17) Mr Greenhalgh estimates that MRL spent the following sums in promoting goods bearing the trade mark SCHREIBER were spent:

2004	£7,675,879
2005	£9,136,658
2006	£8,463,605
2007	£7,938,091

Exhibited at MG-2 is a breakdown of the advertising expenditure of MRL by reference to the media used. The exhibit shows the sum spent on promotion has been apportioned by reference to the sales percentage of SCHREIBER products in relation to MRL's total sales, rather than by an actual expenditure. As Mr Harris submitted at the hearing this method of calculation of the expenditure cannot give a completely accurate figure. The table is reproduced below:

	2004	2005	2006	2007	TOTAL
Internet	210,241	29,874	12,441	61,599	314,155
Outdoor	21,261	nil	1,007,663	936,269	1,965,193
Press	7,790,576	10,658,165	9,204,833	8,516,348	36,169,922
Radio	559,840	nil	102,286	142,874	805,000
TV	13,172,393	15,833,667	14,380,560	13,454,213	56,840,833
PR	402,780	490,274	426,175	488,734	1,807,963
Research	531,786	521,876	497,623	548,602	2,099,887

Instore Comms	5,223,412	5,690,356	5,145,167	4,717,148	20,776,083
	27,912,289	33,224,212	30,776,748	28,865,787	120,779,036

18) Exhibited at MG-3 is the catalogue *mfi Bedrooms Spring 2006*. The reader is advised that the product information in the catalogue was correct at the time of going to publication in March 2006. Some of the pages cover both HYGENA and SCHREIBER products. The bulk of the pages show either HYGENA or SCHREIBER products on their own. The following SCHREIBER products can be seen: fitted wardrobes, chests with drawers, wardrobes, mirrors, bedside cabinets, dressing tables, bedside chests, ottomans, stools and armoires. Of particular importance, taking into account the submissions of the parties, is the presence of beds on SCHREIBER pages. On pages 18 and 19 the SCHREIBER JAVA DARK range is presented; this consists of a double wardrobe, an ottoman, a single seven drawer chest, a double five drawer chest, a double three drawer chest, a beside cabinet, a mirror, a double wardrobe, a kingsize bed and a double bed. All of these goods have the same prefix for the product code: BLD. The rubric for the range includes the following: "Mixing veneers with solid wood, this free standing collection includes a dramatic double or kingsize bed, wardrobe, combi robe, four different chests of drawers and a stylish ottoman". On page 20 the VICENZA range is presented. Included in the rubric for this range is the following: "Vicenza takes the cool, modern feel of Milan and adds intensity with the darker, warmer tones of beech. The Vicenza double bedstead has been created to provide a perfectly matched centrepiece to the room". On page 37 the LOIRE and WILLOW ranges are presented. A picture of a LOIRE double bedstead appears and the reader is advised that the bedstead is available in both double and kingsize sizes. A picture of a WILLOW double bedstead appears and the reader is advised that the bedstead is available in both double and kingsize sizes. The rubric for the WILLOW range includes the following: "Match up with the Willow bedstead and working at home range".

19) The JAVA DARK, LOIRE, WILLOW and VICENZA beds also appear on pages 61 to 63, in a section identified as mfi bedsteads. The rubric for the VICENZA bed advises that it "goes with Vicenza bedroom". The rubric for the JAVA DARK bedstead states that "it goes with Java Dark bedroom". The WILLOW and LOIRE bedsteads have a similar rubric. Certain of the other bedsteads have no additional rubric with them, certain of them state that the go with various HYGENA ranges and a couple advise that they go with any bedroom.

Evidence of GTL.

20) The first evidence of GTL consists of a witness statement by Mr Stephen Michael Reese. Mr Reese is a solicitor and partner of the intellectual property group of Olswang. The witness statement contains no evidence of fact, it is

simply a critique of the evidence of MFI. I bear in mind the comments in reaching my decision made by Mr Reese but will not summarise them here. However, I note that Mr Reese states that the electrical appliances referred to in the evidence of Mr Purvis are household brands such as Bosch and Smeg. In exhibits DGP-1 and DGP-2 there are clear references to appliances being furnished under the name SCHREIBER. The registrations do not encompass such goods, however, as the statement of Mr Reese goes to the probity of the evidence of MFI I have commented upon it here.

21) GTL also furnished a witness statement by Mr Michael George Clare. MFI requested that Mr Clare attend for cross-examination. The registrar agreed that he should attend for cross-examination. A 30 day window was given for Mr Clare to attend the hearing. Mr Clare did not attend. Mr Harris submitted that owing to his absence his evidence should be afforded no weight. Ms Mensah considered that it should still be afforded weight and taken into account. Mr Clare gives his opinion as to how the furniture retail business is divided in the United Kingdom. As this case is based on the facts relating to one business and the use that it has shown or has not shown I cannot see that this is particularly relevant to the case. His statements could all be open to close scrutiny through cross-examination. Mr Clare goes on to give his opinion as to the business of MFI. He states that "it is the industry's understanding that MFI has started to shift its focus away from flat-pack bedroom cabinetry to the more lucrative sub-sector of fitted kitchen cabinetry". I cannot see how Mr Clare can speak for the industry, he is giving his opinion. The evidence furnished by MFI in relation to turnover and sales flatly contradicts his statement. The question of the focus of MFI is moreover not relevant in this case, this case is about what, if any, genuine use has been established. Mr Clare then goes on to comment on the specifications of the registrations. He states that the terms are either ambiguous or too wide to describe the goods which MFI sells fairly. I cannot see any ambiguity in the terms. As to the breadth, that is a question of the facts of the case and for me to decide on the basis of the evidence and the case law. The question of a fair specification is one that is decided by the case law in relation to the issue. Mr Clare goes on to give a view of what the evidence establishes. This again is a matter for me to decide. Again he comments upon the specifications of the registration and states that they are far too broad to be a reasonable and fair description of the goods. This presumes that Mr Clare has a knowledge of the case law in relation to genuine use, that he has an understanding of the concepts relating to revocation for non-use and that he can put himself in the position of the average, relevant consumer; as this is the basis upon which any revised specification will be honed. He goes on to say why he believes consumers visit furniture retailers, I cannot see why this is relevant. Mr Clare then goes on to state that he believes that MFI has no interest in using its SCHREIBER trade mark in respect of beds or mattresses. Revocation is about use in a past period and so his comment is not relevant. How is Mr Clare privy to the trade marketing strategy of MFI? He is clearly not.

22) I consider that virtually all parts of the witness statement could have given fertile ground for cross-examination. There is no explanation as to how and why Mr Clare was chosen by GTL. I find his statement about the interests of MFI in beds or mattresses astonishing. Why did Mr Clare focus upon these goods amongst all of those which are encompassed by the specification? Owing to his absence for cross-examination I consider that Mr Clare's evidence should be given no weight. In the context of a revocation for non-use action, even if it had been given weight, I cannot see that it would have had any effect.

Genuine use

23) A convenient summary of the criteria relating to genuine use was given by the Court of First Instance (CFI) in *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-191/07*:

“99 In interpreting the concept of genuine use, account should be taken of the fact that the ratio legis of the requirement that the earlier mark must have been put to genuine use if it is to be capable of being used in opposition to a trade mark application is to restrict the number of conflicts between two marks, in so far as there is no sound economic reason resulting from an actual function of the mark on the market (Case T-174/01 *Goulbourn v OHIM – Redcats (Silk Cocoon)* [2003] ECR II-789, paragraph 38). However, the purpose of the provision is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-2811, paragraph 38, and judgment of 8 November 2007 in Case T-169/06 *Charlott v OHIM – Charlo (Charlott France Entre Luxe et Tradition)*, not published in the ECR, paragraph 33).

100 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 registration (Case C-234/06 P *Il Ponte Finanziaria v OHIM* [2007] ECR I-7333, paragraph 72; see also, by analogy, Case C-40/01 *Ansul* [2003] ECR I-2439, paragraph 43). In that regard, the condition of genuine use of the mark requires that the mark, as protected on the relevant territory, be used publicly and externally (*Silk Cocoon*, paragraph 99 above, paragraph 39; *VITAFRUIT*, paragraph 99 above, paragraph 39; *Charlott France Entre Luxe et Tradition*, paragraph 99 above, paragraph 34; see also, by analogy, *Ansul*, paragraph 37).

101 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 (VITAFRUIT, paragraph 99 above, paragraph 40; Charlott France Entre Luxe et Tradition, paragraph 99, paragraph 35; see also, by analogy, Ansul, paragraph 100, paragraph 43).

102 As to the extent of the use to which the earlier trade mark has been put, account must be taken, in particular, of the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use (VITAFRUIT, paragraph 99 above, paragraph 41, and Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 36).

103 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The characteristics of those goods and services, the frequency or regularity of the use of the trade mark, whether the mark is used for the purpose of marketing all the identical goods or services of the proprietor or merely some of them, or evidence of use which the proprietor is able to provide, are among the factors which may be taken into account (Case C-416/04 P Sunrider v OHIM [2006] ECR I-4237, paragraph 71).

104 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case (VITAFRUIT, paragraph 99 above, paragraph 42; Charlott France Entre Luxe et Tradition, paragraph 99 above, paragraph 37; see also, by analogy, Ansul, paragraph 100 above, paragraph 39).

105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT) [2002] ECR II-5233, paragraph 47).”

24) The European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated:

“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'être*, 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.”

25) Ms Mensah submitted that there was no evidence of external use of the trade mark; to establish genuine use, the use has to be external use. In the event that it was found that there had been external use her submissions related to what use the evidence showed. Ms Mensah also submitted that the evidence from between 1988 and 2001 was not relevant. As the applications have been made under section 46(1)(a) of the Act as well as section 46(1)(b) this evidence is relevant, as it can affect the date from which revocation might take place.

26) Ms Mensah submitted that there was no evidence that the use of SCHREIBER was anything other than internal. There was no evidence showing that the catalogues, for instance, were distributed to the public. In the four years between 2004 and 2007 £20,776,083 was spent on in-store communications. Mr Harris submitted that these in-store communications included catalogues and brochures. In my view this is a reasonable submission. Behind the premise of Ms Mensah is that MFI over a period of years spent an enormous sum on in-store communications in relation to, inter alia, SCHREIBER, but that this was never put before the public. It produced catalogues and price lists but they were not put before the public. The catalogues are highly professional, they are clearly designed for the public; truly large sums have been expended on promotion. I find it inherently improbable that an undertaking would over a period of years would go to the trouble of producing catalogues and then not distribute them to the public. In his statement Mr Purvis states that MRL has been “offering goods for sale branded with the trade mark SCHREIBER in the UK since around 1987/8”. He goes on to say “SCHREIBER is currently one of the brands of furniture, electrical appliances and interiors exclusively available from my Company”. Mr Purvis says “offering goods for sale that are branded”, he speaks of the present. Mr Harris made reference to the decision of Mr Richard Arnold QC, sitting as the appointed person, in *Pan World Brands Ltd v Tripp Ltd (Extreme)* [2008] RPC 2. In that case Mr Arnold stated at paragraph 36:

“Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness’s evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness’s evidence.”

There is nothing incredible about the evidence of Mr Purvis, or that of Mr Greenhalgh; indeed their statements are in keeping with the exhibits that they have furnished. MFI has established that the trade mark SCHREIBER has been used externally during the period 9 February 2002 to 8 February 2007 and also prior to this period and the use has been substantial.

27) The only sales figures given for SCHREIBER kitchen furniture are for the year 2007. As MFI’s accounting year runs from February, these figures would cover the period from February 2007 to January 2008. The final date for showing proof of use is 8 February 2007 and so it could be theoretically possible that none of the turnover occurred in a material period. The resumption of use criteria of section 46(3) might, theoretically, apply:

“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.”

The sales for kitchen furniture in 2007 were £60.8 million. It seems unlikely that sales of this scale could be generated from a standing start. There is a continuum of promotional period over the years exhibited, from 2 December 1988 to May 2007 (after the material date, of course) in relation to kitchen furniture. MFI has established use of SCHREIBER in relation to both kitchen and bedroom furniture during the period 9 February 2002 to 8 February 2007 and also prior to this period.

The promotional figures.

28) As Mr Harris conceded the allocation of promotional expenditure by correlation to the proportion of sales of SCHREIBER products does not give accurate figure. In fact the allocation might well do MFI a disservice. The publications produced at DGP-3, DGP-4, DGP-5 and MG-3 cover both HYGENA and SCHREIBER products, so the expenditure made on these publications covers both sets of products; so part of the expenditure on promoting HYGENA products of its nature also promotes SCHREIBER, and vice versa; these brands are Siamese twins for at least some promotional purposes. The catalogues

promote both brands. There has been considerable promotion of the SCHREIBER brand. Of course, if GTL had wanted to challenge the statements in relation to promotion it could have requested to cross-examine Mr Greenhalgh. It did not make such a request.

The goods upon which the trade mark has been used and a fair specification.

29) In *Animal Trade Mark* [2004] FSR 19 Jacob J stated:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

Aldous LJ in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 held:

“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 judgment 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 bicycles. That would be unfair when the only use was in relation to motor cars. 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 notional consumer would describe such use."

In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the CFI stated:

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol*)

(*HIPOVITON*) [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has

been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.....

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category."

30) It is necessary to decide upon what goods the trade mark has been used and then to decide how the average consumer would describe the use and who is the average consumer. The average consumer for the goods of the registrations is the public at large. It is necessary to decide whether the use shown will be described by a category or a sub-category of goods or by the name of the specific goods. In the context of this case I have particularly borne in mind the finding of the CFI that

"the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

31) Following the concession of MFI, the proof of use relates to:

articles of domestic furniture

and

bedding, bins, towel dispensers, mirrors, mattresses, parts and fittings for furniture; all included in Class 20.

Registration no 1046742.

32) The evidence of MFI shows use of SCHREIBER across a wide panoply of bedroom furniture, both fitted and non-fitted. There are few items of bedroom furniture that are not shown. The turnover figures for the various ranges of SCHREIBER furniture are substantial. I consider that taking into account the breadth and scale of use that the average consumer would describe the use shown as use on bedroom furniture. This to me is clearly the appropriate fair specification. A good deal of time was spent at the hearing in relation to the use of the trade mark in relation to beds. Mr Clare made specific reference to beds

and mattresses; so it would seem that beds and mattresses are of importance to this case, although this has never been specifically identified. The specification upon which I have decided will encompass beds, however, as this category of goods appears to be of importance in the context of this case I will comment specifically upon beds.

33) The SCHREIBER JAVA DARK, LOIRE, VICENZA and WILLOW ranges all include beds. In paragraph 16 I give the turnover figures for these ranges, which are substantial. Ms Mensah did not consider that the presence of the beds in these ranges of SCHREIBER furniture established that the trade mark was used in relation to them. It was significant to Ms Mensah that the beds were also shown in the catalogue exhibited at MG-3 amongst other beds. At the side of the pages “mfi bedsteads” appears. However, at the sides of all of the pages mfi and a descriptive term appears. So at the side of the SCHREIBER pages “mfi bedrooms” appears. So I do not consider that the appearance of “mfi bedsteads” on the bed pages is of itself particularly significant. On the pages relating to SCHREIBER the beds are clearly an integral part of the range. I cannot see how the prospective customer if ordering JAVA DARK bedroom furniture, including the bedstead, would not consider that it was part and parcel of the SCHREIBER package and that SCHREIBER was being used in connection with the bed. On the page relating to the LOIRE and WILLOW ranges the beds are shown separately and prominently; they are integral parts of the furniture range. It clearly makes good business sense for MFI to display the bedsteads on pages devoted to bedsteads; a purchaser may wish to purchase the bedstead but not the whole range of the furniture. (In the same way that The COLLINGHAM and BOSTON stools and mirrors appear in the accessories page of the catalogue exhibited at DGP-3 as well as on the pages relating to these SCHREIBER ranges.) This does not gainsay use of SCHREIBER in relation to the bedsteads in another context, it is to be borne in mind that the issue is about use **in relation to** the goods. There are no individual sales figures for the beds but the sales figures for the ranges are given. There is, also, no need for a single bed to have been sold; the requirement for genuine use is to maintain or create a share in the market, so the active seeking of sales can be enough.

34) So beds are not only covered by the fair specification but also use of SCHREIBER in relation to beds is shown.

35) In relation to kitchens the goods shown are virtually all parts of fitted kitchens. Mr Harris referred to island units being shown. In my view these island units, whether described by MFI as freestanding or not, are part and parcel of a fitted kitchen. The only free standing furniture which I have been able to discover in the publications relating to SCHREIBER kitchens is the Argyle dining table and chairs, which appear on page 33 of the catalogue exhibited at DGP-5. This furniture also appears on page 52 of the catalogue under the heading “Dining”. I consider that the same arguments must apply to this range of furniture as applied to the presence of beds in ranges of bedroom furniture, the beds also appearing

in the bedstead part of the catalogue: SCHREIBER is being used in relation to the ARGYLE dining table and chairs. The presentation on page 33 is such that I cannot see how SCHREIBER would not be seen as being used in relation to the dining table and chairs. In relation to the use of SCHREIBER the table and chairs are being presented in the catalogue as kitchen furniture. This use of SCHREIBER in relation to freestanding furniture is very limited but there is nothing to suggest that the presence in the catalogue is token or is there to maintain a trade mark. 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).”

The CFI considered *The Sunrider* principles in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-325/06*:

“32 To examine whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, production or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine. Even minimal use can therefore be sufficient to be deemed genuine, provided that it is viewed as warranted in the economic sector concerned in order to maintain or create a share in the market for the goods or services protected by the mark (*VITAFRUIT*, paragraph 27 above, paragraph 42, and *LA MER*, paragraph 26 above, paragraph 57; see, by analogy, *Ansul*, paragraph 24 above, paragraph 39, and the order in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 21).

33 The Court of Justice also added, in paragraph 72 of the judgment in *Sunrider v OHIM*, paragraph 27 above, 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, which means that 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. Thus, the Court of Justice has held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (*LA MER*, paragraph 26 above, paragraph 58).”

In *La Baronia de Turis, Cooperativa Valenciana v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-323/03 CFI* stated:

“44 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other. Thus, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness (*HIPOVITON*, cited above, paragraphs 35 and 37).”

I have no idea as the sales of the ARGYLE range of goods at large nor dining tables and chairs in particular; so this is a very different situation than in relation to beds, where the sales figures for the various ranges are given. In the context of the evidence this is the sole indication of SCHREIBER being used in relation to free standing furniture. I do not consider that, in the absence of other evidence, taking into account the enormous size of the market, that this single occurrence in a catalogue can be considered to establish that during the material dates that MFI was maintaining or creating a share in the market in relation to the trade mark SCHREIBER for dining tables and chairs in particular and free standing furniture in general.

36) I consider that fitted kitchen furniture represents a clear sub-category, and a sub-category that is to be distinguished from free standing furniture. Consequent upon this finding I consider that a fair specification for the kitchen goods, in the context of the specification for registration no 1046742, is fitted kitchen furniture.

37) Mr Harris suggested that the specification for registration no 1046742 should be: *kitchen and bedroom furniture; parts and fittings therefor; all included in class 20*. I do not concur with him re the description of the kitchen furniture. The absence of the qualifying term *domestic* and the inclusion of *parts and fittings* expand the scope of the registration; not

something that is possible . I find that the specification for registration no 1046742 should be limited to: *domestic fitted kitchen furniture and domestic bedroom furniture*. The evidence before me does not suggest that there has been any wider usage since the registration of the trade mark, consequently, this partial revocation will be under section 46(1)(a) of the Act and take effect from 19 January 1983.

Registration no 1372485.

38) MFI is only seeking maintenance of the registration in respect of:

bedding, bins, towel dispensers, mirrors, mattresses, parts and fittings for furniture; all included in Class 20.

39) In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”². Words should be given their natural meaning within the context in which they are used, they cannot be given an unnaturally narrow meaning³. The class of the goods in which they are placed is relevant in determining the nature of the goods⁴. Consideration should be given as to how the average consumer would view the goods⁵.

40) The evidence shows use of SCHREIBER in relation to mirrors in the KINGSLAND range of furniture published in October 1999, in the MFI catalogue for winter 2002, in the MFI price list and the *mfi Bedrooms Spring 2006* catalogue. The average consumer is likely to describe the goods shown simply as mirrors, it is not appropriate to limit the term. MFI has established genuine use of SCHREIBER in relation to mirrors.

² *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

³ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

⁴ *Altecnic Ltd's Trade Mark Application* [2002] RPC 34.

⁵ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 dealt with a non-use issue but are still pertinent to the consideration of the meaning and effect of specifications:

“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 section 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 notional consumer would describe such use”

41) Parts and fittings for furniture can encompass a number of products but they are limited to being those products which are appropriate to class 20. Goods such as corbels, soffits, plinths and cornices where they are parts and fittings for furniture are appropriate to class 20; where they are building materials they will be appropriate to class 6 or 19 (depending on material of manufacture). SCHREIBER is shown as being used in relation to a variety of products that can be reasonably described as parts and fittings for furniture: panels, soffits, corbels, end panels, cornices, plinths, pelmets, décor panels and rails, cornice and pelmet rails. One can also see use on such things as tie racks, which are being sold as parts and fittings for furniture. I consider that the only appropriate term to describe the type of goods rehearsed is parts and fittings for furniture and that MFI has established genuine use of SCHREIBER in relation to these goods.

42) The SCHREIBER catalogue exhibited at DGP-2 shows on page 33 a towel rail and a bin, being accessories for fitted kitchens. This catalogue, owing to its date of issue, is relevant to the section 46(1)(a) ground but not to the section 46(1)(b) ground. Mr Harris identified use on towel rails as use in relation to towel dispensers. Giving both terms their normal meaning, a towel rail, is as it says, a rail from which a towel hangs; a towel dispenser is a contrivance from which towels are dispensed. The former is used for cloth towels, the latter for paper towels; this is illustrated in the evidence of MFI eg at the bottom of page 45 of the catalogue exhibited at DGP-5. I do not consider that towel rails can be equated with towel dispensers. There is no other use of SCHREIBER directly in relation to bins and no use of SCHREIBER directly in use in relation to towel dispensers. Bins of various kinds, towel rails, towel stands and a towel rack (which as shown on page 44 of DGP-5 is a form of towel dispenser) appear in the catalogues but without reference to SCHREIBER, they appear as general accessories for fitted kitchen furniture that can be used for either SCHREIBER or HYGENA kitchen furniture. Certain of the products bear the trade mark SOVEREIGN. The products will be used in either a HYGENA or SCHREIBER kitchen. The use of the products in a SCHREIBER kitchen is not the same as the use of the trade mark in relation to them; of which other than as noted above in relation to DGP-2 there is no evidence. In the absence of any other evidence, the goods could be seen as MFI or SOVEREIGN goods. Consequently, I find that MFI has not established genuine use in relation to towel dispensers. The use in relation to a bin is limited to one catalogue. However, there is nothing to suggest that this is token or coloured use; consequently, it is sufficient to defeat the section 46(1)(a) ground but not, owing to its date, the section 46(1)(b) ground.

43) Bedding in class 20 includes pillows but it does not include such things as blankets, bed linen and duvets. Bedding and mattresses appear in the parts of the catalogues relating to SCHREIBER furniture. However, there is no indication that SCHREIBER is used in relation to these products. In pages 61 to 63 of MG-3 the customer is advised in relation to the bedsteads that the mattress is extra, it is not an integral part of the package. The customer is also advised that:

“All beds are self-assembly and exclude ornaments, mattresses and bedding, etc.”

The pages advertise SILENTNIGHT and RESTASSURED mattresses. There is nothing to suggest that SCHREIBER has ever been used in relation to bedding and mattresses. Mr Harris submitted that mattresses can be seen in the catalogues, that they can be seen in the catalogues is not an indication that the trade mark has been used in relation to them. It is hardly surprising that in pictures of beds mattresses are shown. In respect of mattresses and bedding the trade mark will be revoked under section 46(1)(a).

44) Consequent, upon the above the specification of registration is to be limited to:

Mirrors; parts and fittings for furniture; all included in class 20.

The revocation in respect of bins will be under section 46(1)(b) of the Act and so take effect from 9 February 2007. There is nothing to suggest that use of the trade mark in relation to the other goods has taken place since the date of the completion of the registration process. In relation to the other goods of the specification, for which the registration is to be revoked, the revocation will take effect from 20 April 1996.

Summing-up.

45) The specification of registration no 1046742 is limited to *domestic fitted kitchen furniture and domestic bedroom furniture*. The specification of registration no 1372485 is limited to *mirrors; parts and fittings for furniture; all included in class 20*.

Costs

46) As each party has had a measure of success I make no award of costs.

Dated this 5th day of May 2009

**David Landau
For the Registrar
the Comptroller-General**