

O-209-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2278584  
BY ASSOCIATED NEWSPAPERS LIMITED TO REGISTER THE TRADE  
MARKS**

**IT'S FRIDAY !  
IT'S FRIDAY**

**IN CLASS 16**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 93787  
BY CHRISTOPHER ALAN SIMPSON**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No. 2278584  
By Associated Newspapers Ltd to register**

**IT'S FRIDAY  
IT'S FRIDAY!**

**as a series of two marks in relation to goods in class 16**

**and**

**IN THE MATTER OF Opposition thereto under No. 93787  
by Christopher Alan Simpson**

### **BACKGROUND**

1) On 21<sup>st</sup> August 2001 Associated Newspapers Ltd (hereafter "Associated"), Northcliffe House, 2 Derry Street, Kensington, London W8 5TT applied to register the following as a series of two trade marks:

**IT'S FRIDAY  
IT'S FRIDAY!**

It was published on 1<sup>st</sup> July 2005 for the following goods in class 16:

*"Newspapers and printed guides, features and listings"*

The journal entry records that it was accepted on the basis of "Honest Concurrent Use with 1506133 (5977, 3652) and others".

2) On 3<sup>rd</sup> October 2005 Christopher Alan Simpson of 61 Clapham Common Northside, London SW4 9SA (hereafter "Simpson") filed notice of opposition to the application. The opposition is based on grounds under Section 5(1), 5(2)(a) and (b) of the Trade Marks Act 1994 ("the Act").

4) Simpson relies on his earlier Community registration 1425446. The details of this trade mark, together with the goods and services which are alleged to be identical or similar:

#### **Mark:**

**ITSFRIDAY**

**Filing and registration dates:** 10<sup>th</sup> December 1999 and 17<sup>th</sup> June 2003 respectively.

**Goods and services alleged to be identical or similar:**

Class 9

*..... publications in electronic form; ..... publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites).*

Class 16

*Promotional material relating to on-line directory services*

Class 35:

*Advertising services, employment / personnel recruitment and information services relating thereto; advertising services, promotional services, exhibition services, publicity services, employment / personnel recruitment provided on-line from a computer database or the internet; provision of information relating to businesses and companies; compilation of advertisements for use as web pages on the Internet; providing advertising space in electronic publications and on web sites; providing advertising space on the internet.*

Class 36:

*Provision of insurance, financial, monetary and real estate information.*

Class 38:

*Providing access to data, including text, graphics, electronic documents, via the Internet, providing directory, news group services; website services; information services relating to the aforesaid.*

Class 39:

*Provision of information relating to travel.*

Class 41:

*Education services; entertainment services; recreation services; leisure services; cultural services; sport services; radio and television entertainment; provision of information relating to education, entertainment, recreation, leisure, culture, radio, television and sport; provision of information relating to education, entertainment, recreation, leisure, culture, radio, television and sport, on-line from computer databases or facilities provided on the Internet (including web sites); all the aforesaid relating to geographical locations, places of interest, shops, markets, training,*

*events, holidays, the arts, conferences, exhibitions, competitions, contests, carnivals, pageants, displays, shows, fashion shows, programmes, performances and / or to consumer news; publishing and publication services;*

Class 42:

*Information services in the form of a directory relating to catering services, dining out, drinking out, bar services, public house services, dining and / or drinking establishments; information provided on-line from a computer database or from the Internet of all the aforesaid.*

5) Associated filed a counterstatement denying the grounds for opposition.

6) Only Simpson filed evidence in these proceedings which is summarised below. A hearing by telephone conference took place on 14<sup>th</sup> May 2009 to determine both the substantive issue and a request by Associated's attorney for a stay of the implementation of my decision pending the outcome of a revocation action before OHIM brought by Associated against Simpson's mark. Simpson (the opponent) was represented by Ms Claire Lazenby and Associated (the applicant) was represented by Mr Martin Krause of Haseltine Lake. Both sides seek an award of costs.

#### **Simpson's evidence.**

7) Joanne Claire Lazenby has provided a witness statement dated 16<sup>th</sup> October 2008. She is a registered trade mark attorney acting, as I have said, on behalf of Simpson. She says the purpose of her statement is to put in evidence, information which may assist in considering whether the goods of the application are similar to the goods of the earlier mark. To this end, Exhibit JCL1 comprises a copy of application Form TM3 filed on 21<sup>st</sup> August 2001, comprising the basis of the application in suit. This form, which in any event is available to me as a matter of public record, shows that the original specification was broader than the application as published and shows in particular that the terms "features", "listings" and "printed guides" did not appear as such in the original application. Ms Lazenby's point is that, on the legal basis (see section 39(2) of the Act) that a specification cannot be extended, all such terms must be construed as falling within the broader terms "printed matter" or "printed publications", both of which did appear in the original specification.

8) Diana Pennock Connolly has provided a witness statement dated 15<sup>th</sup> October 2008. She is managing director of Findtech Ltd ("Findtech"), a company set up in 2004 with the aim of providing information research services to the IP profession. Her brief from Ms Lazenby was to research the extent to which as of 2001, being the material date of the application, sources of information on news, sports, leisure, entertainment and cultural events were available both from the internet

as well as in printed form, in particular in relation to newspapers, guides and listings.

9) She says that the best source of this information is Willings Press Guide (hereafter the "Press Guide"), which is a comprehensive directory of periodical publications updated annually. This guide is used by media buyers responsible for buying advertising space . The 128<sup>th</sup> Edition was published in 2002 and contains circulation figures and other information for the previous year, 2001. The Press Guide is no longer in print and back copies no longer available. Hence copies taken for the purposes of exhibits are taken from the edition in Findtech's own archive.

10) Exhibit DC1 is a copy of the Contents pages and 'Welcome' section to the 2002 Press Guide edition. These note the "brand new "E-Zine" section", containing latest "contact and publication information for this rapidly expanding sector of the media".

11) Exhibit DC2 shows the top newspaper titles (daily, national and Sunday newspapers and consumer magazines) by circulation appearing in the Press Guide. Exhibit DC3 merely explains how the circulation figures are authenticated.

12) Exhibit DC4 shows the individual entries in the Press Guide for the top 12 national daily newspapers listed in the Top Titles. Of those 12 titles, only 2 – The Daily Mail and Daily Express- were without an online version. That is to say that a web site address is clearly indicated against all of the other titles.

13) Exhibit DC5 are copies from the Press Guide section entitled "Electronic Magazines". This shows that 7 out of 12 of the top newspaper titles also had electronic magazines.

14) Exhibit DC6 comprises copies of pages from the internet dated no later than 2001 to show some of the material published online by the newspapers and includes copies of pages of news summaries and items from websites branded as the "ELECTRONIC TELEGRAPH", "FINANCIAL TIMES", "GUARDIAN UNLIMITED" and "INDEPENDENT".

15) Exhibit DC7 shows pages from the internet dated from between 1998 and 2001 taken from the media's own online directory 'guide' called MEDIA UK, which has been available online since 1995. These pages show that THE SUN newspaper was the most popular in 2002 of all the websites for which the MEDIA UK site acted as a portal.

16) Exhibit DC8 shows copies of press articles from the DOW JONES FACTIVA database published between 2000 and 2002 concerning the development of online newspapers during the period. Exhibit DC9 comprises copies of later articles published from a number of sources: THE REGISTER, BBC and

FACTIVA, published between 2002 – 2008, but commenting on the development of online newspapers, in the years preceding and including 2002 as well as after that year.

17) Exhibit DC10 comprises copies of further pages from the Press Guide showing an index of titles by subject matter. The index has been chosen on the basis that the subjects covered, eg Entertainment, Holidays, Cinema, Theatre are all subjects for which guides and listings are typical. The index includes publications such as, eg TIME OUT, EMPIRE, NEW MUSICAL EXPRESS, RADIO TIMES, TV TIMES, to name but five. Exhibit DC11 shows individual entries in the Press Guide against some of those publications showing, eg their circulation figures and website addresses. Ms Connolly says that the “E-Zine” section of the Press Guide has 486 entries, 22% of which contain an express reference to ‘guide’ or ‘listing’, either in the title or summary of content. A selection of entries from the “E-Zine” section is provided at Exhibit DC12.

18) The online directory, ‘MEDIA UK’, was available as an online guide in 2001 and Exhibit DC13 shows archive pages from 1998. Those pages show separate directories for TV, radio, magazines and newspapers. Within those directories are links to magazines such as TIME OUT, CRICKET WORLD MONTHLY, TV TIMES and SKY TV GUIDE. Finally, Exhibit DC14 comprises copies of links from those archive pages to:- SKY TELEVISION GUIDE, TIME OUT and the WORLD’S LIVING GUIDE. This is intended to fortify the argument that guides and listings also had internet versions alongside their traditional printed formats.

## **DECISION**

### **Section 5(1)**

19) I need to consider firstly the opposition, as based on Section 5(1) of the Act. Section 5(1) reads:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier mark is protected.”

20) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

Simpson's mark was filed on 10<sup>th</sup> December 1999 and it completed its registration procedure on 17<sup>th</sup> June 2003. Associated's mark was filed on 21<sup>st</sup> August 2001. Thus Simpson's mark is clearly an earlier trade mark in accordance with the Act.

21) As Simpson's mark was registered on 17<sup>th</sup> June 2003 and the application in suit published on 1<sup>st</sup> July 2005, it is not subject to proof of use requirements.

### **Comparison of the marks**

22) In the European Court of Justice ("ECJ") Case C-291/00 (*LJT Diffusion SA v Sadas Vertbaudet SA*) ("*Sadas*"), the Court said in relation to Art 5(1)(a):

"Article 5(1)(a) 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 a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer."

*Sadas* is the lead authority on the question of whether marks are identical. Whilst Art 5(1)(a) of the Directive 89/104EEC, referred to in the quote above, relates to the scope of rights available to a proprietor once a mark is registered, the Court in *Sadas* says the same interpretation given to Art 5(1)(a) applies also to Art 4(1)(a), being the relevant provision for these purposes.

23) The application is a series of two marks in capital letters, the difference being the presence of an exclamation mark. The two words "IT'S" and "FRIDAY" are separated. The earlier mark comprises the two words conjoined, "ITSFRIDAY", without any apostrophe or exclamation mark. Applying the *Sadas* test, I believe the differences between the respective marks, being the conjoined nature of the words and absence of apostrophe in the earlier mark, and presence of an exclamation mark in one of the series marks, are all differences which may go unnoticed by an average consumer. By "unnoticed" I should stress that in *Sadas*, the Court acknowledges that the assessment should take account of the fact that consumers rarely have the chance to make a direct comparison between the respective marks and must instead rely on an imperfect picture them kept in their minds (para 52).

24) Although the words are conjoined in the earlier mark, an average consumer will inevitably break down the mark into separate, recognisable parts or words to make sense of the conjoined word. In this respect, I reject the submission of Mr Krause that the earlier mark will simply be seen as a 'string of letters', leaving itself open to possibly different interpretations by the consumer. In other words, in certain contexts the string may be seen as 'I-T-S Friday'. I do not agree. The only 'interpretation' by the average consumer is the simplest and most obvious – namely that the consumer will see the 'string' as two words "It's" and "Friday". Furthermore, apostrophes are notoriously omitted or misplaced these days. Finally, the presence of an exclamation mark as an element of one of the marks in the series will not change the overall

impression left on the average consumer. Like apostrophes, exclamation marks have lost much of their currency and impact these days, owing to over use, or misuse. I should mention that in relation to the presence of additional punctuation, Ms Lazenby alerted me to the case of *WebSphere Trade Mark* [2004] FSR 39 in which the presence of a hyphen in otherwise identical marks was considered to be insignificant, applying *Sadas* principles. Although both marks were being used in relation to the internet where the hyphen may have been significant (when, eg typing in a URL), the Court felt it was wrong to limit communication of the respective marks to the internet as conventional visual means were also used, such as magazine advertising to promote the respective marks. In this context, the hyphen would have assumed much less significance and would only be apparent on a side by side analysis which, of course, *Sadas* cautions against. This case reinforces the conclusion I have arrived at.

25) The therefore find that the respective marks are identical.

### ***Comparison of the goods***

26) Turning to the goods, the application is in respect of

Class 16

Newspapers and printed guides, features and listings”

27) The relevant goods of the earlier mark, in class 16 are:

Class 16

Promotional material relating to on-line directory services.

28) Turning to the case law on the question of identity, it is important to recognise that the respective specifications need not be co-extensive to be considered identical. The European Court of First Instance (CFI) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05*, at paragraph 29, states:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

29) Three further cases on the way that specifications ought to be interpreted should be borne in mind. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* ("*Thomson*") [2003] RPC 32, at para 31, Aldous LJ, says

"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."

Although this was in the context of arriving at a fair specification consequent to an attack of revocation on the grounds of non-use, the principle that it is the public and circumstances of the relevant trade that should underpin consideration as to the terms used in a specification nonetheless holds good. Secondly, there is the case of *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd* ("*Beautimatic*") [2000] FSR 267, in which the principle of giving words their ordinary (rather than an unnaturally narrow) meaning was enshrined. Finally, there is the case of *Avnet Incorporated v Isoact Ltd* ("*Avnet*") [1998] FSR 16 where Jacob J (as he then was) says:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

Although his comments relate to specifications for services the same principle applies also to goods. In summary, the *Beautimatic* and *Avnet* cases urge an approach that is neither unnaturally narrow nor overly wide, whilst the *Thomson* case stresses that the exercise is not one of lexical analysis in a vacuum but by reference to how the average consumer may perceive matters in the relevant trade.

30) With that case law in mind, Ms Lazenby urges me to find that both "features" and "listings" are identical to Simpson's specification in class 16. She says that a "feature" is broad enough to encompass any material, whether editorial or advertorial in a printed publication; one of the purposes of a "feature" may well be to promote something. In relation to "listings" she says that a 'listing' is itself a promotional tool in that it promotes to the public the names and addresses of organisations on any given subject. At para 27 of her skeleton argument Ms Lazenby says:

"If I run an online directory I will need to promote the existence of that directory. The way to promote that directory is to produce the listings in written form, and hence listings is a promotional tool for the directory."

31) I find her arguments strained in relation to "features" and 'listings'. The difficulty here is that the description, "promotional material relating to an online directory" is not so much a recognised '*category*' of, eg newspapers and printed guides, features or listings, but a description which goes to the *nature and content*, rather than a recognised *type* of promotional material. As such, the parameters of protection are

obscure. Striving to comprehend matters from the perspective of the average consumer and the trade as the case law requires, it is stretching things to say that such a consumer or trader would, in normal usage, understand “promotional material relating to an online directory” to be a “feature”, still less a “listing”. The relevant dictionary definition of “feature” is:

“ a newspaper or magazine article or a broadcast programme devoted to a particular topic ( also **feature film** ) a full-length film intended as the main item in a cinema programme.”<sup>1</sup>

32) The first thing to note is that “feature” has no independent existence apart from a newspaper or magazine of which it forms a part. Secondly, the definition points in my opinion to ‘editorial’ rather than ‘advertorial’, or otherwise purely ‘promotional’ content. I appreciate that sometimes the boundaries can be blurred and advertorial material can be made or disguised to look like editorial material. There is no evidence on this point but I am aware of such usage from my own experience. But I do not believe that the average consumer (of whatever type, be they consumer or user) would regard promotional material promoting an online directory as having the status of a “feature” within a newspaper or magazine, unless such a newspaper or magazine were dedicated to such matters. This I find unlikely, and so I am not persuaded that, given its normal meaning and when viewed by the average consumer and trade, “features” is identical to “promotional material relating to an online directory”.

33) As regards “listings”, the argument becomes even more strained. Ms Lazenby urges me to accept that owners of an online directory will ‘promote’ their directory by producing written listings. Whilst it is conceivable that the owners of an online directory would produce a written version of their product - YELLOW PAGES ® may be an example, but the written version is not a promotional tool; it is simply a written version and would be understood as such.

34) I do not understand Ms Lazenby to be arguing that any of the other items listed in Associated's specification are identical to her goods and therefore, taking account of my principles identified in the case law relied upon, I do not find the goods to be identical. The consequence of my finding is that the ground under section 5(1) fails and section 5(2)(a) falls to be considered.

### **Section 5(2)(a)**

35) Section 5(2)(a) reads:

“(2) A trade mark shall not be registered if because –

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<sup>1</sup> “feature *n.*” *The Concise Oxford English Dictionary*, Twelfth edition . Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008. *Oxford Reference Online*. Oxford University Press. UK Intellectual Property Office. 15 July 2009 <<http://www.oxfordreference.com/views/ENTRY.html?subview=Main&entry=t23.e20042>>

- (a) it is identical with an earlier trade mark and is to be registered for goods and services similar to those for which the earlier trade mark is protected, or
- (b).....

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

36) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04* and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (d) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (e) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (f) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(g) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

### **Comparison of the marks**

37) In my analysis under section 5(1) I found the respective trade marks to be identical and have no reason to find otherwise under section 5(2)(a). The trade marks are thus identical.

### **Comparison of the goods/services**

38) In assessing the similarity of goods and services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the ECJ stated at paragraph 23 of the Judgment:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.’

39) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

40) My strategy at the hearing and the approach I shall take here is to confine my analysis to those of Simpson’s goods or services which may be considered to be closest to those of Associated. I can see no point in considering all those goods and services which Ms Lazenby asserts are similar. If she cannot succeed in relation to the goods and services selected below then she will not succeed at all.

41) My selection is based on the position adopted by Mr Krause with which I agree. At paras 3 and 4 of his skeleton argument he says:

“3. The Applicant accepts that there is a degree of similarity of the goods covered by the application and the goods and services covered by the

earlier trade mark, as highlighted by the Opponent in the amended specification.

4. The degree of similarity varies, but the high point of the Opponent's case must lie with the goods "electronic publications" and the services "publishing and publication services."

42) "Electronic publications" are covered in Class 9 of Simpson's specification within the term: "computer software and *publications in electronic form*; computer software and *publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites)*." As contended by Ms Lazenby, and conceded in his skeleton argument and at the hearing by Mr Krause, the word "and" separates "computer software" from "publications". I find there is no limitation to the effect that the publications covered only relate to computer software. Moreover, the services "publishing and publication services" are unequivocally covered by Simpson's specification in Class 41. Given Mr Krause's concession as to the 'high point' of the case for similarity I intend to consider Associated's specification only in relation to those broad terms conceded as making up that high point. In doing so I am aware Ms Lazenby pressed her case at the hearing, declining to withdraw any of Simpson's goods or services from the comparison, primarily because there was some debate as to whether 'newspapers', 'guides' or 'listings' were properly classified as a good (in class 9) or service (in either eg class 41 or 42) . As I understand her precise concern it was to do with the 'guides' and 'listings' rather than the 'newspapers'. As regards newspapers, her position was that irrespective of how the online versions were properly classified in 1999, they were either 'caught' (my term) by Simpson's publications in class 9 or publishing services in class 41. The position was less clear to Ms Lazenby as regards 'printed guides' and 'listings', which may have been closer to eg directory services in class 42 than the broader terms in class 9 and 41. As I have said, my approach to this is to consider the 'high point' concession by Mr Krause and test that against the evidence in the case, the view of the consumer, as well as case law. On that basis, the respective goods and services for comparison are as follows:

<b>Associated's goods</b>	<b>Simpson's goods and services</b>
<p>Class 16</p> <p>Newspapers and printed guides, features and listings.</p>	<p>Class 9</p> <p>Publications in electronic form; publications in electronic form supplied on-line from databases or from facilities provided on the internet (including web sites).</p> <p>Class 41</p> <p>Publishing and publication services.</p>

43) Despite Ms Lazenby's position that none of her client's goods or services be withdrawn from consideration, it will be noted that I have not included in my list above, Simpson's goods in class 16, which may instinctively be regarded as Simpson's best case, being in the same class. For the reason I have already given in relation to my analysis under section 5(1), namely that Simpson's goods in class 16 are defined by nature and content rather than type I am not convinced they do in fact represent the best case.

44) Simpson's evidence is directed to one simple question: in 2001 (the material date) what was the extent to which, if at all, the types of printed publications covered by Associated were available electronically as well as in printed format? It should be noted that I accept Ms Lazenby's argument and evidence directed to the fact that: "features", "printed guides" and "listings" in Associated's specification must all be construed as comprising "printed matter" or "printed publications". These broader terms originally appeared in Associated specification and the narrower terms which emerged must be construed not to extend the original breadth of the specification (section 39(2) of the Act). If it is established from the evidence that such publications were available electronically, whether from web sites or other electronic format, then the case for similarity of goods becomes inevitable. In other words, as Ms Lazenby puts it, the average consumer will, upon seeing or being aware of a particular title in printed format will, when they see the same title in electronic format, simply assume that the two are merely different versions of the same title, emanating from the same economic source. My approach will be firstly to consider Simpson's class 9 goods against Associated's class 16 goods (excluding 'features'). Secondly, I will consider Simpson's class 41 services against Associated's class 16 goods (again excluding 'features'). Finally I will apply my findings in respect of the first and second comparisons to the term 'features' in Associated's class 16 specification.

***(a) Class 9 (electronic publications, including online or from the internet) and their similarity with Class 16 (newspapers, printed guides and listings)***

45) The evidence shows emphatically that as at 2001, almost all major newspapers had online versions. Importantly, the evidence does not stop at simply showing that such newspapers had websites only, it goes further into the content of the material available electronically over the internet at the material date. Exhibits DC6 and DC7 actually show some of the material available, whilst Exhibit DC8 comprises editorial material on the growth of online newspapers. I notice for example that in one of those articles in THE DAILY TELEGRAPH dated 26<sup>th</sup> July 2001, it is claimed that THE DAILY TELEGRAPH was the first paper to go online in July 1994. It was not just the main nationals that had online versions either; in an article dated 27<sup>th</sup> October 2000 in THE TIMES, it is said that the THE EVENING PRESS in York has an online version. The possibility

that not every newspaper in the land had an online version does not detract from the general trend and position as at the relevant date, which would have been understood by the average consumer. Based on the evidence, the position as regards newspapers therefore is that as at 2001 most would have had a presence on the internet. When this is factored into the assessment of similarity of goods, the only conclusion possible is that urged on me by Ms Lazenby, that “electronic publications” in class 9 includes electronic publications of traditional printed newspapers which must be considered highly similar to “newspapers” in class 16. There is even an argument they would be identical despite being in different classes. This is because they will be viewed by the average consumer as simply a different version or format of the same title, emanating from the same source. Applying the strict *Canon* factors however, I find instead that “newspapers” and “electronic publications” are highly similar. Their method of use will be different (one is read from print, the other from a screen); the users may well be different (if you read the printed version, there would be no need to read the electronic version as well); the channels of trade would be different in that the printed version would be sold through distributors via newsagents or supermarkets, whilst the electronic version would simply be made available over the internet. Applying the *Canon* test, my finding then is that “newspapers” and “electronic publications” in class 9 are highly similar.

46) The position is less clear as regards “printed guides” and “listings”. Although Exhibits DC10 and 11 shows that the Press Guide refers to certain printed guides and listings, in contrast to the evidence in relation to newspapers, the extent to which such publications had embraced the web (not just by having a web site) is less clear. Part of the problem undoubtedly lies with the difficulty in establishing the boundaries of what may be described as a “printed guide”, which may range from a single, one-off publication dedicated, eg to a particular area, landmark or attraction, to a national periodical dedicated to providing a consumer or buyer with a guide to, eg cars, HI-FI, entertainment or holidays.

47) “Listings”, on the other hand, has a more precise meaning in the field of publications, namely that which refers to a list such as, eg television programmes. There is undoubtedly overlap between “printed guides” and “listings”; the term “listings” would I think be subsumed as a sub-category within the broader term “printed guides”. The evidence establishes that at least some material which could be termed either a “printed guide” or a “listing” (eg TV TIMES, TIME OUT, SKY TELEVISION GUIDE and WORLD’S LIVING GUIDE) had a web presence beyond a mere web site at the material date. On the basis of that evidence I conclude that the same finding in respect of newspapers, namely that they are highly similar to electronic publications in class 9, applies also to “printed guides” and “listings”.

**(b) Class 41 (publishing and publication services) and their similarity with Class 16 (newspapers, printed guides and listings)**

48) As I have said, Ms Lazenby was concerned at the hearing not to withdraw from the comparison terms which appeared in the services classes of Simpson's specification given the uncertainties of classification, and in particular whether 'newspapers' 'printed guides' and 'listings' provided in electronic format are properly classified as a good or a service. My understanding of the current Nice Classification is that electronic publications which are downloadable are properly classified in class 9 as a good, whereas publications which are not downloadable are properly classified as a service in class 41. I am not aware of the history behind this classification division and nor does the evidence in this case address the particular question whether the electronic versions of newspapers and listings were downloadable at the material date or simply available on screen. Printed guides are by definition 'printed' and so I must assume that no electronic version is included within the scope of that term. My approach so far in the comparison between class 9 and class 16 goods has been to avoid the particular classification question, and instead focus on the expectations of the average consumer based upon the evidence filed as regards the question of similarity. Nevertheless, and for the benefit of any doubt, I wish also to consider the question of the similarity of "newspapers" "printed guides" and "listings" in class 16 with "publishing and publication services" in class 41.

49) Based on the *Canon* test, the service of publishing will have a different nature and end user to that of the publications themselves. In addition, the average consumer for the service of publishing may well be authors themselves whilst the average consumer for the publications may be the public, whether general or specialised. That said, there is nevertheless an inevitably close relationship between the service and the resulting goods; the one cannot exist without the other and so they may be said to be complementary. Publishers may thus provide both a service to authors (including journalists) as well as a service, directly or indirectly, to the public in terms of selling their publications. Those publications, which will of course include newspapers printed guides and listings, will invariably carry the publisher's mark somewhere, in the paradigm case it will be part of the title, eg BERLITZ Travel Guides. In the specific case of newspapers, particularly given the sensitivities of media ownership in the UK, the various groups of user and consumer are reasonably familiar with who may be the proprietor/publisher of a particular title, eg Associated News Ltd publish the DAILY MAIL and News International publish THE TIMES and NEWS OF THE WORLD. The titles and publishers are intimately linked and associated, the one with the other. This familiarity would undoubtedly in my view lead to confusion and dispute if one publisher or proprietor's name/mark were to start being used by another, regardless of whether the title of the newspaper were to stay the same. It could well be (it certainly is with newspapers) that the end consumer for such reading material may well make their selection based upon the content and style which they have come to expect from a certain publisher. I am reinforced in

those conclusions as the Second Board of Appeal at OHIM in Case R 1170/2005-2 *Gouden Gids BV v Yell Ltd* dated 27<sup>th</sup> July 2007 found exactly the same. Part of para 25 and para 26 in full of that decision reads as follows:

“Thus, it is true that publishing services primarily target the authors while the publications themselves are addressed to the consumers. This is also the rationale behind the different classification, in the Nice Classification, of ‘books, magazines, etc.’ (Class 16) as opposed to the ‘*publication of books, magazines, etc.*’ (Class 41).

26. However, although it is true that the goods in Class 16 and the services in Class 41 are of different nature and that their primary purpose and intended public are different, these goods and services are intertwined in various ways. Firstly, the goods and services are complementary, since the final product (books, magazines, etc.) is necessarily the result of a publishing activity. Secondly, the final purpose of the publishing services (Class 41) is precisely the distribution and sale of the final goods (books, magazines, etc., in Class 16), to the public. For this reason, the activities of a publishing company can involve both the provision of publishing services to authors and the sale of goods to consumers, for example when publishing companies operate their own network of bookstores. Moreover, publishers normally affix their marks on the publications (i.e. on the end-product) directed to the consumer. Consumers often make their selection of publications on the basis of the publisher’s mark, which can reflect certain content or style (e.g. legal publications, literature, etc.). Hence, also from the consumer’s point of view, a publisher’s mark can operate both as a service and as a product mark. Therefore, the Board finds the printed media listed in Class 16 of the earlier trade mark similar to the services listed in item (i) of paragraph 24 above.”

Applying the *Canon* test, I therefore find that “newspapers”, “printed guides” and “listings” are similar to “publishing and publication services” in class 41.

(c) **Features**

50) That leaves just “features”. My starting point is that given the description of a “feature”, in the Oxford English Dictionary to which I have already referred in para 31 above, I cannot accept that a “feature” has an independent existence apart from the publication of which it is considered a dominant or distinctive element. On that basis my conclusions in relation to similarity of the other types of publications must hold good for features as well.

51) Accordingly I hold that features are either highly similar to, or similar to, either “electronic publications” in class 9, or “publishing and publication services” in class 41 of Simpson’s specification.

### ***The average consumer and user***

52) Ms Lazenby identifies three groups of average consumer or user for Associated's products. The first and most obvious being members of the general public who buy newspapers (including features), guides and listings. Secondly, there are media buyers who buy advertising space in both printed and electronic publications. Thirdly, there are press officers who use printed and electronic publications in which to place editorial material. I do not understand Mr Krause to dispute this.

53) I think it a significant feature of all these groups that although the purchase of, eg a newspaper may be of relatively low cost, there will nevertheless be significant brand awareness. Different newspapers will appeal to the views of their, invariably loyal, readership and the general public will be aware of what they can expect from each. Likewise, the other groups of users will similarly be aware, with the help of press guides such as those referred to in evidence, of those publications in which their advertising or editorial material will be most effective.

54) The average consumer for Simpson's goods and services will, I believe, substantially overlap, in terms of being drawn from the same source (general public) even though the overlap may not be coterminous. The reader (or interested user) of online directories, electronic publications and publishing services may well also read newspapers, guides and listings and the features contained therein, especially if material is of general and universal interest.

### ***Distinctive character of the earlier mark***

55) Prior to bringing my findings together I need to make an assessment of the distinctive character of the earlier mark – just how distinctive is it? There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*. As there is no evidence of use of Simpson's mark I only have the inherent characteristics of the mark to consider. I must also consider how distinctive the mark is in relation to the goods and services for which it is registered and for which it is sought to be registered. The words "It's Friday" do not have inherently high distinctive character in relation to printed or electronic matter. When used, eg as a title for any sort of publication, whilst not being entirely descriptive of the content, the impact and intent is clear. It is intended to convey a 'feel-good' and upbeat image associated with the end of the traditional working week and anticipating the pleasures and freedoms the weekend will bring. As such I believe the earlier mark to be of low to average inherent distinctive character.

### ***Likelihood of confusion***

56) My findings can now be brought together in an overall global assessment. This will necessarily take account of imperfect recollection and that confusion includes both direct (mark against mark) and indirect confusion (although the marks may not be confused the consumer will assume products bearing the respective marks emanate from the same source).

57) Given the identity of the marks and the similarity of the goods and services my conclusion is that there is likely to be direct confusion between the respective marks and thus the opposition under section 5(2)(a) succeeds in its entirety.

## **APPLICATION FOR A STAY OF THE IMPLEMENTATION OF THE DECISION**

### ***Nature of the request***

58) Mr Krause argued that in the event that the applicant was unsuccessful to any extent, the implementation of my decision should be stayed pending the outcome of revocation proceedings against Simpson's mark brought before OHIM by Associated. He had supplied a witness statement exhibiting a copy of an application to revoke Simpson's mark filed on 11<sup>th</sup> May 2009, three days before the hearing. The application had been made on the basis of Art 51(1)(a) of the Community Trade Mark Regulation ("CTMR") which concerns revocation on the basis of non-use. Mr Krause's request was opposed by Ms Lazenby.

59) Mr Krause was at pains to say that he was not asking for a *stay of proceedings* but a *stay of implementation*. In light of my finding above, in effect, a stay of execution. He said that this distinguished his case from others which involved stays or suspensions where there are concurrent proceedings and one jurisdiction may defer to another. He had no problem with my determining the substantive issue as above; what he urged me not to do was to implement my decision in the event I found against him, either in totality or in part. I think this is a distinction without a difference. Simpson ends up being denied victory until some uncertain date in the future, whilst the status of the application also remains uncertain as far as the opponent (and third parties) are concerned. Plainly, the issue is not the same as a co-pendency scenario where, in an opposition, the registrar is constrained not to refuse an application as the opponent's mark(s) has(ve) not matured into registration(s). Rather, this is the applicant contending that he should enjoy the 'benefit' of a stay of execution as a result of separate proceedings against the opponent's mark, brought by himself. On that basis I intend to treat the application as a request for a stay, but to ask myself in the first instance whether such a stay would have any material effect on the proceedings. The starting place for such an analysis is to remind myself of the relevant dates.

***The relevant dates and the effect of the revocation action.***

60) Associated's application was filed on 21<sup>st</sup> August 2001 and published on 1<sup>st</sup> July 2005. Simpson's earlier mark was filed on 10<sup>th</sup> December 1999 and registered on 17<sup>th</sup> June 2003. Section 6A of the Act states:

**" 6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b).....

Thus, when Simpson lodged opposition against Associated's mark on 3<sup>rd</sup> October 2005, in accordance with s.6A (3) (a) his CTM was not subject to proof of use requirements as his mark had only been registered on 17<sup>th</sup> June 2003, well within 5 years of the date of publication of Associated's mark on 1<sup>st</sup> July 2005.

61) The earliest date an application for revocation on the grounds of non-use could have been filed against Simpson's mark before OHIM was 18<sup>th</sup> June 2008.

Had such an application been lodged on that date, the effect of revocation would have been in accordance with Art 55(1) of the CTMR which reads as follows:

*“Article 55*

**Consequences of revocation and invalidity**

1. The Community trade mark shall be deemed not to have had, as from the date of the application for revocation or of the counterclaim, the effects specified in this Regulation, to the extent that the rights of the proprietor have been revoked. An earlier date, on which one of the grounds for revocation occurred, may be fixed in the decision at the request of one of the parties.”

62) The default position is thus that revocation of Simpson’s mark could only have effect at the earliest from the date of application for revocation. In the event, application by Associated for revocation against Simpson’s mark took place well after 18<sup>th</sup> June 2008, on 11<sup>th</sup> May 2009. No earlier date for revocation had been sought by Associated and, in any event, could not be requested (on grounds of non-use) to have effect from an earlier date prior to 18<sup>th</sup> June 2008.

63) This means that for the period between the date of publication of Associated’s mark, 1<sup>st</sup> July 2005, and the earliest possible date of revocation, being 18<sup>th</sup> June 2008, Simpson’s mark would (and will continue to) constitute a valid and enforceable mark. This is a different circumstance to an invalidity action, a fact which has been commented on in the case of *Hormel Foods Corp v. Antilles Landscape Investments NV* [2005] RPC 28, (“*Spambuster*”), where Richard Arnold Q.C. sitting as a Deputy Judge of the Chancery Division said at para 97:

“A claim for revocation of a trade mark is fundamentally different to a claim that the trade mark was invalidly registered. A claim that a trade mark is invalidly registered is a claim that the mark should never have been registered for whatever reason, and has wrongly remained on the Register ever since. It thus essentially concerns the position as at the application date (subject to the slight anomaly created by the proviso to s. 47(1) of the 1994 Act). By contrast a claim that a trade mark should be revoked is a claim that the mark, even though it may have been validly registered, should be removed from the Register because of events occurring subsequent to registration, e.g. because it has not been used by the proprietor for five years.”

That view is echoed in Kerly’s Law of Trade Marks and Trade Names, 14<sup>th</sup> ed at 10-003.

64) So, during the period in which Simpson’s mark was valid and enforceable he enjoyed, in full, the benefits of registration and those benefits would not be

removed as a result of revocation of his mark (see also *RIVIERA Trade Mark* [2003] (“*Riviera*”) RPC 59 at paras 14 and 15). For example, if an infringement action had already been brought or may be brought in the future (subject to any limitation period), claiming damages involving the period in which Simpson’s mark was valid and enforceable then that infringement action would continue, with relief being available to Simpson even though his mark was subsequently revoked.

65) It is worth noting that the *Riviera* case was decided prior to the coming into force of Section 6A of the Act concerning an opponent’s non-use in an opposition. So, in para 20 of the *Riviera* case it is said:

“20. The net result of this is that it is vital for a party seeking to revoke an earlier trade mark in order to clear the way for its own application, or to resist an application to have its own registration declared invalid on the basis of the earlier trade mark, to make a request in its application for the conflicting earlier trade mark to be revoked with effect from a date which precedes the date of its own application for registration.”

66) In *Riviera* therefore it was felt that the operative, and fixed date, an applicant for revocation had to bear in mind was the date of application of his own mark and it was vital that he sought revocation of the opponent’s mark from a date earlier than his own date of application, failing which the revocation would be ineffective in regard to the opposition. With the coming into force of Section 6A of the Act, it is the date of publication of the later mark which has now become the operative, and fixed, date to bear in mind.

67) At the hearing I was referred to several cases which, for the following reasons, do not address the precise circumstances of the request Mr Krause has made. Mr Krause alerted me to Case C-145/05 *Levi Strauss & Co v Casucci SpA* which concerns the power (or lack of) of a national Court to order cessation of an infringer’s sign during a period when the right being asserted was subject to a revocation action. This does not tackle the specific request before me as it relates to specifically injunctive relief in an infringement case, as distinct from an application for a stay in an opposition.

68) Then Mr Krause took me to Case T-191/04 *MIP Metro Group Intellectual Property GmbH & Co KG v OHIM*. He notes that the CFI applies a purposive approach, based on the principles upon which relative grounds for refusal and opposition proceedings are to be construed. Although the case concerns the detailed OHIM procedures in relation to requiring evidence of renewal, the Court concludes, inter alia, at para 32 that:

“The function of an earlier mark as a means of identifying its origin cannot be undermined by another mark which is registered only after the term of

protection of the earlier mark has expired. If there is no period during which both marks co-exist, no conflict can arise.”

As the intervener’s mark had expired *prior* to the date of the decision by the opposition division, the opposition no longer had any purpose as both marks would not co-exist. The difficulty with this case is that it concerns OHIM specific procedures in relation to a mark which an opponent has allowed to expire before the date of decision, rather than one challenged on grounds of non-use revocation by the applicant.

69) The fundamental question remains, whether in the light of the *Riviera* decision, the application for revocation by Associated will have any effect at all in this opposition. A case I was not referred to by either Mr Krause or Ms Lazenby, but instead I alerted them to is CFI Case T-161/07 *Group Lottus Corp, SL v OHIM* (“*Coyote Ugly*”). The original language of this case is Spanish. With the agreement of the parties I requested a translation of this case from the Foreign Office into English and sought the parties’ comments after the hearing. Paras 47-50 of the original version in Spanish read as follows:

“47 El artículo 43, apartado 2, del Reglamento nº 40/94, que se refiere al «examen de la oposición», establece que, «a instancia del solicitante, el titular de una marca comunitaria anterior que hubiere presentado oposición, presentará la prueba de que, en el curso de los cinco años anteriores a la publicación de la solicitud de marca comunitaria, la marca comunitaria anterior ha sido objeto de un uso efectivo en la Comunidad para los productos o los servicios para los cuales esté registrada y en los que se base la oposición, o de que existan causas justificativas para la falta de uso, con tal de que en esa fecha la marca anterior esté registrada desde hace al menos cinco años». A falta de dicha prueba, ha de desestimarse la oposición.

48 En el presente asunto, la marca anterior de la interviniente fue registrada el 23 de octubre de 2001 y la oposición se formuló el 19 de agosto de 2002, mientras que la solicitud de la marca por la demandante se presentó el 26 de octubre de 2001 y se publicó el 12 de agosto de 2002. Por tanto, el 12 de agosto de 2002, fecha de publicación de la solicitud de la marca comunitaria, la marca anterior no llevaba registrada desde hacía al menos cinco años, puesto que había sido registrada el 23 de octubre de 2001. Por consiguiente, conforme al artículo 43, apartado 2, del Reglamento nº 40/94, la interviniente no estaba obligada a demostrar ante la OAMI, a instancias de la demandante, el uso efectivo en la Comunidad de dicha marca para las «cervezas» de la clase 32, que son los productos considerados por la División de Oposición y por la Sala de Recurso para apreciar el riesgo de confusión.

- 49 Por otra parte, la caducidad de la marca anterior no se declaró sino con efectos al 8 de mayo de 2007, fecha de presentación de la solicitud, y no con efectos de la fecha de registro de esta marca, como se desprende del apartado 1 de la decisión de la División de Anulación de 11 de julio de 2008. Por tanto, la fecha a partir de la cual se considera que la marca comunitaria no produce los efectos previstos por el Reglamento es el 8 de mayo de 2007, y no el período anterior, respecto al cual se pronuncia la resolución impugnada en el presente asunto.
- 50 Por consiguiente y aunque pudiera interponerse un recurso ante la Sala de Recurso contra la citada decisión de la División de Anulación, no procede tener en cuenta esta decisión para apreciar la legalidad de la resolución impugnada. La demanda presentada en el presente asunto se refiere a una marca anterior que producía efectos en el momento en que se adoptó la resolución controvertida.”

This has been translated into English by the Foreign Office as follows:

47. Article 43(2) of Regulation (EC) No 40/94, headed ‘Examination of opposition’, provides that ‘if the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years’. In the absence of such proof, the opposition must be rejected.

48. In this case, the earlier mark belonging to the intervener was registered on 23 October 2001 and notice of opposition was lodged on 19 August 2002, whilst the applicant’s trade mark application was lodged on 26 October 2001 and published on 12 August 2002. Therefore, on 12 August 2002, the date of publication of the Community trade mark application, the earlier mark had been registered for less than five years, given that it had been registered on 23 October 2001. Consequently, pursuant to Article 43(2) of Regulation (EC) No 40/94, the intervener was not required to furnish proof to OHIM, at the request of the applicant, that that mark had been put to genuine use in the Community for ‘beers’ in Class 32, which were the products taken into account by the Opposition Division and by the Board of Appeal when assessing the risk of confusion.

49. Moreover, the revocation of the earlier mark was only declared effective as from 8 May 2007, the date on which the application was lodged, and not as from the date of registration of the mark, as is evident

from paragraph 1 of the decision of the Revocation Division of 11 July 2008. Therefore the date from which the Community mark can no longer be considered to have the effects provided for in the regulation is 8 May 2007, and not the earlier period in relation to which the contested decision was delivered in this case.

50. Consequently, although an appeal could be lodged before the Board of Appeal against the aforesaid decision of the Revocation Division, it is not necessary to take that decision into account when assessing the legality of the contested decision. The application lodged in this case relates to an earlier mark which was effective at the time the disputed decision was adopted.

70) Neither party has argued that I should not in principle rely upon a decision of the CFI in relation to the interpretation of a provision of the CTMR. I think this is the correct position to take; the CFI were offering an interpretation of Art 43(2) of the CTMR (which has since been renumbered as Art 42(2) of Regulation (EC) 207/2009 of 26<sup>th</sup> February 2009). This is the equivalent provision in the CTMR to Section 6A in the Act which I have quoted above. The CFI's view is not one which, at the very least, has no application or can be ignored. Unsurprisingly however, both parties' interpretation of the CFI Judgment is different. Specifically, Mr Krause's response to this case is to say that the CFI is, given its rules of procedure (specifically Art 65 of the CTMR and Art 135(3) of the Rules of Procedure of the Court of First Instance) simply stating that at the time the Board of Appeal adopted the disputed decision (2<sup>nd</sup> March 2007) the subsequent revocation (decided by the revocation division on 11<sup>th</sup> July 2008, but with effect from 8<sup>th</sup> May 2007) was not a fact which, on appeal, could be taken into account when assessing the legality of the Board of Appeal's disputed decision. Based on the last sentence of para 50, Mr Krause says that had the earlier mark been revoked at the time the Board of Appeal came to issue its decision, another view may well have been taken. This accords, says Mr Krause, with the current practice before OHIM, of suspending an opposition where the earlier mark is the subject of a revocation action (even where the provisions of Art 43(2) do not apply), and OHIM will then dismiss the opposition if the earlier mark is revoked, even where the effective date of revocation is after the date of application of the opposed trade mark.

71) I cannot accept Mr Krause's view of this case for the following reasons:

- (a) if the CFI cannot annul or alter a decision by the Board of Appeal on grounds which come into existence subsequent to the adoption of its decision, then quite simply the discussion in particular in paras 47 and 48 of the *Coyote Ugly* case is entirely irrelevant and/or self-indulgent. There is no need for the CFI to discuss the issue of the requirement on an opponent to prove use and at what time that arises. Instead, it suffices for the CFI to say it is incapable of annulling or amending the Board of

Appeal's decision since the application for revocation (whenever that decision may have effect) was lodged after the Board of Appeal's disputed decision;

- (b) instead, we must treat the discussion in paras 47 and 48 in particular as being meaningful in relation to the interpretation of the substantive provisions of Art 43(2) of the CTMR. In my view, the CFI is saying an opponent may be required to prove use of his mark only if at the date of publication of the later mark his mark is over 5 years old. If it is not, he is under no (ongoing) obligation to prove use and nor is his opposition undermined by an action for revocation which still leaves his mark valid and enforceable at the relevant date of publication;
- (c) it is essential to view the passage as a whole. The arguments in paras 49 and 50 simply reinforce, without in any way displacing the view taken in paras 47 and 48. It is noted in this respect that para 49 commences with the word "moreover". In para 49, the CFI says the effective date of revocation is 8<sup>th</sup> May 2007, being outside the "earlier period" in relation to which the contested decision was delivered. In my view, the "earlier period" describes the period between 12<sup>th</sup> August 2002 (date of publication of the opposed mark) and 2<sup>nd</sup> March 2007 (date of contested decision). In paras 49 and 50, the CFI is simply noting (secondarily to its primary view in paras 47 and 48) that the legality of the Board of Appeal's decision cannot in any event be brought into question by a revocation decision having effect, (a) *after* it has decided the matter, and also, (b) when at the time the Board of Appeal took its disputed decision, the earlier mark was valid. In other words, paras 49 and 50 should not be read as at variance with paras 47 and 48, and in some way suggestive of other periods or dates (other than the date of publication of the later mark) as being 'operative' dates, in accordance with Art 43(2), as far as the revocation is concerned. Rather, they serve to (further) rebut the claim that the CFI (in its appellate role) ought to have regard to the revocation of the earlier mark, subsequent to the disputed decision, in *its* consideration of the appeal;
- (d) although Mr Krause says the CFI's rules of procedure (specifically Art 65 and Art 135(3)) are at the heart of its decision, it is more than a little surprising then that there is absolutely no mention of these Articles. Rather, the CFI is keen instead to properly construe Art 43(2) and specifically makes reference to that Article.

72) My conclusion in relation to the *Coyote Ugly* case is that it is consistent with the earlier *Riviera* case, in that both cases require that for a revocation determination to have anything other than academic effect in an opposition it must be effective prior to a 'fixed date' – the date of application of the later mark in *Riviera*, or the date of publication of the later mark in *Coyote Ugly*. If the

*Riviera* case were to be decided today, with the introduction of Section 6A of the Act, I assume the ‘fixed date’ would be the date of publication of the later, opposed mark. It is implicit from this that at the time of deciding an opposition, exactly when (or by whom) any pending or concluded revocation action is lodged or decided is only relevant if such an action has the effect of ‘knocking out’ an earlier mark to a date earlier than the date of publication of the opposed application. This satisfies the need for legal certainty and avoids contingencies such as delays in deciding the opposition, whoever may be responsible for those delays. **For this reason I conclude that the application for revocation in this case will have no impact on the opposition, since at the date of publication of Associated’s mark, Simpson had and will continue to have, whatever the outcome of the revocation, a valid mark.**

### **Stay**

73) Despite the position I have taken above, I nonetheless think it necessary to consider whether Mr Krause has made good his case for a stay, based on an assessment of factors, in case I may be wrong in my analysis above.

74) It is necessary in this regard to note that the application by Associated for revocation against Simpson’s mark had been filed with the OHIM on 11<sup>th</sup> May 2009. That is, three days prior to the hearing before me. Prior to the hearing, Mr Krause had not advanced any reason why, when he could have challenged the validity of Simpson’s mark at any time after its registration, and applied to revoke on grounds of non-use at any time on or after 18<sup>th</sup> June 2008, he waited until 11<sup>th</sup> May 2009 to file an application for revocation. Indeed, as Ms Lazenby noted, an application for invalidity against Simpson’s mark had even been anticipated in Associated’s counterstatement (para 5), filed as early 11<sup>th</sup> October 2006.

75) At the hearing I asked Mr Krause to explain his delay. In reply, Mr Krause said that an invalidity application was not filed shortly after of the filing of the counterstatement because of “jurisdictional and evidentiary” issues, without being specific, peculiar to OHIM proceedings. As far as the lateness of the revocation action was concerned, Mr Krause said he had put Ms Lazenby on notice that an application for revocation would be filed and that he had only recently become aware of certain “practice” which may support his request. In response Ms Lazenby said notice had been given in without prejudice correspondence going back to October 2008. Based on this exchange at the hearing and the lack of explanation prior to the hearing, I cannot conclude that the delay has been properly explained by Mr Krause. In particular I am concerned that from his response at the hearing, the jurisdictional and practice aspects which he sought to use to explain his delay are, (a) not specified and, (b) may have occurred to him well after the date when he could have first applied for revocation. On that basis, even if I am wrong in my initial analysis as to the lack of effect of the revocation in this opposition I would nonetheless have no hesitation in concluding that no case for a stay is made out either.

***Conclusion on the stay request***

76) My conclusion is that the request by Mr Krause for a stay of the implementation of my decision is not made out, (a) on the basis that the revocation action would be academic in any event, or (b) that no case for a stay has in any event been made.

**Costs**

77) Simpson has been entirely successful in the opposition and in resisting the request for a stay of implementation and is thus entitled to a contribution towards his costs. Accordingly I hereby order Associated Newspapers Ltd to pay Christopher Alan Simpson the sum of £2,500. The award is made on the following basis:

Filing opposition (including official fees) - £500  
Considering counterstatement – £200  
Filing evidence – £500  
Preparing for and attending hearing – £ 1,300  
Total - £2, 500

The figure for preparing for and attending the hearing is at the higher end as notice of attendance at the hearing on the part of Mr Krause and the request for a stay were received late by the registry (the day before the hearing), necessitating further and supplemental response and argument.

78) 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 17<sup>th</sup> day of July 2009**

**Edward Smith  
For the Registrar,  
the Comptroller-General**