

O-294-09

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1212689

**IN THE NAME OF KABUSHIKI KAISHA BANDAI NAMCO GAMES (ALSO
TRADING AS NAMCO BANDAI GAMES INC)**

OF THE TRADE MARK:

**スカイキッド
SKYKID**

IN CLASSES 9 AND 28

AND THE APPLICATION FOR REVOCATION

THERE TO UNDER NO 83305

BY BRITISH SKY BROADCASTING GROUP PLC

Trade Marks Act 1994

**In the matter of registration no 1261289
in the name of Kabushiki Kaisha Bandai Namco Games (also trading as
Namco Bandai Games Inc)
of the trade mark:**

**スカイキッド
SKYKID**

**in classes 9 and 28
and the application for revocation
thereto under no 83305
by British Sky Broadcasting Group Plc**

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) Registration no 1261289 is the result of the merging of trade mark registration nos 1261288 and 1262189. It is in the ownership of Kabushiki Kaisha Bandai Namco Games (also trading as Namco Bandai Games Inc) (Namco). The trade mark is registered for the following goods:

robots for amusement purposes, coin-and counter-freed apparatus and instruments, all included in Class 9; amusement apparatus adapted for use with television receivers; pre-recorded magnetic tapes and discs, cartridges for the aforesaid tapes and discs; video games; video tapes; parts and fittings included in Class 9 for all the aforesaid goods.

toys, games (other than ordinary playing cards) and playthings.

The above goods are in classes 9 and 28 respectively of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as amended and modified.

3) The registration process in relation to the class 9 goods was completed on 11 March 1988. The registration process in relation to the class 28 goods was completed on 15 April 1988.

4) On 28 July 2008 British Sky Broadcasting Group Plc (Sky) filed an application for the revocation of the trade mark on the basis of sections 46(1)(a) and 46(1)(b) of the Act. Sky amended its statement of grounds, on the advice of the Trade Marks Registry, to seek revocation of the registration under section 46(1)(a) of the Act from 16 April 1993. As two registrations, with different dates for the completion of the registration process, were merged there are two dates in respect of section 46(1)(a) of the Act. It was agreed at the hearing that the dates from which Sky is seeking revocation Under section 46(1)(a) of the Act the class 9 goods of the registration are revoked with effect from 12 March 1993 and the class 28 goods with effect from 16 April 1993

5) In relation to section to 46(1)(b) of the Act Sky claims that the trade mark has not been used for the period from 28 July 2003 to 27 July 2008 and seeks revocation from 28 July 2008.

6) In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

“40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal:”... 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."(This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

"15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect."

7) All of the evidence that Namco furnished was filed with its counterstatement. In its counterstatement it denies the grounds for revocation. It goes on to comment on use of "the SKYKID game". It states that the registered trade mark has been used in the United Kingdom. The evidence consists of a witness statement by Ms Kerry Joanne Moroney. Ms Moroney is a trade mark attorney representing Namco in these proceedings. She refers in her statement to "the SKYKID game". SKYKID is the name of computer game. She states that the evidence furnished with her witness statement shows use of the registered trade mark within the section 46(1)(b) of the Act period. The evidence exhibited consists of pages downloaded from the Internet. SKY KID appears on the pages. The registered trade mark does not appear on any of the pages. Mr Moroney makes no statement as to the use of the trade mark as registered in her witness statement. There is no evidenced of use of the trade mark as a whole ie with the top part. At the hearing Ms Moroney accepted that there is no use of the trade mark as registered; Namco is relying upon of SKYKID, as being use which does not alter the distinctive character of the trade mark. Ms Moroney submitted that the evidence filed shows use in relation to *video games*.

8) The details of the registration advise that the part of the trade mark above SKYKID consists of Japanese characters, they transliterate as SKYKID. Ms Moroney submitted that the average consumer in the United Kingdom would see the elements above SKYKID as characters in a foreign language and that they would be "glossed over" and so there absence does not alter the distinctive character of the trade mark in the form in which it was registered. There is no reason to assume or know that the average consumer in the United Kingdom will

know that the matter appearing above the word in Roman script is Japanese. He or she might see it as being in an oriental script but again there is no reason to assume this. The upper part of the trade mark takes up more space than the element in Roman script. It strikes the eye. It is not descriptive, it is not allusive, it is not de minimis. I cannot see why this part of the trade mark should be “glossed over” by the average consumer. The use of the trade mark omits the use of the upper element. The upper part of the trade mark by the manner in which it strikes the eye, by the way that it will not be dismissed as being descriptive, is very much part of the distinctive character of the trade mark. The absence of the upper element does alter the distinctive character of the mark in the form in which it was registered. **Consequently, Namco has shown no use of the trade mark as registered.**

9) There is nothing to indicate that the trade mark has ever been used in the form in which it was registered in the United Kingdom since the dates of the completion of the registration process. Consequently, I find for Sky under section 46(1)(a) of the Act. The class 9 goods of the registration are revoked with effect from 12 March 2003 and the class 28 goods with effect from 16 April 2003.

Costs

10) Sky having been successful, is entitled to a contribution towards its costs. Ms Moroney submitted that it should be taken into account that the revocation was launched without warning. Ms Bowhill, for Sky, submitted that Namco was effectively on notice owing to an action brought before the Community trade mark office. If Namco had not defended the application the absence of notice would have a bearing upon any award of costs. It did defend the action. A defence that was first based on a claim to use on all of the goods of the registration and also on use of the trade mark as registered. I see no reason that any adjustment of costs should be made because of the absence of notice.

11) Sky having been successful is entitled to a contribution towards its costs. I award costs of the following basis:

Preparing a statement and considering the statement of Namco:	£600
Preparing for and attending the hearing:	£500

TOTAL	£1,100
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I order Kabushiki Kaisha Bandai Namco Games (also trading as Namco Bandai Games Inc) to pay British Sky Broadcasting Group Plc the sum of £1,100. 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 23rd day of September 2009

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

The hearing took place on 23 September 2009.

Ms Jessie Bowhill of counsel, instructed by Olswang, appeared for Sky.
Ms Kerry Moroney, of Mewburn Ellis, appeared for Namco.