

O-254-11

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF:

- 1) **ASSOCIATED NEWSPAPERS LIMITED OPPOSITION (NO. 96081) TO TRADE MARK APPLICATION (NO. 2356356) BY MIP METRO GROUP INTELLECTUAL PROPERTY GMBH & CO KG TO REGISTER THE TRADE MARK:**

METRO

IN CLASSES 16 AND 41

AND

- 2) **MIP METRO GROUP INTELLECTUAL PROPERTY GMBH & CO KG'S APPLICATIONS (NOS 83490 & 83491) FOR REVOCATION OF TWO TRADE MARKS REGISTRATIONS (NOS 1084267 AND 1586405) IN THE NAME OF ASSOCIATED NEWSPAPERS LIMITED FOR THE MARK:**

METRO

BACKGROUND

1) Community Trade Mark no.779116, filed on 20 March 1998, was converted to a UK national application no. 2356356 and published in the Trade Marks Journal on 2 November 2007. The proprietor is MIP Metro Intellectual Property GmbH & Co KG ("MIP"), of Metro-Straße, D-40235 Düsseldorf, Germany. The application is in respect of the following trade mark:



2) The application is in respect of the following goods and services:

Class 16

Goods made from paper; printed matter; instructional and teaching materials in form of printed matter.

Class 41

Publication of books, newspapers and periodicals.

3) On 4 February 2008, Associated Newspapers Limited ("Associated") of Northcliffe House, 2 Derry Street, Kensington, London W8 5TT filed notice of opposition to the application. The grounds of opposition are that the application offends under Section 5(1), Section 5(2)(a) and Section 5(2)(b) of the Trade Marks Act 1994 ("the Act") because the application is for a mark that is either identical or similar to two of Associated's earlier marks and is in respect of identical or similar goods. Associated's earlier marks are:

Mark details	Specification of goods
1084267 METRO Filing date: 27 September 1977	Class 16: <i>Magazines (publications), but not including magazines relating to city life or travel.</i>
1586405 METRO Filing date: 28 September 1994 Registration date: 24 January 1997	Class 16: <i>Books, magazines, printed publications and diaries; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.</i>

4) These marks are both registered and therefore qualify as earlier marks as defined by Section 6 of the Act.

5) MIP subsequently filed a counterstatement denying the opponent's claims and putting it to proof of use in respect of all goods.

6) Further, on 22 July 2009 and 2 June 2009 respectively, MIP filed applications for the revocation of Associated's earlier two marks. Mark no. 1084267 completed its registration procedure on 17 March 1993. MIP seeks complete revocation of the registration under Sections 46(1) (a) and (b) of the Act. It claims that the mark has not been put to genuine use in the United Kingdom, by the proprietor or with its consent, between 18 March 1993 and 17 March 1998 or between 28 May 2004 and 27 May 2009. Success for MIP would mean revocation taking effect on either 22 July 1987, 18 March 1998 or 28 May 2009. Mark no. 1586405 completed its registration procedure on 24 January 1997. MIP also seeks complete revocation and claims that the mark has not been put to genuine use in the UK, by the proprietor or with its consent, between 28 May 2004 and 27 May 2009. Success for MIP would mean revocation taking effect on either 25 January 2002 or 28 May 2009.

7) Associated filed counterstatements in both cases denying that the marks have not been put to genuine use during the above identified five year periods.

8) Only Associated filed evidence in these proceedings but both sides filed written submissions. Both sides ask for an award of costs. The matter came to be heard on 18 November 2010 when Associated was represented by Adrian Speck of Counsel instructed by Bird & Bird LLP and MIP was represented by Terry Rundle for Wilson Gunn.

Associated's Evidence

9) This is in the form of a witness statement, dated 25 September 2009, by Richard James Louis Mead, Finance Director and Assistant Managing Director for Metro, a division of Associated. He has internal responsibility at Associated for the day to day operations for Metro. He explains that Associated purchased its two marks from National Magazine Company Limited with effect from 2 December 1999, but had a non-exclusive licence dating back to 6 October 1998.

10) Mr Mead states that the METRO free-to-consumer newspaper was launched in March 1999. The business model is that the newspaper is distributed to readers on weekday mornings via transport networks and "high-traffic consumer zones of urban centres". Distribution costs for the METRO newspaper and other METRO branded products are illustrated in Exhibit RJLM1. This exhibit is subject to a confidentiality order and, as such, the following table showing these costs will be redacted from the publically available version of this decision:

Year	Amount (£'000)
1998/99	
1999/00	
2000/01	
2001/02	
2002/03	
2003/04	
2004/05	
2005/06	
2006/07	
2007/08	
2008/09	
TOTAL	

11) Mr Mead explains that revenue is generated through advertising and promotional partnerships with companies offering products and services to the readers. Online access to the content of the newspaper is provided at metro.co.uk and metro.mobi websites. He states that public recognition of the METRO brand in the UK is very significant because of the volume of people passing through distribution points for the newspaper at major commuter stations.

12) A number of awards have been won by the METRO newspaper and the METRO brand, such as *Media Week's* "Brand of the Year" in 2001 and *Campaign's* "Medium of the Year". A list of four awards obtained in 2000 and 2001 from metro.co.uk/advertising is provided at Exhibit RJLM3. Mr Mead also refers to other awards won in 2005, 2006 and 2007.

13) Associated's marketing budget for promoting the METRO brand has been in excess of £10 million and has sponsored major events such as the Edinburgh Fringe Festival (2002 to date) and "The Weekender" music festival.

14) The METRO newspaper is the main publication under the brand. Example covers of the newspaper are provided at Exhibit RJLM5 covering a period from 1999 to 2009. The METRO mark appears in a consistent form in the blue coloured masthead that appears at the top of the front page. The first print run was 85,000 copies but by May 2009, this had risen to 1,332,000 copies. As a result METRO is the third biggest newspaper in the UK with a readership of nearly 3.5 million. Exhibit RJLM10 is a graph produced by the National Readership Survey that illustrates the METRO newspaper as being the third biggest paper in the UK behind *The Sun* and the *Daily Mail*. At Exhibit RJLM8, Mr Mead provides a spreadsheet showing the Audit Bureau of Circulation certified distribution figures for METRO. This provides figures for each month from March 1999 to June 2009 and they range from 85,000 in the first month to a peak of 1,362,369 in November 2008 before falling back slightly to 1,335,000 in June 2009.

15) In 2005, METRO became the first free newspaper to be shortlisted for the British Press Awards National Newspaper of the Year. An article, dated 18 February 2005 that appeared on the website pressgazette.co.uk, highlighting the announcement is provided at Exhibit RJLM13.

16) A further exhibit subject to the confidentiality order is provided at Exhibit RJLM. This provides revenue generated by the METRO brand from 1999 to 2009. I do not need to detail them here, but note that they are in the many millions of pounds a year.

17) Mr Mead also details other activities conducted under the METRO brand. These are summarised below:

- The METRO Book Club was launched in October 2007, in conjunction with the online retailer *Amazon*. Each month a book is reviewed by METRO and readers can purchase it at a discount using a promotional code. To date twenty four books have been reviewed. The offers are run in the *MetroLife* section of the paper and are identified by a logo that incorporates both the METRO mark and *amazon.co.uk*.
- Associated has published METRO branded “Rough Guide” travel books between 2004 and 2008. This was a partnership venture with *Rough Guides*. These were in the format of mini-guides and were “pocket book” size. Copies of the front and back covers are provided at Exhibit RJLM20. At the top of the cover appears the METRO mark in its familiar blue rectangle and alongside are the words EXPERIENCES SERIES. At the bottom of the covers are the words “Sponsored by” followed by a *Post Office* mark. Mr Mead explains that these books were given away free to its readers with revenue generated by the books being paid for by sponsors. Exhibit RJLM22, covered by a confidentiality order, illustrates the revenue generated by these books. This shows total revenues of £[REDACTED]. 25,000 copies of the first book were handed out in 2004, 65,000 of the second book in 2005 and 100,000 copies of the third, fourth and fifth books in 2006, 2007 and 2008 respectively.
- The METRO CrushGuide was a book published in 2002. 30,000 copies were distributed of the guide to bars, clubs and pubs across the UK with a retail price of £9.95. The usual METRO mark appears prominently on the cover as illustrated in Exhibit RJLM27.
- Mr Mead provides information regarding a number of magazines:
 - Eight issues of the first of these, called *METRO.co.uk*, were published between January and April 2000 in East Anglia. This was a “home and leisure Internet directory”. Copies of two of

these magazine covers are provided at Exhibit RJLM28 showing that it was sold at a “special introductory price of 50p”. Its name is positioned across the top of the cover page with the word METRO in lower case letters approximately twice the size of the “.co.uk” element. The magazine was distributed through *John Menzies*, *Tesco*, *Sainsbury’s* and *WHSmiths* with sales in the region of 1000-1500 per issue for the first four issues. 55,000 copies of Issue 5 were distributed with the *Daily Mail* newspaper in March 2000.

- A weekly entertainment listing magazine called *MetroLife* was distributed across South East England with the *Evening Standard* newspaper between September 2002 and August 2005. At that time, the *Evening Standard* had a circulation of between 340,000 and 380,000. The name *MetroLife* appeared on the front cover with “metro” in bold white coloured type and “life” in a thinner type and coloured blue.
- A weekly magazine called *MetroPlus* was distributed between January and April 2005 at Zone 1 London underground stations. Its weekly circulation was 46,733 copies. Copies of front covers and other pages are provided at Exhibit RJLM40. The banner title has the word METRO in bold blue type and the word PLUS in a narrow blue type. METRO alone is also featured within its familiar blue background and appears at the top right of the page, alongside the date.
- Under a licence agreement, *The Times* newspaper has published a METRO magazine supplement with its Saturday edition of the paper. Copies of the front cover and other pages are provided at Exhibit RJLM44 and RJLM45 relating to dates in September 1997, March 1998 and September 1998.

MIP’s Evidence

18) No evidence has been filed by MIP, but written submissions were provided on 6 April 2010. I will not detail these here, but I will bear them in mind. Some of these submissions prompted Associated to file further evidence that is detailed below.

Associated’s Evidence in reply to MIP’s submissions

19) This takes the form of a further witness statement by Mr Mead, dated 29 June 2010. In response to MIP’s submission that METRO’s role in the Rough Guides publications was merely as a sponsor, Mr Mead provides further information. He reiterates that it was a joint venture between Associated and Rough Guides. To support this he provides, at Exhibit RJLM49, a PowerPoint presentation made by Associated to Nissan in April 2006. He contends that it is clear from this that Associated’s role was to solicit sponsorship from Nissan for

the METRO Rough Guide. He also reiterates that METRO's feature writers were heavily involved in writing content for each of the jointly-branded publications and this can be seen from the credits pages of the METRO Rough Guides shown at Exhibit RJLM20 to his first witness statement. He lists the names of fifteen METRO employees or freelancers retained by METRO that are listed in these credits as well as some other METRO staff.

DECISION

Proof of use

20) Section 46 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.”

21) In addition, the Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“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 of a kind falling within section 6(1)(a), (b) or (ba) 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) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) 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, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services...”

22) Consideration has to be taken, also, of section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

23) The applications for revocation are based on both Sections 46(1)(a) and 46(1)(b). In *Philosophy di Alberta Ferretti Trade Mark* [2003] RPC 15, the Court of Appeal held that an application for revocation on the grounds of non-use may be made only after the five years following completion of the registration procedure has ended. The date for revocation cannot be less than five years from the date the registration procedure was completed. In *WIS/ Trade Mark* [2006] RPC 22, Geoffrey Hobbs QC, sitting as the Appointed Person said:

“...This permits revocation with effect from the day following the fifth anniversary of completion of the registration procedure in the case of an application which succeeds under s.46(1)(a) and with effect from any subsequent date at which there has been suspension of use for an uninterrupted period of five years in the case of an application which succeeds under s.46(1)(b).”

24) I intend to consider the issue of genuine use, both in the context of the opposition proceeding and in the context of the two applications for revocation, as a single issue. In doing so, I am mindful that there are several distinct but overlapping relevant five year periods, namely:

Earlier Registration	Relevant 5 Year Periods
1084267	<u>Section 46(1)(a)</u> 21 July 1982 to 21 July 1987 <u>Section 46(1)(b)</u> 18 March 1993 to 17 March 1998 Or 28 May 2004 to 27 May 2009 <u>Proof of Use</u> 3 November 2002 to 2 November 2007
1586405	<u>Section 46(1)(a)</u> 25 January 1997 to 24 January 2002 <u>Section 46(1)(b)</u> 28 May 2004 to 27 May 2009 <u>Proof of Use</u> 3 November 2002 to 2 November 2007

25) The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised

by Anna Carboni, sitting as the Appointed Person in O-371-09 SANT
AMBROEUS:

42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

26) Taking account of this guidance from the courts it is clear that genuine use does not need to be quantitatively significant and that, when asking if the use is genuine, it is necessary to assess all surrounding circumstances.

27) It has been conceded by MIP that Associated has demonstrated genuine use in respect of *newspapers*. By extension, it also accepts that goods do not need to be paid for in order for such use to qualify to illustrate that a mark is used in a way that is consistent with its essential function (see the comments of the CJEU in *NASDAQ C-320/07 P*, paragraph 29) them to qualify as use of the mark. Further, Associated conceded at the hearing that it has not demonstrated use in respect of *diaries*. The goods that remain contested, and the reasons why, are:

- *Books*: Here the issue is whether use has been shown on such goods through METRO's business conducted through its book club, its link-up with *Rough Guide* and through its publication of a book entitled *METRO CrushGuide*;
- *Magazines*: Here the issue is whether or not the marks used in respect of these goods are considered as acceptable variant forms of the marks as registered;
- *Printed publications*: Mr Rundle, for MIP argued at the hearing that even if use has been demonstrated in respect of *magazines* and *books* as well as *newspapers*, this is insufficient to allow Associated to retain such a broad term as *printed publications*.

Use in respect of books

28) Associated relies upon its activities undertaken under the mark *METRO Book Club*, books published in collaboration with *Rough Guide* and also a book entitled *METRO CrushGuide*. In respect to the first, the evidence illustrates a retail activity delivered in association with the online retailer *Amazon*. Books were reviewed in the *MetroLife* section of Associated's newspaper with readers able to purchase that book at a discount. There is nothing in the evidence to suggest that the product being provided to the consumer was anything other than the

service of retailing the reviewed books at a discount. As such, it does not support use in respect of the books themselves.

29) The same criticism cannot be applied to the other two uses illustrated. It is clear that the books produced in conjunction with *Rough Guide* were co-branded with both the METRO mark and the *Rough Guide* mark appearing prominently on the cover of the books. Evidence is provided that this partnership venture existed between 2004 and 2008 and that after the first of these years, 100,000 copies were produced. I accept this use as clearly demonstrating that the METRO mark was used in respect of these books. The evidence clearly demonstrates that Associated's involvement was not as a sponsor, as contended by MIP. Joint billing of the METRO and *Rough Guide* marks and evidence of Associated's involvement in the editing and authoring of the book support this as does the name of the book's sponsor being clearly marked elsewhere on the front cover.

30) Finally, there is also use demonstrated from 2002 when 30,000 copies of the *METRO CrushGuide* were produced. This further supports use in respect of books.

31) Taking account of the relevant dates set out in the table at paragraph 23, it is clear that such use corresponds to the latter relevant period for both earlier marks, for purposes of Section 46(1)(b). Having consideration for Section 46(3) of the Act, the dates in which the above use has been demonstrated are sufficient to overcome the revocation attack. Further, the use shown is also sufficient to overcome the proof of use requirement in the opposition case.

Use in respect of magazines

32) The issue in respect of these goods is whether, or not, the use of various magazine titles, all incorporating the word METRO qualify as acceptable variant uses of the mark as registered.

33) It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc (BUD)* [2003] RPC 25. This court of appeal decision provides me with some guidance on how to approach this issue:

“.....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?”

34) More recently, the same issue has been considered by both the General Court (GC) and the CJEU. These cases have been reviewed by Richard Arnold

QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

“33. The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

35) At the hearing Mr Rundle came close to conceding that the use shown in respect of *magazines* qualified as acceptable variant uses when, in response to my question on the issue, he responded by saying “...you’ll have to look at it. I suppose from a personal view ... my money would be on my friend rather than myself, if I was to, in trying to hold the mark, Metro, was not being used as Metro, because it quite clearly is there.” This appears to me to be a pragmatic and sensible position to take. The uses shown are variously *METRO.co.uk*, *MetroLife*, *MetroPlus* as well as *METRO* alone. When applying the guidance provided in *NIRVANA* and *REMUS* it is clear to me that in *METRO.co.uk*, the distinctive character resides in the word METRO, the difference being the addition of the non-distinctive “.co.uk”. This does not alter the distinctive character of the mark METRO.

36) In respect of the magazine titles *MetroLife* and *MetroPlus*, the considerations are slightly different in that both these marks also contain recognizable dictionary words. In the first of these marks, in particular, the addition of the second word creates a mark where the distinctive character resides in the mark, as a whole, as it may be seen as an allusion to life in a metro(politain) environment or life on an underground railway system in a city¹. Such an allusion is different to that created by the mark METRO alone and, therefore, I conclude that the distinctive character of Associated’s earlier mark is altered and use of *MetroLife* does not constitute genuine use of the earlier mark.

37) In respect to the mark *MetroPlus*, here the addition of the word “Plus” does not have the same impact. The PLUS element, whilst it appears alongside the

¹ "metro". Oxford Dictionaries. April 2010. Oxford Dictionaries. April 2010. Oxford University Press. 7 July 2011 <<http://oxforddictionaries.com/definition/metro?view=uk>>.

METRO element, it is a thinner, less visually striking text. Further, it merely alludes to something additional to the concept of METRO, regardless of what that may be. As such it does not alter the distinctive character of the earlier mark. I, therefore, conclude that it qualifies as genuine use of Associated's earlier mark. Even if I am wrong and that use of *MetroPlus* does not qualify as an acceptable variant use, I note that the exhibit provided to illustrate use of the mark *Metroplus* shows use of METRO alone within its familiar blue background appearing at the top right of the page alongside the date. This supports the contention that METRO has been used in respect of magazines.

38) Of course, there is also licensed use by the *Times* newspaper of one magazine title called METRO without any embellishment and, as such, clearly demonstrates use of the marks, as registered, in respect of *magazines*.

39) Taking all of the above into account, use has been demonstrated through the magazines METRO.co.uk, MetroPlus and METRO. These publications were available between January and April 2000, January and April 2005 and September 1997 to September 1998 respectively. Such use covers all the Section 46(1)(b) periods and also the Section 46(1)(a) period in respect of earlier mark 1586405 and summarized in the table at paragraph 23 above. Having consideration for Section 46(3) of the Act, the dates in which the above use has been demonstrated is sufficient to overcome both the revocation attack and also overcomes the proof of use issue in the opposition case.

Fair specification

40) Having established that Associated have demonstrated genuine use in respect of *newspapers*, *magazines* and *books*, I must consider whether such use justifies it retaining the broad term *printed publications* as listed in its earlier registration 1586405. In doing so, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"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."

41) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

"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 pernicky 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."

42) I am also mindful of the guidance provided by the GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

"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 subcategories 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 subcategory 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."

43) Finally, I also take account of the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

"... I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved

by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

44) Taking all of the above into account, it is likely that the “average, reasonably informed consumer” would, when asked to collectively describe *newspapers*, *magazines* and *books*, say that they are *printed publications*. Whilst, the goods in respect of which use has been shown, do not constitute all the goods that may be covered by this term, they all belong to the group described as “printed publications” and that this term “cannot be divided other than in an arbitrary manner”. As such, I find that it is appropriate for Associated to retain the term *printed publications* in the specification of goods of earlier mark 1586405 because of the use demonstrated in respect of *newspapers*, *magazines* and *books*.

45) Taking all of this into account, Associated is entitled to retain the whole of its specification in respect of its earlier mark 1084267 and all except *diaries* in respect of its earlier mark 1586405. Therefore, MIP’s revocation action against Associated’s earlier mark 1084267 fails and its revocation action against Associated’s earlier mark 1586405 is successful, but only in respect of *diaries*.

46) In respect of Associated’s opposition against MIP’s application, it is entitled to rely upon all the goods listed in the specifications of its earlier marks, with the exception of *diaries* listed in the specification of earlier mark 1586405.

Section 5(1), Section 5(2)(a) and Section 5(2)(b)

47) These sections of the Act read as follows:

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

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

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

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

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

48) Associated claims that the respective marks are identical, however, MIP’s mark consists of the word METRO in a block lettering with the letters having a black outline and in-filled with the coloured yellow. Such visual enhancement of the word is absent in Associated’s marks. As such, I conclude that the respective marks are not identical. It follows that the grounds based upon Section 5(1) and Section 5(2)(a) of the Act must fail. I will, therefore, move on to consider the opposition based solely upon the Section 5(2)(b) grounds.

49) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU 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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) 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*,

(f) 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*,

(g) in determining whether similarity between the goods or services covered by two 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*,

(h) 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*,

(i) 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*,

(j) 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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

50) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

‘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 intended purpose and their method of use and whether they are in competition with each other or are complementary.’

51) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

52) I also bear in mind the comments of the GC in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“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).”

53) For ease of reference, the respective goods and services are reproduced below:

Associated’s goods	MIP’s goods and services
<p>Class 16 of earlier mark 1084267: <i>Magazines (publications), but not including magazines relating to city life or travel.</i></p> <p>Class 16 of earlier mark 1586405: <i>Books, magazines, printed publications and diaries; all included in Class 16; but not including timetables and not including any such goods relating to railway systems; or printed publications for use in operating, servicing, and/or repairing motor vehicles, vehicle handbooks, and vehicle parts catalogues.</i></p>	<p>Class 16: <i>Goods made from paper; printed matter; instructional and teaching materials in form of printed matter.</i></p> <p>Class 41: <i>Publication of books, newspapers and periodicals.</i></p>

54) Beginning with MIP’s Class 16 goods and with the above guidance in mind, it is self evident that MIP’s *goods made from paper and printed matter* may both

include *magazines, books and printed publications* (such as *newspapers*) and as such are identical to these terms in Associated's specifications.

55) MIP's *instructional and teaching materials in the form of printed matter* can all be *printed publications* and it follows that these too must be considered as identical goods.

56) Therefore, all of MIP's Class 16 goods are identical to Associated's goods.

57) In respect of MIP's Class 41 services, namely *publication of books, newspapers and periodicals*, this is the service of producing Associated's goods. They, therefore, share at least some of the same trade channels. Further, without the publication services there would be no end product. MIP's services are essential to the existence of the goods covered by Associated's specifications and, therefore, they are complementary in the sense described by the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06. Therefore, whilst their nature and intended purpose may be different, the respective goods and services share a reasonably high level of similarity.


The average consumer

58) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods and services at issue. I have found that all of the respective goods are identical and it follows that the respective average consumers of such goods will also be the same. *Printed matter* and *printed publications* both cover a very wide range of printed goods and as such, there can be an equally wide range of average consumer. At one end of the spectrum, where the goods may be given away free, as in the case of Associated's newspaper, the consumer will be the general public and the purchasing act is not highly considered and is often undertaken given very little regard to the act. At the other end of the spectrum, the terms include, for example, specialist academic publications that will appeal to a small, specialist group of consumers who are likely to take particular care in purchasing such goods. Of course, I also recognise that these are examples of the extremes of the spectrum and that there is a range of consideration and average consumer in respect of other printed goods covered by these terms.

59) In respect of MIP's Class 41 services, publication services will generally be supplied to individuals and companies seeking to have text or other matter prepared for publication and produced so that they are in condition and form ready for sale. As such, the average consumer, whilst there will be considerable overlap with the goods discussed above, will generally be more circumspect and the purchasing process will involve a reasonably high level of consideration.

Comparison of marks

60) For ease of reference, the respective marks are:

Associated's earlier mark	MIP's mark
METRO	

61) When assessing the extent of similarity between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Whilst MIP denies that the marks are identical, it accepts that they are very similar. I concur with this. They are aurally and conceptually identical. Visually, MIP's mark has some visual differences from the same word in an ordinary typeface that forms Associated's marks. These differences are the stylisation and colour used, absent in Associated's marks. Nevertheless, I conclude that the respective marks share a very high level of similarity.

Distinctive character of the earlier trade mark

62) Associated's marks consist of a single, well-known dictionary word and as such it is not endowed with the highest level of inherent distinctive character. Nevertheless, taking account of the exclusions that apply to both lists of goods, the word has no direct meaning for the remaining goods. The marks therefore possess a moderately high level of inherent distinctive character.

63) I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen concluded at paragraph 17 of his decision:

"The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an

element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

64) It is clear from Associated’s evidence that its METRO newspaper, being the third biggest paper in the UK, also benefits from an enhanced level of distinctive character resulting from its use. However, the same cannot be said for Associated’s *books* and *magazines*. Such goods have not been traded in consistently over time or to a degree that the consumer has been educated to associate METRO with such goods. With this in mind, I conclude that the moderately high level of inherent distinctive character is further enhanced through use in respect of *newspapers* only.

Likelihood of confusion

65) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I have found that the respective marks are highly similar, that all the respective goods are identical and that MIP’s services share a reasonably high level of similarity with Associated’s goods. I should say that the exclusions listed at the end of the specifications of both of Associated’s earlier marks have no impact upon my analysis of likelihood of confusion.

66) I have also found there are a range of purchasers and that there is also a range of consideration involved in the purchasing act of the respective goods. In respect of MIP’s services, I found that there is considerable overlap with the average consumer of the goods, but that the purchasing act will generally involve a more circumspect approach with a reasonably high level of consideration. Finally, I have also found that Associated’s mark enjoys a moderately high level of inherent distinctive character and that, in respect of *newspapers*, this is further enhanced through use.

67) Taking all of this into account, I find that there is a very strong likelihood that the average consumer will believe that the goods and services provided under the respective marks originate from the same, or linked, undertaking. The average consumer will fall foul of direct confusion where he/she will think that MIP’s mark is Associated’s mark.

68) In light of the above finding, Associated’s opposition to MIP’s application is successful in respect of all of MIP’s goods and services.

SUMMARY

69) My findings are as follows:

- MIP's revocation action against Associated's earlier mark 1084267 fails;
- MIP's revocation action against Associated's earlier mark 1586405 is successful, but only in respect of *diaries*;
- In respect of its opposition action, Associated is entitled to rely upon all the goods listed in the specifications of its earlier marks, with the exception of *diaries* listed in the specification of earlier mark 1586405;
- Associated's opposition to MIP's application has been successful in respect of all of MIP's goods and services.

COSTS

70) With MIP's revocation actions being substantially unsuccessful and with Associated's opposition having been successful, Associated is entitled to a contribution towards its costs. I take account of the fact that a hearing has taken place but that both sides files evidence in these consolidated proceedings. I award costs on the following basis:

Preparing statement and considering other side's statement	£900
Preparing evidence and considering other side's evidence	£1000
Preparing for, and attending hearing	£900
TOTAL	£2800

71) I order MIP Metro Intellectual Property GmbH & Co KG to pay Associated Newspapers Limited the sum of £2800. 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 21st day of July 2011

**Mark Bryant
For the Registrar,
the Comptroller-General**