

O/356/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No.83760
BY PRNNET
FOR REVOCATION OF TRADE MARK No. 2223630
STANDING IN THE NAME OF
PALMERWHEELER LIMITED**

BACKGROUND

1) The following trade mark is registered in the name of Palmerwheeler Limited (hereinafter PL).

Mark	Number	Registered Date	Class	Specification
MEDIAGILITY	2223630	30.11.2001	9	Electrical and electronic apparatus, equipment and instruments; namely hand held computers, electronic organisers and electronic diaries; apparatus for recording, transmission or reproduction of data, images and sound; magnetic data carriers and recording discs; data processing equipment; computer hardware; computer software; blank and pre-recorded audio and video discs and cassettes, CD-ROM's, optical discs and compact discs; computer software (downloadable) supplied from the Internet; computer software and publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); on-line games and electronic publications (downloadable) supplied from the Internet; computer software and telecommunications apparatus (including modems) to enable connection to databases and the Internet; computer software to enable searching of data; computer software for use in providing financial services and carrying out financial transactions; magnetic and encoded charge cards, credit cards and debit cards; encoded cards; smart cards; holograms for use in securing electronic media; parts and fittings for all the aforesaid goods.
			16	Paper, cardboard and goods made from these materials, not included in other classes; printed matter; publications; books, journals, magazines, manuals, newspapers, handbooks, trade and technical publications; photographs; stationery; instructional and teaching materials (except apparatus); plastic materials for packaging (not included in other classes); printers type; printing blocks; charge cards, credit cards and debit cards, all other than encoded or magnetic; advertising and publicity materials; calendars; catalogues; diagrams; diaries; printed forms; graphic prints; representations and reproductions; writing pads and paper.
			35	Business services; advertising and promotion services and information services relating thereto; accounting, auditing and book-keeping services; business information services provided on-line from a computer database or the Internet; providing specialist business frameworks of rented integrated software; compilation of advertisements for use as web pages on the Internet; advertising technology services relating to business; on-line advertising distribution services relating to business; dissemination of advertising matter; business information, enquiries and investigations; business management and organisation consultancy; business research; commercial business information agencies; compilation and systemisation of business business information into computer databases; cost price analysis; demonstration of goods in relation to business, advertising and promotion services; direct mail advertising; distribution of samples; document reproduction; organisation of exhibitions for commercial or advertising purposes; business services utilising computerised file management; economic forecasting;

				market research and studies; opinion polling; word processing; public relations; publication of publicity materials and texts; radio advertising; sales promotion for others; television advertising and commercials; compiling and providing access to statistical information; advice and consultancy services relating to all the aforesaid services.
			36	Financial and insurance services; financial and insurance information services; information services relating to finance and insurance, provided on-line from a computer database or the Internet; credit and debit card services; issuance of credit and debit cards; issuing of tokens of value in relation to financial and insurance services; financing services; credit control services; financial sponsorship; fund raising; charitable fund raising; trusteeship; advice and consultancy services relating to all the aforesaid services.
			38	Telecommunications; telecommunication and on-line services providing access to software, commercial information, product information, financial information and financial services and transactions; telecommunication of information (including web pages), computer programmes and any other data or images; providing user access to the Internet (service providers) and the World Wide Web; providing telecommunications access and links to computer databases and the Internet; broadcasting services; on-line broadcasting services; telecommunication access services; multiple distribution channel platforms for media and mixed media applications; electronic mail services; telecommunication services relating to E-commerce; multi-media services provided on line; facsimile, telex, telephone and telegram services; mobile telephone services; reception, recordal, networking and transmission of data and information by means of electronics, computer, cable, optical fibre, radio, radio paging, teleprinter, teletype, electronic mail, television, facsimile, microwave, laserbeam, infra red or communication satellite; message sending services; reception, recordal, transmission, networking, storage and display of information from a databank; communication services; communication by computer; on-line communication services; electronic stream scheduling; advice and consultancy services relating to all the aforesaid services.
			41	Education and entertainment services; in-flight entertainment services; information relating to entertainment or education, provided on-line from a computer database or the Internet; providing cinema facilities, including multi-screen cinema complexes; electronic games and entertainment services provided by means of the Internet and the World Wide Web; providing on-line electronic publications (not downloaded) by means of the Internet; publication of electronic books and journals on-line; multi-media services relating to capturing, organising, and providing access to data and images through multi-media applications and channels; arranging and conducting of conferences, congresses, seminars, symposiums and workshops; publication of books and texts (other than publicity texts); publishing services; education information service; teaching and tuition services; rental services; advice and consultancy services relating to all the aforesaid services.
			42	Computer programming; design, development, maintenance and updating of computer software; computer systems analysis; leasing access time to a

			computer database; computer hardware and software rental; rental of integrated software; on-line rental of packaged software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining websites; hosting the websites of others; design services; editing of written texts; licensing of intellectual property; legal research; legal services; research and development for others; photography; printing; technical project studies; quality control relating to computer systems and software; video taping; vocational guidance; security consultancy and services; rental of security apparatus; monitoring of security systems; computer hardware, software and related on-line security services; information (only information in class 42) provided on-line from a computer database or from the Internet relating to all the above services; advice and consultancy services in relation to all the aforesaid services.
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2) By an application dated 30 April 2010 PRNnet (hereinafter PRN) applied for the revocation of the registration under the provisions of Section 46(1)(a) & 46(1)(b) claiming there has been no use of the trade marks on the goods and services for which they are registered in the five year period post registration or in the period 30 April 2005 – 29 April 2010. Revocation dates of 1 December 2006 under Section 46 (1) (a) & 30 April 2010 under Section 46 (1) (b) were sought.

3) On 12 July 2010 PL filed a counterstatement denying PRN's claims stating that the marks had been used or that there were proper reasons for non-use.

4) Only PL filed evidence. The matter came to be heard on 21 March 2012 when PL was represented by Mr Gruselle of Messrs Berwin Leighton Paisner LLP; and PRN was represented by Ms Bowhill of Counsel instructed by Messrs White & Case LLP.

PL'S EVIDENCE

5) PL filed four witness statements. The first three, dated 20 July 2011, 14 September 2011 and 23 September 2011 are by Dean Wheeler a Director of PL, a position he has held since the company's incorporation in 2000. He states:

—3Palmerwheeler Limited is a computer systems and development company, which provides unique web-spaces for projects or events for a number of well established international professionals, in particular in the media and entertainment industry under the MEDIAGILITY brand. Palmerwheeler Limited has been using the Mark continuously in the United Kingdom in relation to software, design, programming, on-line services and related goods and services including a range of entertainment, communication and education services.”

6) Mr Wheeler confirms that Mediagility Limited is a wholly owned subsidiary of PL. I shall therefore refer to Mediagility Limited also as PL as their evidence is effectively that of the registered proprietor, and this point was not contested at the hearing by PRN. It should be noted that all correspondence including

invoices which emanate from Mediagility Ltd have a UK address upon them. Mr Wheeler provides the following range of exhibits, all of which were very badly photocopied, some more so than others. Many of these exhibits cover a number of pages, yet nothing is highlighted as being significant.

- AS2: A letter, with the date redacted, from Mediagility to Promax&BDA (based in London) regarding the provision of a bespoke online awards management service for the 2002 Promax&BDA Europe awards. The letter makes reference to the software being delivered during the period 10 December 2001- 9 February 2002. The software includes structure, nominations, judging proposal and entry, materials receipt, judging and reporting.
- AS3: A website advertising the Promax&BDA competition where entry is open until 11 January 2002, although the awards ceremony is shown as being 8 April 2002. It states that MEDIAGILITY creates tools and services for entertainment and media professionals to use to edit tapes, create shot lists, manage staff and prepare budgets.
- AS4: A letter, with the date redacted, headed Mediagility to Brave Dog regarding a US agency, with an attached contract. The letter mentions software subscription revenues. The contract is dated 13 November 2003.
- AS5: A letter, with the date redacted, headed Mediagility to PROMAX&BDA regarding the functionality and costing of the software and service being provided. It also refers to the subscription software agreement between the parties, and mentions payment for these relating to the months February and March 2003.
- AS6: A letter, with the date redacted, headed Mediagility to the Academy of Television Arts and Science in Los Angeles. The letter talks about the Academy potentially using PL's software in relation to its awards competitions. The letter mentions that "The Mediagility solution is more than good technology. It has that of course, but it is more than just a software package." It goes on to mention how the software assists with "entry process", "automate much of the back office processing", They mention that they discussed issues with all parties involved such as members of the Academy, nominees, judges etc and that the product supplied offers a solution to a broad range of issues faced by anyone managing an awards ceremony. The letter ends "However, much work needs to be done to prepare an awards management service for ATAS. With that in mind, we believe we need to start working with you and your organisation from 1 April 2004, in order to give us the full 21 day run-up to the software live date we believe is necessary."
- AS7: A letter, with the date redacted, headed Mediagility to Bruce Dunlop Associates in London regarding use of the MEDIAGILITY

subscription services". It also states —prices to be held at June 2004 levels to June 30, 2005".

- AS8: Copies of pages from PL's website. These are said to date from 2004, however the documents filed are very poor photocopies and no date is discernible. From what little can be read it would appear to relate to software where goods and services can be shared amongst a digital neighbourhood. It mentions that they create —unique web spaces for proposals or events", there are contact details for the UK and USA.
- AS9: A copy of a proposal to supply —~~DIAGILITY~~DIAGILITY Awards Management Services" to the International Academy of Television Arts and Sciences in New York. This would seem to relate to the provision of software which allows on-line entry, information gathering, media logistics, digital media handling and online and offline balloting. It imports and exports data. It would appear to be dated January 2006 although the date is not particularly clear.
- AS10: A copy of a front sheet only, of a proposal regarding the management of the Golden Trailer Awards. The date has been partially redacted, but it appears to be August 2006. The proposal is from the registered proprietor to Golden Trailer Awards, New York.
- AS11: An invoice dated 31 March 2006 with the word —~~mediagility.com~~mediagility.com" at the top addressed to Baboesh in London relating to the provision of —~~hosts~~hosts" provided in March and April (presumably also in 2006) at a cost of £99 per month.
- AS12: A copy of an invoice, dated 22 April 2008, with the word —~~mediagility.com~~mediagility.com" at the top addressed to Golden Trailer Awards in New York relating to —~~software services~~software services" and —~~premium support~~premium support", also —~~entry processing fees~~entry processing fees", —~~public judge roles~~public judge roles" and —~~VA judge roles~~VA judge roles". The total was for £3,370.
- AS13: A copy of an invoice, dated 30 April 2009, with the word —~~mediagility.com~~mediagility.com" at the top addressed to Golden Trailer Awards in New York relating to —~~software subscription~~software subscription" "two hours of admin" and —~~support~~support". The total was for £1,160.
- AS14: A copy of an invoice, dated 25 April 2010, with the word —~~Mediagility~~Mediagility" at the top addressed to Trailer Central LLC in New York relating to —~~Entry processing~~Entry processing" and —~~Mediagility Application Hosting-North America~~Mediagility Application Hosting-North America". The total was £US\$10,105.
- AS15: An undated document said to be the specification document for —~~awards software~~awards software" prepared in January 2008. It refers to the Mobile User Experience Awards. It appears to be similar to the Golden Trailers Award software. This was sent to a London address.

- AS16: This is an unaddressed proposal for the —Blaesh project” dated 16 July 2008. It bears the name of Mediagility Ltd. Its purpose is to create a web application.
- DW1: A copy of a proposal dated 19 May 2004 to Bruce Dunlop & Associates (London). The document is headed —Mediagility” and appears to be the provision of software and also software subscription on a monthly basis. The software would appear to relate to the storage of media items in a variety of formats, their retrieval, the provision of information of when and by whom the information was accessed and costs of the provision of the information in various denominations to aid billing.
- DW2: A copy of a screenshot from PL’s computer system showing outstanding jobs. This would appear to be an internal document. It is headed as an email dated 1 September 2011 but refers to projects which require attention dated March 2006 under the —mediagilityonline” brand. I do not believe this exhibit has any merit.
- DW3: An internal confidential note of a meeting with PROMAX&BDA, dated 2 December 2002. This appears to all relate to online software. It is headed Mediagility.
- DW4: An internal document regarding Mediagility potential sales, dated 17 September 2002. One note referring to PROMAX&BDA states: —Gent’s lawyer trying to turn it into a bespoke development contract, we are keeping it a subscription and services agreement”.
- DW5: A copy of an agreement between Mediagility and Promax&BDA which relates to the proprietor supplying software. The agreement is dated 25 March 2002.
- DW6: This is a copy of a letter to Sirius Retail Television Ltd, dated 16 September 2002. This states that the scope of the project is:
 - Sirius is engaging Mediagility to identify and document the requirements necessary to replace the existing Sirius Revenue Analysis and Reporting excel spreadsheet solution, with an automated data capture mechanism feeding a secure, dynamic and flexible web-delivered reporting environment (the —Assignment”).
- DW7-32: Copies of invoices. All have the word —Mediagility” at the top, dated 20 August 2001 – March 2003. They refer to the provision of —facilities”, —network access charges”, —line rental”, —internet line installation”, —internet access bandwidth”, “software subscription”. All of the invoices, with one exception are addressed to —PROMAX&BDA” in London. The exception, DW20, is dated 7 October 2002, addressed to Sirius Retail Television in London and relates to —consultancy”.

- DW33: A document which is said to be a specification sheet, but seems to relate to software. The three pages are headed as being prepared for Mr Pawlowski (based in London) on 7 January 2008 regarding the 2008 Mobile User Experience Conference. It is headed —“Mediagility Awards”. This would appear to relate to much the same type of software as that provided under the Golden Trailer Awards, where entry, judging, balloting and results are all carried out on-line.
- DW34: This appears to relate to the second phase of the Babolesh project and again refers to the provision of software. It is dated 16 July 2008 and is headed Mediagility Ltd.
- DW35: This is a copy of an exchange of emails, dated April 2007, with an individual in the UK who obviously had problems in entering the Golden Trailer Awards, and sought advice from the registered proprietor. The email address shows —“mediagility.com”.
- DW36: Copies of emails dated 14 & 15 June 2007 between PL and a supplier regarding invoices sent by the supplier but not received by PL. One from Mr Wheeler of PL to Creative Tank regards —“GA streaming”. It states that PL does not have an invoice from Creative Tank for May —“when the bulk of the streaming happened”. The email address used is —“mediagility.com”. I do not believe this exhibit has any merit.
- DW37: An email, dated 8 April 2009, sent by PL seeking an address from a client in order to invoice them. Again the address used is —“mediagility.com”. I do not believe this exhibit has any merit.
- DW38: An exchange of emails between the Golden Trailer Awards team and an entrant for the awards. These are dated 20 April 2009 and have been copied to PL.
- DW39-49: Copies of invoices, dated 31 March 2008-31 December 2008, totalling £2326.50 relating to the provision of “fast hosts”, and also one dated 30 June 2008 which refers to travel costs, a forum licence and use of a font. All addressed to Babolesh, London, and headed Mediagility.
- DW50: A project requirements report dated October 2002 for Sirius Retail Television. It is headed Mediagility Professional Services. This analyses the processes of Sirius and proposes solutions to the problems outlined in the report, centred around, data capture and data analysis. Effectively its sets out a case for the proprietor to supply a raft of software to improve security and efficiency.

7) The fourth witness statement, dated 26 September 2011, is by Troy Wear the Managing Director of Babolesh, a limited company set up on 15 December 2006 in the UK. Mr Wear has held his position since the inception of the company. He states that his company creates online digital villages that people live in and trade within. He states that his company engaged the

services of PL in September 2007 to design and create a prototype of a web based computer application to manage the transactions between people within their digital villages.

8) That concludes my review of the evidence. I now turn to the decision.

DECISION

9) Prior to the hearing PL filed a revised specification, and following the hearing it further reduced its specification. These revisions to the specification significantly reduce the specification as set out below:

Specification sought to be retained	Specification given up
In class 9: computer software; computer software (downloadable) supplied from the Internet; computer software supplied on-line from databases or from facilities provided on the Internet (including web sites); computer software to enable connection to databases and the Internet; computer software to enable searching of data; computer software for use in providing financial services and carrying out financial transactions.	In Class 9: Electrical and electronic apparatus, equipment and instruments; namely hand held computers, electronic organisers and electronic diaries; apparatus for recording, transmission or reproduction of data, images and sound; magnetic data carriers and recording discs; data processing equipment; computer hardware; blank and pre-recorded audio and video discs and cassettes, CD-ROM's, optical discs and compact discs; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); on-line games; telecommunications apparatus (including modems); magnetic and encoded charge cards, credit cards and debit cards; encoded cards; smart cards; holograms for use in securing electronic media; parts and fittings for all the aforesaid goods.
In Class 16: NOTHING	In Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; publications; books, journals, magazines, manuals, newspapers, handbooks, trade and technical publications; photographs; stationery; instructional and teaching materials (except apparatus); plastic materials for packaging (not included in other classes); printers type; printing blocks; charge cards, credit cards and debit cards, all other than encoded or magnetic; advertising and publicity materials; calendars; catalogues; diagrams; diaries; printed forms; graphic prints; representations and reproductions; writing pads and paper.
In Class 35: Business services; advertising and promotion services and information services relating thereto; business information services provided on-line from a computer	In Class 35: Accounting, auditing and book-keeping services; compilation of advertisements for use as web pages on the Internet; advertising technology services relating to business; on-line advertising

<p>database or the Internet; providing specialist business frameworks of rented integrated software; business information, enquiries and investigations; business research; compilation and systemisation of business information into computer databases; business services utilising computerised file management; compiling and providing access to statistical information.</p>	<p>distribution services relating to business; dissemination of advertising matter; business management and organisation consultancy; commercial business information agencies; cost price analysis; demonstration of goods in relation to business, advertising and promotion services; direct mail advertising; distribution of samples; document reproduction; organisation of exhibitions for commercial or advertising purposes; economic forecasting; market research and studies; opinion polling; word processing; public relations; publication of publicity materials and texts; radio advertising; sales promotion for others; television advertising and commercials; advice and consultancy services relating to all the aforesaid services.</p>
<p>In Class 36: NOTHING</p>	<p>In Class 36: Financial and insurance services; financial and insurance information services; information services relating to finance and insurance, provided on-line from a computer database or the Internet; credit and debit card services; issuance of credit and debit cards; issuing of tokens of value in relation to financial and insurance services; financing services; credit control services; financial sponsorship; fund raising; charitable fund raising; trusteeship; advice and consultancy services relating to all the aforesaid services.</p>
<p>In Class 38: Telecommunications; telecommunication and on-line services providing access to software, commercial information, product information, financial information and financial services and transactions; telecommunication of information (including web pages), computer programmes and any other data or images; providing user access to the Internet (service providers) and the World Wide Web; providing telecommunications access and links to computer databases and the Internet; multiple distribution channel platforms for media and mixed media applications; electronic mail services; telecommunication services relating to E-commerce; multi-media services provided on line; networking and transmission of data and information by means of electronics, computer, cable, optical fibre, electronic mail, television; message sending services; reception, recordal, transmission,</p>	<p>In Class 38: Broadcasting services; on-line broadcasting services; telecommunication access services; facsimile, telex, telephone and telegram services; mobile telephone services; reception, recordal, networking and transmission of data and information by means of radio, radio paging, teleprinter, teleletter, facsimile, microwave, laserbeam, infra red or communication satellite; advice and consultancy services relating to all the aforesaid services.</p>

<p>networking, storage and display of information from a databank; communication services; communication by computer; on-line communication services; electronic stream scheduling;</p>	
<p>In Class 41: Multi-media services relating to capturing, organising, and providing access to data and images through multi-media applications and channels; arranging and conducting of workshops; education information service; teaching and tuition services;</p>	<p>In Class 41: Education and entertainment services; in-flight entertainment services; information relating to entertainment or education, provided on-line from a computer database or the Internet; providing cinema facilities, including multi-screen cinema complexes; electronic games and entertainment services provided by means of the Internet and the World Wide Web; Providing on-line electronic publications (not downloaded) by means of the Internet; publication of electronic books and journals on-line; arranging and conducting of conferences, congresses, seminars and symposiums ; publication of books and texts (other than publicity texts); publishing services; rental services; advice and consultancy services relating to all the aforesaid services.</p>
<p>In Class 42: Computer programming; design, development, maintenance and updating of computer software; computer systems analysis; leasing access time to a computer database; computer software rental; rental of integrated software; on-line rental of packaged software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining websites; design services; research and development for others; quality control relating to computer systems and software; information (only information in class 42) provided on-line from a computer database or from the Internet relating to all the above services; advice and consultancy services in relation to all the aforesaid services.</p>	<p>In Class 42: Hardware; hosting the websites of others; editing of written texts; licensing of intellectual property; legal research; legal services; photography; printing; technical project studies; video taping; vocational guidance; security consultancy and services; rental of security apparatus; monitoring of security systems; computer hardware, software and related on-line security services;</p>

10) The revocation action is based upon Section 46(1)(a) & (b) of the Trade Marks Act 1994, the relevant parts of which read as follows:

-46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)
- (d)

(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.”

11) PRN alleges that the mark has not been used in the five years subsequent to its registration or in the five years prior to the date of the application for revocation. The periods in question are, therefore, 1 December 2001 - 30 November 2006 for Section 46(1)(a) and 30 April 2005-29 April 2010 for the Section 46(1)(b) ground. These were agreed by both parties at the hearing.

12) Where PL claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It reads:

“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.”

13) In *Laboratories Goemar SA's Trade Mark (No. 1)* [2002] F.S.R. 51 Jacob J (as he was then) said:

—Those concerned with proof of use should read their proposed evidence with a critical eye — to ensure that use is actually proved —

and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

14) In determining the issue of whether there has been genuine use of the mark in suit I look to case O-371/09 (*AMBROEUS*) where Ms Anna Carboni acting as the Appointed Person set out the following summary:

—a) 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].

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

(c) 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].

(d) 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].

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

(ii) 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].

(e) 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].

(f) 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].”

15) PL originally did not provide an indication of which exhibits were being relied upon to support which part of the specification, indeed its evidence made no comment as to its activities but simply supplied a number of exhibits, again without comment. A schedule was provided after the hearing at my insistence and PRN was provided an opportunity to comment upon these submissions. This is not a satisfactory way of dealing with matters as I was not afforded an opportunity to discuss issues with both parties but as neither side wished to abandon the hearing it was the next best course of action. I shall therefore rely upon the schedule provided by PL and both parties' comments. The majority of the specification being defended relates to computer software and in considering the evidence I bear in mind the comments of Laddie J. in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850 where he said:

—At the beginning of this judgment I set out the specification of goods in respect of which the plaintiff's mark is registered. In fact the plaintiff only uses it and, I understand, only ever intended to use it in relation to its telecommunications business. The defendant argues that the registration, in so far as it covers computer software, should be restricted as follows: —~~All~~ for use in or with telecommunications systems.”

The defendant argues that on its present wording, the plaintiff's registration creates a monopoly in the mark (and confusingly similar marks) when used on an enormous and enormously diffuse range of products, including products in which the plaintiff can have no legitimate interest. In the course of argument I put to Mr Silverleaf that the registration of a mark for “computer software” would cover any set of recorded digital instructions used to control any type of computer. It would cover not just the plaintiff's type of products but games software, accounting software, software for designing genealogical tables, software used in the medical diagnostic field, software used for controlling the computers in satellites and the software used in the computers running the London Underground system. I think that in the end he accepted that some of these were so far removed from what his client marketed and had an interest in that perhaps a restriction on the scope of the registration to exclude some of the more esoteric products might be desirable. In any event, whether that was accepted or not, in my view there is a strong argument that a registration of a mark simply for “computer software” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly

of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act.”

16) Section 46(6) states:

—46(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.

17) In the instant case the periods governing the revocation actions under Section 46(1)(a) and 46(1)(b) overlap. The periods are 1 December 2001 - 30 November 2006 for Section 46(1)(a) and 30 April 2005-29 April 2010 for Section 46(1)(b). PL is no longer defending a number of goods and services. However, I have no evidence as to whether these were used and cannot be sure whether grounds for revocation existed prior to the date of the application for revocation. These non-defended goods and services are therefore revoked with effect of 30 April 2010. In my opinion, any goods or services which have evidence which is dated solely prior to 30 April 2005 should also be revoked as of the date of the revocation application 30 April 2010. I shall therefore only consider in my deliberations the evidence filed which is dated after 30 April 2005. For ease of reference I list below the exhibits which are dated after 30 April 2005. I also include my views on the relevance of the evidence and the extent to which use has been shown taking reflecting the views of PRN and PL.

- AS9: A copy of a proposal to supply —“DIAGILITY Awards Management Services” to the International Academy of Television Arts and Sciences in New York. This would seem to relate to the provision of software which allows on-line entry, information gathering, media logistics, digital media handling and online and offline balloting. It imports and exports data. It would appear to be dated January 2006 although the date is not particularly clear.
- AS10: A copy of a front sheet only, of a proposal regarding the management of the Golden Trailer Awards. The date has been partially redacted, but it appears to be August 2006. The proposal is from the registered proprietor to Golden Trailer Awards, New York. As no details of what was being offered has been provided I do not believe this exhibit has any merit.

- AS11: An invoice dated 31 March 2006 with the word —mediagility.com” at the top addressed to Babolesh in London relating to the provision of —hosts” provided in March and April (presumably also in 2006) at a cost of £99 per month.
- AS12: A copy of an invoice, dated 22 April 2008, with the word —mediagility.com” at the top addressed to Golden Trailer Awards in New York relating to —software services” and —premium support”, also —entry processing fees”, —public judge roles” and —VIP judge roles”. The total was for £3,370.
- AS13: A copy of an invoice, dated 30 April 2009, with the word —mediagility.com” at the top addressed to Golden Trailer Awards in New York relating to —software subscription” “two hours of admin” and —support”. The total was for £1,160.
- AS14: A copy of an invoice, dated 25 April 2010, with the word —mediagility” at the top addressed to Trailer Central LLC in New York relating to —Entry processing” and —mediagility Application Hosting-North America”. The total was £US\$10,105.
- AS15: An undated document said to be the specification document for —awards software” prepared in January 2008. It refers to the Mobile User Experience Awards. It appears to be similar to the Golden Trailers Award software. This was sent to a London address.
- AS16: This is a proposal for the —Babolesh project” dated 16 July 2008. It bears the name of Mediagility Ltd. Its purpose is to create a web application.
- DW2: A copy of a screenshot from PL’s computer system showing outstanding jobs. This would appear to be an internal document. It is headed as an email dated 1 September 2011 but refers to projects which require attention dated March 2006 under the —mediagilityonline” brand. I do not believe this exhibit has any merit.
- DW33: A document which is said to be a specification sheet, but seems to relate to software. The three pages are headed as being prepared for Mr Pawlowski (based in London) on 7 January 2008 regarding the 2008 Mobile User Experience Conference. It is headed —mediagility Awards”. This would appear to relate to much the same type of software as that provided under the Golden Trailer Awards, where entry, judging, balloting and results are all carried out on-line.
- DW34: This appears to relate to the second phase of the Babolesh project and again refers to the provision of software. It is dated 16 July 2008 and is headed Mediagility Ltd.

- DW35: This is a copy of an exchange of emails, dated April 2007, with an individual in the UK who obviously had problems in entering the Golden Trailer Awards, and sought advice from the registered proprietor. The email address shows —mediagility.com”.
- DW36: Copies of emails dated 14 & 15 June 2007 between PL and a supplier regarding invoices sent by the supplier but not received by PL. One from Mr Wheeler of PL to Creative Tank regards —GAA streaming”. It states that PL does not have an invoice from Creative Tank for May —when the bulk of the streaming happened”. The email address used is —mediagility.com”. I do not believe this exhibit has any merit.
- DW37: An email, dated 8 April 2009, sent by PL seeking an address from a client in order to invoice them. Again the address used is —mediagility.com”. I do not believe this exhibit has any merit.
- DW38: An exchange of emails between the Golden Trailer Awards team and an entrant for the awards. These are dated 20 April 2009 and have been copied to PL.
- DW39-49: Copies of invoices, dated 31 March 2008-31 December 2008, totalling £2326.50 relating to the provision of —fast hosts”, and also one dated 30 June 2008 which refers to travel costs, a forum licence and use of a font. All addressed to Babolesh, London, and headed Mediagility.
- The witness statement, dated 26 September 2011, by Troy Wear the Managing Director of Babolesh, a limited company set up on 15 December 2006 in the UK. Mr Wear has held his position since the inception of the company. He states that his company creates online digital villages that people live in and trade within. He states that his company engaged the services of PL in September 2007 to design and create a prototype of a web based computer application to manage the transactions between people within their digital villages.

19) Exhibits AS9, AS10, AS12, AS13, AS14, DW35 and DW38 all relate to the Golden Trailer Awards. This allows individuals and companies around the world to enter into a competition. The software was supplied by PL and allows for on-line entry, information gathering, media logistics, digital media handling and online and offline balloting. It also imports and exports data. However, this appears to have been provided to a company in the USA, and under Section 46(2) the exception relates to goods being exported not services.

20) The witness statement of Mr Wear and exhibits AS11, AS16, DW34 and DW39-49 all relate to the Babolesh project. This relates to the provision of software which allows users to be part of an online digital village where they can trade with each other, presumably these include financial transactions as well as barter. It is clear that PL also rented the project the use of —fasthosts” but it is not explained what these are. This project was delivered to a company based in London and therefore is acceptable as use in the UK.

21) Exhibits AS15 and DW33 relate to the Mobile User Experience Awards. This would appear to be very similar to the Golden Trailer Awards where entry, judging, balloting and results are all carried out on-line. Again sent to a London address and therefore is acceptable as use in the UK.

22) To my mind, PL has confused its role in providing, broadly speaking, computer software to the use made of it by its clients. Hence the contentions that they have used the mark in suit upon all the services listed in paragraph 9 above, when it is very obvious that this is not the case. For instance PL did not provide any telecommunication services in Class 38 to its clients under the mark in suit after 2003, although its software did rely upon these services for their own purposes when using the software provided by PL. In my opinion, the evidence shows genuine use of the mark in suit upon a very limited range of services. In determining a fair specification I take into account the approach set out by Mr Richard Arnold QC (as he was then) acting as the Appointed Person in O/262/06 (*NIRVANA*) where he said:

—58I derive the following propositions from the case law reviewed above:

(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].”

23) Taking all of the above into account, to my mind, a fair specification would be as follows:

In Class 9: Computer software relating to award ceremonies; computer software to enable connection to databases and the Internet; computer software to enable searching of data; computer software for use in providing financial services and carrying out financial transactions.

In Class 42: Design, development, maintenance and updating of computer software.

24) I must also consider the comments of the ECJ in Case C-246/05 *Armin Haupl v Lidl Stiftung & Co. KG* and also Mr Purvis Q.C. acting as the Appointed Person in case O-276-09 in relation to the proviso under Section 46 (1) regarding proper reasons for non-use. In the instant case PL has not made any submissions regarding reasons for non-use.

CONCLUSION

25) PL chose not to defend the following items in the specification.

In Class 9: Electrical and electronic apparatus, equipment and instruments; namely hand held computers, electronic organisers and electronic diaries; apparatus for recording, transmission or reproduction of data, images and sound; magnetic data carriers and recording discs; data processing equipment; computer hardware; blank and pre-recorded audio and video discs and cassettes, CD-ROM's, optical discs and compact discs; publications in electronic form supplied on-line from databases or from facilities provided on the Internet (including web sites); on-line games; telecommunications apparatus (including modems); magnetic and encoded charge cards, credit cards and debit cards; encoded cards; smart cards; holograms for use in securing electronic media; parts and fittings for all the aforesaid goods.

In Class 16: Paper, cardboard and goods made from these materials, not included in other classes; printed matter; publications; books, journals, magazines, manuals, newspapers, handbooks, trade and technical publications; photographs; stationery; instructional and teaching materials (except apparatus); plastic materials for packaging (not included in other classes); printers type; printing blocks; charge cards, credit cards and debit cards, all other than encoded or magnetic; advertising and publicity materials; calendars; catalogues; diagrams; diaries; printed forms; graphic prints; representations and reproductions; writing pads and paper.

In Class 35: Accounting, auditing and book-keeping services; compilation of advertisements for use as web pages on the Internet; advertising technology services relating to business; on-line advertising distribution services relating to business; dissemination of advertising matter; business management and organisation consultancy; commercial business information agencies; cost price analysis; demonstration of goods in relation to business, advertising and promotion services; direct mail advertising; distribution of samples; document reproduction; organisation of exhibitions for commercial or advertising purposes; economic forecasting; market research and studies; opinion polling; word processing; public relations; publication of publicity materials and texts; radio advertising; sales promotion for others; television advertising and commercials; advice and consultancy services relating to all the aforesaid services.

In Class 36: Financial and insurance services; financial and insurance information services; information services relating to finance and insurance, provided on-line from a computer database or the Internet; credit and debit card services; issuance of credit and debit cards; issuing of tokens of value in relation to financial and insurance services; financing services; credit control services; financial sponsorship; fund raising; charitable fund raising; trusteeship; advice and consultancy services relating to all the aforesaid services.

In Class 38: Broadcasting services; on-line broadcasting services; telecommunication access services; facsimile, telex, telephone and telegram services; mobile telephone services; reception, recordal, networking and transmission of data and information by means of radio, radio paging, teleprinter, teleletter, facsimile, microwave, laserbeam, infra red or communication satellite; advice and consultancy services relating to all the aforesaid services.

In Class 41: Education and entertainment services; in-flight entertainment services; information relating to entertainment or education, provided on-line from a computer database or the Internet; providing cinema facilities, including multi-screen cinema complexes; electronic games and entertainment services provided by means of the Internet and the World Wide Web; Providing on-line electronic publications (not downloaded) by means of the Internet; publication of electronic books and journals on-line; arranging and conducting of conferences, congresses, seminars and symposiums ; publication of books and texts (other than publicity texts); publishing services; rental services; advice and consultancy services relating to all the aforesaid services.

In Class 42: Hardware; hosting the websites of others; editing of written texts; licensing of intellectual property; legal research; legal services; photography; printing; technical project studies; video taping; vocational guidance; security consultancy and services; rental of security apparatus; monitoring of security systems; computer hardware, software and related on-line security services.

26) The above must therefore be regarded as being revoked with effect from 30 April 2010. My findings above will result in the following specification also being revoked with effect from 30 April 2010.

In class 9: computer software; computer software (downloadable) supplied from the Internet; computer software supplied on-line from databases or from facilities provided on the Internet (including web sites);

In Class 35: Business services; advertising and promotion services and information services relating thereto; business information services provided on-line from a computer database or the Internet; providing specialist business frameworks of rented integrated software; business information, enquiries and investigations; business research; compilation and systemisation of business information into computer databases; business services utilising computerised file management; compiling and providing access to statistical information.

In Class 38: Telecommunications; telecommunication and on-line services providing access to software, commercial information, product information, financial information and financial services and transactions; telecommunication of information (including web pages), computer programmes and any other data or images; providing user access to the Internet (service providers) and the World Wide Web; providing telecommunications access and links to computer databases and the Internet; multiple distribution channel platforms for media and mixed media applications; electronic mail services; telecommunication services relating to E-commerce; multi-media services provided on line; networking and transmission of data and information by means of electronics, computer, cable, optical fibre, electronic mail, television; message sending services; reception, recordal, transmission, networking, storage and display of information from a databank; communication services; communication by computer; on-line communication services; electronic stream scheduling;

In Class 41: Multi-media services relating to capturing, organising, and providing access to data and images through multi-media applications and channels; arranging and conducting of workshops; education information service; teaching and tuition services;.

In Class 42: Computer programming; computer systems analysis; leasing access time to a computer database; computer software rental; rental of integrated software; on-line rental of packaged software; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining websites; design services; research and development for others; quality control relating to computer systems and software; information (only information in class 42) provided on-line from a computer database or from the Internet relating to all the above services; advice and consultancy services in relation to all the aforesaid services.

27) I propose to limit the specification to the following:

In Class 9: Computer software relating to award ceremonies; computer software to enable connection to databases and the Internet; computer software to enable searching of data; computer software for use in providing financial services and carrying out financial transactions.

In Class 42: Design, development, maintenance and updating of computer software.

28) The specification I am suggesting is not the result of simple “blatant lining” and therefore I intend to give both parties an opportunity to comment upon my proposal. Once I have received these submissions I will make a determinative decision, both on the specification which should remain upon the Register and also those services which are to be revoked. Both parties have one month from the date of this decision to provide said submissions.

COSTS

29) Initially PL sought to defend the whole of its specification, reducing it slightly prior to the hearing, and further in its post hearing submission. PL also failed in its evidence or in its pre-hearing submissions to link the exhibits to the relevant services, instead relying upon a broad brush approach which can be likened to the old adage of “never mind the quality feel the width”. They have put PRN to consider additional work post the hearing as they had to consider the 74 pages of submissions by PL and produce their own 105 page rebuttal. To my mind, much of this work was completely unnecessary. PL has made a number of wide ranging claims for the exhibits provided. For example:

- DW2 is said to support: In Class 9 –computer software; computer software (downloadable) supplied from the Internet; computer software supplied on-line from databases or from facilities provided on the Internet (including web sites); computer software to enable connection to databases and the Internet; computer software to enable searching of data.” The exhibit is described by PL in their submissions as: “This screen shot is an example of the Mediagility software which is clearly web based software. Whilst the example is dated in an email from 1 September 2011, the screen shot shows the software as at 27 March 2006.” In fact it is an internal document which simply lists projects which require attention but does not provide any detail in relation to those projects.
- DW36 is said to support in class 41: electronic stream scheduling; The exhibit is described by PL in their submissions as: “This email string between Creative Tank and Mediagility from June 2007 discusses an invoice for the bulk of the streaming work that Mediagility did for Creative Tank.” In fact the email string appears to relate to work done by Creative Tank for PL and the fact that invoices sent by Creative Tank do not appear to have been received by PL.
- AS10 and DW37 are not mentioned once in the post hearing submission.

30) Most of the contentions made by PL fly in the face of the authorities regarding revocation which state, broadly, that only those services which have been clearly shown to have had genuine use of the mark upon them should be considered defended, and that services should be relatively narrowly defined. PRN have sought costs above the normal scale, and have provided a bill of costs. I invite PL to comment upon the bill of costs provided by PRN and also allow PRN to make further comments regarding their bill in the light of my

decision above. Both parties are given one month from the date of this decision to provide said submissions. I shall make a determinative order of costs once I have considered the comments of both parties.

Dated this 25th day of September 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**