

O-181-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No.84253  
BY PINK RIBBON INC.  
FOR REVOCATION OF TRADE MARK No. 2213862  
STANDING IN THE NAME OF  
BREAST CANCER CAMPAIGN**

## BACKGROUND

1) The following trade mark is registered in the name of Breast Cancer Campaign hereinafter BCC).

Mark	Number	Registered Date	Class	Specification
PINK RIBBON	2213862	09.06.00	41	Organisation of balls.

2) By an application dated 23 February 2012 Pink Ribbon Inc. (hereinafter PRI) applied for the revocation of the registration under the provisions of Section 46(1)(b) claiming there has been no use of the trade mark on the services for which it is registered in the five year period 3 February 2007 – 2 February 2012. A revocation date of 3 February 2012 is sought.

3) On 30 April 2012 BCC filed a counterstatement stating that the mark had been used. It states that the mark is used annually in relation to a ball which raises money for the charity. It states that the balls have been held since 1995 and that the event in 2011 was the seventeenth such ball. The statement states that the ball in 2010 raised over £250,000 through the sale of tickets and fund-raising activities associated with the ball such as an auction at the ball.

4) Only BCC filed evidence. The matter came to be heard on 17 April 2013 when BCC were represented by Ms Michaels of counsel instructed by Messrs Wallace LLP; PRI were not represented and nor did they provide any written submissions.

## BCC'S EVIDENCE

5) BCC filed a witness statement, dated 29 June 2012, by Delyth Jane Morgan (Baroness Morgan of Drefelin) the Chief Executive of BCC a position she has held since 1 July 2011. Prior to her appointment she was a patron of BCC and also a patron of the Pink Ribbon Ball. The facts in her statement come from her own knowledge and the records of BCC. She states:

“3.1 The proprietor has organised a series of balls named “Pink Ribbon” at the Dorchester Hotel in London. The series commenced in 1995 and the event on 8 October 2-11 was the seventeenth annual Pink Ribbon Ball all of which were to raise funds for the proprietor.”

6) Baroness Morgan states that the organisation of the ball takes place throughout the year and culminates at the ball each October. In addition to employees of BCC there is a team of volunteers who carry out the work to organise each ball. The income raised by the balls and provided to BCC is as follows:

Year	£
2007	245,082
2008	215,781
2009	240,876
2010	228,112
2011	242,646

7) Baroness Morgan states that since its inception the balls have raised approximately £4million for the charity. Each ball has been attended by approximately 300 people, although the numbers have increased slightly in recent years. She also provides the following exhibits:

- DM1: This consists of a programme for each of the balls for the years 2007 – 2011 inclusive. Each programme is printed on high quality glossy paper and is the size of an average magazine. The front has the legend “PINK RIBBON BALL” and the year. It also has the logo of BCC, the name and address of the Dorchester Hotel and the date of the event (always in October). Apart from 2011 the words PINK RIBBON are printed in uppercase in plain font. The 2011 cover has the word “PINK” in standard font with the word “RIBBON” in “hand written” form. Each programme has a message from the charity detailing its work and also providing information about the event itself such as the menu, the chef, and the timing of the evening. They also have a huge number of advertisements from the various corporate sponsors, most stating their support for the Pink Ribbon Ball.
- DM2: This consists of tickets for the balls. All have the words “PINK RIBBON BALL” and the year of the event on the front cover. All are dated within the relevant period.
- DM3: Brochures with details of the auction lots. Each has the words PINK RIBBON BALL” and the year of the event on the front cover. All are dated within the relevant period.
- DM4: This consists of copies of five invoices from the Dorchester Hotel for each year’s ball. They are addressed to THE PINK RIBBON BALL and are dated October 2007-October 2011 inclusive. They show that there were 390 attendees in 2010 and 346 attendees in 2011. Each bill is for approximately £38,000.
- DM5: Copies of references to each year’s PINK RIBBON BALL in the newsletter produced by BCC. Each article has photographs of attendees and a write up which mention the ball by name.
- DM6-9 inclusive: copies of press cuttings which show pictures of those attending each PINK RIBBON BALL for the years 2008-2011 inclusive. The various articles all mention the event by reference to the trade mark.

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

## **DECISION**

9) The revocation action is based upon Section 46(1)(b) of the Trade Marks Act 1994, the relevant part of which reads as follows:

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

(a) .....

- (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.”

10) PRI alleges that the mark has not been used in the period 3 February 2007 – 2 February 2012. A revocation date of 3 February 2012 is sought.

11) Where BCC 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 it. 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.”

12) 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.”

13) In determining the issue of whether there has been genuine use of the mark in suit I look to case O-372/09 (*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 “token”, 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].”

14) I take into account the views of the CJEU in Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2009] ETMR 14 in which it was asked to consider the following question:

“Is Article 12(1) of [the directive] to be construed as meaning that a trade mark is put to (genuine) use to distinguish goods and services of one undertaking from those of other undertakings in the case where a non-profit-making association uses the trade mark in announcements for events, on business papers and on advertising material and that trade mark is used by the association’s members when collecting and distributing donations inasmuch as those members wear badges featuring that trade mark?”

15) The answer was as follows:

“16 With regard to the question whether a non-profit-making association, carrying on activities such as those described in paragraphs 7 and 9 of the present judgment, may be regarded as making genuine use of a trade mark within the meaning of *Ansul*, it should be pointed out that the fact that goods or services are offered on a non-profit-making basis is not decisive.

17 The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services.

18 In addition, as the Radetzky-Orden admitted in its written observations submitted to the Court, paid welfare services exist. In modern society, various types of non-profit-making association have sprung up which, at first sight, offer their services free but which, in reality, are financed through subsidies or receive payment in various forms.

19 It cannot be ruled out, therefore, that trade marks registered by a non-profit-making association may have a *raison d'être*, in that they protect the association against the possible use in business of identical or similar signs by third persons.

20 As long as the association in question uses the marks of which it is the proprietor to identify and promote the goods or services for which they were registered, it is making an actual use of them which constitutes ‘genuine use’ within the meaning of Article 12(1) of the Directive.

21 Where non-profit-making associations register as trade marks signs which they use to identify their goods or their services, they cannot be accused of not making actual use of those marks when in fact they use them for those goods or services.

22 In any event, in accordance with the finding of the Court in paragraph 37 of *Ansul*, and as the Advocate General pointed out in point 30 of his Opinion, use of a trade mark by a non-profit-making association during purely private ceremonies or events, or for the advertisement or announcement of such ceremonies or events, constitutes an internal use of the trade mark and not ‘genuine use’ for the purposes of Article 12(1) of the directive.

23 It is for the national court to ascertain whether the BKFR has used the trade marks of which it is the proprietor to identify and promote its goods or its services to the general public or whether, on the contrary, it has merely made internal use of them.

24 In the light of the foregoing considerations, the answer to the question referred must be that Article 12(1) of the Directive is to be construed as meaning that a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association’s members wear badges featuring that trade mark when collecting and distributing donations.”

16) In the instant case the evidence shows that BCC has organised an annual ball under the mark in suit for each of the last seventeen years. Examples of the programmes used for each of the five years in question were provided. Evidence was also provided of the income derived from these events. It is clear that the event was publicised, not least to companies who paid for their advertising to appear in the programme. The balls were also advertised to supporters of the charity, as the market for tables at a ball is somewhat limited. To my mind there can be no doubt that the mark in suit has been used in the organising of balls.

## **CONCLUSION**

17) The mark must therefore be regarded as having been used and the revocation actions fails in its entirety.

## **COSTS**

18) BCC has been successful in defending its mark and it is therefore entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£300
Preparing evidence	£700
Preparing for and attending a hearing	£900
<b>TOTAL</b>	<b>£1900</b>

19) I order Pink Ribbon Inc. to pay Breast Cancer Campaign the sum of £1900. 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 1st day of May 2013**

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