

O-032-16

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 1550700 FOR THE TRADE MARK

FURNITURELAND

AND

REGISTRATION NO 2183949B FOR A SERIES OF 6 TRADE MARKS



BOTH IN THE NAME OF FURNITURE VILLAGE LIMITED

AND

CANCELLATIONS THERETO UNDER NO 500653 AND 500654
BY FURNITURELAND CO.UK.LTD

Background

1. Registration No 1550700 is for the trade mark FURNITURELAND, has a filing date of 15 October 1993 and was entered into the register on 17 February 1995. It is registered in respect of “Furniture and parts and fittings therefor; all included in Class 20”.

2. Registration No 2183949B is for a series of six trade marks as shown on the front cover of this decision. It has a filing date of 8 December 1998 and was entered into the register on 11 June 1999. It is registered in respect of “Furniture and parts and fittings therefor”. The colours blue, yellow and red are claimed in the first, third and fifth marks of the series.

3. Both registrations stand in the name of Furniture Village Limited (“the registered proprietor”).

4. Applications to revoke both registrations were filed by Furnitureland.co.uk.Ltd (“the applicant”). The applications are brought on grounds under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”). The applicant claims that registration 1550700 was not used in the period 11 March 2006 to 10 March 2011 and seeks revocation from 11 March 2011. In respect of registration 2183949B, the applicant claims three periods of non-use of the mark (i.e. 17 October 2009 to 16 October 2014, 18 July 2009 to 17 July 2014 and 11 March 2006 to 10 March 2011) and seeks revocation from 17 October 2014, 18 July 2014 or 11 March 2011.

5. Section 46(1) of the Act states that:

“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 purpose 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 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.”

6. Section 100 is also relevant and reads:

“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.”

7. The registered proprietor filed counterstatements. In respect of registration No 1550700 it denies there has been no genuine use of the mark in the relevant period. In the alternative, it claims use of the mark resumed after the expiry of the relevant period and so it should not be revoked relying on grounds under section 46(3) of the Act. In defending 2183949B, it makes the same claims but also claims an additional defence on grounds under Section 46(2) of the Act.

8. In its applications, the applicant refers to earlier revocation proceedings in relation to registration Nos 2401897 for the mark FURNITURELAND and 2041896 (a composite mark containing the word furnitureland). It states that the composite mark was surrendered but that the word mark proceeded to a full decision and subsequent appeal. As a result of that appeal, it notes that:

“Non-use [of the mark FURNITURELAND] has been established for the 5 year period ending 10 March 2011. (Decision of the Appointed Person Geoffrey Hobbs QC O-128-14). No evidence (sic) of use of this trade mark during that non-use period was tendred (sic) in those proceedings”.

9. During the course of proceedings Mr Davies has made repeated references to the earlier revocation action, suggesting that a finding of non-use in relation to registration 1550700 follows. Registration No 2401897 covered a wider range of goods and services than involved in these proceedings but included furniture as here. It was also for the mark FURNITURELAND and revocation of it was also sought from 11 March 2011. There is, therefore, a good deal of similarity between the current and earlier proceedings. Whilst, in relation to the earlier proceedings it was found that genuine use of the mark had not been shown in relation to the defended goods and services within the relevant period, that finding cannot mean that the current registration should be subject to automatic revocation. Whilst the marks of registrations 2401897 and 1550700 were both FURNITURELAND and the specifications overlap, each of the registrations is a separate one. Furthermore, registration 2401897 was defended only on the basis that genuine use of the mark had been made in the relevant period which, as I have set out above, is not the case here. In short, the fact that the earlier revocation action was successful is not determinative of the outcome in the current proceedings.

10. The two current revocation proceedings were consolidated. Only the registered proprietor filed evidence. Neither party filed written submissions. The applicant sought to be heard and the matter originally came before me for a hearing on 2 November 2015. The registered proprietor was represented by Mr Guy Tritton of Counsel instructed by Bracher Rawlins LLP and the applicant by Mr Jim Davies of Elevation Legal. For reasons to which I will return below, that hearing became a procedural one and the hearing on the substantive issue was adjourned. A further hearing was appointed and took place on 15th December 2015 when the parties were again represented by Mr Tritton and Mr Davies.

11. I pause at this point to record that following the filing of the registered proprietor's evidence, the IPO wrote to Mr Davies on 20 April allowing him until 22 June 2015 to file evidence or submissions in support of the applications. Nothing was filed and so, by way of a letter dated 22 July, the parties were advised that the evidence rounds were concluded. They were also advised that the cases would be forwarded to the IPO's Hearings Section with the parties having the option to request either an oral hearing or a decision from the papers.

12. The registered proprietor acknowledged receipt of this letter in its letter of 30 July. It indicated that its preliminary view was that "there is not a need for an oral hearing [but that once it had received the appropriate letter from the IPO it could] finally determine whether or not to request an oral hearing or that a decision be made on the papers". It sent a further chaser letter on 11 August advising that it "would be obliged to receive contact from [the IPO] regarding the further conduct of the revocations actions and in particular arrangements for the hearing thereof".

13. On 24 September, the applicant requested to be heard. As a result, and by way of letters dated 29 September 2015, the parties were advised of the date appointed for the hearing (2 November). The letter also contained the following:

"Unless you have already done so, I would be grateful if you could inform the Registrar within 14 days from the date of this letter, who will represent your clients..."

It was not until the 28 October that the registered proprietor advised the IPO of the name of the person who would be attending the hearing on its behalf. In one of his emails dated 29 October (see below), Mr Davies indicated he was “reconfirming” that he was appearing on behalf of the applicant. There is no record of him having previously “confirmed” his attendance although it is clear that he has represented the applicant throughout the course of these proceedings. I note that the 14 day period mentioned in the IPO’s letter is not a statutory period but an administrative one.

14. On 29 October 2015, i.e. two working days before the hearing, Mr Davies began a flurry of correspondence with and telephone calls to the registrar. His first email contained the following:

“..we were not aware [until receiving its letter of yesterday’s date] that the registrant intended to attend the hearing...We would ask for leave to adduce evidence that calls into question the credit of the registrant’s witness in this matter. We would also ask for leave to cross examine the registrant’s witness at the hearing.

Further, we confirm that our client intends to question the absence of certain documents that should have been retained by the registrar and the absence of which resulted in an apology from UK IPO; as well as the status of one of the marks on the register during the relevant period. We would also ask that the author of that apology be made available for questioning at the hearing.”

15. A response to that email was sent by the IPO the same day. In relation to Mr Davies’ requests to file evidence and cross examine the registered proprietor’s witness, it noted that they had been made just two working days before the hearing and were not supported by any reasons or justification. In relation to the alleged absence of the unidentified documents, he was asked to provide further information. The parties were advised that the hearing would go ahead as planned.

16. Mr Davies sent a further email the following day. It contained the following:

“We confirm that we relied on the registrant’s failure to respond to the requirement set out in your letter of 29 September 2015 who (if anyone) would be representing their client within 14 days; and took that to mean that they would not be appearing...

It is relevant to consider that materially the same marks and same facts have already been considered by both yourselves and then by Mr Geoffrey Hobbs QC, sitting as an appointed person...The outcome of that dispute was that the marks were removed from the register. We therefore took the registrant’s silence on appearing in that context; and took it to mean that they were not intending to fight an apparently hopeless cause.

Instead they left it to the last possible moment (and long after the deadline set in your letter) to confirm (as we had done by requesting the hearing) that they did in fact intend to appear; and are doing so through experienced and learned counsel. The other side are well aware that I would be representing

our client and that I am based in Australia. They know this, not least because I appeared at the previous hearings of the related matter and flew from Australia to London for those hearings to appear in person on behalf of the client.

We are also now in possession of further evidence (which we did not have at the previous hearing) which is material to the issues in dispute and which contradicts evidence filed by the registrant. When it appeared to us that there would not be a contested hearing, there appeared to be no need to rely on that evidence. Now that we hear, outside of the timetable that you sent to the parties, that the other side are appearing, we need to file and rely on that evidence.

Since it is directly at odds with, and goes to the credit of, the other side's witness evidence; we also need to apply to have those witnesses available for cross examination.

Further, we engaged in correspondence from your office that shows that documents that may be important (depending on the approach taken by the other side) apologizing for the loss and/or destruction of a document relevant to at least one of the trade marks in issue. Again, we wish to rely on this document (and correspondence related to it) in the event that it proves relevant in argument; and possibly question those involved at the hearing.

...

We apologise for the timing of these requests, but stress that they arise directly from the late notice by the other side that they intended to appear at the hearing..."

17. Mr Davies asked for the hearing to be postponed. Again, Mr Davies was advised, by telephone, that the hearing would not be postponed but that I would deal with his requests as preliminary points at that hearing and then adjourn it if necessary.

18. On the morning of the hearing, and some ten minutes before it began, Mr Davies filed even more written material. At the start of the hearing, I considered the requests as a preliminary point and, after hearing submissions from both parties, I then adjourned the hearing to allow me properly to review all the material filed. I advised the parties of my decision by way of a letter sent the following day.

19. A copy of the letter is shown at Annex A to this decision but can be broken down as follows:

- i. Mr Davies had made submissions that the applicant had not filed evidence because it assumed the registered proprietor was not going to attend the hearing and was not therefore defending the revocation actions. Quite clearly, the registered proprietor WAS defending the actions on a number of bases. Not only had it filed counterstatements and evidence but it had also, as set out above, continued to correspond with the registrar regarding the conduct of the cases. Following the filing of the registered proprietor's evidence, the

applicant had been allowed until 22 June 2015 to file whatever evidence or submissions (if any) it wished to support its case. None was filed within the period allowed and no requests to extend that period were received. The question of whether or not matters would be substantively determined following a hearing or from the papers on file was not in issue during the period allowed for the applicant to file its evidence or submissions and cannot have influenced the applicant's decision whether or not to file them.

- ii. In revocation proceedings it is a matter for the registered proprietor to show what use has been made of its mark(s) but Mr Davies submitted that his clients would be unfairly prejudiced if the applicant's evidence was not admitted. Referring back to the earlier revocation proceedings mentioned above, he submitted that had he been aware of the current registration when those earlier ones had been launched, he would have applied to cancel all of them at the same time. He submitted that he had not identified them. He also submitted that the registered proprietor had not identified them either because it had not referred to them in an earlier Nominet dispute between the parties. Furthermore, he submitted, the registered proprietor had itself opposed a third party's application for registration but had not relied on these registrations as part of that action. He submitted that the reason he was unaware of them, and the reason why the registered proprietor hadn't referred to them, is that they must have been removed from the register at some point before being restored to it at some later point. In relation to registration no 1550700, he submitted that when he had sought a copy of the relevant registry file, information was missing from it. What was missing was a form which led to the recordal an assignment of that registration on the trade marks register. I refused Mr Davies' request that an officer from the Registry be brought to the hearing "for questioning". For the reasons given in my letter, the fact that Mr Davies had failed to identify the marks, the registered proprietor had not relied on them in other proceedings and absence of such a form from the official file cannot be said to lead to a finding that these registrations must have been removed from the register and later restored to it: it is simply not credible. I refused to allow the admittance of the applicant's evidence.
- iii. Whilst I refused to admit it, I reviewed the evidence *de bene esse*. Mr Davies had submitted that it "calls into question the credit of the registrant's witness". In my view it did no such thing. The evidence took the form of a witness statement by Mr Davies and was little more than a recitation of the claims set out in the preceding paragraph. It would not be of any relevance to the matters to be determined.
- iv. As to the initial request to be allowed to cross examine the registered proprietor's witness (singular), Mr Davies had given no explanation of why he considered it necessary other than claiming that his (Mr Davies') evidence (which I refused to admit) called Mr Wynne's "credit" into question. At the hearing, he submitted he also sought to cross examine Mr Duggan who had provided evidence in the earlier proceedings, a copy of which had been referred to and exhibited to Mr Wynne's witness statement. Mr Davies submitted that he wanted to cross examine them on a range of topics on

which they had not, in fact, given evidence. I refused the request for cross examination as being wholly without merit.

- v. I indicated that the substantive hearing would be reappointed to take place as soon as possible and that I would consider an award of costs to the registered proprietor in respect of the adjourned hearing.

20. As indicated above, the hearing was reappointed to take place on 15 December 2015. Despite having been warned at the earlier hearing about the consequences of failing to file documentation in good time, less than an hour before the appointed commencement time of the hearing, Mr Davies filed a supplementary skeleton argument. This was well outside the period prescribed in the relevant Tribunal Practice Notice TPN 1/2004 which advises that skeleton arguments should be filed by 2pm two working days prior to the hearing, in this case by 2pm on Friday 11th December. The hearing took place by three-way video link with Mr Davies in Australia, Mr Tritton in London and me in Newport. Due to technical difficulties, the hearing started half an hour or so after the appointed time which is likely to be the reason why Mr Tritton was able to state that he had had the chance to read, briefly, the late-filed skeleton argument and did not seek an adjournment. As he also said, the supplementary skeleton argument gave no indication e.g. by way of “track changes” of how, if at all, it differed from the one that Mr Davies had filed in relation to the earlier appointed (and adjourned) hearing which had made things very much harder for the opponent to review. When challenged, Mr Davies accepted the second skeleton argument was late-filed and apologised but was unable or unwilling to give any explanation for the lateness.

21. At that reappointed hearing, Mr Davies referred to what he called the novel aspects of the case and again tried to resurrect his allegations that the marks must have been removed from the register. He submitted that this was a case that I should consider referring to the Court for determination because of its complex nature. I declined to do so, indicating that I considered the substantive actions to be those of normal revocation applications.

22. The question to be determined in the first instance is whether or not the registered proprietor had made genuine use of its marks. In *Stichting BDO v BDO Unibank, Inc.*, [2013] EWHC 418 (Ch), Arnold J. considered the matter of genuine use and stated as follows:

“51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or 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]; *Sunrider* [70]; *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]; *Sunrider*, [70]-[71].

(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]; *Sunrider*, [72]".

23. Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question". The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

Registration 1550700

24. In relation to this registration, the applicant's skeleton arguments included the following statement:

"Insofar as the evidence shows use for certain specifications of use, the more recent use of the trade mark is admitted, as far as it goes.

For the avoidance of doubt, it is not admitted that use has been proven for all specifications prescribed in Class 20 and that broad specification is challenged on the grounds of policy and in accordance with the principles previously referred to in the Asos Court of Appeal decision."

25. Understandably perhaps, the registered proprietor had been somewhat confused by this statement but indicated that it assumed that the applicant was referring to the lack of use shown in the evidence in respect of "parts and fittings". Working on that assumption, it accepted in its skeleton argument that no use had been shown in relation to such goods and agreed that the registration should be revoked to that extent.

26. At the hearing, I asked Mr Davies to clarify matters and to specify exactly what use was, in fact, being admitted and what was not. I also asked him to explain the "policy" grounds to which he referred. He replied:

"This part of this case is quite, I suspect, completely novel and quite difficult. There are other parts that are more routine, one might say, particularly in relation to the composite mark and arguments about whether or not that has been used or not recently.

The history of this dispute and also the history of the word mark, if I may call it that for ease of reference, is somewhat protracted and, as I say, unique. There is not an argument, if this is your question madam, that the evidence that has been put in in relation to use of the word mark in the last few years is, as it stands, evidence of use in the context of those categories of furniture that it has been used in.

We challenge whether or not the broad specification should be reduced and in the skeleton that was sent to you this morning, madam, we refer you to what I refer to as the ASOS case, the Court of Appeal case that was handed down earlier this year. The court took a view that if one could categorise in appropriate specifications of use, that was how the use should be protected, not giving a wider protection than that that has been applied in that use.

In that sense, we say, the evidence of use, the recent use, does not cover in its entirety the broad brush of furniture but should be, if you like, filleted to cover what is the actual use and the appropriate policy guidance provided by the Court of Appeal."

27. Mr Davies went on to make specific reference to the lack of use in respect of goods such as carpets and floor coverings but I pointed out to him that such goods were not covered by either of the registrations under attack. After consulting his papers, he said that he had made a mistake. Having again asked him to clarify what use the applicant was admitting, and reminding him that the mark stood registered for *furniture and parts and fittings therefor* (with the registered proprietor having agreed there was no use made in respect of *parts and fittings*) he went on to say:

“The ASOS case draws a distinction between different types of clothing, madam, for example. We would say the same principles should be applied to furniture. The public is able to distinguish, for example, between a retailer of wooden chairs or wooden furniture and perhaps other types of furniture which are quite distinct and should not be protected in a broad brush approach.”

And:

“...the mark should be limited in that way to the use that the evidence provided can support. It cannot support use for all categories of furniture because that is not the use that has been made of it.”

28. After further questioning, he submitted that the specification should be limited to wooden furniture because this was the extent of use shown in the evidence and “is quite an understandable category in the eyes of the general public”. Making no comment on his submission, I reminded him that there is material within the registered proprietor’s evidence relating to e.g. beds and upholstered chairs which would not be described as “wooden furniture” and he responded:

“If that is the case, then we would accept that as well... There has been no attempt on our part to deny that the evidence they put in is genuine or valid, and accurate. We say it only goes so far when looking at categorisations. It covers a whole class of use”.

29. Despite his earlier comments in support of the denied request for cross examination whereby he sought to challenge the registered proprietor’s evidence and the credibility of those giving it, the end result, as I understand it, is that Mr Davies, on behalf of the applicant, concedes that the registered proprietor has shown genuine use of the trade mark FURNITURELAND registered under no 1550770 but challenges the extent of that use insofar as the goods are concerned.

30. For his part, Mr Tritton referred me to the *Stichting* case and a paragraph from it set out in Mr Davies’ own skeleton argument wherein Arnold J. himself referred to a number of cases including *Daimler AG v Sony Group Co Ltd* [2009] EWHC 1003 (Ch). In this latter case Geoffrey Hobbs Q.C sitting as a Deputy High Court Judge said:

“...the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use but the particular categories of goods they should realistically be taken to exemplify...”

Arnold J went on to say:

“58. As Mr Hobbs added when sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd* (BL O/345/10) at 11:

“For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned”.

31. The registered proprietor’s evidence takes the form of a witness statement of Eamon Wynne dated 27 March 2015. Mr Wynne states he is the Commercial Director of the registered proprietor, a position he has held since 1 April 2012. Before this, he says, he was the company’s Sales and Operations Director, a position he had held since 15 January 2004.

32. Mr Wynne’s witness statement has 28 exhibits attached to it. Exhibits 1 and 2 are other witness statements both of which were filed in the earlier proceedings mentioned by the applicant in its pleadings. Exhibit 1 is the witness statement of Edward Duggan dated 27 January 2012 which itself refers to exhibits A to M (exhibit F is not supplied). Mr Duggan was, at that time, Finance Director of the registered proprietor. Exhibit 2 is a witness statement of Mr Wynne, then Sales and Operations Director, dated 15 August 2012 which itself refers to exhibits 1 to 3 (exhibit 3 is not supplied). I note, at this point, that much of the documentation exhibited to all three witness statements appears to be photocopies of photocopies. It is, in some instances, impossible to see what they were intended to show. What follows is a summary from all three witness statements. I shall refer to Mr Wynne’s earlier witness statement as Wynne1 and his later witness statement as Wynne2.

33. Each of the registrations the subject of this decision was applied for by a company called Furnitureland Ltd (a company which went into liquidation and was dissolved in June 2010). On 3 March 2006, that company’s administrators assigned the registrations to the registered proprietor. On 7 January 2011, the registered proprietor set in train the re-launch of the mark FURNITURELAND in relation to the sale of furniture and related retail services. On 19 January 2011 it instructed True Digital Ltd to create a website plan and marketing overview for the re-launch of the brand. On 15 February 2011, the registered proprietor registered the domain name furnitureland.uk.com. The business “went live” on 25 March 2011 through the website, offering a range of furniture products including living room, dining room and bedroom furniture under the FURNITURELAND trade mark. The launch was publicised to customers through an advertisement in the *Daily Star* on 10 March 2011 (Duggan).

34. Trade under the mark did not “prove to be as commercially successful as had been hoped” but the registered proprietor amended its trading style and a FURNITURELAND collection of furniture was launched in April 2012 in the registered proprietor’s 40 stores. At this date, there were said to be two dining room and one bedroom furniture ranges (which included tables, chairs, cupboards, sideboards, display units, bookcases, mirrors, wine racks, bedsteads and wardrobes) being sold under the mark. It is said that £1.1m worth of furniture was sold under the mark in the four months to August 2012 (Wynne1).

35. Since that time furniture products, again including dining tables, chairs, display units, sideboards, coffee/lamp tables, bookcases, beds, wardrobes and chests of drawers are said to have been sold under the mark in all 40 of the stores operated by the registered proprietor throughout the UK as well as via its websites furniturevillage.co.uk and furnitureland.uk.com. Sales figures, inclusive of VAT, for each month from September 2012 to February 2015 are given and vary from a low of £83,311 in June 2014, (the next lowest being £130,348 in March 2014) to a high of £470,826 in January 2013. Figures of the number of items sold from September 2013 range from a low of 376 in June 2014 to a high of 1801 items in August 2014 (Wynne2).

36. Furniture products under the mark are said to have been advertised widely in the registered proprietor's catalogues produced in October 2012 (1 million copies), January 2013 (6 million copies), Autumn 2013 (500,000 copies), Christmas 2013 (4m copies), Winter 2013/14 (6 million copies) and Spring 2014 (500,000 copies). Of the October 2012 catalogue, half is said to have been distributed with *YOU* magazine with the remainder, split equally, being sent to previous customers or handed out in store. Of the January 2013 catalogue, 5.5m were distributed through the national press and the remainder again split equally between previous customers and handed out in store. At exhibits 5, 6 and 7 are extracts from these catalogues said to show the mark. Due to the very poor quality of reproduction, I cannot see the mark on the first two exhibits which are from the October 2012 and January 2013 catalogues. The material at exhibit 7 is said to be from the catalogues from the Autumn 2013 to Spring 2014 catalogues. On some of the pages I can see the word FURNITURELAND as well as "furnitureland" in lower case letters to the right of which is what appears to be a silhouette of a shape of a house.

37. I remind myself that the relevant period in relation to this registration is 11 March 2006 to 10 March 2011. The only evidence relating to use within this period is that of an advertisement (Duggan) published in the *Daily Star* on 10 March 2011, the very last day of the relevant period. This is the same evidence as was relied on in the earlier revocation proceedings referred to above and which was found not to constitute genuine use. Mr Tritton did not seek to persuade me that there could be any different finding in respect of the current case, however, that does not mean that the registration should be revoked. As I indicated earlier, the registered proprietor also relies on the alternative defence that use of the mark resumed after the relevant period.

38. Whilst the registered proprietor's evidence is not without fault, it is sufficient, as the applicant now accepts, to show genuine use of the mark FURNITURELAND. Despite his comments on the extent of use, Mr Davies does not deny that the use has been made in relation to a wide range of furniture as set out above. I reject Mr Davies' submission that the specification should be limited to wooden furniture. I also reject his later submission that it should be limited to whatever other type of furniture the evidence shows.

39. Mr Tritton submitted that it is not appropriate to limit a specification on the basis of a characteristic of goods. He went on to submit :

“...furniture is not only a fair specification, there has been wide use across that range of furniture and that it would be unfair, and indeed an artificial distinction, to start trying to split this specification into, for instance, tables, chairs, cupboards, sideboards, display units, etc., etc. “

40. I agree with Mr Tritton. Whilst the evidence shows furniture that could be described as being for a specific use e.g. dining tables, the evidence shows a much wider range of goods being offered for sale. Whilst I am sure that it is possible to name some specific items of furniture which have not been shown in the evidence, the range of furniture shown, and now accepted to have been sold under the mark, is a wide one. I do not consider the relevant consumer would refer to the goods on which genuine use has been shown as anything other than *furniture* which is a fair specification for the use shown.

41. The application to revoke registration No 1550700 fails in respect of *furniture* but, given the registered proprietor's concession, succeeds in respect of *parts and fittings therefor*.

Registration no 2183949B

42. On behalf of the applicant, Mr Davies submitted that no use has been made of any of the marks within the series as registered. There is no mention in the evidence that I can see to the use of any of these marks and Mr Tritton did not refer to me any whether during any of the relevant periods or at any later date. Indeed, in his skeleton argument he accepted that the registered proprietor “acknowledges that is has not made use of the Device Marks in precisely the form registered...” Again, that is not the end of the matter, as the registered proprietor makes the alternative claim under section 46(2) of the Act that there has been use of a mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In making this claim, it relies on the use made in the form as registered under no 1550770.

43. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was) sitting as the Appointed Person summarised the test under section 46(2) of the Act as follows:

"33. The first question [in a case of this kind] 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 that 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."

See also *Remus Trade Mark* – BL O/061/08 (Appointed Person) & *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (Ch) and *Orient Express Trade Mark* - BL O/299/08 (Appointed Person).

44. In his skeleton argument, Mr Tritton submitted:

- “a. The Device Marks consist of the word ‘FURNITURELAND’ accompanied by ornamentation and background colouring;
- b. such ornamentation and background colouring is neither eye catching, noticeable, memorable or dominant with regard to the word element;
- c. the Device Marks thus comprise a dominant word and subservient ornamental elements; and
- d. the only common element to the series of device marks is FURNITURELAND. Accordingly, the reasonably observant reader of the registration would recognise that the registrant was seeking to register FURNITURELAND with various variants of decorative background elements.”

45. In support of his case, Mr Tritton referred me to the *CHLOREX* (R 0579/2008-2) and *FRIBO* (T-324/09) decisions and submitted that, as the OHIM Guidelines on Proof of use state: “where the decorative elements can be considered banal, then their omission does not change the distinctive character of the sign”.

46. In the *CHLOREX* case, the consideration was whether use of the mark *CHLOREX* was use which did not alter the distinctive character of a composite mark where the word *CHLOREX* was presented in an upward V formation below which was a triangle device containing two test tubes, the mark being relied on for goods registered in classes 1 and 3. In the *FRIBO* case, the consideration was between the word *FRIBO* and a composite mark where the word (with a stylised letter R) was presented on a background that was described as a “ribbon or tag”.

47. Mr Tritton went on to submit:

“In the present case, the figurative elements of the Devices Mark are background decorative features that can be considered wholly subordinate to the word mark and also banal decorative elements.”

48. Mr Davies submitted that the marks in suit could be distinguished from those referred to by Mr Tritton. He submitted:

“We say that the composite mark is more than merely a depiction of the word FURNITURELAND...Clearly, there is a distinct pattern in the mark, in each of the iterations of it, lines appear between the two words and in four of the six versions the words FURNITURE and LAND are on separate lines and are not continuous. On the first two they are in different colours and the background is different, and there is a clear line between the two. We say that none of these actually say FURNITURELAND in plain vanilla terms in any event, regardless of the fact that there are other elements in the composite mark...”

We say the overall impression of this composite mark is not that of FURNITURELAND as a word mark because that would be to extend its protection beyond what it is entitled to, but it is to a composite mark that has not been used ever, as far as we are aware...”

49. As shown on the front cover of this decision, the six marks consist of a number of elements. Each is presented on a rectangular background made up of a darker and a lighter section (whether in colour or not). The word ‘Furniture’ is presented on the darker section, the word ‘land’ on the lighter section. In the first two marks, the two sections are positioned beside each other and there is a contrasting cursive swirl under the letters ‘reland’. In the remaining four marks, the darker and lighter sections are placed one on top of the other with the contrasting cursive swirl appearing in the lighter section and extending almost the full width of it. As indicated above, the colours blue, yellow and red are claimed in three of the marks. The 6 marks each have the dual coloured rectangular background and swirl device which are elements not present in the mark for which use had been shown. Whilst these other elements are part of the marks and may be noticed by the relevant consumer, they are not distinctive elements and, in the context of the marks as wholes, are wholly subordinate to the words appearing on them. I do not consider that the fact that the words ‘Furniture’ and ‘land’ could be said to have a degree of separation, either by their different coloured backgrounds or by the fact that, in respect of marks 3-6 they appear one word above the other, alters the fact that the distinctive character of the mark rests in the combination of the words “Furnitureland”.

50. Consequently, I find that use of the mark FURNITURELAND is use in a form differing in elements which does not alter the distinctive character of the six marks in the form in which they were registered and therefore the registered proprietor succeeds in its defence brought on grounds under section 46(2) of the Act.

Summary

51. Each of the registrations will be revoked with effect from 11 March 2011 insofar as they are registered for *parts and fittings therefor*. They will remain registered for *Furniture*.

Costs

52. In both of his skeleton arguments Mr Davies submitted:

“The Appellant should receive an order for its costs of this hearing, in addition to the one already made by the Hearing Officer”.

Whilst I presume his use of the title “Appellant” is an error and is intended to mean ‘applicant’, there has been no order for costs already made to it in these proceedings.

53. Whilst the registrations will be revoked insofar as they cover *parts and fittings* the registered proprietor has retained its registrations and had the greater measure of success. It is entitled to an award of costs in its favour to reflect this.

54. As I have set out above, these proceedings were originally set down for a hearing on 2 November 2015. The fact that the hearing on the substantive merits of the case was adjourned on that day was wholly attributable to the fact that in the two days leading up to it, the applicant's representative filed a significant volume of correspondence and made a number of requests including a request to file evidence and cross examine one or more of the registered proprietor's witnesses. The last of this correspondence was filed some ten minutes before the hearing and led to the adjournment of that hearing. I indicated that I would consider an award to the registered proprietor in respect of it.

55. At the hearing Mr Tritton referred to his skeleton argument and submitted:

"...the conduct of this case has, quite frankly, in our submission, been a scandal by the applicant for revocation. I am not sure if I can say anything more, other than to say that at the very least we should have our costs off the scale for the adjourned hearing on 2 November. In fact, I go so far as to say that my clients should be compensated and by that I mean simply so that it is not substantially out of pocket in relation to its legal expenses in relation to the contact in relation to these proceedings. I have to say that I have been doing this job for some time and this is one of the more extreme cases that I have come across in relation to the conduct, and indeed if I may say so, the point being run was, as you rightly said and in our submission, incredible."

56. Mr Tritton has submitted a breakdown of the costs totalling some £14,257 with £1000 relating to the adjourned hearing itself.

57. To a certain extent, the preparation carried out by the registered proprietor for the hearing which was set down for 2 November 2015 would not needed to have been repeated for the hearing which was set down at the earliest possible opportunity, and took place, on 15 December 2015 though the cost of attendance would have been duplicated. There can be little doubt, however, that the registered proprietor will have been caused an amount of extra work and inconvenience because of what I consider to be the unreasonable behaviour of Mr Davies on behalf of his client and the confusing and sometimes contradictory arguments raised.

58. Taking all matters into account, I award costs on the following basis:

For preparing a statement and considering the statement of the applicant:	£300 x 2
For preparing evidence and considering and commenting on that of the applicant:	£1000
Preparing for and attendance at the hearing on 2 November:	£1000
Considering and responding to the late filed correspondence:	£500
Preparing for and attendance at the hearing on 15 December:	£900
Total:	£4000

59. I order Furnitureland.Co.UK.Ltd to pay Furniture Village Limited the sum of £4000 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of January 2016

**Ann Corbett
For the Registrar
The Comptroller-General**

ANNEX A

Elevation Legal
82 Dartmouth Park Hill
London
N19 5HU

Our ref: CA 500653
Your ref:
Date: 3 November 2015

Dear Mr Davies,

Trade Mark Registration Nos: 1550700 and 2183949B in the name of Furniture Village Ltd and consolidated cancellation actions Nos 500653 and 500654 thereto by Furnitureland.Co.UK.Ltd

A hearing was appointed to take place yesterday. In the two days leading up to the hearing, you made very late requests to be allowed to file evidence and to cross examine the registered proprietor's witness. On the morning of the hearing, you forwarded by email a fairly substantial amount of written material which neither I nor the other side had had the opportunity to review. In the event, I considered your requests as a preliminary point and heard submissions from both parties. I adjourned the substantive hearing to allow me properly to review the material you had filed. Having now done so and taking the submissions made by both parties into account, I write to advise you of my decision. **Both requests are refused.**

The requests were first made in an email sent to the registry on Thursday 29th October. In respect of the request to file evidence, you submitted that you had not thought it necessary to file evidence previously as you assumed that the registered proprietor was not going to attend the hearing and was not therefore defending the cancellation actions. It my view that argument is a non sequitur and the submission is, at best, misguided.

The registered proprietor had joined proceedings by way of the filing of counterstatements and had filed evidence in support of its case. Quite clearly, it was defending the cancellation actions. It was a matter for you and your client to review that evidence and, if you considered it appropriate, to respond to it within the period allowed. That period expired on 22 June 2015 without the applicant filing evidence. Whether or not the proceedings would eventually be determined from the papers or following a hearing would not have been known at that time and so this could not have had any effect on the applicant's consideration of whether or not to file evidence within the period allowed in any event. Absent evidence from the applicant, the parties were advised that they could request to be heard or could opt for a decision to be made from the papers already on file. You subsequently requested to be heard so a hearing was appointed. Whether or not the registered proprietor intended to attend that hearing (and there is no requirement that it should attend) could not have altered the fact that it was, quite clearly, defending the cancellation actions and a decision on the merits would follow. The simple fact remains that, for

whatever reason, the applicant did not file evidence within the period allowed for it to do so.

You also submitted that the evidence should be admitted because your client would otherwise be unfairly prejudiced. You referred to the fact that your client had previously filed cancellation actions against the registered proprietor in respect of other registrations for the same or similar trade marks which were, ultimately, successful (one being surrendered, the other proceeding to a full determination by the Appointed Person). You submitted that had you been aware of the current registrations when those earlier cancellation actions were launched, you would have applied to cancel them at the same time. You submitted that the reason you were unaware of the current registrations was because you could only assume they must have been “removed” from the register at some point then, subsequently, restored to it. You said you arrived at this assumption for several reasons, the first being that in an earlier Nominet dispute, the registered proprietor had not made any mention of these registrations and so must not have been aware of them itself. You also made reference to the fact that the registered proprietor had itself opposed a third party’s application for registration but had not relied on these registrations as part of that action. Finally, you submitted that when you sought a copy of the relevant registry file for registration 1550700, information was “missing” from it.

In my view, the allegation is simply not credible. There is no evidence that these registrations have, at any time, been removed from the register. Whilst the registered proprietor may not have referred to them when dealing with the Nominet dispute, that in no way goes to show that it was not aware of them or that they had been removed from the register as claimed. It simply shows it saw no need to refer to them. The same is true in respect of its opposition to the third party’s application for trade mark registration: the registered proprietor determined on which registrations it wished to rely in those proceedings and these registrations were not included. As for the claim that information was “missing” from the relevant registry file, it seems you requested a copy of the file for registration no 1550700 because there was an appeal pending before the Appointed Person in respect of the earlier cancellation proceedings. In respect of that registration, copies of the file were, at that time, held in paper form. Following an exchange of correspondence, you were eventually provided with a copy of the file and noted that it did not contain a copy of a form requesting to record an assignment. It was explained to you, in writing, that where a single form is filed seeking to record assignments of a number of registrations, the register is amended as required and a copy of the form is placed on the lead file rather than each individual file. It appears that no trace of the form was found on any of the available files in a resultant search. Whilst that is regrettable, it cannot be said that the absence of such a form in any of the files leads to a finding that the registration itself was, for unexplained reasons, “removed” from the register at some unknown date and at some later but equally unknown point “restored” to the register. I note, in passing, that the electronic version of the registration available, for example, on the IPO website shows the recordal of an assignment as well as subsequent renewal actions but mentions nothing that would indicate the validity of that registration, and therefore its presence on the register, had been subject to any challenge prior to the current proceedings. You requested that the officer who corresponded with you be brought to the hearing “for questioning”. For reasons that should be obvious, I refuse that request.

In my view, the applicant will not be unfairly prejudiced by the refusal to admit the evidence it now seeks to file. The applications for cancellation of the registrations are made on the grounds that the marks have not been used within given periods. The registered proprietor has defended on the basis that the marks have been used or, in the alternative, that such use was recommenced at a later date. This latter defence was not one that was claimed in the earlier cancellation proceedings involving different registrations. Under the provisions of Section 100 of the Trade Marks Act 1994, it is a matter for the registered proprietor has to “show” what use has been made of its registrations. It therefore bears the onus in these proceedings.

Whilst I have refused to admit the evidence the applicant now seeks to file, I have reviewed it de bene esse. It consists of a witness statement, presumably made by yourself. You indicated in your email that the evidence “calls into question the credit of the registrant’s witness”, however, in my view, it does no such thing. The content of the evidence is little more than a recitation of your claims as I have set out above. It would not be of any relevance to the matters I have to decide in the substantive proceedings. For all of the above reasons, I refuse to admit it into the proceedings.

In addition to seeking to file evidence, the applicant, through you, sought permission to cross examine the registered proprietor’s witness (singular). Its evidence takes the form of a witness statement of a Mr Wynne. In your email, you gave no indication of why you considered it necessary or appropriate to cross examine him other than claiming that your evidence (which I have refused to admit) calls his “credit” into question. At the hearing, you also indicated that you would want to cross examine another individual, a Mr Duggan. Mr Duggan had filed a witness statement in the earlier cancellation proceedings and extracts from that witness statement have been referred to by Mr Wynne in his witness statement. You submitted that you wanted to question both men on a range of topics on which they had not, in fact, given evidence. In my view, the requests are no more than a fishing exercise and, as with the request to file evidence, are wholly without merit and I refuse them.

That being the case, the substantive hearing will now be reappointed to take place as soon as is possible. As I indicated to both parties, I will consider an award of costs to the registered proprietor in respect of yesterday’s hearing as part of the overall costs award.

A copy of this letter has today been sent to Bracher Rawlins.

Yours sincerely,

Ann Corbett (Mrs)
Principal Hearing Officer