



Neutral Citation Number: [2018] EWHC 3608 (Ch)

Appeal Nos: CH/2011/0343 and CH/2011/0445

**IN THE HIGH COURT OF JUSTICE**  
**BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES**  
**APPEALS (Chd)**  
**ON APPEAL FROM THE UK INTELLECTUAL PROPERTY OFFICE**

Rolls Building  
7 Rolls Buildings, Fetter Lane  
London, EC4A 1NL

Date: 21/12/2018

**Before:**

**MR JUSTICE HENRY CARR**  
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**Between:**

**PATHWAY IP SARL**  
**(formerly REGUS NO. 2 SARL)**

**Appellant**

**- and -**

**EASYGROUP LTD**  
**(formerly EASYGROUP IP LICENSING LIMITED)**

**Respondent**

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**Mark Vanhegan QC** (instructed by **Kempner & Partners LLP**) for the **Appellant**  
**Simon Malynicz QC** and **Stephanie Wickenden** (instructed by **Stephenson Harwood LLP**)  
for the **Respondent**

Hearing date: 26 November 2018  
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**Judgment Approved**

## Mr Justice Henry Carr:

### Introduction

1. Unless familiar with the law of registered trade marks, you might think that it is relatively straightforward. Regrettably, you would be wrong. As illustrated by the recent judgment of Arnold J in *Sky Plc v SkyKick UK Ltd* [2018] EWHC 155 (Ch); [2018] RPC 5 ("the *Sky* case"), trade mark litigation can raise multiple legal issues of Byzantine complexity. In comparison with the *Sky* case, this judgment is a minnow. Nonetheless, it deals with some challenging issues, which require careful consideration.
2. This is an appeal from the decision of Mr M. Foley, an experienced hearing officer of the UK Intellectual Property Office (hereafter "UKIPO"), acting on behalf of the Registrar of Trade Marks, dated 6 June 2011 ("the Decision"). By the Decision the hearing officer revoked registered trade mark nos. 2160489 and 2208166 (individually "489" and "166" and collectively "the Trade Marks") with effect from 5 January 2004 and 24 June 2005 respectively ("the Relevant Period"), for non-use under section 46 of the Trade Marks Act 1994 (the "Act").
3. The Trade Marks are registered in respect of the sign "easyoffice" in various fonts and coloured backgrounds. The appellant is the registered proprietor of the Trade Marks. The specifications of both of the Trade Marks state that they are for "Provision of office facilities, rental of office equipment". In 2009 the respondent made two applications for revocation of the Trade Marks for non-use. By the Decision, the hearing officer found no genuine use during the Relevant Period of the Trade Marks that fell within the scope of the registered specifications and concluded that the registrations should be revoked in their entirety.
4. The hearing officer interpreted the scope of the services in the specifications, i.e. "the provision of office facilities" and "rental of office equipment", by reference to their natural and ordinary meaning. He then adopted a narrower interpretation of the specifications by reference to the Nice Classification lists in Class 35, which was the class in which the Trade Marks were registered. In so doing, he relied upon the judgment of the Court of Appeal in *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928; [2002] RPC 34 ("the *Altecnic* case").
5. The approach taken by the hearing officer, which had regard to the Nice Classification when considering the scope of the registered specifications, was in accordance with practice guidance published by the UKIPO and the European Union Intellectual Property Office ("EUIPO") (the details of which are set out below). However, the appellant contends that this approach is wrong in law, in the light of the judgments of Arnold J in *Omega Engineering, Inc v Omega SA* [2010] EWHC 1211 (Ch); [2010] FSR 26 ("the *Omega 1* case"); *Omega Engineering, Inc v Omega SA* [2012] EWHC 3440 (Ch); [2013] FSR 25 ("the *Omega 2* case") and *Fil Ltd v Fidelis Underwriting Ltd* [2018] EWHC 1097 (Pat) ("the *Fidelis* case"). Judgments in the *Omega 2* case and the *Fidelis* case were handed down subsequent to the Decision of the hearing officer.

6. The appellant has also applied for permission to adduce the prosecution files for the Trade Mark applications as fresh evidence in the appeal. This is unusual, as save in very limited circumstances the prosecution history is irrelevant and inadmissible when considering revocation for non-use.

### Chronology

7. This case has taken an extraordinary amount of time to reach this stage. A brief chronology was helpfully provided by Mr Vanhegan QC, who appeared for the appellant. I set out what I regard as uncontroversial dates and events.

10 March 1998	BAA Limited (which became BAA plc, a predecessor in title of the appellant) filed an application for 489 for the “provision of serviced office accommodation, business services”, in Class 35
8 April 1998	UKIPO objected to the specification.
15 May 1998	Following correspondence with the examiner, the appellant changed the specification of 489 to “Provision of office facilities, rental of office equipment”, still in Class 35.
4 January 1999	489 was registered.
9 September 1999	BAA Limited filed an application for 166 for the “Provision of office facilities, rental of office equipment”, in Class 35.
23 June 2000	166 was registered.
21 September 2009	The respondent filed applications for revocation of 489 and 166. It relied on sections 46(1)(a) and (b) of the Act. It sought revocation of 166 with effect from 24 June 2005 and revocation of 489 with effect from 5 January 2004.
8 April 2010	The applications for revocation were consolidated.
14 October 2010	Hearing before the hearing officer.
6 June 2011	Decision of the hearing officer who found no genuine use falling within the scope of the registered specifications and decided to revoke 166 with effect from 24 June 2005 and 489 with effect from 5 June 2004.

December 2011	The parties consented to an adjournment of the appeal in the light of a pending reference to the Court of Justice of the European Union (“the CJEU”) in Case C-307/10 <i>Chartered Institute of Patent Attorneys v Registrar of Trade Marks (IP Translator Trade Mark)</i> ECLI:EU:C:2012:361; [2013] RPC 11 (“the <i>IP Translator</i> case”).
19 June 2012	Judgment of the Grand Chamber of the CJEU in the <i>IP Translator</i> case.
17 December 2012	The appellant changed its name to Pathway IP SARL.
8 May 2014	The respondent changed its name to Easygroup Ltd.
5 January 2018	The appellant made an application to adduce fresh evidence in the appeal.
26 November 2018	Hearing date of the appeal.

8. Two points emerge from this chronology. First, the appellant needs to show genuine use within the Relevant Period between 21 September 2004 and 20 September 2009. Secondly, after the *IP Translator* case had been decided by the CJEU, the appellant did not seek to relist its appeal until receiving a letter from the respondent dated 31 January 2017 asking for confirmation that the appeal was no longer being pursued. Although the appeal had been adjourned, there was no stay. The respondent contended that the reason why the appeal was not prosecuted was because, while the appeal was pending, the Trade Marks remained on the Register and from the perspective of third parties and the public they were valid and enforceable. This is strongly denied by the appellant, who claims that settlement discussions were continuing at least until 2017. Even if I had the material to decide this dispute, which I do not, I regard it as irrelevant to the issues on this appeal. The respondent has not applied to strike out the appeal and therefore, it has to be decided.

### **Relevant sections of the Act**

9. Section 46 of the Act provides as follows (so far as relevant):

“46 Revocation of registration.

(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;

...

...

(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.”

10. Section 100 of the Act provides as follows:

“100 Burden of proving use of trade mark.

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.”

## **The Decision of the hearing officer**

### *The Evidence*

11. After having given the background to the consolidated applications, the hearing officer summarised the evidence at [8] – [17] of the Decision. This consisted of four witness statements.

12. Mr Holah, a partner at Field Fisher Waterhouse LLP, made two witness statements, both dated 22 March 2010, which differed only in relation to one exhibit. Exhibited to these witness statements was a Counterstatement dated 3 December 2007, made in relation to previous revocation proceedings brought against BAA Limited by Nuclei Ltd (to whom the Trade Marks were subsequently assigned by BAA Limited) in respect of 166. The Counterstatement served by BAA Limited asserted at paragraph [1] that the then proprietor provided serviced office facilities and equipment at Gatwick Airport under and by reference to 166. The Counterstatement asserted at [4] – [5] that:

“4. The Proprietor has made genuine use of the Mark for all services for which it is registered in class 35. Attached and marked Annex 2 are various Easyoffice Occupation Agreements with licence periods commencing from 26 April 1999 to 1 August 2007. These are black and white copies of colour documents which have been redacted to remove

commercially sensitive information. Attached at Annex 3 is an example of the Occupation Agreement showing the Proprietor's Mark in colour. Further, attached at Annex 4 is sample marketing literature advertising the Proprietor's services dated and in use from May 1999.

5. All units on the Proprietor's premises are currently, and have consistently been, occupied and it has thus been unnecessary to engage in any further advertising or marketing campaign. However, the Proprietor's services have at all material times been branded with and by reference to the Mark continue to be so branded.”

13. In its annexures the Counterstatement provided documents purporting to evidence that use, including:
- i) Various occupation agreements relating to the letting of office facilities, with licence periods between 1999 and 2007, which listed various items such as computers, printers and fax machines as being available. As the hearing officer noted, not all occupation agreements were included. Although numbered from 1 to 41, numbers 9 to 20 and 22 to 24 were not included in the exhibit.
  - ii) An advertising leaflet dating from May 1999, advertising the availability of serviced offices, marketing and training facilities, additional office and display equipment and car parking.
14. The third witness statement was made by Mr Regan, the then Group Legal & Commercial Director of Regus Plc, of which the appellant was a subsidiary, dated 19 March 2010. The hearing officer summarised Mr Regan's evidence as follows:

“12. Mr Regan says that Nuclei Limited had been acquired by Regus Group in 2007 at which time they had already traded under the mark EASYOFFICES. He says that prior to the acquisition, a due diligence search was carried out which revealed that BAA owned the registrations for EASYOFFICE. As it was not known whether the marks were being used by BAA, the revocation actions were launched. Mr Regan says that after the filing of the revocations, he established that the marks were used in relation to a set of serviced offices in Atlantic House at Gatwick Airport. He recounts having visited these premises in July 2007, finding that the building was occupied by a variety of different businesses, including EasyOffice, who had rooms on the first and second floor of the main building. He says that the signage for EasyOffice featured the trade mark as protected by registration No. 2208166.

13. Mr Regan says that from his visit it was clear that the EasyOffice brand was in use and so negotiations to purchase the registrations commenced with BAA, part of which would be a license for BAA to continue to use the marks. Mr Regan

says that he also saw evidence filed by BAA in earlier revocation proceedings which confirmed the use that he saw during his visit.”

15. The fourth witness statement was made by Mr Guise, a solicitor at Field Fisher Waterhouse LLP, dated 19 March 2010. The hearing officer summarised Mr Guise’s evidence as follows:

“15. Mr Guise says that on 15 March 2010 he carried out searches on the internet, the results of which he provides as Exhibits HG1 to HG5. Exhibit HG1 consists of a print from the BAA Gatwick website headed "Rental Guidelines from April 2009" and includes price lists for the majority of the office and industrial accommodation available for rent at the Gatwick site as at April 2009. EasyOffice is shown as the only supplier of "serviced offices", providing a telephone for enquiries.

16. Exhibit HG2 to HG5 consist of prints from various property and business advice websites advertising the availability of premises at Atlantic House, Gatwick Airport, each stating that the property "benefits from easymeeting and easyoffice facilities" and that "the easyoffice product includes a suite of furnished offices suitable for immediate occupancy".”

*The key parts of the Decision*

16. The hearing officer began his analysis at [25] of the Decision. He stated that as a matter of plain language, “rental of office equipment” was “no more and no less the rental of any equipment that may be used in an office”. He noted that, in the Nice Classification, the entry “Rental (Office machines and equipment –)\*” in Class 35 included an asterisk, which indicated that the rental of machines and equipment that may be used in an office could also be found in other classes. He also noted that while the rental of photocopiers was listed in Class 35, the rental of fax machines, modems and phones was in Class 39, the rental of computers was in Class 42, and the rental of furniture was in Class 43. He concluded that the specifications of the Trade Marks could therefore not cover these services. He added that the rental of printers would also fall into Class 42 as a computer peripheral.

17. At [26] the hearing officer considered the natural and ordinary meaning of “the provision of office facilities” and concluded that:

“26. An office “facility” can be anything that facilitates the functioning of an office, which in class 35 can be a physical item (within the scope set out in the previous paragraph) or a human endeavour such as secretarial typing services, data processing and document reproduction, etc.”

18. At [27] he said:

“27. An “office” in terms of a place at which to do something would not, in normal parlance be referred to as “equipment”,

being more rather a “facility” but that does not mean such a service falls within the description of “Provision of office facilities” in Class 35. The applicants drew my attention to the Nice Classification, in particular, the explanatory notes for Class 35, and the entry “Rental of offices [real estate]” listed as being proper to Class 36. There is also an entry “Rental of meeting rooms” showing this service to be proper to Class 43 along with the provision of temporary accommodation that is more for short-term use. As the subject registrations are registered in Class 35 the registrations cannot encompass the service of renting office accommodation.”

19. The hearing officer then assessed whether there had been any genuine use of the Trade Marks in respect of such services. At [28] he said:

“28. Having ascertained the scope of the specifications for which the subject marks are registered, I need to assess whether there has been any use of the marks in respect [of] such services. As the applicants highlight, the evidence in this case is not extensive, consisting primarily of a collection of Occupation Agreements numbered from 1 to 41, although, as I indicated above, not all Agreements within this number run have been provided. The Agreements relate to the provision of office facilities by Gatwick Airport Limited at "EasyOffice premises at Gatwick Airport". The first Agreement was signed on 19 April 1999 and relates to the provision of office No 118a for the period 26 April 1999 to 25 April 2000. Under ["Additional facilities" can be seen that this included the provision of a "one desk and one chair", a "small table" and two "easy chairs". The Agreements list "Additional facilities" as being available, including "stand alone" and "networked" personal computers, printers, fax machines and "other". Car parking is also available to order. The latest of the Agreements relates to the letting of office No. 119b for the period 1 August 2007 to 29 February 2008. Apart from 2003 there is an agreement for each intervening year, with most activity taking place in 2006 and 2007. Whilst the information relating to the customer's details has been redacted, it is possible to see from the signatures that some Agreements are repeat bookings.”

20. Mr Vanhegan pointed out that this paragraph contains one of several errors in the Decision, possibly explicable by the lapse of time of eight months between the hearing and the Decision. The occupation agreement for 2003 was exhibited whereas the agreement for 2002 was not. A further example is at [7]. The hearing officer stated that the applicants were represented by Kirsten Doherty. This was incorrect. They were represented by Guy Hollingworth.
21. I do not consider that errors of this nature are material to the Decision. They are typographical errors or obvious corrections which Counsel would have corrected before the Decision was approved if, as in the High Court, a draft of the Decision had been sent out for this purpose.



22. At [31] he considered the occupation agreements and stated that:

“31. The Agreements also have a menu item of "other". It could be argued that this is use in respect of the rental of office equipment, however, the registered proprietors have listed items of office equipment that they had available for rent, none of which fall within the scope of Class 35 and therefore the specifications of the subject registrations. These "other" facilities may, or may not, involve the provision of equipment or facilities that would be proper to Class 35 but it cannot be right simply to surmise that "other" means "anything possible". None of the Agreements shows anything has been provided that would fall within the scope of the registered specifications.”

23. At [32] he turned to the advertising leaflet from 1999. He concluded that of the “facilities” listed, only photocopying fell within the scope of the specifications. He noted that this was listed as “access to photocopying facilities” in the leaflet and said that the use of the word “access” made it unclear whether the service was provided by Easyoffice or a third party. He concluded that:

“Easyoffice is a service that provides the physical space of an office with facilities and equipment provided as an adjunct; listed as an option available only to those renting their office space rather than a general service.”

24. At [33] the hearing officer considered whether he was able to gauge the extent of use of the Trade Marks, and whether the use was as an adjunct to the rental of office space. He said:

“33. Where I have some difficulty is in gauging the extent of the use that has been made of the marks. Apart from knowing that the services have been offered and provided under the marks since 1999, and potentially, that 41 agreements were concluded, there is nothing that informs me about the extent of any commercial exploitation, be that in sales on the market concerned, or in promotional activities. Whilst the use need not be quantitative significant for it to be deemed genuine, the fewer the instances, the more conclusive the evidence must be. The Agreements are "conclusive" instances that there has been use and, in combination with the leaflet, show this to have extended to providing access to photocopying facilities under the mark. So, notwithstanding the lack of detail, I consider there is sufficient from which to infer that there has been real (and not token) use, which is consistent with the essential function of a trade mark, in respect of the provision of the rental of office space. Part of this has involved the provision of "office facilities" but as I have highlighted, this has been as adjunct to the office rental to those renting their office space rather than a general service. As such, this does not amount to "real commercial exploitation of the Mark on the market for such [services]..." aimed at maintaining or creating an outlet

for the goods or services for which the mark is registered, or a share in the market for such goods or services" *Ansul*, [37]-[38]; *Silberquelle*, [18].”

### **The issues on this appeal**

25. The issues can be summarised as follows:

- i) Whether the appellant’s application to adduce additional evidence on appeal should be granted.
- ii) Whether the hearing officer wrongly construed the scope of registered services by reference to the classes set out in the Nice Classification; in particular, after stating that the scope of the registered services should be construed by reference to the words used in the specification, by giving such words the meaning that they possess as a matter of ordinary language, whether the hearing officer erred as a matter of law by narrowing the natural meaning by reference to Class 35 of the Nice Classification.
- iii) Whether the hearing officer compounded his alleged error by excluding any services which could be construed as falling within the categorisation of services set out in any of the other classes of the Nice Classification, even though such classes are not mutually exclusive, and by referring to the wrong edition of the Nice Classification.
- iv) Whether the evidence filed by the appellant showed genuine use of the Trade Marks during the Relevant Period.

### **Nature of an appeal to the High Court**

26. The approach which the Court should take on appeals such as the present was not in dispute, and was summarised by Floyd J in *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch); [2011] ETMR 22 ("the *Galileo* case"), at [11]-[14]:

“11 This is an appeal brought pursuant to s.76 of the Act. Such appeals are not by way of a rehearing but are a review. The principles were set out by Robert Walker L.J. in *Bessant v South Cone Inc (REEF Trade Mark)* [2002] EWCA Civ 763; [2003] R.P.C. 5, at [17]–[30]. Robert Walker L.J. said at [28]:

“The appellate court should in my view show real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

12 At [29], Robert Walker L.J. said this:

“The appellate court should not treat a judgment or a written decision as containing an error of principle simply because of its belief that the judgement or decision could have been better expressed.”

13 In that case the High Court judge had reversed the decision of a Hearing Officer. The Court of Appeal held that he had been wrong to do so. Robert Walker L.J. in dismissing the appeal said this: “I consider that the Hearing Officer did not err in principle, nor was he clearly wrong.”

14 I conclude that, unless I am satisfied that the Hearing Officer made an error of principle, I should be reluctant to interfere. I should interfere if I consider that his decision is clearly wrong, for example if I consider that he has drawn inferences which cannot properly be drawn or has otherwise reached an unreasonable conclusion. I should not interfere if his decision is one which he was properly entitled to reach on the material before him.”

### **The appellant’s application to adduce additional evidence on appeal**

#### *Legal principles*

27. I considered the new evidence which the appellant applied to adduce *de bene esse* and indicated that I would decide this issue as a part of this reserved judgment. I set out the principles in relation to the exercise of the Court’s discretion to admit fresh evidence in trade mark appeals in *Consolidated Developments Ltd v Cooper* [2018] EWHC 1727 (Ch); [2019] FSR 2 and I shall apply those principles to the present application. At [19] of that judgment, I said:

“19. As Lewison LJ memorably observed in *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, [2014] F.S.R. 29 at [114], the trial is not a dress rehearsal: it is the first and last night of the show. This emphasises the need to adduce all relevant evidence at the first hearing, rather than to attempt to adduce further evidence on appeal. Once the last night of the show has finished, the audience are unlikely to be interested in additions to the script.”

#### *Application to the facts*

28. I have reached the conclusion that in all the circumstances, the application by the appellant to adduce additional evidence on appeal should be refused. My reasons are as follows:

#### *The evidence could have been filed earlier and no adequate explanation has been offered to explain the delay*

29. Mr Vanhegan contended that the first occasion upon which the appellant became aware that the respondent would seek to assert that some of the services in respect of which the appellant alleged genuine use fell outside of the scope of the registration was on receipt of the respondent’s skeleton argument before the hearing officer on 12 October 2010 (the hearing having been fixed for 14 October 2010). He explained that the point had not been pleaded by the respondent. Mr Małyńcz QC, who appeared for the respondent, pointed out that the pleadings were not in evidence.

The appellant indicated that all the pleadings were in the appeal bundles. I have no reason to doubt what Mr Vanhegan said. If the respondent wished to dispute this, it could have shown me that the issue had been pleaded. It did not do so.

30. Mr Vanhegan pointed out that the respondent served no evidence in relation to the revocation proceedings. It did not lead any evidence as to the Registry practice current at the time of the applications for the Trade Marks, nor put in evidence the relevant edition of the Nice Classifications or list of services in respect of each class.
31. Mr Vanhegan submitted that the first time that it was suggested that services such as the provision of desks and cupboards, a voicemail answering service, fax machines, PCs and printers etc. fell outside the scope of the Class 35 registration was when it appeared in [25] of the hearing officer's Decision, which was not given until 6 June 2011. Accordingly, he submitted that prior to the hearing it was not reasonably to be expected that the evidence which the appellant now seeks to lead would have been relevant or necessary to any issue to be determined at the hearing. I accept this submission, and I consider that this provides an explanation as to why the evidence was not submitted by the date of the hearing.
32. However, as the appellant pointed out in its skeleton argument, the hearing officer took a full eight months before delivering the Decision. In my judgment, it was apparent to the appellant on receipt of Mr Hollingworth's skeleton argument, and following oral argument at the hearing, that it was being asserted that the use relied upon by the appellant fell outside the scope of Class 35. The appellant had ample time to draw the hearing officer's attention to the prosecution history before he handed down the Decision. The hearing officer could then, if he considered it relevant, have dealt with it in his Decision. The appellant did not do so. A party acting with reasonable diligence in respect of this evidence would have done so. There was no explanation as to why the appellant did not do this.

*The evidence is inadmissible and irrelevant*

33. This is a fundamental objection, which requires consideration of the content of the prosecution files.

*Content of the prosecution files*

34. In relation to 489, on 10 March 1998, the appellant's predecessors in title (BAA Limited) applied to register the mark in respect of the "Provision of serviced accommodation; business services" in Class 35. It had the benefit of expert advice from D Young & Co. On 8 April 1998, the examiner wrote to D Young & Co stating that the application did not appear to meet the requirements for registration and enclosed an Examination Report. The Examination Report said that:

"Class 35 – Specification

There is an objection under Section 3(6) because the specification is so wide that there is some doubt about the accuracy of the statement on the application form that the applicant is using, or intends to use, the mark on all the goods/services applied for. The goods/services should therefore

be listed by name and restricted, or documents or other information supplied to show that the specification accurately describes the range of goods/services for which there has been market use, or which are proposed to be used.

This objection has been raised in view of the wide term this objection has been raised in view of the wide term ‘Business services’.

The specification is not acceptable because the following terms are not understood, or are too imprecise for classification purposes:-

‘Provision of serviced office accommodation’. I would be grateful for some information with regard to the services as they may be proper to other classes e.g. class 36.”

35. On 1 May 1998 D Young & Co submitted a letter enclosing an easyoffice leaflet dated January 1998, (“the 1998 Leaflet”). The information contained in the 1998 leaflet is materially the same as the information set out in BAA’s easyoffice leaflet dated May 1999 which is referred to by the hearing officer in the Decision, as identifying a number of services which do not fall within the specification.
36. The letter of 1 May 1998 said:

“With regard to your query concerning the specification of services, we attach a leaflet giving details of our client’s “easyOFFICE” services. We would suggest that these could properly be described as business support services involving the provision of reception, secretarial, photocopying and communication services. Alternatively, “office support services” would appear to be an appropriate term

The essence of serviced office accommodation is that the supplier provides to the customer the type of office services which would be available normally to a business which had its own office accommodation and staff. In the present case, the arrangement is that these are rented out to customers by the hour, the day or the week as the case may be.”
37. Mr Malynicz drew attention to the characterisation of the services offered by the applicant as “the provision of reception, secretarial, photocopying and communication services”. He pointed out, correctly, that this characterisation is not consistent with the case now sought to be advanced by the appellant on this appeal. However, since I consider that the prosecution files are irrelevant and inadmissible, this point is not open to the respondent.
38. On 15 May 1998, the examiner wrote to D Young & Co thanking them for the further information. The letter said:

“I suggest the following for your consideration in respect of the specification: “Provision of office facilities, rental of office equipment”. The above specification would also overcome the Section 3(6) objection.”

39. On 15 July 1998 D Young & Co wrote to confirm acceptance of the examiner's revised specification. On 31st July 1998 the application was formally amended to “Provision of office facilities, rental of office equipment”.
40. In relation to 166, on 9 September 1999 BAA applied for 166 in relation to “Provision of office facilities, rental of office equipment”, (Class 35). On 22 September 1999 the examiner raised an objection under section 41(2) of the Act in respect of the allowability of each of the images as a series of marks. No objection or comment was made as to the specification of services or the class in respect of which it was applied for. Following a hearing on 10 January 2000 the examiner determined that the differences in the marks were immaterial and thus waived the series objections under section 41(2).
41. The appellant contends that the prosecution history is relevant for the following reasons. The specific services considered by the hearing officer not to fall within Class 35 were considered by the Registry as at 1998 as being appropriately and fairly described by the term: “Provision of office facilities, rental of office equipment”. That term was not volunteered by the applicant but suggested by the Registry. When making that suggestion, the Registry specifically had in mind whether there might be other classes in which such services might be more appropriately registered; but as at 1998, the Registry considered that such services should be registered in Class 35. This is said to be evidence of Registry practice at the material time, which is said to be relevant to the *Altecnic* issue.
42. I reject this submission. The prosecution history shows that, with the benefit of expert advice, the applicant for the Trade Marks chose to apply for them in Class 35. It did not choose to apply in a different class e.g. Class 36, nor to specify the goods or services by name in the specifications. That was a decision for the applicant.
43. I do not accept that the letter of 19 May 1998 evidences Registry practice at the time. It was no more than one of a number of suggestions by an individual examiner, which the applicant was free to adopt or reject. It was also free to challenge the decision of the examiner if it considered it to be wrong.
44. Jacob LJ considered the relevance of prosecution history to determination of the scope of a trade mark specification in *Phones 4U Ltd v Phone4u.co.uk Internet Ltd* [2006] EWCA Civ 244: [2007] R.P.C. 5. He held that other than in the case of a limitation under section 13 of the Act, it was irrelevant:

“71 As to the permissibility of using the correspondence with the Office, it is the general rule that one does not go to the prosecution history of a monopoly to determine its extent. Thus, in the context of patents Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] R.P.C. 9 at [35] said:

“The courts of the UK, the Netherlands and Germany certainly discourage, if they do not actually prohibit, use of the patent office file in aid of construction. There are good reasons: the meaning of the patent should not change according to whether or not the person skilled in the art has access to the file and in any case, life is too short for the limited assistance which it can provide.”=

72 But the position is different in the case of a limitation under s.13. For there one asks whether the trade mark owner has agreed to a limitation. Clearly what is contemplated is some sort of agreement with the Office—which I think could result either from an original agreement in the application at the outset or as the result of a limitation proposed during prosecution. So, in that narrow context one can reasonably expect to look at the prosecution history to see whether there was an agreement.”

45. It is possible that there are other cases, not concerned with limitation, where the Court will be prepared to consider the prosecution history. For example, in the *Altecnic* case, which was concerned with amendment of a trade mark application, the prosecution history was discussed. In addition, account now has to be taken of the judgment of the Supreme Court in *Actavis UK Ltd v Eli Lilly and Co.* [2017] UKSC 48; [2017] RPC 21 at [87] – [88]. However, the fact that, in limited circumstances, the Court may consider patent prosecution history when addressing the question of infringement by equivalents (and in particular the third question formulated by Lord Neuberger) has no relevance to the application before me. In *L'Oréal SA v RN Ventures Ltd* [2018] EWHC 173 (Pat); [2018] FSR 20, I emphasised that reference to patent prosecution history is the exception, and not the rule, and that parties should think carefully in future before incurring additional costs in arguing about the prosecution history. The same is true, to an even greater extent, in proceedings concerning registered trade marks.
46. For these reasons, I decline to exercise my discretion to admit the fresh evidence.

### **The *Altecnic* and *Omega 1* cases**

47. Before turning to the question of the effect (if any) of the class number on scope of the specification, I shall consider the judgments in the *Altecnic* and *Omega 1* cases, which have given rise to the debate in the present appeal.

#### *The Altecnic case*

48. The applicant in *Altecnic* had applied to register a trade mark in Class 7 for “Valves; valves for use in water circulation; blending valves; and all other goods/services in this Class.” It then wrote to the Registry claiming that it had made a mistake and that the application should instead be classified in Class 11. It was permitted to delete the words “and all other goods/services in this Class” pursuant to section 39(1) of the Act, as it thereby restricted the goods covered by the application. It was common ground that Class 11 was the more appropriate class for the goods of interest to the

applicant. The Registry allowed the request and arranged for the application to be transferred from Class 7 to Class 11.

49. During an opposition it was claimed by the opponent that the decision by the Registry to amend the classification of *Altecnic's* application was *ultra vires*. The hearing officer held that the change in class was indeed *ultra vires*. The power to amend applications is set out in section 39(2) of the Act. The only relevant power was to correct obvious mistakes. The hearing officer explained that the application form must list the goods or services on which the trade mark is used or is proposed to be used. If a class number is relied on, together with a description of the goods and/or services which may be ambiguous, then that class number must be considered part of the descriptor attached to the list. If the list of goods and services is at odds with the stated class number the Registrar must be able to correct the classification under the provisions of Section 34(2) or 39(2)(c) of the Act. There was, however, no power to accede to the application of *Altecnic* to amend the class. It was clear that the valves fell within Class 7, which was not at odds with the listed goods, so there was no inconsistency within the class number and the specification of the goods. There was no "obvious mistake" which could be the subject of an amendment under section 39(2)(c).
50. In allowing the appeal from the decision of the hearing officer, Laddie J held that:
- i) Classification is primarily a matter of administrative convenience, the classes representing "convenient, but loosely defined, pigeonholes into which applications can be put".
  - ii) There is a distinction between the classification of the trade mark and the specification of goods to which it is to be applied.
  - iii) Section 32 does not impose on the applicant any obligation to define the class into which the registration falls.
  - iv) Classification is determined under section 34 of the Act by the decision of the Registrar in the exercise of his discretion which cannot be challenged on appeal and is only subject to judicial review if irrational.
  - v) The distinction between the specification of goods on an application for registration and the classification of trade marks under section 34 directly affects the issue of amendment under section 39.
51. Laddie J stated at [25] of his judgment that:

"It follows that the argument that the amendment here has to be shown to be obvious is misplaced. A change of class under s.34, even if initiated by the proprietor, may well not be an application to amend the application. I use the expression "may well not" here deliberately. In some cases, a proprietor may define the goods or services to which he intends to apply the mark by reference to a particular class. For example, he may apply for a mark in respect of "all goods in Class X" or "the following goods in Class X." If that form for wording is used



then the proprietor may be held to have adopted the existing classification so as to define what goods he intends to use the mark on. In other words, the form of words used in the classification has been adopted as the statement of goods or services required by section 32(2)(c). To that extent the classification becomes part of his statement of goods and, if so, changing the class may amount to an alteration of the goods or services in relation to which it is sought to register the mark. However, in this case the statement of goods was “Valves; valves for use in water circulation; blending valves.” After the change of class, the statement of goods was unaltered.”

52. In summary, the learned judge considered that since the specification did not refer to goods in Class 7, and since the class was for administrative convenience only, it did not affect the scope of the specification and therefore amendment was possible under section 34 of the Act. It was not necessary to show that an obvious error had been made.

53. This argument was supported by the respondent on appeal. Its argument is recited at [37] of the judgment of Mummery LJ.:

“37. Mr Purvis contended that the judge was right for the reasons he gave and adopted the judge's analysis of the system of classification of goods and of the distinction between the power to permit amendment of an application under section 39 and the power to change the class of goods under section 34. He emphasised that the classes of goods varied greatly in terms of generalisation, were not by definition mutually exclusive and were neither precise nor logical. They had always been treated as a matter of administrative convenience only. So far as the applicant was concerned there was no obligation on him under section 32 to make an application by reference to any particular class. Classification was an administrative matter for the Registrar under section 34. The change of class in this case was a decision within his discretionary power.”

54. That submission was rejected by the Court of Appeal. In addition to submissions from the parties, the Court heard submissions from the Registrar on the law and the practice in the Registry. It also asked for information about practice on this point from the Office for Harmonization in the Internal Market (OHIM, now EUIPO). The Court concluded that Class 7 was a part of Altecnic's application in the context of the specification of goods. The fact that the system of classes of goods is for the purpose of administrative convenience or that the identification of the class number serves such purposes did not prevent the statement in the class number from being a part of the application, which can only be amended in accordance with the provisions of the Act and the Trade Mark Rules. Since valves fell within Class 7, this was not an obvious mistake. It was an amendment of the application which could only be made under section 39(2) of the Act and not simply by virtue of the determination of the question under section 34.

55. In an important passage at [42] Mummery LJ, with whom the other members of the court agreed, said:

“This result is not inconsistent with the approach in the current general practice of the Registry nor, as I understand it, with the general practice of OHIM in dealing with amendments to an application by treating the Class number in the application for registration as part of the application. In my judgment, the Registrar is entitled to treat the Class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods. The application is a considered statement of the applicant which, on ordinary principles of the construction of documents, has to be read as whole to determine its meaning and effect. The fact that the internationally agreed Nice Classification System has been devised to "serve exclusively administrative purposes" (see, for example, Rule 2(4) of the Commission Regulation 2868/95 EC) does not mean that the selection by the applicant of one or more Class numbers in his application for registration has to be totally ignored in deciding, as a matter of the construction of the application, what the application is for and whether it can properly be amended. I would reject the submission of Mr Purvis that it is only permissible to take account of the Class number when it is expressly (or implicitly) referred to in the description of the "Specification of goods" column of Form TM3, as in the examples helpfully discussed by Jacob J in *British Sugar PLC -v- James Robertson & Sons Limited* [1976] RPC 280 at p.289 (e.g. consideration of the relevance of the practice of the Registrar at the date of registration of adding to the list "All included in this class" and "All included in class X"). That kind of case is no doubt a stronger one for interpretation of the application by reference to the Class number, but I fail to see why it should be the only kind of case in which the Class number can be taken into account by the Registrar or why the Registrar should have to ignore the Class number which the applicant (or his advisers on his behalf) have inserted in the Form TM3 as part of the required expression of the applicant's case in relation to the registration of the trade mark.”

56. In summary, the Court of Appeal relied upon the practice of the Registry and OHIM in dealing with amendments to an application by treating the class number in the application for registration as part of the application and held that:

- i) The Registrar is entitled to treat the class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the specification of goods;

- ii) On ordinary principles of construction, the application has to be read as a whole to determine its meaning and effect and the application includes the class number;
- iii) The fact that the Nice Classification System has been devised to serve exclusively administrative purposes does not mean that the selection of one or more class numbers has to be totally ignored in deciding, as a matter of construction of the application, what the application is for and whether it can properly be amended;
- iv) If the specification expressly refers to the class e.g. “all included in Class X” that is a stronger case for interpretation of the application by reference to the class number;
- v) However, that is not the only kind of case in which the class number can be taken into account by the Registrar, nor should the Registrar have to ignore the class number which the applicant (or his advisers’ on his behalf) have included.

*The Omega 1 case*

57. The *Omega 1* case concerned construction of a trade mark co-existence and demarcation agreement entered into between the parties on 11 April 1984. The claimant, Omega Engineering Inc, manufactured and marketed products for the measurement and control of temperature and other scientific measuring instruments under the trademark OMEGA; the defendant manufactured and marketed wristwatches and other chronometers. The defendant objected to the claimant's application to register the trade mark in respect of certain goods in Class 14. The claimant argued that pursuant to the 1984 co-existence and demarcation agreement the defendant had undertaken, amongst other things, not to object to its registration in respect of the goods applied for and by opposing the application, the defendant had acted, and continued to act in breach of the agreement. Arnold J granted summary judgment in favour of the claimant.

58. At [4], the learned judge said:

“For reasons that will appear, central to these disputes is a very technical, not to say arcane, area of trade mark law, namely that of classification. In order properly to understand the disputes, let alone to resolve them, it is essential to know the relevant law at the relevant dates, namely April 1984 and May 2007...”

59. The characterisation of classification as technical and arcane is certainly justified. At [5] Arnold J noted that “for administrative reasons, in particular so as to facilitate searching, it has long been the practice of trade mark registries throughout the world to classify... goods and services into numbered classes”.

60. At [6]-[8] he provided the background to the Nice Classification (which is currently in its 11th edition).

“The Nice Agreement

6 In 1957 an international convention concerning the classification of goods and services, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (the Nice Agreement), was agreed. This came into force in 1961 and has subsequently been revised on three occasions. The Nice Agreement provides for the establishment and periodic revision of a classification consisting of: (i) a numbered list of classes (each of which consists of a “class heading” which describes the goods or services in that class) together with explanatory notes; and (ii) an alphabetical list of goods and services with an indication of the class into which each of the goods or services falls: see art.1(2). The Nice Classification is based on that drawn up at the London conference in 1934.

7 It should be noted that the Nice Agreement is only an agreement as to classification, not as to the effect of classification. Thus art.2(1) provides:

“Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.”

8 The United Kingdom acceded to the Nice Agreement and adopted the Nice Classification, initially by way of amendment of Sch.IV to the 1938 Rules in 1964: see the account given in *CAL-U-TEST Trade Mark* [1967] F.S.R. 39 at 43–45. As at April 1984 the Nice Agreement continued to be implemented in the United Kingdom by Sch.IV to the 1938 Rules (as subsequently amended) made under the 1938 Act.”

61. At [13]-[16] Arnold J considered the effect of classification under the Trade Marks Act 1938. In particular, he said at [13] and [16]:

“13 The effect of classification under the 1938 Act was stated by Kerly’s *Law of Trade Marks and Trade Names*, 11th edn, (1983) at para.5-05 as follows:

“Classification is primarily a matter of convenience in administration e.g. in facilitating the search which is necessary to ascertain whether the application is objectionable under section 12 [of the 1938 Act]. What is of real importance in determining the rights of parties, as has been pointed out, is the specification of goods or services entered on the Register and the validity of the registration ...” ...

16 As was pointed out in *Kerly* at §5-06, the position was different where the specification of the mark expressly incorporated a reference to the class (such as where it was registered for “all goods within Class X” or for “widgets included in Class X”). In such a case, the question whether any particular goods did or did not fall within the specification was to be answered by reference to the Registrar’s practice at the date of registration: see *CAL-U-TEST* at 46 and *GE Trade Mark* [1969] RPC 418 at 458–459.”

62. Arnold J then considered the position under the Act and the Trade Mark Rules 2000 which were, at the second of the relevant times in that case, the then applicable rules. He noted at [21] that, in contrast to the 1938 Rules, under the 2000 Rules, an application, and thus a registration, could cover more than one class. The position remains the same under the Trade Mark Rules 2008, which have replaced the 2000 Rules.

63. At [22] he then referred to the *Altecnic* case, citing in particular paragraph [42] of the judgment of Mummery LJ, which I have set out above. Arnold J said:

“22 In *Altecnic Ltd’s Trade Mark Application* [2001] EWCA Civ 1928; [2002] R.P.C. 34 the Court of Appeal held that a statement by an applicant for registration in his application form as to the class of the goods in respect of which registration was sought formed part of the application and was to be taken into account in interpreting the scope of the application at least during prosecution.....”

64. Arnold J’s conclusions on the construction of the agreement in question in the *Omega I* case began at [66]. Of relevance to the present case are the following passages. At [70] he pointed out that:

“The combined effect of rr.7(2) and 8(1) of the 2000 Rules and of para.(b) of the General Remarks to the ninth edition of the Nice Classification was that in some cases it was now possible to register the same goods in more than one class.”

65. Applying that finding, he found that at [71] that “the Goods are proper to both Class 9 and Class 14, and hence can be registered in both those classes.” He continued, at [72]:

“72 As the hearing officer explained in para.17 of the Decision, this is perfectly consistent with *Altecnic*:

“... So the statement of the class number does form part of the application. However, the system of classification is such that a multipurpose composite object can be in both classes correctly and be the same product if it is described in appropriate terms. Such a product is not on a par with a term that could be in a multitude of classes and dependent on the class would be different, so valves in classes 7, 10, 11 and

15 are all very different creatures, a valve for a pump, a valve for a heart, a valve for a radiator, a valve for a trumpet. In such a case the lack of specificity of the description means that the class into which the goods has been placed defines the nature of the goods and, as in *Altecnic*, to change the class would be to change the very nature of the goods and so be contrary to section 39(2) of the Act. If an application was made in class 7 for a more specific term, e.g. heart valves, the applicant would be advised that they should be transferred to class 10 as they cannot be in class 7. What is key to the issue is the degree of specificity of the terminology used. In this case there is a great deal of specificity in the terminology, there is no doubt as to the specific nature of the goods for which protection is sought; the same goods for which cover has already been granted in class 9 ...”

66. Finally, at [75] Arnold J considered (although ultimately he did not decide) whether a registration for the goods in question in Class 14 had a different scope to a registration in Class 9:

“75 ... It may perhaps be argued that a registration for the Goods in Class 14 has a different scope to a registration for the goods in class 9. This depends on whether the decision of the Court of Appeal in *Altecnic* applies in the infringement context as well as in the registration context, and if so what its effect is. Those are difficult issues, and they potentially give rise to a further difficult issue, which is whether *Altecnic* was correctly decided. In that regard it may be noted that the Court of Appeal differed from Laddie J., a judge of great experience in this field, and that the Judicial Committee of the House of Lords granted *Altecnic* leave to appeal against the decision of the Court of Appeal, but the case subsequently settled. Again, it is neither necessary nor appropriate for me to express any view on these issues.”

67. In summary, Arnold J considered that the *ratio* of the *Altecnic* case was confined to the proposition that a statement by an applicant for registration in his application form as to the class of the goods in respect of which registration was sought formed part of the application and was to be taken into account in interpreting the scope of the application at least during prosecution; [22]. It did not decide whether the decision applied in the context of infringement, which remained an open question. On this appeal, the appellant reserved the right to contend that *Altecnic* was wrongly decided, but that is not a matter for this court.

### **Limitation of the scope of the specification by reference to the Nice class number**

*The appellant's submissions*

*The ratio of the Altecnic case*

68. The appellant submitted that the ratio of the Court of Appeal's decision in the *Altecnic* case was that a statement by an applicant in his application form selecting the class numbers of goods, in respect of which registration was sought, could be taken into account in resolving an ambiguity in the list of the specification of goods in the application form. The decision does not establish the proposition that, when considering use of a registered trade mark, the natural and ordinary meaning of words used in the specification should be limited by reference to the class number of the Nice Classification, even where the words were ambiguous or vague.
69. That proposition is supported by [22], [72] and [75] of the judgment of Arnold J in the *Omega 1* case, which Arnold J applied at [25] of his judgment in the *Omega 2* case.
70. It is also supported by the description of the *ratio* of the *Altecnic* case by the Court of Appeal on appeal from that judgment [2011] EWCA Civ 645; [2011] ETMR 40, where Mummery LJ said at [31] – [32] that:

“31. In his judgment Arnold J included a substantial and interesting section (paragraphs 4-30) examining the legal framework of the classification of trade marks. He cited from paragraph [42] of the judgment in *Altecnic*, a case on the application of the ordinary principles of the construction of documents to determining the scope of a trade mark application. It was held that a statement by an applicant in his application form selecting the Class numbers of goods, in respect of which registration was sought, could be taken into account in resolving an ambiguity in the list of the specification of goods in the application form.

32. I do not question the accuracy of Arnold J's exposition of trade mark law or the proposition that the 1984 Agreement must be construed against its legal and factual background. I am doubtful, however, about the assistance that can be derived, in construing clause [5], from the state of the relevant trade mark law on classification of goods at the date of the 1984 Agreement, or at the date of Swiss's alleged breach of it, or from the decision of this court in *Altecnic*.”

71. Therefore, it is said that the Court of Appeal in the *Altecnic* case did not concern itself with how a specification, as registered, should be construed for the purposes of infringement or, as here, when considering revocation for non-use.

Article 2(1) of the Nice Agreement

72. Arnold J cited Article 2(1) in the *Omega 1* case at [7] and said:

“It should be noted that the Nice Agreement is only an agreement as to classification, not as to the effect of classification.”

73. Furthermore, Arnold J considered a submission in the *Fidelis* case at [88] that the term “financial services” should be narrowly construed to exclude insurance services, amongst other reasons “because the class headings and explanatory notes to the relevant editions of the Nice classification distinguish between “insurance” and “financial affairs””. He rejected that submission at [90] and said that:

“... the short answer to this is that the Nice Agreement is an agreement as to classification, not as to the effect of classification: see Article 2(1). Save to the limited extent recognised in *Altecnic Ltd's Trade Mark Application* [2001] EWCA Civ 1928, [2002] RPC 34, class has no bearing on the interpretation of terms in specifications of goods or services ...”.

#### Other legislation

74. The appellant contends that none of the relevant statutory and/or European legislation supports the proposition that the Nice Classification should be used when interpreting the scope of the specification of goods/services when considering infringement or use. Rather it is said that any references to the Nice Classification in that legislation make expressly clear that its use is for administrative purposes only, during the course of prosecution. It relied upon: the Madrid Agreement Article 4(1); the Madrid Protocol Article 4(1)(b); and Commission Regulation 2868/95/EC (implementing Council Regulation 40/904/EC) Article 1, Rule 2(4), the latter of which provides that:

“The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.”

#### No reference to the Nice Classification in the Trade Marks Directive

75. The appellant points out that the Act was enacted so as to bring into effect First Council Directive 89/104 of 21 December 1988 (the “Trade Marks Directive”). The Trade Marks Directive made no reference to, nor contained any requirement in Articles 5, 10, 11 or 12 (or elsewhere) that when considering the “goods or services... for which the trademark is registered” or “the goods or services covered by the trademark” that reference must be made to the Nice Classification.

#### Public policy

76. The appellant submits that this conclusion is supported by policy considerations. The public should be able to tell from the specification of goods or services entered on the Register whether or not use will infringe. It would be undesirable if, to determine whether there is infringement or use, the public had to consult the relevant Nice Classification which existed as at the date of the application for registration of



the trade mark in question. It suggests that reference to the Nice Classification would cause uncertainty for the following reasons:

- i) The current edition of the Nice Classification Specification is contained in several volumes with over 1000 pages;
- ii) The classes are not unique and mutually exclusive in that the same goods/services may appear in different classes;
- iii) The goods/services listed in any class are not fixed, as the classification may change and indeed has changed over time; and
- iv) There is now no centralised searching service of the Nice Classification.

77. In my view, these are powerful arguments in support of the appellant's case on this issue. Mr Malynicz submitted that the observations of Arnold J which I have cited were all *obiter*. That is correct in relation to the *Omega 1* and *Omega 2* cases, but I was less convinced that his submission was correct in relation to the *Fidelis* case. Whether or not this is correct, it is far from a complete answer. Arnold J is a very experienced judge and a leading expert in trade mark law, who has thought very carefully about this issue, and has set out full reasons for his view.

78. However, I have heard arguments from the respondent which were not advanced before Arnold J including, but not limited to, the effect of the *IP Translator* case on this issue. For reasons that appear below, it is unnecessary for me to reach a concluded view on this question in order to resolve this appeal. I do not consider that it is appropriate to do so, in the light of the judgments of Arnold J, and because further submissions would be required as to the interpretation of Article 2 of the Nice Agreement. However, I have concluded that I should express a provisional view, having heard very detailed argument from Counsel.

79. I have reached the provisional view, in the light of the respondent's arguments, that it is appropriate to use class number as an aid to interpretation of the specification where the words used in the specification lack clarity and precision. This applies to granted registrations as well as to applications, and therefore applies in the context of infringement actions and revocation claims. My reasons for reaching this conclusion are set out below.

80. Of course, in many cases, it will be unnecessary to use the class number in this way, as the words chosen in the specification will be sufficiently clear and precise. Indeed, in the present case, I consider that the disputed phrase “provision of office facilities” is sufficiently clear and precise, so that its ordinary and natural meaning can be ascertained without reference to the class number.

*Reasons for limiting the scope of the specification by reference to the Nice Classification class number*

#### *The IP Translator case*

81. The *IP Translator* case did not concern class numbers. However, it did concern the requirement of clarity and precision of specifications where class headings from the Nice Classification had been used to define goods and services for Community trade

mark applications and registrations. In my judgment, the parties were justified in agreeing to an adjournment pending the judgment of the CJEU in this case. The requirement of clarity and precision in the context of the Nice Classification is of importance to the outcome of this appeal.

82. The *IP Translator* case and its aftermath was explained in detail by Arnold J in the *Sky* case at [140] – [153]. In particular, as the judge set out, the *IP Translator* case related to Communication 4/03 of the President of OHIM of 16 June 2003 concerning the use of class headings in lists of goods and services for Community trade mark applications and registrations. Paragraphs III(2) and IV(1) of Communication 4/03 stated that:

“It constitutes a proper specification of goods and services in a [Community Trade Mark] application if the general indications or the whole class headings provided for in the Nice Classification are used. The use of these indications allows a proper classification and grouping. [OHIM] does not object to the use of any of the general indications and class headings as being too vague or indefinite, contrary to the practice which is applied by some national offices in the European Union and in third countries in respect of some of the class headings and general indications.” (III(2))

and:

“The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this, the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class.” (IV(1))

83. The Chartered Institute of Patent Attorneys (“CIPA”) applied to register the trade mark IP TRANSLATOR as a UK trade mark using the class heading of Class 41, namely “education; providing of training; entertainment; sporting and cultural activities”, as the specification of services. The Registrar of Trade Marks interpreted the specification in accordance with Communication 4/03 as covering all services in Class 41, including translation services, and refused the application on the ground that the trade mark was descriptive in relation to translation services. CIPA appealed to the Appointed Person. Geoffrey Hobbs QC sitting as the Appointed Person, [2010] RPC 31, referred the following questions of interpretation of Directive 2008/95 to the CJEU:

“1. Is it necessary for the various goods or services covered by a trade mark application to be identified with any, and if so what particular, degree of clarity and precision?

2. Is it permissible to use the general words of the class headings of the [Nice Classification] for the purpose of identifying the various goods or services covered by a trade mark application?

3. Is it necessary or permissible for such use of the general words of the Class Headings of [the Nice Classification] to be interpreted in accordance with Communication No 4/03 ...?”

84. The CJEU answered those questions at [64]:

“- Directive 2008/95/EC must be interpreted as meaning that it requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark;

- Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise;

- an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of that class or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.”

85. At [38] – [41] the CJEU made clear that in the context of identification of goods and services, the conditions for obtaining and continuing to hold a registered trade mark must in general be identical in all Member States:

“38. As a preliminary point it must be observed that there is no provision of Directive 2008/95 which directly governs the question of the identification of the goods and services concerned.

39 However, that observation is not sufficient to support a finding that the determination of goods and services for the purposes of registration of a national trade mark is a matter which does not fall within the scope of Directive 2008/95.

40 Although it is apparent from recital 6 of the preamble to Directive 2008/95 that the Member States remain free to fix the provisions of procedure concerning, inter alia, the registration of trade marks (see, to that effect, *Case C 418/02 Praktiker Bau- und Heimwerkermärkte* [2005] ECR I 5873, paragraph 30,

and *Case C 246/05 Häupl* [2007] ECR I 4673, paragraph 26), the fact remains that the Court has held that determination of the nature and content of the goods and services eligible for protection by a registered trade mark is subject, not to the provisions on registration procedures, but to the substantive conditions for acquiring the right conferred by the trade mark (*Praktiker Bau- und Heimwerkermärkte*, paragraph 31).

41 In that regard, recital 8 of the preamble to Directive 2008/95 emphasises that attainment of the objectives at which the approximation of the laws of the Member States is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark be, in general, identical in all Member States (see, to that effect, *Sieckmann*, paragraph 36; *Case C 363/99 Koninklijke KPN Nederland* [2004] ECR I 1619, paragraph 122; and *Case C 482/09 Budějovický Budvar* [2011] ECR I 8701, paragraph 31).”

86. The CJEU then considered the requirement of clarity and precision for the identification of goods and services at [42] – [45]. It made clear (and it is obvious) that this requirement is relevant when assessing grounds for refusal or invalidity of a registration:

“42 As regards the requirement of clarity and precision for the identification of the goods and services covered by an application to register a sign as a trade mark, it must be held that the application of certain provisions of Directive 2008/95 depends to a great extent on whether the goods or services covered by a registered trade mark are indicated with sufficient clarity and precision.

43 In particular, the question of whether or not any of the grounds for refusal or invalidity set out in Article 3 of the Directive apply to the mark must be assessed specifically by reference to the goods or services in respect of which registration is sought (see *Koninklijke KPN Nederland*, paragraph 33, and *Case C 239/05 BVBA Management, Training en Consultancy* [2007] ECR I 1455, paragraph 31).

44 Similarly, further grounds for refusal or invalidity concerning conflicts with earlier rights provided for by Article 4(1) of the directive presuppose the identity or similarity of the goods or services designated by the two conflicting marks.

45 Moreover, the Court has held that, although it is not necessary to specify in detail the service(s) for which registration is sought, since, to identify those services, it is sufficient to use general wording, the applicant must conversely be required to specify the goods or types of goods to which those services relate by means, for example, of other more specific details. Such details will make it easier to apply the

articles of Directive 2008/95 referred to in the previous paragraphs, without appreciably limiting the protection afforded to the trade mark (see, by analogy, *Praktiker Bau- und Heimwerkermärkte*, paragraphs 49 to 51).”

87. The CJEU discussed the requirement of clarity and precision in relation to the entry of registered trade marks in the public register at [46] – [49]. The Grand Chamber explained that, as well as the competent authorities, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties:

“46 In that connection, it must be recalled that the entry of the mark in a public register has the aim of making it accessible to the competent authorities and to the public, particularly to economic operators (*Sieckmann*, paragraph 49, and *Case C 49/02 Heidelberger Bauchemie* [2004] ECR I 6129, paragraph 28).

47 On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and the publication and maintenance of an appropriate and precise register of trade marks (see, by analogy, *Sieckmann*, paragraph 50, and *Heidelberger Bauchemie*, paragraph 29).

48 On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties (*Sieckmann*, paragraph 51, and *Heidelberger Bauchemie*, paragraph 30).

49 Accordingly, Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”

88. At [50] – [56] the CJEU discussed whether the use of the general indications of the class headings in the Nice Classification was compatible with the requirements of clarity and precision. It held that use of such general indications of the class headings to identify the goods and services for which the protection of the trade mark was sought was not precluded, provided that such identification was sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought:

“50 Directive 2008/95 contains no reference to the Nice Classification and, consequently, imposes no obligation or

prohibition on Member States with regard to its use for the purposes of registration of national trade marks.

51 However, the obligation to use that instrument stems from Art.2(3) of the Nice Agreement which provides that the competent Office of the countries of the Special Union, which encompasses almost all the Member States, is to include in the official documents and publications relating to registrations of marks the numbers of the classes of the Nice Classification to which the goods or services for which the mark is registered belong.

52 Since the Nice Agreement was adopted pursuant to Art.19 of the Paris Convention and Directive 2008/95 , according to recital 13, was not intended to affect the obligations of the Member States resulting from that Convention, it must be held that that directive does not preclude the competent national authorities from requiring or agreeing that an applicant for a national trade mark should identify the goods and services for which he is seeking the protection conferred by the trade mark by using the Nice Classification.

53 However, in order to guarantee the effectiveness of Directive 2008/95 and the smooth functioning of the system for the registration of trade marks, such identification must meet the requirements of clarity and precision which, as held in para.49 of the present judgment, are laid down by the directive.

54 In that connection, it must be observed that some of the general indications in the class headings of the Nice Classification are, in themselves, sufficiently clear and precise to allow the competent authorities to determine the scope of the protection conferred by the trade mark, while others are not such as to meet that requirement where they are too general and cover goods or services which are too variable to be compatible with the trade mark's function as an indication of origin.

55 It is therefore for the competent authorities to make an assessment on a case-by-case basis, according to the goods or services for which the applicant seeks the protection conferred by a trade mark, in order to determine whether those indications meet the requirements of clarity and precision.

56 Accordingly, Directive 2008/95 does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought, provided that such identification is sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought.”

89. The CJEU considered the extent of protection resulting from the use of all the general indications of a class heading at [57] – [64]. It noted that there were, at the time, two approaches to the use of the general indications of the class headings of the Nice Classification, namely:
- i) the approach derived from Communication 4/03, when the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within the class, and;
  - ii) the literal approach, which seeks to give the terms used in those indications their natural and usual meaning.
90. The CJEU considered that the existence, in parallel, of those two approaches was liable to affect the smooth functioning of the system for the registration of trade marks in the Union. The two approaches might lead to a difference in the extent of the protection of a national trade mark if it is registered in several Member States, and of the protection of the same mark if it was also registered as a Community trade mark. Such a difference might affect, *inter alia*, the outcome of an action for infringement, as such an action might have greater success in the Member States which follow the approach of Communication 4/03. Moreover, a situation in which the extent of the protection conferred by the trade mark depends on the approach to interpretation adopted by the competent authority and not on the actual intention of the applicant ran the risk of undermining legal certainty both for the applicant and for third party economic operators.
91. The CJEU concluded at [61]- [62] that:
- “61...in order to respect the requirements of clarity and precision mentioned above, an applicant for a national trade mark who uses all the general indications of a particular class heading of the Nice Classification to identify the goods or services for which the protection of the trade mark is sought must specify whether its application for registration is intended to cover all the goods or services included in the alphabetical list of the particular class concerned or only some of those goods or services. If the application concerns only some of those goods or services, the applicant is required to specify which of the goods or services in that class are intended to be covered.
- 62 An application for registration which does not make it possible to establish whether, by using a particular class heading of the Nice Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise.”
92. In summary, the *IP Translator* case established that:
- i) Whilst Directive 2008/95 contains no reference to the Nice Classification and, consequently, imposes no obligation or prohibition on Member States with regard to its use for the purposes of registration of national trade marks,

the obligation to use that instrument stems from Art.2(3) of the Nice Agreement, which was adopted pursuant to Art.19 of the Paris Convention and Directive 2008/95; recital 13.

- ii) The competent Office of the countries of the Special Union, which encompasses almost all the Member States, is to include in the official documents and publications relating to registrations of marks the numbers of the classes of the Nice Classification to which the goods or services for which the mark is registered belong.
  - iii) The requirements of clarity and precision must be taken into consideration when considering registered trade marks as well as applications;
  - iv) As well as the competent authorities, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties;
  - v) General indications of the class headings to identify the goods and services for which the protection of the trade mark was sought were not precluded, provided that such identifications were sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought;
  - vi) Different approaches to the use of the general indications of the class headings of the Nice Classification might lead to a difference in the extent of the protection of a national trade mark if it is registered in several Member States, and of the protection of the same mark if it was also registered as a Community trade mark. This ran the risk of undermining legal certainty both for the applicant and for its competitors;
  - vii) Therefore, the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection of the trade mark is sought was not precluded, provided that such identification is sufficiently clear and precise to allow the competent authorities and economic operators to determine the scope of the protection sought.
93. In the light of the *IP Translator* case and its subsequent codification by amendments to the Trade Mark Regulation (EU) 2017/1001 and Trade Mark Directive (EU) 2015/2436, the respondent's case is that class numbers cannot be ignored, as they can play a significant role in designating goods and services with clarity and precision and in ensuring certainty for economic operators when viewing the Register. The respondent does not contend that the class numbers will always be necessary to achieve clarity and precision in the specification, as in many cases the words chosen will be sufficiently clear and precise. In such cases, the scope of the specification will be clear from the ordinary and natural meaning of the words chosen. In those cases, the class number is merely confirmatory and does not change the meaning of the terms used.
94. However, because in some instances the words chosen may be vague or could refer to goods or services in numerous classes, the class may be used as an aid to interpret



what the words mean with the overall objective of legal certainty of the specification of goods and services. For example, the word “valves” which was considered in the *Altecnic* case can refer to goods which may be included in 11 different classes of the Nice Classification, as Laddie J observed at first instance. This was referred to by the hearing officer in the *Omega I* case, in a passage cited with approval by Arnold J at [72] of his judgment (*supra*). The hearing officer explained valves in Classes 7, 10, 11 and 15 are all very different creatures, a valve for a pump, a valve for a heart, a valve for a radiator, a valve for a trumpet. In such a case the lack of specificity of the description means that the class into which the goods have been placed defines the nature of the goods. Mr Malynicz also noted that valves could be registered in Class 9 for the purposes of electrical guitar amplifiers, or as valves for vehicle tyres in Class 12 or as valves for use in baby bottles in Class 10. Without the additional information provided by the class number, a specification for “valves” would not satisfy the requirement of clarity and precision.

95. This could potentially mean that a registered trade mark could be asserted against a competitor in an infringement case in relation to goods that were distant from the proprietor’s real area of activity. It also may negatively impact on the proprietor. A trade mark may be descriptive for one sort of valve (e.g. the trade mark Baby Flow for valves in Class 10) but not for another sort of valve (e.g. Baby Flow for valves in Class 11). Ignoring, in such cases, the class in which the trade mark is registered, which is clearly visible on the Register, is, in my view incompatible with the *IP Translator* case, and incompatible with the principle of legal certainty.
96. In the context of revocation applications based on no genuine use, where a specification otherwise lacks clarity and precision, it may be of considerable importance to be able to refer to the class in which the goods or services are registered. It may be unfair to the proprietor not to refer to the class, if it enables clarity and precision to be established. If it is not possible to ascertain with clarity and precision the scope of the specification, then it is very difficult to see how the proprietor can prove use of goods or services within that specification. It may be unfair to the opponent not to refer to the class, if such reference makes clear that the goods or services relied on as having been used by the proprietor are not goods or services properly to be regarded as within the scope of the specification.

#### *Interpretation of Article 2(1) of the Nice Agreement*

97. To repeat, Article 2(1) of the Nice Agreement provides:

“Subject to the requirements prescribed by this Agreement, the effect of the Classification shall be *that attributed to it by each country of the Special Union. In particular, the Classification shall not bind the countries of the Special Union* in respect of either the evaluation of the extent of the protection afforded to any given mark or the recognition of service marks.” (emphasis added)
98. The respondent submits that this Article does not mean that that the Nice Classification is irrelevant to scope of protection. On the contrary, it means that the country in question may give the Classification whatever effect it chooses. The Nice Agreement is not binding as to the extent of protection given, and the United

Kingdom may decide to adopt the classes as an aid to construction of trade mark specifications, which it has chosen to do.

99. My provisional view, based on the language of Article 2 (1) and the *IP Translator* case where Article 2 was specifically referred to, is that this interpretation is correct. However, I did not hear argument as to the purpose of Article 2 in the context of the whole of the Nice Agreement, nor as to its legislative history. It may well be that the purpose of Article 2(1) is to give autonomy to contracting states as to the effect of the Classification, and to permit, but not require them, to have regard to the Classification when determining the scope of protection of a trade mark. That purpose, in respect of EU Member States, would now have to be considered in the light of the *IP Translator* case.

#### *EUIPO and UKIPO Practice*

100. It appears from practice guidance that both the UKIPO and the EUIPO take the Nice Classification class numbers into account when considering the clarity and precision of goods and services in respect of which trade marks are sought to be registered. The EUIPO Classification section of its Manual states at section 4.1.1:

“A term may be part of the description of goods and services in several different classes; it may be clear and precise in a particular class without further specification, because its natural and usual meaning *and the class number* leave no doubts as to the scope of protection.

If the scope of protection cannot be understood, sufficient clarity and precision may be achieved by identifying factors such as characteristics, purpose and/or identifiable market sector 1. Elements that could help to identify the market sector may be, but are not limited to, the following:

consumers and/or sales channels;

skills and know-how to be used/produced;

technical capabilities to be used/produced.

If protection is sought for a specialised category of goods and services or a specialised market sector belonging to a different class, further specification of the term may be necessary.

For example: clothing for protection against fire (Class 9); clothing for operating rooms (Class 10); clothing for pets (Class 18); clothing for dolls (Class 28).

From these examples it is obvious that the term clothing can be interpreted in various ways *but must always be defined by purpose or market sector pertaining to a particular Nice class*. In addition, it shows that clothing in Class 25 would not cover any of the categories of goods mentioned above.” (emphasis added)

101. Similar guidance is given by the UKIPO manual, which cites the *Altecnic* case in support:

“3.7 Care must be taken concerning the scope of what a particular item covers *when viewed in the context of the class in which it is applied or registered*. For example, a registration in respect of “articles of clothing” in Class 25 does not include “articles of clothing for protection against accidents” in Class 9. Similarly, an application for “cases” in Class 18 could not include within its scope “violin cases” in Class 15: ...”  
(emphasis added)

102. Practice of the EUIPO and UKIPO is far from determinative; see Kitchin LJ in *Glaxo Wellcome UK Ltd (t/a Allen & Hanburys) v Sandoz Ltd (No 2)* [2017] EWCA Civ 335; [2017] FSR 33 at [62] and [67]. However, such practice was considered in the *Altecnic* case and the parties are agreed that the practice of UKIPO at the date of application for the Trade Marks is relevant, although Mr Vanhegan suggests that the practice of EUIPO is not. In my view, in the light of the need to avoid diverging approaches to scope of protection, as emphasised by the CJEU in the *IP Translator* case, conformity of practice between the UKIPO and EUIPO (which takes account of *IP Translator*) is relevant and important.
103. The manuals both suggest that class number should always be taken into account, together with the ordinary and natural meaning, to see whether the requirement of clarity and precision is satisfied. It is certainly the case that the class number always forms part of the context, and the guidance is consistent with the *Altecnic* case, where Mummery LJ referred to the class number as a part of the context, and ambiguity of language by way of example only. However, that does not mean that the class number is always required to determine the natural and ordinary meaning of the words used in the specification, which may be sufficiently specific so that the scope of the specification is clear and precise. For the purposes of this appeal it is unnecessary for me to express any view on circumstances where the class number would be relevant where the natural and ordinary meaning of the words used in the specification is clear and precise, as this goes further than the respondent's argument.

*The judgment in the Altecnic case was not confined to the facts*

104. The respondent challenges the appellant's proposition that the judgment in the *Altecnic* case can be confined to its factual and procedural background. Whilst the issue in that case concerned amendment of the specification, exactly the same considerations would apply when it comes to construing the specification for the purposes of assessing distinctiveness during examination, construing the specification of an earlier mark in an opposition, infringement by a third party or revocation for non-use or deceptiveness. In all of these instances it is necessary to understand the scope of the goods or services covered. Where the words are neither clear nor precise, for example because they apply to goods or services registrable in multiple classes, the class number must be relevant to resolve ambiguity.
105. It points out that the reasoning of Mummery LJ was not confined to the facts, or the particular procedural phase then in issue. Rather, it was a case concerning construction of the scope of a specification. The specification can only have one

meaning, irrespective of whether it is being considered in at the application stage, or in the context of an infringement claim or in an application for revocation. Accordingly, in cases where the class number is to be taken into account when interpreting the scope of the application, it must also be taken into account when interpreting the scope of the granted specification.

106. Furthermore, the appellant concedes that where the specification contains the phrase “all included in class X” it is appropriate to use the class number when interpreting the scope of the specification, but not otherwise. The respondent contends that, where necessary to achieve clarity and precision, it is also appropriate to use the class number which appears on the public register. Indeed, the appellant’s argument was expressly rejected by Mummery LJ in the *Altecnic* case.
107. In my provisional view, this submission is correct. If the word “valves” is interpreted at the application stage by reference to its class number as referring to valves for use in baby bottles in Class 10, it cannot be interpreted, once granted, as having a different meaning e.g. valves for vehicle tyres in Class 12. In my view, the Court of Appeal were applying general principles of construction to the specification in the case before them, which had regard to the context in which the words were used. The reasoning is not confined to the facts of the case.

#### **The natural and ordinary meaning of the words used in the specifications**

108. The next question is to consider the natural and ordinary meaning of the words used in the specifications. The appellant accepts that the hearing officer was correct to state at [24] that it is first necessary to ascertain the scope of the services in respect of which the Trade Marks have been registered. If the use relied upon by the appellant falls outside the specifications of services for which the Trade Marks are registered, then the hearing officer was correct in his conclusion that the registrations should be revoked in their entirety.
109. The appellant accepts that the hearing officer was correct to rely upon the observation of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at page 289 that:
- “When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.”
110. The appellant accepts that the hearing officer was also correct to be cautious about the potential width of certain service marks and rightly reminded himself of the observation of Jacob J in *Avnet, Inc v Isoact Ltd* [1998] FSR 16 who said at page 19:
- “In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

111. That principle was recently reinforced and supplemented by Arnold J in the *Fidelis* case who said at [86], in relation to specifications of services:

“86 I reviewed this aspect of the law in *Omega v Omega* at [22]-[34]. To summarise, terms in specifications of goods and services should be given their ordinary and natural meaning, but this is subject to two overlapping qualifications: first, specifications of services are inherently less precise than specifications of goods, and therefore should be interpreted in a manner which confines them to the core of the ordinary and natural meaning rather than more broadly; and secondly, terms should not be interpreted so liberally that they become unclear and imprecise.”

112. Although not put at the forefront of his argument, Mr Vanhegan submitted that the hearing officer was wrong to assume that all service trade marks are *per se* wide in scope. Whether the mark in question is registered for “goods” or “services”, it is capable of having a narrow or wide scope depending on the words used. He noted that Jacob J’s comments in the *Avnet* case were made in the context of seeking to construe the meaning of the phrase “advertising and promotional services”. I reject this submission. The hearing officer was applying settled principles of law to the facts of the case before him. The phrase “provision of office facilities” is potentially of very wide scope. Amongst many other examples, it could include provision of dining facilities including in-house catering staff, a fleet of cars, IT support staff etc. The hearing officer was correct to consider the core of the ordinary and natural meaning of the terms used in the specification, and not to interpret them so liberally that they became unclear and imprecise.

113. I agree with the hearing officer that the natural and ordinary meaning of the phrase, “rental of office equipment” is the rental of any equipment that may be used in an office. I also agree with the hearing officer’s conclusion at [26] that the natural and ordinary meaning of the phrase “provision of office facilities” is the provision of anything that facilitates the functioning of an office, which could be a physical item, such as a desk, chair or table, or a human endeavour such as secretarial typing services, data processing and document reproduction etc. In my judgment the phrase means the provision of facilities for use in an office and does not include rental of the office itself. This is the core of the ordinary and natural meaning of the term used in the specifications, and the inclusion of the rental of office accommodation would interpret the phrase so liberally that it would be unclear and imprecise.

114. During his oral argument Mr Vanhegan challenged this interpretation. He suggested that the hearing officer had concluded at [27] that the phrase included the rental of office accommodation and had then narrowed its natural and ordinary meaning by reference to Class 35. To repeat, the hearing officer said:

“27. An “office in terms of a place at which to do something would not, in normal parlance be referred to as “equipment”, being more rather a “facility” but that does not mean such a service falls within the description of “Provision of office facilities” in Class 35.”

115. I do not accept that this amounts to a finding by the hearing officer that the relevant phrase includes the rental of an office. When read in the context of the remainder of the Decision, I understand him to have concluded that even if office rental was included within the specifications (which it was not), it was not within Class 35, and therefore would be excluded in any event. Alternatively, if the hearing officer reached the contrary conclusion, I do not agree with him. This is a simple matter of interpretation of an ordinary English phrase and was not the subject of any evidence.
116. It is also relevant to consider whether, until oral argument on this appeal, the appellant had advanced a case that “provision of office facilities” included rental of office accommodation. The skeleton argument of the appellant (registered proprietor) in the Registry Proceedings was filed by Mr Holah of Field Fisher Waterhouse. It did not address the ordinary meaning of any word or phrase in the specifications and therefore did not assert that the phrase included rental of office accommodation. Mr Guy Hollingworth, who appeared on behalf of the respondent in the Registry proceedings, did address this issue. He said at [38] of his skeleton argument that:

“The plain and natural meaning of the term ‘provision of office facilities’ is providing facilities for an office – not providing (or renting) an office itself. Such facilities might include providing office equipment or, perhaps, office services, such as secretarial or clerical services. The term ‘rental of office equipment’ is even more self-explanatory and includes rental of equipment such as computers or photocopiers, for use in the office.”

117. There is no suggestion in the Decision of the hearing officer that Mr Hollingworth’s submission as to the ordinary meaning of the term was disputed by the appellant. Even if it was, the question then arises as to the appellant’s position on this appeal, prior to oral argument. The appellant draws attention to paragraphs [6] and [9] of its grounds of appeal, which state that:

“6. Further the hearing officer failed to address the evidence of use as set out in Annex 4 showing that the marks in question were being used in relation to the provision of “fully fitted and furnished” offices which included within the base cost the provision not only of the rent and rates but also of lighting, power, cleaning, furniture, telephone and line rental and in relation to the meeting/training room offices the provision of “overhead projectors”, “flipcharts”, “complementary spring water”, “coffee point”, “snacks machine” and extra facilities on request.”

“9. In fact the evidence established that the mark had been used in the provision of fully serviced offices which service included (a) the provision of the rental or lease of offices (or real estate) *and* (b) the provision of office facilities and rental of office equipment. The evidence established that the service provided under the marks was the provision of “fully fitted and furnished” offices, which service included within the base cost the provision of not only rent and rates but also the costs

associated with the provision of “lighting”, “power”, “cleaning”, “furniture” “telephone line rental” and relation to the meeting/training room offices the provision of “overhead projectors”, “flip charts”, “complimentary spring water”, “coffee point”, “snacks machine” and “extra facilities on request”. Accordingly the evidence established that the provision of office facilities and rental of office equipment was an essential part and not a mere adjunct to the services which were being provided under the marks”

118. As I read those grounds of appeal, they are contending that the hearing officer failed to take into account that, when providing fully serviced offices, additional offices facilities were provided to those that he considered in the Decision. I do not understand them to assert that the rental or lease of offices was itself within the specifications. In any event, any ambiguity was resolved by appellant's skeleton argument for the appeal served on 18 July 2011. This was consistent with the interpretation advanced by Mr Hollingworth and accepted that the hearing officer was correct as to the ordinary meaning of the phrase. It stated at [18] that:

“... the hearing officer was therefore correct to hold when seeking to construe the meaning of the Appellant’s registered services: “the provision of office facilities, rental of office equipment”, that:

(1) “*as a matter of plain language the scope of the service provided in the rental of office equipment is no more and no less the rental of equipment which may be used in an office*”, (see paragraph 25 of the Decision); and

(2) “*an office facility can be anything that facilitates the functioning of an office, which ...can be a physical item ...or a human endeavour such as secretarial and typing services, data processing and document reproduction etc...*”, (see paragraph 26 of the Decision).”

119. Similarly, the appellant's supplemental skeleton argument for the appeal served on 29 October 2018 was clear that the hearing officer was correct in his interpretation of the natural and ordinary meaning of the words used in the specifications of the Trade Marks. It stated at [31] in section B(5) – (7) that:

“(5) The hearing officer – correctly identified the meaning of the service as:

(a) [rental of office equipment] - *the rental of any equipment that may be used in an office*; and

(b) [provision of office facilities] – *the provision of anything that facilitates the functioning of an office which can be a physical item or a human endeavour such as secretarial and typing services, data processing and document reproduction etc..*

(6) That meaning is clear and precise.

(7) That meaning represents the core of the ordinary and natural meaning of the specification, namely the core services, which are encompassed when providing fully serviced offices.”

120. In summary, far from challenging the hearing officer’s conclusion at [26], the appellant has accepted that it was correct. In my view, it is not open to the appellant to advance a contrary case during oral argument. Furthermore, the appellant has positively asserted in its supplemental skeleton that the interpretation of the hearing officer is clear and precise and represents the core of the ordinary and natural meaning of the words used in the specifications. It is very difficult to row back from that, and to present an alternative meaning at this stage of the appeal.

**Is the phrase “Provision of office facilities” clear and precise?**

121. In this regard, I refer to the aftermath of the *IP Translator* case. As explained by Arnold J in the *Sky* case at [148]:

“148. On 20 November 2013 the Trade Mark Offices forming the European Trade Mark and Design Network (“TMDN”) (namely, EUIPO, the Offices of the Member States and the Norwegian Office) issued version 1.0 of a Common Communication on the Common Practice on the General Indications of the Nice Class Headings as part of a Convergence Programme initiated by EUIPO to harmonise practice. The Common Communication explained that, having reviewed all the general indications in the Nice class headings in order to determine which were sufficiently clear and precise, the TMDN had concluded that the 11 general indications set out below were not clear and precise, and consequently could not be accepted without further specification, whereas the remaining general indications were considered acceptable:

- i) Class 6 – goods of common metal not included in other classes;
- ii) Class 7 – machines;
- iii) Class 14 – goods in precious metals or coated therewith;
- iv) Class 16 – goods made from these materials [paper and cardboard];
- v) Class 17 – goods made from these materials [rubber, gutta-percha, gum, asbestos and mica];
- vi) Class 18 – goods made of these materials [leather and imitations of leather];
- vii) Class 20 – goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell,



amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics;

viii) Class 37 – repair;

ix) Class 37 – installation services;

x) Class 40 – treatment of materials; and

xi) Class 45 – personal and social services rendered by others to meet the needs of individuals.”

122. Accordingly it was not felt necessary to review the general indication in the Nice Classification for Class 35. This was presumably because the phrase was already thought to have sufficient clarity and precision. This is (and was in the 7<sup>th</sup> Edition current at time of the applications for the Trade Marks) for “Advertising; Business Management; Business Administration; Office Functions”.

123. In my judgment, the phrase “provision of office facilities” is clear and precise. It is clearer and more precise than “office functions”. It means the provision of facilities for use in an office. It is potentially of wide scope and so the hearing officer was correct to consider the core of the ordinary and natural meaning of the words used. The interpretation that he set out at [26] of the Decision is, in my judgment, clear and precise. Indeed, as pointed out above, both parties have advanced a positive case that the meaning of the phrase is clear and precise.

124. Based on my provisional view of the law, this was not a case where it was necessary to consider the class number and limit the services (if any) in respect of which the Trade Marks had been used during the Relevant Period to exclude those which fell within the natural and ordinary meaning. Therefore I shall assume in favour of the appellant that the hearing officer erred in law in excluding services, other than photocopying, by reference to the class number.

### **Exclusion of services which may fall into a number of different classes; construing the services by reference to the wrong edition of the Nice Classification**

125. The appellant alleges that the hearing officer made a further error of law by excluding those services from his consideration which may fall into a number of classes. There is no doubt, from the authorities cited above, that goods or services may be registered in more than one class, depending on the degree of specificity of the words chosen. Further, it points out that he referred to Class 43 of the Nice Classification at [25] and [27] which did not exist in the 7<sup>th</sup> Edition, which was current at the time of the applications for the Trade Marks.

126. In answer, the respondent submits that:

- i) Neither of these points is contained in the appellant’s grounds of appeal and no application was made to amend the grounds of appeal to include them. The respondent is correct about this;
- ii) The hearing officer was aware of the fact that certain goods or services could be registered in more than one class, because he expressly referred to this at

[25]. He excluded only those which could only be registered in one class, and was entitled to consider which class was most appropriate for their registration.

- iii) The hearing officer must have been looking at the wrong edition of the Nice Classification but that this made no difference to his decision because there were no material differences between the respective explanatory notes for Class 35 in those editions.

127. Even if I assume that the appellant is correct in its contentions (and I shall make this assumption) this gets it no further than the assumption that I have already made in its favour, based on my provisional view of the law. I shall assume in favour of the appellant that the hearing officer erred in law in excluding services, other than photocopying, by reference to the class number.

### **The rival contentions on the evidence**

128. The respondent contends that, even if the hearing officer erred in interpreting the specifications of the Trade Marks by reference to the class numbers in the Nice Classification, the appeal must still be dismissed because the appellant's evidence failed to prove use during the Relevant Period.

129. I have assumed, in favour of the appellant, that the hearing officer erred in law by narrowing the ordinary meaning of the words used in the specifications of the Trade Marks by reference to the class in which they are registered. On that assumption, it is necessary to consider the following issues:

- i) Did the appellant's evidence show that use within the specifications during the relevant period was warranted in the economic sector concerned to maintain or create a share in the market for registered goods or services?
- ii) In particular, did the appellant's evidence satisfy the onus upon it to establish, on a balance of probabilities, that based on the nature of the services in question, the characteristics of the market concerned and the scale, scope and frequency of the proprietor's use of the Trade Marks for those services, that genuine use of the Trade Marks had been made during the Relevant Period?
- iii) Was the use in relation to any of the services within the specifications of the Trade Marks ancillary to the core function of the appellant's trade, and therefore an adjunct to the provision of office space?

### *Genuine use of a trade mark – legal principles*

130. The hearing officer's summary of the legal principles at [21] was not criticised by the appellant. However, I was referred to a number of more recent statements of the law, which expand on the principles that he set out in the light of subsequent judgments of the CJEU. For the purposes of this judgment, it is sufficient to refer to the summary provided by Arnold J in *The London Taxi Corp Ltd (t/a London Taxi Co) v Frazer-Nash Research Ltd* [2016] EWHC 52 (Ch); [2016] FSR 20 ("the *London Taxi* case"), at [217] – [219], whose judgment was affirmed on appeal. This

summary was recently applied by Arnold J in *W3 Ltd v Easygroup Ltd* [2018] EWHC 7 (Ch); [2018] FSR 16 at [194] – [195] and the parties agreed that it was accurate. I shall not quote the paragraphs, which are lengthy, due to the number of authorities on this subject, although I have had regard to all of the principles set out therein.

131. In the context of this appeal, certain of those principles require further analysis. Genuine use must be by way of real commercial exploitation of the trade mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark. The hearing officer concluded at [33] that use which is a mere adjunct to the general service provided under and by reference to the Trade Marks did not amount to “real commercial exploitation”. In my judgment, his reasoning is correct as a matter of law. It is emphasised by the judgment of Floyd J in the *Galileo* case, which was handed down subsequent to the Decision of the hearing officer.
132. In the *Galileo* case, Floyd J rejected the argument of the appellant that, notwithstanding that its main service was the provision of software for the purpose of travel and accommodation reservations, the fact that such software contained specific programs for e.g. accounting, mapping and word processing, meant that it should be able to maintain a specification for those types of software. Floyd J concluded that such use was not seen as warranted in the sector to create or maintain a share in the market for the goods or services in question. He said at [47]:

“It seems to me that the core question on which he [the hearing officer] had to decide was whether “computer software for travel and accommodation reservations” was a fair description of the use which the proprietor had proved, notwithstanding that aspects of the functionality of the software package could be used for tasks which were not themselves the making of reservations. The making of reservations was undoubtedly the core function of everything which the proprietor sold. All the extra functionality was ancillary to that purpose.”

133. Furthermore, all of the relevant factors must be taken into account when determining whether there is real commercial exploitation of the mark. The decision of the General Court of the CJEU in Case C-141/13 P *Reber Holding & Co KG v OHIM* ECLI:EU:C:2014:2089 is a clear illustration that evidence of retail sales under or by reference to the trade mark may be insufficient to prove genuine use. In the *London Taxi* case, Arnold J referred to the helpful analysis of *Reber* by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15); [2016] ECC 15, at [24] – [45]. As Professor Annand pointed out, use was proven of the mark “Walzertraum” in the form of retail sales of a range of praline chocolates from a bakery in a small tourist town on the German border. There had been retail sales from the bakery of about 40 to 60 kg of such chocolates per year, and it was accepted that such sales had been continuous. Nonetheless, it was held that the Walzertraum mark had not been genuinely used during the relevant period, which decision of the General Court was affirmed on the law by an Order of the CJEU. Paragraph [32] of the Order of the CJEU stated:

“32 However, contrary to the view taken by the appellant, the assessment of the genuine use of an earlier mark cannot be limited to the mere finding of the use of the trade mark in the course of trade, since it must also be a genuine use within the meaning of the wording of Article 43(2) of Regulation No 40/94. Furthermore, classification of the use of a trade mark as genuine likewise depends on the characteristics of the goods or services concerned on the corresponding market.... Accordingly, not every proven commercial use may automatically be deemed to constitute genuine use of the mark in question.”

134. This must be the case, since the onus is on the trade mark proprietor to prove that there has been real commercial exploitation of the mark. All relevant circumstances must be considered including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use. Proof of retail sales may be insufficient to establish the relevant facts.

*The appellant’s appeal in respect of the evidence*

135. The appellant submits that the hearing officer erred in his consideration of the evidence. The hearing officer is criticised for questioning at [32] of the Decision whether the appellant had provided photocopying services under or by reference to the Trade Marks. It is said that he had either overlooked or misunderstood the unchallenged evidence before him which was set out in Annex 4 to Exhibit A to the Witness Statement of Mark Holah in respect of 166 (at pages 39-40 of tab 16 of the appeal bundle):

“Easyoffice provides

Air-conditioned offices furnished with chairs, lockable desks and cupboards

Your own telephone lines with phones supplied

Access to photocopying facilities...

Optional Extras available

Additional furniture...

Fax machines

Additional telephones

Additional telephone/fax line rental

Telephone calls charged at standard BT rates

Photocopies – 6p per page”

136. Further, it is said that the hearing officer failed to address the evidence of use as set out in Annex 4 to the effect that the Trade Marks in question were being used in relation to the provision of “fully fitted and furnished” offices which included within the base cost the provision not only of the rent and rates of those offices but also of lighting, power, cleaning, furniture, telephone and line rental and in relation to the meeting/training room offices the provision of “overhead projectors”, “flip charts”, “complimentary spring water”, “coffee point”, “snacks machine” and extra facilities on request.
137. I reject this ground of appeal, for the following reasons. First, at [34] the hearing officer found that the occupation agreements were conclusive instances that there had been use, and in combination with the advertising leaflet, show this to have extended to providing access to photocopying facilities under the Trade Marks. It cannot be a ground of appeal for the appellant to complain about his findings in relation to the photocopying facilities, which were in its favour.
138. Secondly, the advertising leaflet at Annex 4 is dated May 1999. This is several years before the start of Relevant Period from which the hearing officer revoked the Trade Marks. There is no evidence that the brochure was used during the relevant period. On the contrary, paragraphs [4] – [5] of the Counterstatement, which is relied on by the Appellant, states that Annex 4 is “sample marketing literature advertising the Proprietor's services dated and in use from May 1999”. However, it asserts that “All units on the Proprietor's premises are currently, and have consistently been, occupied and it has thus been unnecessary to engage in any further advertising or marketing campaign.” This does not establish use during the Relevant Period of this advertising leaflet.

*Other evidence of provision of office facilities*

139. I shall apply the natural and ordinary meaning of this phrase, which includes anything that facilitates the functioning of an office, which could be a physical item, such as a desk, chair or table, or a human endeavour such as secretarial typing services, data processing and document reproduction etc., but does not include rental of the office itself. In accordance with the appellant’s case, I shall not limit the natural and ordinary meaning by reference to Class 35. I have reached the view that, even on this favourable assumption to the appellant, the appeal must be dismissed. Even if all of the services relied on by the appellant are included in the specifications of services, it has still failed to provide the necessary evidence of genuine use. My reasons are as follows.
140. First the advertising leaflet does not constitute evidence of such use during the Relevant Period and there is no indication that it was distributed during the Relevant Period.
141. Secondly, I am prepared to accept (as was the hearing officer) that the offices which were rented during the Relevant Period, as evidenced by the occupation agreements, were furnished and had some facilities. However, there is no attempt in the evidence

of the appellant to quantify any use of the Trade Marks in respect of such facilities. Nor do the agreements provide any kind of quantification of such use. The same is true in relation to rental of office equipment. The agreements which have been exhibited are occupation agreements for offices at Gatwick Airport which contain an option for additional facilities such as a stand-alone desk or a networked personal computer etc. Occasionally, such options have been taken up – e.g. a small table and two easy chairs have been specified. Generally, no additional facilities have been requested.

142. Thirdly, in relation to the provision of office facilities (as I have construed that phrase) and the provision of office equipment, it is not possible to conclude that any use of the Trade Marks was viewed as warranted in the sector to create or maintain a share in the market for the goods or services in question, since the relevant circumstances are not addressed in the appellant's evidence. That evidence focuses on the rental of offices, and does not provide the relevant facts in relation to the provision of facilities for use in such offices.
143. Fourthly, I consider that the hearing officer was amply justified in his conclusion at [33], on the basis of the evidence before him, that the provision of office facilities under or by reference to the Trade Marks had been as an adjunct to the office rental to those renting office space, rather than as a general service. As such, it did not amount to real commercial exploitation of the Trade Marks on the market for maintaining such services and was not aimed at maintaining or creating an outlet for the services for which the Trade Marks are registered, or a share in the market for such services.

#### *Rental of office space*

144. During the course of his oral argument, Mr Vanhegan contended that the provision of office facilities included the rental of office space and that the evidence showed genuine use in respect of rental of office space. I have rejected the submission, for the reasons set out above. However, in case I am wrong, I will shortly set out my views on this issue.
145. None of the witness statements nor any of the exhibits relied upon by the appellant give any figures for turnover in respect of rental of office space during the relevant period. However, Mr Vanhegan submitted that an annual figure could be calculated from that evidence. He referred to the advertising leaflet from 1999, which contained prices for each of the four types of units which it advertised, together with a meeting/training facility. He relied on the Counterstatement which, at [5], stated that:

“All units on the Proprietor's premises are currently, and have consistently been, occupied and it has thus been unnecessary to engage in any further advertising or marketing campaign. However, the Proprietor's services have at all material times been branded with and by reference to the Mark continue to be so branded”

146. Mr Vanhegan submitted that the yearly income for Easyoffice in respect of each unit would have been (if at all times the rates had remained fixed as at May 1999): (1)

£929 x 12 = £11,148; (2) £1394 x 12 = £16,728; (3) £1858 x 12 = £22,296; (4) £2322 x 12 = £27,864; in total = £78,036. The yearly income for the meeting/training facility if fully occupied (which was not asserted in the Counterstatement) would have been (£700 x 52) = £36,400 (again at the May 1999 rates).

147. Mr Malynicz criticised the calculation on the following bases:

- i) There is no evidence that the occupation agreements were actually leased at the sums and on the terms suggested in the advertising leaflet.
- ii) Paragraph [4] of Ms Chandler's Counterstatement presents the leaflet merely as "sample marketing literature" (because it was in 1999 and so therefore well before the Relevant Period). The first page of the leaflet states that all particulars therein are subject to contract. Ms Chandler does not state that the rates in the leaflet were the rates charged. Indeed, at [5] of the Counterstatement Ms Chandler suggests the leaflet was never circulated after 1999, let alone during the Relevant Period.
- iii) There is no evidence to suggest that the offices were charged by the number of workstations, which forms the basis of Mr Vanhegan's turnover calculations. The occupation agreements list only a "basic fee" and "additional facilities". The "basic fees" in the occupation agreements have all been redacted and no one appears to have paid for "additional facilities", which required express selection.
- iv) There was no evidence that the units let had separate addresses or were of different sizes. The numbers 118a, 118b, 119a and 119b suggest different rooms/units within a single office, and the prices listed in the advertising leaflet could relate to different configuration options for a single office.
- v) The burden was on the appellant to remove doubts about what this evidence shows; a burden which it failed to discharge. There were a number of obvious steps the appellant could have taken in this regard; for example, it could have asked any of the BAA employees whose names were in the occupation agreements (unlike the names of the occupants, these names were not redacted) to provide context to these documents. No such steps were taken.
- vi) Further, the occupation agreements contain no evidence of:
  - a) What a "workstation" consists of, nor evidence of how many workstations, if any, were occupied in each office;
  - b) Any take up of marketing or training suites. The evidence in fact suggests that these were marketed under the name "easymeetings", not easyoffice anyway;
  - c) Charges for additional features which would reasonably be expected to be in a "work station", such as a personal computer;
  - d) Any charges for the so-called facilities of cleaning, electricity etc.; and

- e) Charges being incurred for anything other than rental of offices in Class 36 (and that does not differentiate between furnished/unfurnished).
148. I was most impressed by the ingenuity and resourcefulness of Mr Vanhegan's submission. But, as the saying goes, "you can't make a silk purse out of a sow's ear". Mr Vanhegan disputed the accuracy of certain of Mr Malynicz's assertions, but I accept the generality of the respondent's case on this issue. The turnover calculations were an ingenious *ex post facto* reconstruction, unsupported by specific evidence of quantification, which had not been advanced before the hearing officer. The appellant did not provide turnover figures at first instance and redacted the rental figures from the occupation agreements. The attempt to infer turnover on appeal is, in my view, unreliable.
149. There is a further reason for rejecting the appellant's case in respect of rental of office space. Even if I were to accept the turnover calculations it is not possible to conclude that any use of the Trade Marks was viewed as warranted in the sector to create or maintain a share in the market for the goods or services in question. As to the scale and frequency of use of the Trade Marks, there is no direct evidence from any tenant or landlord. However, the occupation agreements bear repeat signatures from the same individuals, indicating that a small number of tenants were renewing their agreements. All such agreements were for units at Gatwick Airport, which suggests a very limited territorial use of the Trade Marks.

### **Conclusion**

150. For the reasons given above, this appeal is dismissed.