

IN THE HIGH COURT OF JUSTICE
BUSINESS AND PROPERTY COURTS OF ENGLAND AND WALES
INTELLECTUAL PROPERTY LIST (ChD)
INTELLECTUAL PROPERTY ENTERPRISE COURT
UK TRADE MARK NO. 3,362,772

Rolls Building
New Fetter Lane
London

Neutral Citation Number: [2024] EWHC 3256 (IPEC)
Date: 17 December 2024

Before :

HER HONOUR JUDGE MELISSA CLARKE
sitting as a Judge of the High Court

BETWEEN :

Claim No: IP- 2023-000102

ALICE LIMITED

Claimant

- and -

(1) PHOTOGRAM LIMITED
(2) LIAM DONOVAN
(3) VISHAAL KUMAR

(4) VIKAS KUMAR

Defendants

Dr David Ivison (instructed by Downing IP) for the **Claimant**
Mr Aaron Wood (instructed by Brandsmiths) for the **Defendants**
Trial date: 24 October 2024

JUDGMENT

Her Honour Judge Melissa Clarke:

A. INTRODUCTION

1. This is judgment on liability only in a trade mark infringement claim relating to the word mark ALICE and counterclaim for revocation of that mark, following a one day trial in IPEC.
2. The Claimant is the proprietor of the mark in question which is UK registered Trade Mark Registration No. 3,362,772 for the word mark ALICE filed on 21 December 2018 and registered on 22 March 2019 in respect of “*Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*” in Class 9 and “*Repair, maintenance and refurbishment of apparatus for recording, transmission or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments and sound reproducing apparatus & instruments*” in Class 37 (the “**Alice Mark**”).
3. As I will come to explain, the Defendants accept that the First Defendant has infringed the Alice Mark at least in the period from the commencement of its business in March 2020 until 22 March 2024, which is a date 5 years after the date of registration of the relevant mark, after which it became susceptible to revocation on the grounds of non-use. After this date the Defendants were permitted to amend their defence and counterclaim for such revocation. The Second to Fourth Defendants accept they are joint tortfeasors with the First Defendant and so jointly and severally liable with it for any infringement. However, even if revoked, such revocation will take effect only from 23 March 2024 at the earliest, and it does not affect the Defendants’ liability for prior acts of infringement before this date.
4. This case is therefore about whether the Alice Mark was put to genuine use in the first five years of its revocation, and so whether it is liable to revocation in whole or in part.
5. The Claimant was represented by Dr David Ivison and the Defendants by Mr Aaron Wood. I am grateful to them for their written and oral submissions.

B. THE CLAIMANT AND THE REGISTERED TRADE MARKS

6. The Claimant is a company incorporated in England and Wales on 15 November 2016 with the company number 10479545. It is a business which designs and manufacturers a range of electronic equipment. There is a dispute about whether that is audiovisual equipment or audio equipment, which goes to the question of whether there has been genuine use of the Alice Mark across the scope of the specifications.

C. THE DEFENDANTS

7. The First Defendant is a company incorporated on 12 June 2019 in England and Wales with the company number 12046009.
8. The First Defendant has carried on a business offering, advertising and selling a still and video camera for capturing still images and video in the United Kingdom (“**Alice Camera**”) under and by reference to the signs “ALICE CAMERA” (“**Alice Camera Sign**”) and “ALICE” (“**Alice Sign**”) (together, the “**First Defendant’s Signs**”). This is a digital camera which attaches to a smartphone.
9. The other defendants are directors of the First Defendant and each hold 33% of the issued share capital of the First Defendant. They all describe themselves as co-founders of the First Defendant.

D. THE PLEADED CASE ON TRADE MARK INFRINGEMENT

10. The Claimant alleges, and the Defendants admit save as noted otherwise, that:
 - i) the First Defendant started developing its camera in or around March 2020 and launched a crowdfunding campaign for the “Alice Camera” in February 2021 on the website www.indigogo.com;
 - ii) the First Defendant has made the Alice Camera available to the public for pre-order sales since February 2021;
 - iii) the Alice Cameras were due to be delivered to customers in 2021 but had not yet been shipped to customers as at May 2023;
 - iv) the First Defendant offers and advertises the Alice Camera online by various channels which target consumers in the UK including:
 - a) On its website at alice.camera (the domain being registered on 1 June 2019);

- b) On YouTube @thealicecamera; Instagram @thealicecamera; LinkedIn <https://uk.linkedin.com/company/alice-camera>; and Twitter/ X @thealicecamera;
 - c) On Indigogo at indiegogo.com/projects/alice-camera-an-ai-camera-for-content-creators--2; and
 - d) At Unit 21, BOXPARK Shoreditch, 2-10 Bethnal Green Rd, E1 6GY where its cameras were exhibited from 7 June 2022 to 3 July 2022 between 11am and 6pm each day, under the Alice Camera Sign displayed in the shopfront of a retail unit and on a neon sign on the wall of the unit.
11. The Defendants admit that the First Defendant's cameras have the Alice Sign affixed to them and that the packaging of the cameras also has the Alice Sign and/or the Alice Camera Sign affixed to it. They plead that they have written in open correspondence to the Claimant's representatives before the claim was issued to indicate that following receipt of the complaint they intend:
- i) to re-brand the Alice Camera for the UK market to a sign which does not include the term ALICE;
 - ii) to only target markets outside the UK in relation to cameras bearing the First Defendant's Signs;
 - iii) to not target any marketing bearing the First Defendant's Signs at the UK; and
 - iv) that cameras bearing the First Defendant's Signs would not be manufactured, assembled or packaged in the UK;

however, the Third Defendant, who gave evidence for all the Defendants, resiled from this in cross-examination as I will come to set out. At trial he accepted that the First Defendant's cameras had in fact been assembled in the UK and dispatched to customers in the UK bearing the Alice Sign by the time this pleading had been signed with a statement of truth.

12. As noted, the Claimant pleads and the Defendants accept at paragraph 6 of the Amended Defence and Counterclaim subject to their counterclaim, that by affixing the Alice Sign to cameras or their packaging; offering or exposing the cameras for sale under the Alice Sign; exporting cameras under the Alice Sign or using the Alice

Sign on business papers and in advertising, the First Defendant has infringed the Alice Mark contrary to section 10(1) of the Trade Marks Act 1994 (“TMA”). They further admit at paragraph 7 of the Amended Defence and Counterclaim that by those acts complained of, the First Defendant has infringed section 10(2) TMA.

13. The Claimant pleads, and the Defendants accept, that the Alice Camera Sign consists of two parts “ALICE” and “CAMERA”, of which “ALICE” is the dominant and distinctive part and “CAMERA” is purely descriptive when used in relation to a camera. It further accepts that the Alice Camera Sign has been used in relation to cameras, which are goods identical to the Class 9 “*apparatus for recording transmission or reproduction of... images*” in respect of which the Alice Mark is registered. It denies that the First Defendant’s use of the Alice Camera Sign in the same ways as set out in paragraph [[12]] above infringes the Alice Mark contrary to section 10(1) TMA as it denies that the Alice Camera Sign is identical to the Alice Mark. It further denies that such use of the Alice Camera Sign infringes the Alice Mark contrary to section 10(2) TMA.
14. In its initial Defence filed on 24 October 2023, the Defendants advanced a bad faith attack on the validity of the Alice Mark. That was struck out by HHJ Hacon on 13 June 2024, and he allowed the Defendants to serve an amended Defence and Counterclaim.
15. The Claimant seeks, inter alia, a declaration of infringement of the Alice Mark; injunctive relief; an order for delivery up alternatively destruction of all articles which would breach the injunction; and damages or alternatively at its election an account of profits arising from the trade mark infringement.
16. The Defendants accept that if and to the extent that the Claimant’s claim succeeds, the Claimant is entitled, inter alia, to an order that the acts complained of infringed; to an injunction to prevent the recommencement of such acts; and an order for delivery up or destruction. They do not admit that the Claimant has suffered loss and damage by reason of the First Defendant’s acts of infringement. However, their denial of the Claimant’s assertion that they threaten and intend to continue the acts complained of unless restrained by the Court cannot survive the admissions made by the Third Defendant that they do.

E. THE DEFENDANTS’ COUNTERCLAIM AND CLAIMANT’S REPLY AND DEFENCE TO COUNTERCLAIM

17. The Defendants applied to the UKIPO for revocation of the Alice Mark in April 2024 (cancellation number CA000507189), i.e. after the claim had been issued and proceedings were on foot in IPEC, pursuant to sections 46(1)(a) and 46(1)(b) TMA on the basis that it had not been the subject of genuine use in either class 9, where infringement had been alleged by the Claimant, and in class 37, where it had not. That was dismissed by the IPO, with costs, pursuant to s46(4)(a) TMA which provides that where proceedings concerning the trade mark in question are pending in the court, the application for revocation must be made to the court, and not the registrar.
18. The Defendants were permitted to file an Amended Defence and Counterclaim in which they seek a declaration that the Alice Mark is invalid in its entirety (or, alternatively, in respect of “*Apparatus for recording, transmission or reproduction of sound or images*”) and is revoked with effect from the earliest of:
- i) 23 March 2024 (pursuant to section 46(1)(a) TMA);
 - ii) 25 March 2024 (pursuant to section 46(1)(b) TMA); or
 - iii) 1 May 2024 (pursuant to section 46(1)(b) TMA).
19. The Claimant in its Amended Reply and Defence to Counterclaim pleads that it has put the Alice Mark to genuine use in respect of the goods and services of its specification in the period covered by the Defendants’ counterclaim for revocation. It denies that the Alice Mark is liable to be revoked as alleged in the Counterclaim, but pleads that if it were, the Claimant would seek to amend the specification pursuant to section 46(5) TMA, and will rely on such amended specification if and to the extent necessary, in respect of its claims of trade mark infringement.

F. THE ISSUES

20. The list of issues is set out in the Schedule to the case management order of His Honour Judge Hacon dated 12 June 2024:

Revocation of the Alice Mark

- i) For which goods and/or services has the Alice Mark been put to genuine use in the period between 22 March 2019 and 1 May 2024?
- ii) If and insofar as the Alice Mark is liable to be revoked for lack of genuine use, from what date should such revocation be effective?

- iii) If and insofar as the Alice Mark is liable to be revoked for lack of genuine use, what (if any) is a fair specification having regard to the use (if any) that the Claimant has in fact made of the Alice Mark?

Infringement of the Alice Mark

- iv) Is the Alice Camera Sign identical to the sign comprising the Alice Mark?
- v) To what extent are the First Defendant's cameras identical or similar to the class 9 goods of the specification of the Alice Mark as identified pursuant to Issue 3 above (if any)?
- vi) Has the First Defendant infringed the Alice Mark contrary to section 10(1) TMA including, if relevant, after the date identified pursuant to Issue 2 above?
- vii) Is there a likelihood of confusion such that the First Defendant has infringed the Alice Mark contrary to section 10(2) TMA including, if relevant, after the date identified pursuant to Issue 2 above?

G. THE CLAIMANT'S WITNESS EVIDENCE

- 21. The Claimant relies on the evidence of Paul Andersson, its managing director. He signed the Amended Particulars of Claim and Amended Reply and Defence to Counterclaim, which stand as evidence in IPEC, gave a witness statement dated 22 July 2024, a short additional witness statement dated 23 October 2024 clarifying one aspect of his earlier witness statement, attended court and was cross-examined and re-examined. I found Mr Andersson to be a good witness, straightforward and honest and Mr Wood confirmed for the Defendants in closing that he had no criticism to make of him.

History of the Alice brand

- 22. Mr Andersson's evidence is that the original Alice business was operated through a company called Stancoil Limited from 1969, which was founded by Edward Fletcher, who also established the Alice brand. He says that Mr Fletcher designed and manufactured complete professional audio systems for Jesus Christ Superstar at the Palace Theatre in 1972, the three theatres of the National Theatre on the South Bank, and a large number of other installations in theatres and studios throughout the world, the audio systems of which all bore the Alice mark. The Alice business was later operated through a company called Alice Soundtech Ltd. Mr Andersson says that his own background is as a broadcast engineer, working for the BBC in that capacity for 25 years, during which he said he became very familiar with Alice products such as mixing desks. When he left the BBC he became an independent broadcast design and

installation engineer and continued to use Alice products on installations. Mr Andersson says that following Alice Soundtech Ltd ceasing trading in February 2016, Mr Andersson incorporated the Claimant company in November 2016 and began to acquire assets associated with the Alice brand, in order to rebuild the brand, re-manufacture products well known throughout the industry, and design and sell new products. The Claimant has also employed Mr Edward Fletcher since 2020. None of this evidence was challenged in cross-examination and I accept it.

Products sold by the Claimant under the Alice Mark

23. Mr Andersson's evidence of use is that the Claimant has been selling audio hardware products bearing the Alice Mark to customers in the UK and internationally since 2018 and has been selling audio-visual hardware products throughout the UK since 2019. In cross-examination he agreed that the change to selling audio-visual hardware products was a reference to the introduction of the Alice Longitudinal Timecode Distribution Amplifier ("**Timecode DA**"). I will come back to that.
24. Mr Andersson provides a list of the Claimant's products offered for sale to customers during the relevant period at paragraph 9 of his first witness statement. This shows: 12 different broadcast consoles and mixing desk products, plus the Alice 28 Series which is a broadcast console for bespoke builds; 8 products in the Claimant's pre-amplifier "PAK Range"; 5 products in its "Rack Range" including a stereo compressor, a forward compression amplifier, two distribution amplifiers and the Timecode DA; 6 products in the "500 Lunchbox Series", being an audio compressor, pre-amplifiers, and an audio equaliser; and several miscellaneous products including a microphone extender and peak programme meters ("PPMs"). The Claimant has provided datasheets and technical information for these products which Mr Andersson says are also available to download on the Claimant's website.
25. Mr Andersson's evidence in his first witness statement is that all of these products display the Alice Mark on their face, except those which are sold under the Claimant's sub-brand "Pye" which say "Alice Ltd" on the rear of the product. However, in his second witness statement he clarified that the Claimant also sells some third party products which do not carry the Alice Mark, which he described as a very minor part of its business. He said some of these were spare parts of low value such as Penny & Giles fader knobs, but sometimes they were more costly items such as Yello Tec microphone arms, at £250 each. He said such third party products were made available to customers of the Claimant's own products branded with the Alice Mark,

or the Claimant's services provided under the Alice Mark, in order to provide them with a convenient "turnkey" solution, but were not retailed or distributed as a freestanding item. He thought they generated about £10,000-£20,000 of revenue per year but no significant profit. I have seen invoices bearing the Alice Mark in the Claimant's disclosure which show that it sold such third party goods, and I am satisfied that it did so as part of the Claimant's business and under the Alice Mark.

26. Mr Andersson exhibits printouts from the Claimant's website from 2019 to December 2023 (obtained by use of the Wayback Machine) showing the Claimant's (but not the third party) products for sale and including photographs of certain products which show use of the Alice Mark upon them. Mr Andersson also exhibits printouts from the websites of its six third party UK distributors showing that they each carried and offered for sale to the public certain of the Claimant's products carrying the Alice Mark at the Relevant Period. I accept that the Claimant's products offered for sale on the UK market from its website and through third party distributors all had the Alice Mark upon their face, except for the PYE products which had it on the rear of the product, and that all of them were offered for sale under the Alice Mark.
27. I have heard about one order of products (the Alice Tieline MHB which is a microphone input extender) which Mr Andersson said the customer required to be sold with the client name on them, so the Claimant made a batch of 25 to that specification. Accordingly the physical product in that order was not branded with the Alice Mark, but nonetheless I am satisfied they were offered for sale under the Alice Mark and invoiced with an invoice bearing the Alice Mark. Mr Andersson was also questioned about several products for which the Defendants could not locate invoices. He said that some of them, such as the Alice Air 2016 Quad Guest Headphone Amp, had been supplied as part of mixing desks, and not sold as a standalone product, so he was not surprised that there were no individual sales visible in the invoices. I accept that evidence.
28. Mr Andersson says that the Claimant makes all its branded products in the UK and sells to clients throughout the UK as well as exporting products to other countries. I have seen a selection of invoices from each year from 2020 to 2024 supporting this evidence.
29. Mr Andersson says that all of these products are "*apparatus/instruments used in signal-mixing, sound recording and sound reproducing for use in radio and television production and broadcasting*". He points to the mixing desks (Alice 828 Mk3 and

Alice 28 Series) as an example of audio apparatus. As products which he says are “*of particular application in film and television production*” he points to the Mic Amp PAK Duo with TX & USB, Mic Amp PAK Solo with TX and USB, the Timecode DA and Dual Twin peak programme meters (PPMs) with Sifam 74A and 74B meters.

30. The Mic Amps are as described. On its website the Claimant describes them as “*ideal for remote presenters and contributors to radio and TV shows using an existing microphone and the USB output into a PC or laptop*”.
31. PPMs are used for live-on air audio monitoring and also have post-production use.
32. The Timecode DA forces the same time code signal to be sent to all audio and visual recording equipment used at the location so that they are all synchronised together, and consequently sound and image is also synchronised together. The Claimant’s website describes its uses as including “*On-location shooting with PSC cameras and portable audio mixers that require a jammed LTC timecode signal, outside broadcast trucks or fixed installations that require timecode to be sent to vision mixers, EVS, audio mixing desks and studio clocks etc*”. Mr Andersson confirmed in cross-examination that the time code signal was added to, or embedded within, an input audio signal.
33. Mr Andersson was challenged in cross-examination about whether any of these products could properly be considered ‘audiovisual equipment’ as opposed to audio equipment. He said that the Timecode DA was designed for use in radio and television (including outside broadcast environments and theatre environments) with portable single cameras and for field equipment jamming. He describes it as “*important AV integration equipment which ensures that audio sound desks and cameras work together smoothly using the same time signal, to avoid lip sync issues, for example, and to assist with the editing process...*”. I accept that the Timecode DA is commonly and very frequently used in audiovisual environments, although it can also be used in audio-only environments, particularly those with long runs of cable.
34. In his witness statement Mr Andersson also points to the Mic Amp PAK Duo with TX & USB product as being one which allows two audio signals to be input, mixed within the device, and the resulting audio provided via two audio outputs in the form of standard audio sockets but also via a USB output which is intended to allow the mixed audio to be provided directly to a computing device. He says, “*The intention of this product is to allow content-creators – particularly those making digital video*

content for online applications – working on a laptop who wish to introduce a high-quality audio feed into their computing device to mix it with the video feed available to the computing device”. He was asked in cross-examination if the specification of this product had been developed specifically for content creators, or if he had just said so to support this case. Mr Andersson said that it had been developed for several different uses and one was for content creation. I accept his evidence.

35. Mr Andersson has also exhibited product reviews in independent specialist publications. For example, he has provided an extensive 5-page article from the December 2021 issue of Sound-on-Sound magazine, which he describes in his witness statement as the world’s most recognised audio equipment review magazine (description not challenged in cross-examination). In this the author notes that Mr Fletcher has “*Reunited with the much-loved Alice brand after many years*” and asks if he has “*managed to breathe new life into this classic compact mixer*”, being the Alice 828 Mk 3 analogue mixer. Another article from the same magazine in November 2023 reviewed the Claimant’s stereo optical compressor, the Alice 538R. In both articles the author provides a close analysis of what it sees as the strengths and weaknesses of the relevant product. Mr Wood in closing for the Defendants noted that there was no evidence about whether this was paid-for promotion or not, but he did not question Mr Andersson on the point in cross-examination, so it goes nowhere, in my judgment.

Services provided by the Claimant under the Alice Mark

36. Mr Andersson notes that the very long history of the Alice brand in the field means that there are a large number of legacy Alice products in use by radio and TV broadcasters, sound and video recording companies, as well as products bearing the Alice Mark produced by the Claimant. The legacy Alice products in particular require repair, maintenance and refurbishment now, and he describes that as an important part of the Claimant’s business. He says that it also repairs and refurbishes third party products sent to the Claimant, and performs repair, refurbishment, maintenance and installation work, and broadcasting assistance onsite or in the field for clients. His evidence is that the Claimant provides all such services under the Alice Mark.
37. On this latter point, I have seen from documents in the trial bundle that the Alice Mark appears on invoices from the Claimant for such services. In cross-examination it became apparent that the Claimant does not have a team of service professionals, and those services are all provided by Mr Andersson. Mr Andersson further clarified in

cross-examination that various 2023 invoices to Coyle Limited in the trial bundle relate to the provision of services in his secondary area of expertise, namely railway signalling, i.e. not audiovisual broadcasting or transmission, and so are certainly outwith the Class 37 specification for the Alice Mark.

Sales

38. Mr Andersson has exhibited client invoices showing, inter alia, sales of products to clients in the UK (including third party distributors) for each year from 2020 to 2024 inclusive, and repair, refurbishment, maintenance and installation work for clients from 2021 to 2024 inclusive.
39. Mr Andersson's evidence is that from 1 December 2019 to the end of November 2023 its total sales turnover from the sales of products and services has been approximately £400,000 in total, showing steady growth each year from an annual sales turnover of just under £25,000 for the year ending 30 November 2020 to some £137,000 for the year ending 30 November 2023. From this, as Mr Wood for the Defendants submits and I accept, we must strip out the railway signalling services work, which amounts to approximately £97,000 of the 2023 turnover, bringing the total turnover for the whole period closer to £300,000. Mr Wood also submits that the Court should strip out the third party products for the purposes of considering use of the Alice Mark. However, I have accepted Mr Andersson's evidence that those products were only sold with the Claimant's Alice-branded products or services and so I decline to do so.

Evidence going to likelihood of confusion

40. Mr Andersson exhibits documentation from the Defendants' website which he says causes him to be concerned that customers of the Defendants' camera would be confused that it was one of the Claimant's products, or is being made under licence by the Claimant. These include an article dated 17 May 2022 advertising how the Defendants' camera could be used by professionals to capture photos and videos and live streams of live music and live music events; and an article dated 30 May 2022 advertising how the camera could be used by professionals at live sports events to capture photos and videos and live streams, noting that the "*Alice Camera works with external microphones, tripods, battery packs and storage systems*". Mr Andersson's evidence is that the Claimant's products are also used at live music events and live sports events to capture audio and visual content. He also exhibits screenshots from a video on the Defendants' YouTube channel entitled "*Who is the Alice Camera for?*"

which shows the Alice Camera in use with, and plugged into, two audio mixers, and which appears to market the Alice Camera with an audio mixer for the purpose of recording audio and visual footage together for a podcast. Of course, the Claimant sells a range of audio mixers under the Alice Mark.

41. Mr Andersson exhibits an Instagram post of the Defendants of 14 June 2022 which pictures the Alice Camera with a microphone set up attached, and the tag line “*Read how the Alice Camera can be your best home-studio-friendly device*”, and notes that the Claimant’s products connect to microphones and cameras and are used in home studios as well as professional studios.
42. He also exhibits a review of the Alice Camera on the website www.digitalcatapult.org.uk which quotes the third Defendant, Vishal Kumar, as saying “*The Alice Camera could be really help [sic] for broadcasters, like the BBC or ITV who are massively cut for budgets but don’t necessarily need to take a massive film crew to a remote news location. Instead, they could just take something like an Alice Camera, which will give them the quality that they want, but also the ability to stream content online*”. Mr Andersson notes that many of the Claimant’s customers are British broadcasting companies, and many of its products are used in the field as well as in fixed studios. For example, he says that Alice products are used in the filming of Love Island, and also at the Wimbledon tennis championships. He says he is concerned that the Defendants are targeting customers operating in this same space using the identical Alice Sign.
43. Mr Anderson says that it is common for companies which manufacture and sell cameras also to sell audio and broadcasting equipment, such as well-known professional and consumer goods companies such as Sony, JVC, Panasonic and Canon as well as more specialist companies such as Blackmagic, Datavideo, Arri and Grass Valley, and so he is concerned that those who see or buy the Alice Camera may believe it is a product of the Claimant, or may believe that produced by the Defendants under licence from the Claimant. He has provided evidence of the product range of these companies which shows, for example, that Blackmagic manufactures a range of digital video/film cameras including handheld cameras as well as audio mixing desks, audio monitors and embedded audio/visual switches; Sony manufactures cameras and video cameras across the consumer and professional market, as well as audio and audiovisual equipment for broadcast and production, including audio amplifiers and mixers; and Datavideo which makes video cameras as well as audio mixing equipment. Mr Andersson was questioned about this in cross-examination

which only strengthened his evidence in my judgment, for example noting that Datavideo's equipment is used on large and small television shows and includes a range which relies on an external timecode system. I am satisfied on his evidence that it is common in the industry that companies marketing products similar to the Claimant's products also market cameras, and I accept that he considers it a real risk that the First Defendant's camera, if marketed under the Alice Sign or Alice Camera Sign, would be perceived by the public as a natural product line extension of the Claimant's offering.

H. THE DEFENDANTS' WITNESS EVIDENCE

44. The Defendants did not file any evidence in chief. However, the Third Defendant, Mr Vishaal Kumar filed a witness statement dated 19 August 2024 in reply to that of Mr Andersson, and on behalf of all of the Defendants. HHJ Hacon permitted the Defendants to rely on this witness statement by order of 30 July 2024. Mr Kumar attended court remotely and was cross-examined.
45. Mr Kumar's written evidence is that he believes the Claimant's business is focussed on professionals in the audio/TV industry. He says that in contrast the Alice Camera is aimed at general consumers, including hobbyists and travellers who might want a higher quality of video production, and also video enthusiasts who might want to produce videos for uploading to a user generated content website such as YouTube, or another online platform for videos. He described the Alice Camera as apparatus which attaches to a mobile phone and provides the quality of a Digital SLR or mirrorless camera. It retails at around £750, which he says is around the cost price of mid-level cameras for content creators. He has exhibited some evidence of pricing from a camera magazine which appears to support this assessment. He said that the Alice Camera has obvious benefits over a separate camera from the point of view of the casual user or content creator as it uses less space and is easier to work with the content in terms of uploading media quickly and easily and being able to save videos to their phone.
46. Mr Kumar accepted that, as was Mr Andersson's evidence, the Alice Camera could be used by consumers to capture video at music and sporting events, but said that he considered that was still quite different to the professional products aimed at the industry sold by the Claimant. He said the video content produced by the Alice Camera "*is not comparable to professional TV or film companies*". He accepts that the Alice Camera could be used by more specialist users, which he described as "*very*

much aspirational – it would be wonderful if the market for cameras changes to mean that cameras of the quality of ours becomes “enough” for the television industry”, he says the “main use case” for the Alice Camera is “content creators who want a higher quality of output that they can get from their phone but want to be able to upload media quickly and easily... Ease of use and assistance are key”. He accepted that the Alice Camera could be used with an external audio source such as a microphone.

47. I was not convinced by his evidence that the Defendants did not intend to market the Alice Camera to professionals and considered that it was quite different to professional products, as it runs counter to much of the messaging that the First Defendant has put out to the public, although he sought to dismiss this in cross-examination. When he was asked about the quote on www.digitalcatapult.org.uk where he said that the Alice Camera could be really helpful for broadcasters, and referred to use by professionals in the film or creative industries, he first said *“My understanding is that professionals want complete control and the Alice camera won’t give that”*, and then accepted that it was possible that professionals could use it if they considered it was useful. But he described it as *“just aspirational marketing speak, polished for social media”*. When asked about his quote that the Alice Camera would allow the shooting of *“really high-quality professional footage”* and that it would be *“really helpful for broadcasters like the BBC or ITV”* he described this as *“a hypothesis in 2021, but we realised that BBC and ITV want something very different to the Alice Camera”*. Mr Kumar sought to give opinion evidence on what professional audiovisual industry users want, but he is not an expert in this case and nor do I understand him ever to have been such a professional, and as such does not have the expertise or qualifications to give that opinion, which is inadmissible in my judgment. When asked about a skills video shot at Boxpark Shoreditch in which he said that *“we even had someone who works at Netflix”* interested in the Alice Camera, he accepted that Netflix were one of the biggest producers of content in the world, and this was important to tell to the world, but said he failed to mention it in his witness statement *“because it was dated”*. I consider that he failed to mention it because it did not fit his narrative that the Alice Camera was only really suitable for consumers and casual users *“such as entry level content creators who want a professional look and polished social media content”*, although he did accept that such users could include those who work in the film and creative industries or who aspired to work in the creative industries. In my judgment the evidence suggests that the high quality video output of the Alice Camera, and the benefits which come from its attachment to a mobile telephone, would be of interest to professionals in the

audiovisual industry both for professional use and for their own use outside their working life.

48. Mr Kumar accepted in cross-examination that he had sought and obtained financing for the First Defendant, eventually obtaining £1m in venture capital finance, and that in pitching the business to potential investors he had created business plans and presentations in which he would have set out, amongst other things, the target market for the Alice Camera. None of those have been disclosed. I am satisfied that I am able to draw the inference, and do draw it, that he has not disclosed such documents as they would not support his case that the Alice Camera was intended to be marketed only to consumers and casual users.
49. In relation to the video exhibited by Mr Andersson showing the Alice Camera being used alongside an audio mixing desk, he accepted that some content producers do use audio mixing desks, but he did not believe his target customers would use mixing desks of the sort sold by the Claimant or that they would be likely to use the Alice Camera with a mixing desk. This appears to me to be entirely speculative.
50. In cross-examination, and as previously noted, Mr Kumar resiled almost entirely from the pleaded intention:
- i) to re-brand the Alice Camera for the UK market to a sign which does not include the term Alice. He told the Court “*We don’t have plans to do that [rebrand] currently*”;
 - ii) to only target markets outside the UK in relation to cameras bearing the First Defendant’s Signs. He told the Court that the First Defendant had shipped about 20 Alice Cameras to customers in the UK from about August 2024, who had received them. He confirmed that those all had the sign ‘Alice Camera’ on the front;
 - iii) to not target any marketing bearing the First Defendant’s Signs at the UK. This seems to fall with (i) above; and
 - iv) that cameras bearing the First Defendant’s Signs would not be manufactured, assembled or packaged in the UK. He told the Court that although manufacture had been moved outside the UK, the final assembly of Alice Cameras sent to UK customers from August 2024 had taken place in the UK, and I can infer from that that they were also packaged in the UK before dispatch to customers.

51. It follows from his evidence, as was fairly put to him by Dr Ivison, that the Defendants' pleaded case in the original Defence and at paragraph 14(a) of the Amended Defence and Counterclaim that the Acts complained of had ceased was not true when he signed the Defence in October 2023 or when he signed the Amended Defence and Counterclaim in June 2024. Mr Kumar accepted that that they had not ceased, and he knew that when he signed those documents with a statement of truth.

I. LAW - REVOCATION

52. Section 46(1) TMA provides, so far as is relevant to this case, that 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;

...”

53. Section 46(5) TMA provides that where grounds for revocation exists in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.
54. There is no dispute between the parties on the applicable legal principles, the dispute being on whether such evidence of use as adduced by the Claimant was sufficient to demonstrate genuine use across the specification of the classes in which it is registered, or some reduced specification in those classes.
55. Mr Wood stated in closing that he has no issue with Dr Ivison's summary of the law. That includes that, relying on *Minimax*, Case C-40/01 that the concept of “genuine use” includes use which is small in quantitative terms, provided that use is demonstrated: (i) which is not merely token, i.e. carried out solely for the purpose of sustaining a grade mark registration (at [46]); and (ii) which is real, in the sense of being warranted in the sector concerned to “*maintain or create a share in the market for the goods protected by the mark*” (at [38]).
56. The Court of Appeal provided a helpful summary of principles applicable to determining whether there has been genuine use of a trade mark in *easyGroup v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, [2024] FSR 9 at [106] – [107], citing the

following CJEU cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] E.C.R. I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] E.C.R. I-1159; [2004] F.S.R. 38, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] E.C.R. I-4237, Case C-442/07 *Verein Radetzky-Order v Bundesvereiniguing Kamaradschaft 'Feldmarschall Radetzky'* [2008] E.C.R. I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] E.C.R. I-137, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:593], Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854]:

“106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]–[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]–[23].

(5) The use must be by way of real commercial exploitation of the 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: *Ansul* at [37]–[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, 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: *Ansul* at [38] and [39]; *La Mer* at [22]–[23]; *Sunrider* at [70]–[71], [76]; *Centrotherm* at [72]–[76]; *Reber* at [29], [32]–[34]; *Leno* at [29]–[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and *Ferrari* at [73]–[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office* [EU:T:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth CC* [2013] R.P.C. 24 Daniel Alexander QC sitting as the Appointed Person said:

"19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...

22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal ... comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

57. The parties agree that a helpful summary of the approach that the Court should take when dealing with allegations of non-use, including in cases of partial revocation,

was provided by Henry Carr J in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2017] RPC 12 at [47]:

“I summarise the relevant principles to be applied, as follows:

(i) The principles to be applied when considering whether there has been genuine use were summarised by Arnold J. in *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch); [2013] E.T.M.R. 31; [2013] F.S.R. 35 at [51]. This was set out by the hearing officer at [34] of the UKIPO Decision.

(ii) Genuine use of a trade mark can occur when that mark is used alongside other trade marks or signs; *T-29/04 Castellblanch SA v Office for Harmonisation in the Internal Market* [2005] E.C.R. II-5309; [2006] E.T.M.R. 61; *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2012] EWCA Civ 24; [2012] F.S.R. 19 (“Specsavers”).

(iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch); [2014] E.T.M.R. 57; [2014] F.S.R. 40 (“Thomas Pink”) at [52].

(iv) In cases of partial revocation, pursuant to s.46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

(v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd (EXTREME Trade Mark)* [2008] R.P.C. 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

(vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v ASOS Plc (“ASOS”)* [2015] EWCA Civ 220; [2015] F.S.R. 20 at [56] and [60].

(vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance

different from them; T-256/04 Mundipharma AG v OHIM [2007] E.C.R. II-449; EU:T:2007:46.”

J. DETERMINATION OF THE COUNTERCLAIM FOR REVOCATION

Issue 1: For which goods and/or services has the Alice Mark been put to genuine use in the period between 22 March 2019 and 1 May 2024?

58. The Defendants’ pleaded case at paragraph 17 of the Amended Defence and Counterclaim is that although it is aware of the Claimant’s asserted use, “*it is not believed that this use constitutes genuine use of the Alice [Mark]...*”. In the Defendants’ skeleton argument he said that he would make submissions on genuine use following testing of the Claimant’s evidence in cross-examination. In fact Mr Wood for the Defendants made few submissions on the point in closing. He relied on the guidance of Daniel Alexander KC in *Awareness v Plymouth* at [22], where he noted that “*A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive*”, to submit that on analysis of the invoices disclosed by the Claimant there were very small numbers of sales for most of the Claimant’s products, save the Timecode DA, and for some of the products there were no sales visible in the disclosed invoices. However, he accepted that assessment of genuine use was not “*a numbers game*”. He made a bare submission that the Claimant bore the burden of proof but had not made out the case of genuine use, but Mr Andersson had given and disclosed extensive evidence of use, much of which was not challenged in cross-examination, and Mr Wood said in closing that he had no criticisms to make of Mr Andersson as a witness.
59. The Claimant submits that the Court can be satisfied on the balance of probabilities that it put the Alice Mark to genuine use in relation to all of the Claimant’s products and services offered and provided to the public in the relevant period.
60. I accept the Claimant’s submission. Stepping back and considering Mr Andersson’s evidence and the supporting documentary evidence as a whole, that the Claimant has satisfied me that in the relevant period it has made actual and genuine use of the Alice Mark by offering for sale and selling goods and services to the public throughout the relevant period under the Alice Mark, either by itself as trade mark proprietor mainly but not entirely through its website, or (in relation to the Claimant’s products) to third party distributors/independent retailers for onward marketing and sale to the public.

61. This is supported by, *inter alia*, the invoices disclosed by the Claimant. It was apparent from Mr Andersson's evidence in cross-examination that he does not have a sophisticated billing and accounting system – he described that he produced all invoices himself and if he was away from the office he would have to make up a random invoice number as he would not have the information remotely about what the correct sequential invoice number would be – and I am satisfied that explains why he is not able to push a button on a computer and provide a full breakdown of every separate product that goes into making up a particular invoiced broadcast console, for example. To the extent that Mr Wood for the Defendants suggested that I should draw an adverse inference from the fact that not every invoice in the relevant period has been disclosed, or that the information they contain has not been further broken down, I decline to do so for that reason. However, I am satisfied that Mr Andersson knows the Claimant's business intimately as it is run almost entirely by him with some assistance from Mr Fletcher; he knows what products and services it has sold and to whom (not least because he has performed all of the services), and I found him to be an honest, credible and reliable witness.
62. I am satisfied that the use that I have found amounts to real commercial exploitation of the Alice Mark which can in no way be described as merely token, in my judgment. There is a real business, and I am satisfied that the Claimant has used the Alice Mark as a mark of origin on its own products to either maintain the market share for those products which were legacy products in the Alice brand, or create a market share for new products, all of which are covered by the Alice Mark, even if some of those products have achieved relatively few standalone sales. It has sought to support that growing market share by the production of product leaflets and specifications explaining and marketing its products which are readily available to the public on the Claimant's website; it has achieved six different third party distributors/independent retailers who each carry a range of the Claimant's products bearing the Alice Mark, market them for sale on their websites and order product from the Claimant; the effort taken by the Claimant to revamp legacy products and to launch new ones has been recognised by what I accept is a world-leading audio equipment review magazine which, I have no doubt, would not dedicate pages of at least two issues of its magazine on the Claimant's products branded with the Alice Mark if these were not real products which its readers could easily obtain; and I accept Mr Andersson's unchallenged evidence that the Claimant's products branded by the Alice Mark are used by major professional broadcasters such as the BBC, in the production of a wide range of television and radio programmes attracting huge domestic and international

audiences such as Love Island and the Wimbledon tennis championships, as well as by other non-broadcast users ranging from video and audio production facilities, to theatres and sporting venues.

63. I also find that the Claimant has sold third party products under the Alice Mark to support sales of its own Alice Mark-branded goods and services, and that the Claimant has used the Alice Mark to create market share for the offering and sale of services for repair, maintenance, refurbishment and installation of the Claimant's own products branded with the Alice Mark but also repair and refurbishment of third party audio equipment. I further find that the Claimant has provided more generalised audiovisual and audio broadcasting assistance services for the maintenance of onsite and outside broadcast recording and transmission, including live services, for both radio and television, as Mr Andersson described. The turnover that the Claimant has achieved in the relevant period for goods and services is not large, but it is significant enough to be described as a market share, and is well above anything which could be described as *de minimis*, in my judgment.
64. In my judgment, following Mr Andersson's oral evidence, the Defendants' closing submission that the Claimant had not made out genuine use was patently ill-founded (as well as unsupported), and should not have been made.
65. I will move next to the question of whether the genuine use found is sufficient to support the entire class 9 and class 37 specifications.
66. I repeat the specifications of the Alice Mark in Class 9 and Class 37 for ease of reference here:

Class 9 - Apparatus for recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting"

Class 37 - Repair, maintenance and refurbishment of apparatus for recording, transmission or reproduction of sound or images, audio apparatus, signal-mixing apparatus & instruments, sound recording apparatus & instruments and sound reproducing apparatus & instruments

67. The task for me is to consider whether there has been genuine use across the whole of the specification in each of class 9 and class 37, and if not, arrive at a fair specification having regard to the genuine use made of the trade mark, per Thomas

Pink at [52]. In doing so I remind myself of the guidance of Arnold J (as he then was) in *Stichting BDO*, cited and relied on in *Property Renaissance*, that the Court is not constrained by the existing wording of the specification of goods or services, and in particular it is not constrained to adopt a “*blue pencil approach*” to that wording. The aim is to strike a balance between the respective interests of the proprietor, other traders and the public, having regard to the protection afforded by a registered trade mark, and having informed itself about the relevant trade, decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used, approaching it from the consumer’s perspective.

The Average Consumer

68. The average consumer for this purpose is the same as the average consumer against whose perspective infringement is to be assessed, as for that purpose the average consumer is a notional consumer of the relevant goods and/or services in the specification of the trade mark said to be infringed. There is no dispute on the law relating to the average consumer: his characteristics are well established (see in particular *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501; [2013] FSR 21) and I will not repeat them here.
69. I have had little in the way of submissions about the notional average consumer in either the skeleton arguments or oral submissions of the parties, and nor do they address the average consumer in their pleaded cases. The Claimant submits at paragraph 62 of its skeleton only that the average consumer is a consumer of the goods of the Alice Mark’s specification. The Defendants submit only that the relevant public for the Claimant’s goods – by which I understand it is referring to the average consumer which is the notional construct through which the perception of the relevant public is to be assessed - are sound engineers in the radio and tv industries. Neither party expressly addressed the average consumer or the extent to which, if at all, their average consumers differed, in oral submissions.
70. I consider that the Defendants’ average consumer is far too narrow both in terms of the type of professional they are and the industries they work in. In relation to the type of professional, there is no evidence before me that the average consumer is limited to sound engineers although I am sure the average consumer construct will include sound engineers within it, whereas there is evidence before me that the average consumer is a buyer of audio and audiovisual equipment from a wider range of professional roles, in my judgment.

71. In November 2020, on its website, the Claimant described itself as manufacturing “*products for the pro studio and broadcast market*”. Looking at the Alice 28 and 828 mixing desks, for example, the user handbooks produced by the Claimant describe those as being introduced in 1978 and quickly becoming established as “*the industry standard for audio-visual production and presentation, high quality sound reinforcement, mobile recording facilities and CCTV installations as well as for location recording for TV programmes and series*”. This finds some independent support, in my judgment, in the Sound-on-Sound article from December 2021 that the Claimant’s original 828 mixing desk “*Primarily [found] its home in TV and radio broadcast... a classic...*”. The author, who describes himself as a “*music producer under 40*” and so focusses on audio uses of the mixing desks, goes on to review and recommend the updated version to “*some people looking for a high-end, compact mixer for small radio stations, live sound and podcasting... those, like me, with a fairly serious hybrid music-production studio... jobbing music producers*”.
72. In terms of the industries potential buyers work in, therefore, the Sound-on-Sound article refers to live sound, podcasting and music production, but I am satisfied that this can be extrapolated to live and recorded TV, videocasting (such as on by production of content for YouTube, for example), and video production, as I accept the evidence that those mixing desks were “*industry standard for audio-production and presentation*”, including in TV. I also have Mr Andersson’s evidence that the Mic Amp PAK Duo with TX and USB is aimed at, *inter alia*, content creators, and his evidence about use of the Timecode DA, such that I am satisfied that the Claimant’s products are also used in TV studios, outside broadcast and field facilities, video production facilities, theatres and sporting venues, and by smaller-scale audio and audiovisual content creators. I accept that any such buyers will be likely to have a more than basic level of technical knowledge and understanding to be able to understand at least the base functionality of the fairly specialist equipment that they are buying, even if they do not understand everything that it can do before they have gained familiarity with it in use, and that the average consumer in this case can properly be described as a professional consumer.
73. Doing the best I can, therefore, I find that the average consumer is a professional and technically-competent buyer of audio and audiovisual equipment, and that this construct includes not only sound engineers but also: music, video, TV and radio and theatre producers and technicians; those setting up audio and audiovisual recording, live sound and broadcast facilities; and other content creators.

Submissions

74. In the Defendants' skeleton argument, it notes that the Claimant asserts sales of the Claimant's products branded with the Alice Mark as set out in Mr Andersson's witness statement and submits that those products are not:
- i) Apparatus for recording, transmission or reproduction of sound or images;
 - ii) Signal-mixing apparatus and instruments;
 - iii) Sound recording and sound reproducing apparatus and instruments;
 - iv) Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting.
75. It follows, the Defendants submit, that the only questions which remain are:
- i) whether those products fall within the remaining term "*audio apparatus*";
 - ii) whether "audio mixing desks" falls within "*signal-mixing apparatus and instruments; signal-mixing apparatus and instruments for use in radio and television broadcasting*"; and
 - iii) whether those terms can be retained as registered or must be limited.
76. In closing submissions Mr Wood for the Defendants conceded the possibility that the Timecode DA fell within "*Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*". However he relied on the Defendants' written submission in its skeleton argument that if the Court is satisfied that there had been genuine use on all the Claimant's products, then at best, and subject to the meaning of the term "*audio apparatus*", the application of the law as set out in *Property Renaissance* would lead to the following specification:
- Audio amplifiers; audio compressors; audio pre-amplifiers; audio equalisers; audio mixing desks; audio mixing desks for use in radio and television broadcasting.*
77. The Claimant submits that the evidence of genuine use is sufficient to support the specifications in class 9 and class 37 as they stand, and those specifications fairly reflect the Claimant's business. It submits that if the Court disagrees, so is minded to amend one or both specifications, then, per Richard Arnold KC (as he then was)

sitting as an appointed person in *Nirvana Spa & Leisure Ltd v Boura (NIRVANA)* BL O/262/06 at [58] and [59] cited in *Awareness v Plymouth* at [17], the question of framing a fair specification is a value judgment, and it is one which is for the tribunal to frame, and not the parties. It submits that it would not be right to frame the specification only in respect of audio installations, as: some of the Claimant's products (particularly the Timecode DA) are audiovisual products whose purpose is to synchronise video with audio; that even audio specific products are used in audiovisual installations; and that some of the Claimant's products (particularly the Mic Amp PAK Duo with TX and USB) have an intended use of enabling mixed audio to be provided directly to a computing device so that it can be mixed with video to create audiovisual content.

Determination in relation to Class 9 Specification

78. I do not accept the Defendants' initial assertion set out in paragraph 74 above, as I accept Mr Andersson's evidence that the Mic Amp PAK Duo with TX & USB takes two audio input signals and mixes them within the device, and so I am satisfied that this product falls squarely within "Signal-mixing apparatus and instruments" and "*Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*" and would be understood by the average consumer as such.
79. In terms of the Defendants' remaining questions, I note here that they did not make any submissions in closing about whether the Claimant's products fall within the term "*audio apparatus*", no doubt because there can be no real argument, in my judgment, that the average consumer would consider that they do. So that question appears to fall away.
80. In relation to the 12 different audio mixing desks and broadcast consoles produced by the Claimant (which I have no doubt are for use, *inter alia*, in radio and television broadcasting and I accept Mr Andersson's evidence that they have been sold to UK radio and television broadcasters for that purpose), the Defendants did not provide me with any argument in its skeleton or orally through Mr Wood as to why they should not properly be classified as signal-mixing apparatus or instruments. Nor did Mr Wood ask Mr Andersson, who after all was the person in the courtroom with the technical knowledge to assist the Court on this point, if he agreed that the Claimant's broadcast consoles and mixing desks did not properly fall within the specification as signal-mixing apparatus or instruments. I cannot see how they would not. I have no

doubt that the average consumer would understand that the function and purpose of a mixing desk is that it allows the mixing, management and processing of audio signals from multiple different sources to create a desired, combined sound for sound recording and sound reproduction (for example in theatres). As such I am satisfied that falls squarely within “*signal-mixing apparatus and instruments*” and “*signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*” as well as “*sound recording and sound reproducing apparatus and instruments*”.

81. I have noted that in closing submissions Mr Wood conceded the possibility that the Timecode DA fell within “*Signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*”. I am satisfied that the average consumer would consider it does fall within this, as Mr Andersson was clear in cross-examination that the timecode signal was mixed with, or embedded in, input audio signals and it was used in radio and television broadcasting. However I also find the average consumer would be consider that the Timecode DA also falls within the wider “*Signal-mixing apparatus and instruments*” as I am satisfied on Mr Andersson’s evidence that it is also used outside of radio and television broadcasting environments, such as in theatres and at sporting venues.
82. The main question which remains for the purposes of this case is whether the average consumer would fairly describe the goods in relation to which the Alice Mark has been used as falling within “*Apparatus for recording, transmission or reproduction of sound or images*”. My understanding of the Defendants’ submission on these points is that none of the Claimant’s equipment actually records, transmits or reproduces sound or images, and so the average consumer would not describe them in this way. I note that I have already made findings about the genuine use of “*sound recording and sound reproducing apparatus and instruments*” and “*signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting*”. However, in my judgment the technically-competent average consumer would understand the base functionality of the Claimant’s goods, and would understand that, for example, the Claimant’s mixing desks and broadcast consoles, which I am satisfied are used extensively in both audio and audiovisual environments, either are apparatus for (in the sense that they are “used in”) the recording, transmission and reproduction of sound or images, or would consider they belong to the same group or category as apparatus for recording, transmission and

reproduction of sound or images, and are not in substance different from them, per [47(vii)] of *Property Renaissance*, deriving from *Mundipharma*:

“...protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as for which the mark has been used and which are not in substance different from them”.

83. Accordingly, and on balance, I am satisfied that the Claimant has made genuine use of the Alice Mark in respect of all the goods or services covered by the general wording of the specification.
84. Even if I am wrong on that latter point such that there is not genuine use across the whole specification such that it is necessary to arrive at a fair specification I reject the Defendants’ submission that the application of the law as set out in *Property Renaissance* would lead to the reduced specification for class 9 for which it contends. In my judgment this would directly offend against the stricture at [47(vii)] of *Property Renaissance* that I set out above. It seems to me that a fair specification would not require re-writing the specification but making a small amendment to the current specification so that it reads:

Class 9 - Apparatus for use in recording, transmission or reproduction of sound or images; audio apparatus; signal-mixing apparatus and instruments; sound recording and sound reproducing apparatus and instruments; signal-mixing, sound recording and sound reproducing apparatus and instruments for use in radio and television broadcasting”

85. In my judgment that would strike the correct balance between the respective interests of the proprietor, other traders and the public.

Class 37

86. I will deal with this shortly. I am satisfied that the Claimant has made genuine use of the Alice Mark in respect of all of the services covered by the wording of the specification. I have accepted that it offers and/or has provided “*repair, maintenance and refurbishment services*”, as well as installation services, for its own products which I have found includes “*apparatus for recording transmission or reproduction of sound or images*”, “*audio apparatus*”, (most of the Claimant’s products fall into this category), “*signal-mixing audio apparatus and instruments*” (Timecode DA, mixing desks and broadcast consoles and the Mic Amp PAK Duo), and apparatus for

“sound recording... and sound reproducing” (mixing desks and broadcast consoles). I have also found it has provided repair and refurbishment services in respect of third party audio equipment sent to it.

Issue 2 and Issue 3

87. Given my finding that there has been genuine use throughout the relevant 5-year period, these issues fall away.

K. DETERMINATION OF ISSUES ON INFRINGEMENT

Issue 4 - Is the Alice Camera Sign identical to the sign comprising the Alice Mark?

88. There is no dispute that a sign is identical with the trade mark where it reproduces, without modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer (*C-291/00 LTJ Diffusion SA v Sadas Vertbaudet SA*).
89. The Claimant’s primary position before trial was that the Alice Camera Sign is identical to the Alice Mark as the word “CAMERA” is purely descriptive and carries no trade mark significance, as consumers would understand when they saw “ALICE CAMERA” used in relation to cameras that the brand – the distinctive identifier of the originator of those goods – was ALICE. The Defendants have accepted in the Defence that ALICE is the dominant and distinctive element and “CAMERA” is purely descriptive when used in relation to a camera. Nonetheless they noted in closing submissions that there is no evidence from either party on whether the addition of the word “CAMERA” is so insignificant that it may go unnoticed by an average consumer, and submit that it would be noticed and so the sign is not identical to the mark.
90. When sending out this judgment in draft, I found for the Claimant on this point, and held that the Alice Camera Sign was identical to the sign comprising the Alice Mark. However, counsel for the Claimant contacted me to say that I had overlooked that the Claimant had conceded in closing that the Alice Camera Sign is not identical to the Alice Mark for the purposes of section 10(1) TMA. He is right, I did overlook that he said he did not argue strictly that it is identical but that it was as similar as can be, being an entirely descriptive word “CAMERA” attached to a 100% distinct word,

“ALICE”. As it has been conceded by the Claimant, then I accept that the answer to this question must be taken to be “No”.

91. It follows from my view in the initial draft that if the Alice Camera Sign and Alice Mark are not identical, they are of the highest degree of similarity. ALICE is, as the Defendant concedes, the dominant and distinctive element of the Alice Camera Sign whereas CAMERA is entirely descriptive, and that dominant and distinctive element is visually, aurally and conceptually the same as the Alice Mark. The addition of descriptive word CAMERA injects only an insignificant conceptual difference and changes nothing about the distinctive message of the first word ALICE, which is the only element with trade mark significance as identifying the origin of the goods, in my judgment. I accept the Claimant’s submission that if CAMERA does not go entirely unnoticed by the average user, the fact that the Alice Camera Sign is used in the context of ALICE used solus in the Alice Sign on the face of the cameras and elsewhere in the Defendant’s advertising and marketing would remove any doubt on the part of the average consumer that ALICE was the mark of origin of the goods.

Issue 5 - To what extent are the First Defendant’s cameras identical or similar to the class 9 goods of the specification of the Alice Mark as identified pursuant to Issue 3 above (if any)?

92. I have identified the specification of the Alice Mark to remain as registered. The Defendants have admitted that the Alice Camera Sign has been used in relation to cameras, which are goods identical to the Class 9 specification “*apparatus for recording transmission or reproduction of... images*” in respect of which the Alice Mark is registered.

Issue 6 - Has the First Defendant infringed the Alice Mark contrary to section 10(1) TMA including, if relevant, after the date identified pursuant to Issue 2 above?

93. Similarly, given my finding that the specification of Class 9 remains as registered, the Defendants admit that the First Defendant has infringed the Alice Mark contrary to section 10(1) TMA by use of the Alice Sign complained of from the commencement of its business in March 2020.
94. The Claimant’s concession that the Alice Camera Sign is not identical to the Alice Mark means that the First Defendant has not infringed the Alice Mark contrary to section 10(1) TMA by use of the Alice Camera Sign complained of.

Issue 7 - Is there a likelihood of confusion such that the First Defendant has infringed the Alice Mark contrary to section 10(2) TMA including, if relevant, after the date identified pursuant to Issue 2 above?

Law

95. Section 10(2) TMA provides:

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where because—

(a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or

(b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

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

96. Section 10(2)(a) is therefore potentially engaged in relation to use of the Alice Sign complained of, as the Alice Sign is identical to the Alice Mark, and section 10(2)(b) is potentially engaged by the use of the Alice Camera Sign complained of, as I have found the Alice Camera Sign to be highly similar to the Alice Mark.

Determination

97. I can deal with this issue shortly. At paragraph 5 of the Defendants' skeleton they accept that on the Defendants' pleaded case, "*but for the counterclaim, there is infringement under section 10(1) and section 10(2) of the Act in respect of the Alice Sign*". This was also my reading and understanding of the Defence and Counterclaim, as I summarised the pleadings at the start of this judgment. By making that admission, the Defendants must be accepting that there is a likelihood of confusion on the part of the public which includes the likelihood of association between the Alice Sign and the Alice Mark: i.e. that the identical Alice Sign is used in relation to goods and services similar to those for which the trade mark is registered. For this reason Mr Wood for the Defendants in closing stated in relation to the question of whether the Alice Camera Sign was identical to the Alice Mark "*our admission on section 10(2) means this is slightly academic*".

98. In my judgment, if there is a likelihood of confusion on the part of the public between the identical Alice Sign and the Alice Mark, as the Defendants accept there is, then

there is equally a likelihood of confusion on the part of the public between the Alice Camera Sign and Alice Mark which I have found to have the highest degree of similarity. The only distinction is the use by the Defendants of the descriptive word “CAMERA” in relation to a camera and in my judgment that does not operate to have any effect on the likelihood of confusion. The Defendants’ acceptance that the Alice Sign is used in relation to goods or services similar to those for which the trade mark is registered must apply equally to the Alice Camera Sign, as both the Alice Sign and the Alice Camera Sign have been used in relation to the same goods – the First Defendant’s camera. Accordingly, I am satisfied that there is a likelihood of confusion such that the First Defendant has infringed the Alice Mark contrary to section 10(2) TMA by use of the Alice Camera Sign complained of from the commencement of its business in March 2020.

99. I note for completeness that this analysis would still hold good, in my judgment, even if the Class 9 specification was amended as suggested in paragraph 84 above.
100. The Claimant goes further and submits that even if the Class 9 specification had been reduced along the lines that the Defendant had submitted was appropriate, there would still be section 10(2) TMA infringement by use of the Alice Sign and the Alice Camera Sign as the remaining specification of the Alice Mark would still, on any view, include goods which were very similar to the Alice Camera. Whether that is the case or not would depend on the wording of the actual specification, but in case it is helpful, I make the following findings:
- i) I am satisfied that both the Alice Camera and the Claimant’s goods comprise are electronic devices which record, or facilitate the recording of, sound and/or video signals as I have found, and I note that it is not disputed that the First Defendant’s cameras do themselves record and store sound as well as video and still images (including via an external microphone);
 - ii) I have found that the Claimant’s goods are, and I am satisfied that the Alice Camera can, be used in the context of the production of film, TV and video content, such that those working in recording studios, TV studios, podcast studios, etc. can be expected to be exposed to both parties’ goods in the course of their work. I have rejected the Third Defendant’s evidence that the Alice Camera will likely only be used by casual users;

- iii) I have found that it is common in the industry that companies marketing products similar to the Claimant's products also market cameras, and that Mr Andersson's concern that there is a risk that First Defendant's camera, if marketed under the Alice Sign or Alice Camera Sign, would be perceived by the public as a natural product line extension of the Claimant's offering is a real one; and
- iv) I am satisfied that at least some of the Claimant's goods and the First Defendant's cameras are complimentary and can be used together. The Claimant points to the Defendant's own marketing video showing their camera in use in a studio next to a mixing desk, which it submits, and I accept, could be used together produce a video with high-quality sound.

L. SUMMARY

101. A summary of my determinations is as follows:

- i) The Claimant has satisfied me of genuine use across the specifications of the registration of the Alice Mark in class 9 and class 37.
- ii) The Defendants' counterclaim for invalidity for non-use will be dismissed.
- iii) The First Defendant has infringed the Alice Mark contrary to section 10(1) and section 10(2)(a) TMA by use of the Alice Sign complained of from the commencement of its business in March 2020.
- iv) The First Defendant has infringed the Alice Mark contrary to section 10(2)(b) TMA by use of the Alice Camera Sign complained of from the commencement of its business in March 2020.
- v) By their own admission, the Second, Third and Fourth Defendants are joint tortfeasors with the First Defendant and so jointly and severally liable with it for those infringements.