

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION UNDER NUMBER  
10491 BY DIALOG ABC LIMITED FOR REVOCATION OF  
TRADE MARK NUMBER 1429292 IN THE NAME OF  
PUBLICIS LIMITED**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF an Application under No 10491 by Dialog ABC Limited for Revocation of Trade Mark No 1429292 in the name of Publicis Limited**

#### **BACKGROUND**

1. Trade mark registration No 1429292 is in respect of the mark Dialogue and is registered in Class 35 for a specification of:

Advertising services; public relations services, promotional services and marketing; all relating to advertising; all included in Class 35.

2. The mark was registered on 25 June 1990 and the registration stands in the name of Publicis Limited.
3. By an application dated 21 December 1998, Dialog Limited, applied for the registration to be revoked on the ground that :

“The trade mark has not been put to bona fide use in the United Kingdom for an uninterrupted period of five years prior to the making of this application for all the services for which the trade mark is registered”.

This goes to Section 46(1)(b) of the Act.

Alternatively, if use of the trade mark in respect of any services is shown, the applicant for revocation seeks to limit the specification to those services only and to delete broad terms. This goes to Section 46(5).

4. While the applicant submits that Publicis Limited may have made limited use of the mark DIALOG (which has not been registered) they contend that this cannot support the validity of the registered trade DIALOGUE because it differs in elements which alter the distinctive character of the mark.
5. The registered proprietor filed a Counterstatement in which they deny the assertions in the application. The registered proprietor and the applicant for revocation both ask for an award of costs in their favour.
6. Both sides have filed evidence in these proceedings. The matter came to be heard on 27 April 2001, when the applicant was represented by Ms Cookson of Nabarro Nathanson and the registered proprietor by Mr Edenborough of Counsel, instructed by Forrester Ketley & Co

### **Registered Proprietor's Evidence (Rule 31(3))**

7. This consists of a statutory declaration dated 24 March 1999 and comes from James Christopher Bardsley Whitworth, the Group Finance Director of the Publicis Group (which included Publicis Limited), a position he has held since 1991.
8. Mr Whitworth states that Publicis Limited established a subsidiary public relations company under the name Publicis Dialogue in 1986 and that Publicis Dialogue Limited traded under the DIALOGUE name, providing public relations services and related advertising services. He draws attention to Exhibit JCBW 1 to his declaration which is a copy of a document produced in June 1990 in response to a questionnaire from the American Soybean Association, and invoices relating to the purchase of advertising. Mr Whitworth submits that this document and the invoices, although dating from 1990, show the nature of the Publicis Dialogue business.
9. Next, Mr Whitworth states that the business continued under the DIALOGUE name until 1995 when, following a management buy-out, Publicis Dialogue was closed and the business was continued under the name DIALOGUE AGENCY by the Dialogue Agency Limited who continue to trade and use the DIALOGUE trade mark with the consent of Publicis Limited. Mr Whitworth refers to Exhibit JCBW 2 to his declaration which comprises a collection of documents relating to The Dialogue Agency Limited explaining the nature of its business, together with a letter and press release relating to the transfer of the business under the DIALOGUE name from Publicis Dialogue to The Dialogue Agency and brochures produced by The Dialogue Agency for its clients, with the name of the Agency appearing on the back of the brochures.
10. Mr Whitworth goes on to state that in June 1998, Publicis Limited launched a global direct marketing network under the name Publicis Dialog and at Exhibit JCBW 3 to his declaration is a copy of an article giving details about Publicis Dialog, which appeared in the 4 May 1998 edition of Precision Marketing. He adds that the Publicis Dialog Agency provides marketing and sales promotion services.

### **Applicant's Evidence**

11. This consists of a statutory declaration by Annabel Hart dated 24 February 2000. Ms Hart is a solicitor working for Field Fisher Waterhouse, who represented the applicant.
12. Ms Hart states that, in her view, the only relevant evidence in Mr Whitworth's declaration is his Exhibit JCBW 2 which describes the services of THE DIALOGUE AGENCY. She adds that in order to establish whether there has been any actual use of the mark DIALOGUE by The Dialogue Agency Limited she suggested that her client, David Lock (representing the applicant for revocation) telephoned Mr Haigh the Director of The Dialogue Agency, to find out whether the DIALOGUE mark was used during the critical period in relation to this revocation action.

13. Following Mr Lock's conversation with Mr Haigh, Ms Hart states that she decided to contact the latter directly by letter to ask if he was prepared to come to the offices of Field Fisher Waterhouse to discuss the matter and provide a statutory declaration for evidence. A copy of Ms Hart's letter to Mr Haigh is at Exhibit AH 1 to her declaration. She adds that on 28 October 1999 a reminder fax was sent to Mr Haigh and on 29 October 1999 he telephoned her and stated that he had been the Managing Director of Publicis Dialogue Limited from September 1989 until the end of 1994, that he had organised the registration of the trade mark DIALOGUE (No 1429292) and that at the end of 1994 there was a buy-out. He said that at the beginning of 1995 he worked for The Dialogue Agency as a Managing Director, that the company had been trading continuously since that date and that the areas in which the company traded included public relations, advertising, direct mail and media relations. Mr Haigh informed her that the first time he heard about the applicant directly was when a supplier had accidentally billed goods to The Dialogue Agency which belonged to Dialog Limited. At this stage his company had decided that Dialog Limited was very small and therefore it did not concern them.

#### **Registered Proprietor's Evidence**

14. This consists of two witness statements, one each from Steven John Wake and David Edward Bickerton Haigh, dated 6 July 2000 and 10 August 2000 respectively.
15. Mr Wake is a partner of Forrester Ketley & Co who are representing Publicis Limited in these proceedings. He refers to Mr Whitworth's statutory declaration of 24 March 1999 in which Mr Whitworth stated that following a management buy-out in 1995, the DIALOGUE name has been used by The Dialogue Agency Limited. Mr Wake then draws attention to Exhibit SJW 1 to his statement, which comprises a copy of a statutory declaration made by David Edward Bickerton Haigh, a Director of the Dialogue Agency Limited, on 18 August 1999, in related opposition proceedings, and also a copy of relevant exhibits.
16. Mr Wake states that Mr Haigh's declaration of 18 August 1999 contains additional information in relation to the use of the DIALOGUE name by The Dialogue Agency since 1995 and adds that Exhibit DEBH 2 to the declaration is a copy of the member profile for The Dialogue Agency Limited as held on the records of the Public Relations Consultants Association (PRCA) and gives a summary of the services provided by The Dialogue Agency Limited. While the document identifies the profile as being of 18 August 1999, Mr Wake notes that the second page refers to "current clients" and identifies those which have served in excess of five years ie from at least as early as August 1994. He adds that The Dialogue Agency took over the membership of PRCA from the Publicis Group following the management buy-out in 1995, hence the reference to the date of business commenced as being September 1996 in the Member Profile of Exhibit DEBH 2.
17. In his witness statement, Mr Haigh explains that he is a Director of The Dialogue Agency Limited, a position he has held since the company commenced trading in February 1995 and that his company is an independent public relations consultancy

providing public relations services, which includes advertising services, promotional services and marketing services. Prior to that time, Mr Haigh was Managing Director of Publicis Dialogue Limited, a subsidiary of Publicis Limited, a position he held from September 1990 until the management buy-out in January 1995. He states that following the management buy-out, The Dialogue Agency carried on the public relations consultancy business previously undertaken by Publicis Limited. Mr Haigh adds that Publicis Limited is the registered owner of UK trade mark registration No 1429292 (the registration in suit) and that The Dialogue Agency Limited has been using the mark in relation to public relations services and the associated advertising, promotional and marketing services since February 1995 with the consent of Publicis Limited.

18. Mr Haigh confirms that his company provides a wide range of services under the heading of public relations consultancy and he states that this includes advertising, promotional and marketing services as well as media and market research, consumer and media relations, copy writing, events and exhibitions management and production of collateral materials. He provides details of his company's recent turnover figures, as follows:-

<b>Year (to 31<sup>st</sup> March)</b>	<b>Turnover</b>
1995	£ 49,900
1996	£398,000
1997	£620,000
1998	£578,000
1999	£702,000

19. Next, Mr Haigh states that the DIALOGUE name is used in relation to all the activities undertaken by his company and that, as examples, The Dialogue Agency has provided services on behalf of Alaska Seafood Marketing Institute ("ASMI") and Consorzio Del Proscuitto di Parma ("Parma Ham") since the company was formed in 1995. He continues, that a project activity summary is produced every year for these clients and Exhibit DEBH 1 to his statement is a copy of the project activity summaries for "Parma Ham" for December 1996 to June 1999. Mr Haigh goes on to draw attention to Exhibit DEBH 2 to his statement, which comprises a bundle of Evaluation Reports for ASM I for the years 1995 to 1999 which show what activities were undertaken and the consumer advertorials show the advertising undertaken. There are reports for specific public relations and promotional exercises eg the T.G.I Friday's Report dated June 1998 for "ASMI" setting out the marketing plan approved by the client. Mr Haigh concludes that together, these documents show that The Dialogue Agency Limited undertakes work in all four areas for which the DIALOGUE trade mark is registered - advertising, public relations, promotional and marketing services.
20. Finally, Mr Haigh at Exhibits 3 and 4 to his statement submits a collection of documents relating to his company and the nature of its business (including agency account details), in addition to copies of invoices to clients dated the five years prior to 21 December 1998.

21. This concludes my summary of the evidence in these proceedings. I now turn to the decision.

## **DECISION**

22. Section 46 of the Act states:-

23. 46.-(1) The registration of a trade mark may be revoked on any of the following grounds-
- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
  - (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
  - (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
  - (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that-

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any case the application is made to the registrar, he may at any stage of the proceedings refer to the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.

24. In addition Section 100 of the Act is relevant. It reads:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

25. The applicant's ground of attack goes to Section 41(b) of the Act and the relevant uninterrupted period of five years non-use is claimed to be the five years prior to the marking of the application for revocation ie. the five years prior to 21 December 1998. Once this application was made, the effect of Section 100 was to place the onus on the registered proprietor to show the extent and nature of the use made by them of the mark; as noted by Mr Clarke QC. sitting as the Appointed Person in *Crysotheroque Zolotas* (0/464/99) and *Floris* (0/465/99).

26. At the Hearing, Mr Edenborough submitted that the evidence filed in relation to the use of THE DIALOGUE AGENCY from 1995 onwards by the Dialogue Agency Limited, was sufficient to discharge the onus of showing the extent and nature of use and showed substantial use during the relevant period. He argued that the use fell within Section 46(2) of the Act as use in a form not altering the distinctive character of the mark, that the proprietor's consent to the use had been given and that the use was genuine and in relation to the full width of the specification of services for which the mark is registered.

27. Mrs Cookson attacked Mr Edenborough's submissions on the following basis:

- (i) The Dialogue Agency Limited did not have the consent of the registered proprietor to use the mark;

- (ii) use of THE DIALOGUE AGENCY does not meet the requirements of Section 46 (2) of the Act as such use altered the distinctive character of the mark;
- (iii) use of THE DIALOGUE AGENCY amounts to use of a company name only and does not constitute trade mark use;
- (iv) that, in any event, any use has only been in relation to "public relations services" and not in relation to the full width of the services covered by the proprietor's registration.

28. Firstly, I turn to the issue of whether use of THE DIALOGUE AGENCY constitutes use of the registered mark DIALOGUE, taking into account the provisions of Section 46(2) which state that use of a trade mark includes "use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered".

29. In ELLE Trade Marks, 1997 FSR 529, Lloyd J had to consider whether registrations of the mark elle (in lower case) in the middle of a circle with a cross off the circle bottom right (the symbol for the female gender) could be defended on the basis of the use of ELLE in upper case letters. He concluded that

"..... one comes back to the question whether, by omitting the device and by converting the four letters of the word from lower to upper case, something has been done which alters the distinctive character of the mark from the registered form. In my judgment it has. It seems to me that the device is at least as much what makes the mark distinctive as the word. the use of the word alone and in capitals does alter the distinctive character of the mark, in my judgment, in a significant and substantial way. Therefore, although I do not proceed by analogy with Section 41, I agree with the decision of Mr Knight on this point and without having to consider the position as regards disclaimer."

30. The ELLE case does not, I accept provide a direct analogy. The mark in use in that case was part of and, therefore less than the mark registered. In the present case, the registered mark is contained within the mark in use.

31. In my considerations of this issue I also note Kerly's Law of Trade Marks and Trade Names, Thirteenth Edition, which states that:

"..... if the proprietor relies on use of a variant of the registered mark, the variant must be compared with the registered mark to see whether the differences are such as to alter the distinctive character of the mark. The process of comparison is a matter of impression. The distinctive elements of the mark in the form in which it was registered should be identified. Likewise with the variant. Are the differences significant enough to alter the distinctive character of the mark? If the variant passes the test, then the use of the variant must be taken into account."



32. As the mark in suit (DIALOGUE) is registered as a single word, the distinctive character of the mark must be the word itself. Does the addition of the words THE and AGENCY to make up the totality THE DIALOGUE AGENCY alter the distinctive character of the mark? In my opinion the answer is no. The additional elements are both non-distinctive, the word "agency" merely indicating a service sector business, and the only trade mark element within the totality is the word DIALOGUE. As it is the word DIALOGUE which makes the major indeed the only, trade mark contribution to the mark THE DIALOGUE AGENCY, I see no reason why a member of the public should not take the mark, in totality, as a badge of origin having essentially the same trade mark characteristics as the word DIALOGUE.
33. Mrs Cookson also submitted that THE DIALOGUE AGENCY has only been used as a company name, or part of a company name, and not as a trade mark. However, it seems to me that the evidence, in particular the exhibits relating to the Parma Ham and Alaska Seafood Marketing Institute accounts at DEBH 1 and DEBH 2 to Mr Haigh's witness statement of 10 August 2000, clearly shows THE DIALOGUE AGENCY as being the provider of numerous services. No other indication as to the origin of the services is shown and in my view, THE DIALOGUE AGENCY is functioning as a trade mark in that it acts as a badge of origin for the services.
34. In view of the above, I will take into account use of the mark THE DIALOGUE AGENCY for the purposes of this decision.
35. I now go on to consider whether use of the mark by The Dialogue Agency Limited is with the consent of the registered proprietor of the mark. In this connection, Mrs Cookson pointed out that there is no record of a license between the parties, nor of any control by the proprietor on the use of the mark.
36. Statements in relation to consent are contained within Mr Whitworth's statutory declaration of 24 March 1999 at paragraphs 3 and 5 and Exhibit JCBW 2 to that declaration, and also in Mr Haigh's witness statement of 10 August 2000, paragraph 8. In summary, it consists of assertions by Mr Whitworth (Group Finance Director of the proprietor) and Mr Haigh (Director of the Dialog Agency Limited) that following a management buy-out, involving the closure of a subsidiary of the proprietor, The Dialogue Agency Limited was created and allowed to use the DIALOGUE trade mark with the proprietor's consent. Exhibit JCBW 2 contains a Press Statement announcing that from 1 February 1995, Publicis agreed to transfer the business and goodwill of Publicis Dialogue to The Dialogue Agency Limited.
37. Section 46 does not contain any reference to licences but is clear in specifying 'consent' which, I believe, is wider in meaning than license under the Act. I am fortified in this view by the following comment on Section 46(1)(a) from the publication 'Notes on the Trade Marks Act 1994 (which was prepared for the use of Parliament during the passage of the Bill): that "..... [use] may be by the proprietor or with his consent, which includes use by a licensee."

38. Furthermore, Section 46 of the Act is based upon, and is intended to give effect to, Articles 10 to 12 of the First Council Directive 89/104 approximating the Trade Mark Laws of Member States. Article 10(3) of the Directive is in the following terms:-

"Use of the trade mark with the consent of the proprietor or by any person who has the authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor."

39. This may be contrasted with the wording of Article 8(1) of the Directive, which is as follows:

"A trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A licence may be exclusive or non-exclusive."

40. The wording of these provisions suggest that "consent" has a broader meaning than "licence". This suggests that consent given by the registered proprietor to another party to use the registered trade mark may be relevant for the purposes of Section 46 of the Act even if the registered proprietor exercised no control over the quality of the goods to which the other party applies the trade mark through a traditional licence arrangement.

41. At first sight this conclusion seems difficult to square with the function of a trade mark, which has been described by the European Court of Justice in the following terms:

"The essential function of a trade mark is giving to the consumer or ultimate user a guarantee of the identity of the origin of the marked product by enabling him to distinguish, without any possible confusion, that product from others of a different provenance. For a trade mark to perform this function, it must offer a guarantee that all the goods bearing it have originated under the control of a single undertaking which is responsible for their quality."

42. Ms Cookson drew my attention to the issue of bare licenses, which recently came before the House of Lords in Scandecor Development AG v The Scandecor Marketing AV and Others, 4 April 2000. Lord Nicholls of Birkenhead dealt with the question of bare licences in paragraphs 36-41 of his opinion before concluding that:

"The House should refer to the European Court of Justice the question whether a trade mark is to be regarded as liable to mislead the public within the meaning of Article 12(2)(b) if the origin of the goods denoted by the mark is a bare exclusive licensee."

43. Paragraphs 56 and 57 of Lord Nicholls' opinion appear to be of particular relevance to this case. They are reproduced below.

"56. For completeness, I mention the contention of Mr Rosen QC based on Article 10(3) of the Directive. Article 10 makes provisions regarding the non-use of trade

marks. Article 10(3) provides that "use of the trade mark with the consent of the proprietor ..... shall be deemed to constitute use by the proprietor." Mr Rosen submitted that the proper interpretation of this article is that use with consent constitutes deemed use by the proprietor for all purposes. Accordingly, the use of the marks by Scandecor Marketing and Scandecor Limited on their goods was not likely to "mislead the public". Their use is deemed to be use by the proprietor of the marks, Scandecor International. The 1994 Act should be construed accordingly.

57. I cannot accept this. I agree with Lloyd J that the context of Article 10(3) makes clear that Article 10(3) is directed at the non-use provisions of Articles 10 and 11. It is not applicable to the revocation provisions in Article 12(2)(b). Those are the provisions carried into Section 46(1)(d) of the Act. The Act incorporates the effect of Article 10(3) into Section 46(1)(a). The mark may be revoked it, for a period of 5 years, it has not been put to genuine use "by the proprietor *or with his consent.*"

I consider this is *Acte Clair*. The Court of Justice should not be burdened with this further point. That Court is burdened enough without being asked questions to which the answer is obvious."

44. It appears from this that:

1. Use with the consent of the registered proprietor of a trade mark is deemed to be use by the proprietor himself for the purposes of Section 46(1)(a) and (b) of the Act;
2. This is reconciled with the function of a trade mark by Section 46(1)(d) of the Act which states that use (with the proprietor's consent) which results in deception of the public as to the origin or the quality of the goods, renders the registration of the trade mark liable to revocation.
3. The question of whether the registered proprietor has exercised sufficient control over the use of his trade mark is therefore a matter which may be raised by way of an attack under Section 46(1)(d) of the Act, but it is not a matter which is relevant to the question of whether the mark has been used for the purposes of Section 46(1)(a) and (b) of the Act.

45. Notwithstanding that a license is not relevant in relation to use of a mark for the purposes of Section 46(1)(a) or (b), neither the proprietor nor The Dialogue Agency Limited, have submitted evidence of a written contractual agreement in relation to consent or the use of the mark. However, consent can be granted on the basis of a verbal agreement or contract.

46. What am I to make of the position in relation to consent in this case? The mark THE DIALOGUE AGENCY has been in use since 1995 by The Dialogue Agency Limited with the knowledge and approval of the proprietor of the mark in suit. This must infer that the proprietor consents to such use and is consistent with the statements of Mr Whitworth and Mr Haigh. Furthermore, it seems to me, in light of my earlier

comments on the issue, that consent by a registered proprietor to another party is not negated by a registered proprietor failing to exercise any control over the quality of the services to which the other party applies the mark through a license arrangement. In my view, Mrs Cookson's arguments in relation to the lack of any evidence from the proprietor on the control of the mark in suit go, in effect, to misrepresentation under Section 46(1)(d), the provisions of which are set out earlier in this decision. However Section 46(1)(d) has not been pleaded by the applicant, nor has the applicant filed any evidence in relation to this ground. Accordingly, I do not intend to address Section 46(1)(d) in this decision.

47. Finally, I must consider whether use of THE DIALOGUE AGENCY has been in relation to all the services for which the mark it is registered or, as the applicant claims, for public relations services only.
48. The proprietor's registration covers "Advertising services; public relations services, promotional services and marketing; all relating to advertising."
49. Collins Dictionary (third edition, 1994) defines Advertising as: 1. The promotion of goods or services for sale through impersonal media, such as radio or television. 2. The business that specializes in creating such publicity. 3. Advertisements collectively; publicity. Public relations is defined as: 1.a. The practice of creating, promoting or maintaining goodwill and a favourable image among the public towards an institution, public body, etc. b. The methods and techniques employed. c. The public relations industry. 2. The condition of the relationship between an organization and the public. 3. The professional staff employed to create, promote, or maintain a favourable relationship between an organisation and the public.
50. It seems to me that there is a clear overlap between advertising and public relations in that they both involve promotional activities and the creation of goodwill on behalf of or for the benefit of others.
51. Turning to the evidence filed in relation to use of THE DIALOGUE AGENCY, Mr Haigh's Witness Statement of 10 August 2000 and the exhibits attached thereto are of considerable assistance. Turnover is detailed at paragraph 5 of Mr Haigh's statement (summarised earlier in this decision) and Exhibit DEBH 3 lists eight Dialogue Agency accounts in existence during 1998, which include Alaska Seafood Marketing Institute and Consorzio del Prosciutto di Parma Exhibits 2 and 3 to Mr Haigh's statement relate to details of the activities undertaken or proposed in relation to the Alaska Seafood Marketing Institute (ASMI) and the Consorzio del Prosciutto di Parma (Parma Ham).
52. On Parma Ham (Exhibit DEBH1), there are booklets entitled "Public relations proposals" covering the years 1996 to 1999. these demonstrate a wide range of activities undertaken/proposed in promoting the Parma Ham product, including:-
  - (i) The Parma Ham Information Service which covers all media relations, issues press releases and encourages consumers and trade journalists to contact the service for information and recipes;

- (ii) arranging reader offers in both the general consumer and trade press to promote product awareness;
  - (iii) organising press trips, tastings and events, principally for food writers, to secure press coverage for the product.
53. On ASMI (Exhibit DEBH 2), similar Evaluation and Proposal Reports have been produced covering a wide range of activities, which include:-
- (i) the preparation of advertorials containing recipes for national magazines e.g. Weight Watchers, BBC Good Food, The Guardian Weekend Supplement;
  - (ii) schools promotion, intended for ASMIs branded partners to reach a wide number of young consumers;
  - (iii) arranging joint promotions e.g. with TGI Fridays.
54. Mrs Cookson contends that the activities undertaken by The Dialogue Agency are essentially restricted to public relations. However, my view from the evidence is that they go far wider and in addition to public relations, involve advertising (the promotion of goods through impersonal media) e.g. through advertorials containing recipes, and reader offers. Also the involve promotional services and marketing in relation to publicising and promoting goods for customers. Furthermore, I have no doubt that the use is genuine, given the nature and quantity of the relevant use.
55. To conclude, I find that the mark THE DIALOGUE AGENCY falls within the provisions of Section 46(2) of the Act, has been used with the proprietor's consent and has been used within the relevant period on all services covered within the specification for which the mark is registered. The application for revocation fails.
56. The registered proprietor's are entitled to a contribution towards their costs and in this regard Mrs Cookson submitted at the hearing that as the applicant was content to have a decision taken on the papers, the expenses of the hearing should not be borne by the applicant. I reject this argument. The registered proprietors have a right to be heard and in the event their submissions were successful. I would only add that there was no requirement for the applicants to attend the hearing and argue their case through aural submissions.

57. I order the applicants to pay the registered proprietor the sum of £850. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the determination of this case if any appeal against this decision is unsuccessful.

**Dated this 31 day of July 2001**

**JOHN MACGILLIVRAY**  
**For the Registrar**  
**the Comptroller-General**