

O-001-07

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 2198808
IN THE NAME OF BRYAN FREDERICK WADE
OF THE TRADE MARK:**

AZURRA

IN CLASSES 35, 41 AND 42

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 82374
BY AZURA GROUP LIMITED**

Trade Marks Act 1994

**In the matter of registration no 2198808
in the name of Bryan Frederick Wade
of the trade mark:
AZURRA
in classes 35, 41 and 42
and the application for revocation
thereto under no 82374
by Azura Group Limited**

BACKGROUND

1) On 6 January 2006 Azura Group Limited, which I will refer to as AGL, filed an application for the revocation of trade mark registration no 2198808. The registration is for the trade mark AZURRA and is registered for the following services:

business information, consulting and advisory services; business planning; commercial auditing; business process planning; business organization consultancy; business appraisals; strategic planning and analysis for business; marketing; market analysis; market research; market surveys; corporate and product branding; corporate and product positioning; business competitor analysis; economic forecasting; demographic analysis; analysis of business and commercial information; provision of trade information; commercial data research and analysis; business report preparation;

arranging and conducting conferences and seminars;

software design including data product design; retail planning; town planning.

The above services are in classes 35, 41 and 42 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The registration is in the name of Bryan Frederick Wade. The registration process for the trade mark was completed on 7 January 2000.

2) AGL states that the trade mark should be revoked, partially or wholly, under section 46(1)(a) of the Trade Marks Act 1994 (the Act) because within the period of five years following the date of the 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 services for which it is registered and there are no proper reasons for non-use.

3) In the alternative AGL states that the trade mark should be revoked, partially or wholly, under section 46(1)(b) of the Act because such use (if any) has been suspended for an uninterrupted period of five years between 4 January 2001 and 4 January 2006, and there are no proper reasons for non-use.

4) AGL states that, being unaware of any use, it performed searches for the trade mark and was unable to find any evidence of its use. AGL submits that the grounds for revocation existed on 4 January 2006 and that in accordance with section 46(6)(b) of the Act that the rights of the proprietor ceased from that date.

5) On form TM26(N) AGL gives two dates from which it requests revocation: 4 January 2006 and 7 January 2005.

6) Mr Wade filed a counterstatement. He admits that the trade mark has not been used in relation to the following services:

business planning; commercial auditing; business organization consultancy; business appraisals; market surveys; economic forecasting; demographic analysis; provision of trade information; business report preparation;

arranging and conducting conferences and seminars;

retail planning; town planning.

7) Mr Wade states that the trade mark has been put to genuine use in the United Kingdom by him, or with his consent, in relation to the following services:

business information, consulting and advisory services; business process planning; strategic planning and analysis for business; marketing; market analysis; market research; corporate and product branding; corporate and product positioning; business competitor analysis; analysis of business and commercial information; provision of trade information; commercial data research and analysis;

software design including data product design;

during the period of five years following the date of completion of the registration procedure and has been put to genuine use in the United Kingdom by him or with his consent in relation to the services listed above between 4 January 2001 and 4 January 2006.

8) Mr Wade states that if it is found that there has not been genuine use of the trade mark, then there are reasons for non-use. He states that in 1999 he was diagnosed with prostate cancer and underwent radiotherapy and hormone therapy for this condition throughout most of 2000. Mr Wade, as the sole provider of services under the AZURRA name, could not develop his AZURRA consultancy business during this period, as he had originally intended, owing to his ill health. From October 2000 Mr Wade attempted to regenerate his consultancy business which, he states, offered all the services in the registered specification. He states that the business did not recover from this period of inactivity. In 2003 Mr Wade formally closed down the business and retired. Prior to this, he had licensed the AZURRA trade mark to Azurra IT Solutions Pte Ltd, now renamed

Azurra Solutions Pte Ltd, which he states has used the trade mark in the United Kingdom between 2002 and 7 January 2005 for the following services:

business information, consulting and advisory services; business planning; business process planning; business organisation consultancy; strategic planning and analysis for business; marketing; corporate and product branding; corporate and product positioning; analysis of business and commercial information; provision of trade information; business report preparation;

software design including data product design

Mr Wade states that the licence to Azurra Solutions Pte Ltd extends to the remaining services of registration but that such services are closely related to his personal skills and expertise and require a specialist to provide them. Mr Wade submits that his serious illness, long treatment and consequent retirement constitute proper reasons for non-use and that the application for revocation should be dismissed.

9) Mr Wade states that the registration should be “sustained” in relation to the following services on the grounds of use by the proprietor between 2000 and 2003 and by his licensee between 2002 and 2006:

business information, consulting and advisory services; business process planning; strategic planning and analysis for business; marketing; market analysis; market research; corporate and product branding; corporate and product positioning; business competitor analysis; analysis of business and commercial information; provision of trade information; commercial data research and analysis;

software design including data product design.

10) He states that to the extent that the mark has not been used in the relevant five year period in respect of any of the services for which it is registered there were proper reasons for non-use, at least during a substantial part of any such five year period.

11) Mr Wade furnished evidence with his witness statement.

12) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing or filed written submissions. Consequently, this decision is made upon the basis of the evidence, the statement of grounds and the counterstatement.

EVIDENCE

Witness statement of Bryan Frederick Wade

13) Mr Wade is the registered proprietor of the trade mark. After leaving his employment with MapInfo/The Data Consultancy in the summer of 1999, Mr Wade set up a consultancy business that he named Azurra Consultancy. He states that during the second half of 1999 he was providing consultancy services to MapInfo under the trade mark AZURRA. He was working three days a week, providing consultancy services to MapInfo. At this time he set up a website to offer and promote a range of consultancy services for potential clients. He also approached business contacts to secure further work. He registered the domain name azurra.co.uk. Two registration certificates from Nominet are exhibited, expiring on 21 June 2003 and 21 June 2005, and a printout from WHOIS.

14) In the winter of 1999 Mr Wade fell ill with cancer. Owing to the illness, and the treatment for it, Mr Wade did not work from December 1999 to October 2000. He states that during this time the website was active but that he did not undertake any promotional activity. Mr Wade states that from October 2000 he received a number of requests for data design work under the trade mark AZURRA but none of these requests led to paid work, however, potential projects were discussed in depth with clients. Mr Wade states that the work he did under the trade mark AZURRA was complex and that there are only a small number of entities which would make use of the services that he provides. He states that, consequently, it is not uncommon for a large numbers of meetings and discussions to take place before work is done and it is also common for a large number of meetings and discussions not to lead to work. Mr Wade states that he, or his son-in-law (with his consent) genuinely offered the following services in the United Kingdom under the trade mark AZURRA during the relevant time period:

business information, consulting and advisory services; business process planning; strategic planning and analysis for business; marketing; market analysis; market research; corporate and product branding; corporate and product positioning; business competitor analysis; analysis of business and commercial information; provision of trade information; commercial data research and analysis; business report preparation;

software design including data product design.

15) Mr Wade states that prior to setting up and trading under the trade mark AZURRA he had a great deal of experience in providing the relevant services. He states that he promoted the services in class 35 by the use of his website www.azurra.co.uk and through direct approaches to clients and existing business contacts. He states that he had a national reputation in relation the class 42 services, which meant that he did not need to promote the services as people came to him.

16) Mr Wade gives his qualifications: BSc (Sociology), specialising in social statistics, a Dip T&RP (Town and Regional Planning). He was also a fellow of the Chartered

Management Institute and a member of the Market Research Society. On his sixtieth birthday, 18 November 2003, Mr Wade closed his business. Mr Wade exhibits copies of pages downloaded from his website. They do not bear any date but Mr Wade states that they represent what his website looked like in 2003. The page headed “The business” states, inter alia:

“By focusing on business strategy and market knowledge we aim to improve your business by means of:

- Strategic business analysis
- Market analysis
- Market Research
- Corporate and product positioning
- Corporate and product branding
- Management consultancy”

Mr Wade states that he has not personally traded under the trade mark AZURRA in relation to any of the services of registration since the middle of 2003. He states that his son-in-law has provided services in classes 35 and 42 in the United Kingdom from his base in Singapore to large United Kingdom clients. He states that in 2005 his website became live again by web forwarding to the website of his son-in-law.

17) Mr Wade states that business information, consulting and advisory services in class 35 was the core of the services which he offered. He states that one of his clients was CACI market analysis division. Mr Wade states that business process planning was undertaken by his son-in-law from 2003 under the trade mark AZURRA, with his consent. He states that *strategic planning and analysis for business; marketing; market analysis; market research; corporate and product branding; business competitor analysis; analysis of business and commercial information; commercial data research and analysis* were promoted services but did not lead to any specific projects.

18) Income and expenditure for B F Wade t/a Azurra Consulting are exhibited; these are for the years ending 31 March 2000 and 2001. These are not formalised accounts but one page sheets. The former sheet shows a fee income of £28,333 and the latter an income of £1,500.

19) Mr Wade states that in terms of *corporate and product positioning*, the work that he did for CACI involved advising of the correct positioning of CACI’s third party demographic and digital map products.

20) In terms of *software design including data product design*, Mr Wade states that he was regularly approached to comment on the design of new and potential digital data products for geographical information systems and retail market analysis. He states that, owing to the limited appeal of this work, he was only interested in undertaking it if the fee was right. He states that agreement on fee levels was never reached and consequently

no work of this nature was undertaken. Mr Wade states that one of the core aspects of his son-in-law's work undertaken under the trade mark AZURRA is the design of software.

21) Mr Wade states that he licensed the use of the trade mark AZURRA to his son-in-law.

Witness statement of David Young

22) Mr Young is the son-in-law and licensee of Mr Wade. He resides in Singapore. He is a director of Azurra Solutions Pte Ltd (previously named Azurra IT Solutions Pte Ltd). This is a company incorporated in Singapore on 15 July 2002. He states that the company offers project management services in Singapore, Malaysia, United States, Australia and the United Kingdom. Mr Young states that prior to setting up Azurra IT Solutions Pte Ltd he was granted an oral licence by Mr Wade to provide services under the trade mark AZURRA in Singapore and the United Kingdom.

23) He states that the work of Azurra IT Solutions Pte Ltd has covered and does cover the following services as defined by the AZURRA trade mark specification:

business information, consulting and advisory services; business planning; business process planning; business organization consultancy; strategic planning and analysis for business; marketing; corporate and product branding; corporate and product positioning; analysis of business and commercial information; provision of trade information; business report preparation;

software design including data product design.

24) Mr Young states that during 2002 and 2003 Azurra IT Solutions Pte Ltd carried out and completed work for several clients located in the United Kingdom. He states that two of these were British Telecom and American Express. The work was actually commissioned by another British company: edocs Europe (UK) Ltd for these two clients. He states that this is a subsidiary of a United States company, edocs Inc. Mr Wade states that under the terms of the commission, Azurra IT Solutions Pte Ltd was to invoice the United States company. Mr Wade states that the services were delivered by Azurra IT Solutions Pte Ltd, using the trade mark AZURRA on stationery and documentation, directly to British Telecom and American Express in the United Kingdom.

25) Mr Young exhibits copies of invoices bearing the name Azurra IT Solutions Pte Ltd as follows:

25 October 2002, to edocs in the United States;
1 December 2002, to edocs in the United States;
31 December 2002 to edocs in the United States;
1 February 2003 to edocs in the United States;
6 March 2003 to edocs in the United States;
1 April 2003 to edocs in the United States;

1 May 2003 to edocs in the United States;
16 July 2003 to GoSpeedDating in Leeds.

The services provided are described variously as: consulting fees, prof services – consulting fees, PS BT WP support consulting fees, PS – consulting fees, presales – consulting fees, presales fees, GoSpeedDating. Mr Young states that the invoices relate to work done for British Telecom, American Express and GoSpeedDating.com. None of the material exhibited by Mr Young shows use of Azurra on its own; it shows use of Azurra IT Solutions Pte Ltd.

26) Mr Young states that since 2005 the old Azurra Consulting website, previously used by Mr Wade, has been reactivated and automatically redirects visitors to the Azurra Solutions Pte Ltd website.

DECISION

27) Section 46 of the Act reads as follows:

“(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 other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

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

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

(a) the date of the application for revocation, or

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

Consideration has to be taken, also, of section 100 of the Act which states:

“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.”

Consequent upon section 100 the onus is upon the registered proprietor to prove that it has made genuine use of the trade mark in suit, or that there are proper reasons for non-use.

28) AGL has requested revocation under sections 46(1)(a) and 46(1)(b). In relation to the former ground it seeks revocation from 7 January 2005. Mr Geoffrey Hobbs QC, sitting as the appointed person, stated the following in *DataSphere* (BL O/018/06):

“In order to have raised such a claim pursuant to section 46(1)(a), the Applicant should have requested revocation with effect from 2 February 1996 (the day following the 5th anniversary of the date on which the trade mark was registered on completion of the procedure for registration).”

This was the position that he had adopted in *WISI* BL O/251/05. It was also the approach of Gibson LJ in *Philosophy di Alberta Ferretti* [2003] RPC 15. The registration date of the application was 7 January 2000, consequently, the first date that revocation took place under section 46(1)(a) was 8 January 2005. The request for revocation, under section 46(1)(a) was 7 January 2005 and so was a day too early. Consequently, the request was flawed and must, in my view be rejected (see also *Lowden Trade Mark Case* [2005] RPC 18 re the effects of a premature date for revocation for non-use).

29) This leaves the section 46(1)(b) case, which AGL claims runs from 4 January 2001 to 4 January 2006. In fact a five year period commencing on 4 January 2001 will be completed on 3 January 2006. Consequently, the period referred to is 5 years and 1 day, and the request to revoke the trade mark from 4 January 2006 is not premature, and so stands.

30) Mr Wade defends himself in two ways. He states that the trade mark has been used for certain services but if it is found that it has not been then he pleads that there are proper reasons for non-use. It strikes me as odd to claim that the trade mark has been used and then claim that if it is found that it has not then there are proper reasons for non-use; I am not sure that the two positions are compatible. However, this does not need to trouble me in this case. *Kerly's Law of Trade Marks and Trade Names* (fourteen edition) states in relation to proper reasons for non-use:

“10-072 References to "proper reasons for non-use" need to be interpreted in accordance with Art.19(1) of TRIPS which uses the expression "valid reasons based on the existence of obstacles" to the genuine use which is required. "Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other governmental requirements for goods or services protected by the trademark, shall be recognized as valid reasons for non-use.”

10-073 Whether there are proper reasons for non-use is something to be decided in all the circumstances of the case. One factor which must always be taken into account is the legislative purpose of the non-use provisions (see above), which has been described as the requirement to use a trade mark or lose it. In *Invermont*, [[1997] R.P.C. 125.] the hearing officer gave some guidance, which has been applied subsequently: "... bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirement to use a trade mark or lose it, I think the word proper, in the context of section 46 means: apt, acceptable, reasonable, justifiable in all the circumstances. I do not think that the term "proper" was intended to cover normal situations or routine difficulties. I think it much more likely that it is

intended to cover abnormal situations in the industry or the market, or even perhaps some temporary but serious disruption affecting the registered proprietor's business. Normal delays caused by some unavoidable regulatory requirement, such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman's own control and I think he should plan accordingly.'"

The basis of Mr Wade's claim for proper reasons for non-use is his illness. As his business was a one man business this could be the basis for a claim that there were proper reasons for non-use. The period of his illness and treatment ran from December 1999. In October 2000 he tried to regenerate his business, so I cannot see that the illness could be seen as stopping his use from then onward. The business did not take off, that is part and parcel of commercial life; it is not, in my view, a proper reason for non-use. The period under consideration is from 4 January 2001 to 4 January 2006, I can see no basis for a claim that there were proper reasons for non-use in that period and so Mr Wade cannot benefit from the proper reasons for non use provision.

31) Mr Wade and Mr Young describe the services provided in terms of the specification. Specifications seldom closely reflect the actual world of commerce. There is no indication of the specific services that have been provided. Mr Wade refers to large numbers of meetings and discussions; no notes or minutes of these meetings are provided. There is no indication as to who was at the meetings and what was specifically discussed. He refers to a contract with CACI and describes it in terms of the specification rather than specifically stating what it was for. No copy of the contract has been furnished. Mr Young provides no copies of contracts for the business that took place in the United Kingdom. The profit and loss accounts of Mr Wade tell me nothing about what he was supplying. From the evidence I have no idea as to what services were provided under the trade mark.

32) The basis of what constitutes genuine use was decided by the European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85:

"1. Article 12(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark. The fact that a mark that is not used for goods newly available on

the market but for goods that were sold in the past does not mean that its use is not genuine, if the proprietor makes actual use of the same mark for component parts that are integral to the make-up or structure of such goods, or for goods or services directly connected with the goods previously sold and intended to meet the needs of customers of those goods.”

33) The ECJ ruling means that use to create an outlet for services can be sufficient. Mr Wade’s website lists what Azurra Consulting was intending to do:

“By focusing on business strategy and market knowledge we aim to improve your business by means of:

- Strategic business analysis
- Market analysis
- Market Research
- Corporate and product positioning
- Corporate and product branding
- Management consultancy”

Can having a website of itself be seen as an action to create an outlet for services? If of itself it could, then it would be an easy way of defending any trade mark. Set up a website and list goods and services. There is no indication of the number of hits on the website. Websites are usually advertised by businesses in their promotional material. There is no promotional material. Website owners will imbed metatags to get hits; they can pay Google to have advertisements for their sites to appear as the result of searches for certain key words. There has been no evidence of anything having been done. All that Mr Wade has done is set up a website, which a child in his back bedroom could do. I consider that the simple fact of the existence of a website is not enough to show that the proprietor of a trade mark is actively seeking to create an outlet for its services. He needs to show how he set out to let people know about the website.

34) In *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01 [2003] ETMR 98* the Court of First Instance stated:

“47 In that regard it must be 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.”

In *Laboratoire De La Mer Trade Marks [2002] FSR 51* Jacob J held:

“9 In the present cases, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye -- to ensure that use is actually proved -- and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

The absence of primary documentation in this case does not give me enough even for probabilities or suppositions. It is not that the t's have not been crossed or the i's dotted, they have not even be written. The onus is upon the proprietor to show the actual use, the proprietor has not done this. Mr Wade and Mr Young quote the specification rather than identify the specific services that they state have been supplied. In a revocation action the competent authority assesses the actual use and then fashions a specification based upon this; an impossibility in this case (see *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32, *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03, Animal Trade Mark* [2004] FSR 19 and *Omega SA v Omega Engineering Inc* [2003] FSR 49). It is not the job of the proprietor to do this. Mr Wade's case is built upon assertion rather than evidence.

35) Nothing turns upon the oral licence referred to. However, a licence, whether oral or not, will of its nature have conditions and terms. No reference is made to them. Mr Wade also refers to being asked to comment on the design of new and potential digital data products. Again there are no specifics. Commenting on software is very different from designing software; I can comment on the word processor software that I am using to write this decision, I have no idea of how to design that software. In his counterstatement Mr Wade says that both that the trade mark has been used in relation to *provision of trade information* and that it has not; this is clearly an error, but an error that leaves me not knowing what the purported position is.

36) The application for revocation under section 46(1)(b) is successful and the registration is to be revoked in its entirety from 4 January 2006.

COSTS

37) Azura Group Limited having been successful is entitled to a contribution towards its costs. I order Bryan Frederick Wade to pay Azura Group Limited the sum of £500; made up of the £200 fee for filing the application and £300 for the statement of grounds. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of January 2007

**David Landau
For the Registrar
the Comptroller-General**