

O-033-07

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 1552116
IN THE NAME OF MICRO MEDICAL LIMITED
OF THE TRADE MARK:**

MICROGAS

IN CLASS 10

**AND THE APPLICATION FOR REVOCATION THERETO
UNDER NO 82164
BY LINDE MEDICAL SENSORS AG**

Trade Marks Act 1994

**In the matter of registration no 1552116
in the name of Micro Medical Limited
of the trade mark:
MICROGAS
in class 10
and the application for revocation
thereto under no 82164
by Linde Medical Sensors AG**

BACKGROUND

1) On 25 May 2005 Linde Medical Sensors AG, which I will refer to as Linde, filed an application for the revocation of trade mark registration no 1552116. The registration is for the trade mark MICROGAS (the trade mark) and is registered for the following goods:

gas sensing apparatus for medical purposes; apparatus for use in hospitals and nursing homes for measuring the concentration of a gas; all included in Class 10.

The registration is in the name of Micro Medical Limited, which I will refer to as MML. The registration process for the trade mark was completed on 9 December 1994.

2) Linde states that it has sought protection for its international registration of the trade mark MICROGAS in class 10 in the United Kingdom. The registrar issued a provisional refusal of the request for protection, citing the trade mark. Linde requested MML to grant consent to the granting of protection of its trade mark in the United Kingdom. This was refused. Linde states that an examination of MML's website does not indicate MML sells any products under the trade mark. Linde seeks revocation of the trade mark under section 46(1)(b) of the Trade Marks Act 1994 (the Act). It claims that the trade mark has not been used for the period from 3 November 1998 to 3 November 2003 and seeks revocation of the trade mark from 3 November 2003.

3) MML filed a counterstatement. It states that it has used the trade mark in the material period. It does not understand why a revocation action should be filed on the basis of its website; an enquiry to MML would have revealed use of the trade mark.

4) Both sides seek an award of costs. MML wishes the minimal nature of the enquiry as to use by Linde to be taken into account in relation to the costs.

5) 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; both sides filed written submissions. This decision is based upon the evidence filed and the written submissions.

DECISION

6) 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.

7) Evidence was furnished by Graham Henry Jones, MML’s trade mark representative in this case, and Christopher Patrick Lawson. Mr Lawson is the technical director of MML. Mr Jones’ evidence included letters from Sue Burrett and documents supplied by Ms Burrett. Ms Burrett is the personal assistant to Mr Lawson. Michael Arthur Lynd, Linde’s trade mark representative in this case, filed evidence for Linde.

8) Mr Lawson designed the products sold under the trade mark. Mr Lawson states that although replacement sensors are not specifically titled MICROGAS on price lists, the replacement sensors (which are sometimes referred to as transducers) are clearly for the MICROGAS products. Evidence re sales to EME Limited has been furnished by MML (see below re invoices). Mr Lynd in his evidence seems to doubt the existence of the company. He refers to a search he conducted on the Companies House website to find the company, which failed. Mr Lawson states that EME Limited, at the time of the sale, was a British registered company based in Brighton. MML has not only furnished copies of invoices to EME, it has also furnished order forms from EME. The order forms bear EME’s details. The order forms also show the full name of the company: EME (Electro Medical Equipment) Ltd. Mr Lynd’s failure to find EME on the Companies House

website is likely to arise from the failure of his search strategy. If he had put in EME Electro he may well have got a different answer.

9) Mr Lynd in relation to export sales states that there is no evidence to show that the trade mark was affixed to the goods. Mr Lawson states that the trade mark is affixed to MML's products in the United Kingdom, this applies to products for sale in the United Kingdom and also to products for export. Pictures of the MICROGAS product and its packaging are exhibited as is an actual machine. The monitor bears the name MICROGAS on the outside and MicroGas in the battery compartment. The sensor, for nitrogen dioxide, bears the name MICROGAS. When the machine is switched on the first thing that appears in the display is MICRO MEDICAL MICROGAS V3.1. Labels are exhibited. A monitor bearing the trade mark has been supplied, Mr Lawson has stated that the product sold abroad has the trade mark affixed to it. In the absence of any contradictory evidence, I consider that this evidence has established that products sold for export bear the trade mark.

10) Mr Lynd raises the issue of whether sales to Micro Direct Inc were internal sales. The European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 [2003] ETMR 85 commented upon internal use:

“37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d'être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.”

This raises the issue as to what is internal use. In relation to an exhaustion of right question, the ECJ stated:

“44 The answer to the first question must therefore be that Article 7(1) of the Directive must be interpreted as meaning that goods bearing a trade mark cannot be regarded as having been put on the market in the EEA where the proprietor of the trade mark has imported them into the EEA with a view to selling them there or where he has offered them for sale to consumers in the EEA, in his own shops or those of an associated company, without actually selling them.”

(Peak Holding AB v Axolin-Elinor AB Case C-16/03)

It might be extrapolated from this that internal use would be limited to use by companies that are linked in terms of ownership. However, in *Laboratoires Goemar SA v La Mer Technology Inc* [2005] ETMR 114 Neuberger LJ stated:

“39 Following the guidance given by the European Court in *Ansul* and *La Mer*, there is a substantial measure of common ground between the parties as to the nature of the "genuine use" of a mark required by Art.10 of the Directive. It is agreed that use which is merely internal to the registered proprietor's undertaking (or, presumably, to that of his licensees or agents), or use which is "merely token, serving solely to preserve the rights conferred by the mark" (to quote from [36] of the judgment in *Ansul*) will not suffice. What divides the parties is whether use which is neither internal nor token can nonetheless be excluded from the concept of "genuine use", either because it has not come to the attention of end-users and consumers, or because it is insignificant in the context of the relevant market.”

So, Neuberger LJ considers that use by an agent will be considered as internal use; use by a wholesaler will, however, not count as internal use:

“51 Finally, I should mention the judge's suggestion that the use of the mark relied on in this case was effectively internal, and therefore could not qualify as genuine. As Mummery L.J. has explained, the use of the mark relevant for present purposes related to five separate occasions, and in relation to a small quantity of goods. However, that does not assist on the question of whether or not the use was internal. The essential point is that the occasion was a transaction between the proprietor of the mark as seller of the goods, which were sold and shipped pursuant to an arm's length apparently bona fide sale, to an independent wholesaler in this country. Such a sale cannot, in my view, be characterised as a transaction internal to the proprietor's organisation.”

Mr Lynd exhibits an MML catalogue which lists four names and addresses; one of these is of Micro Direct, Inc. Mr Lawson states that Micro Direct, Inc is a distributor of MML's products in the United States. It is an independent company. MML has no shareholdings in Micro Direct, Inc and vice versa. There are no common employees in the two companies and no common ownership. If Micro Direct, Inc is a distributor of the goods of MML it may be considered to be its agent and so use in relation to it would not amount to external use; that it was not owned by MML or had any common employees would not matter. If it is a wholesaler, sales would represent external use. Owing to other evidence in this case I do not consider that anything turns upon the sales to Micro Direct, Inc and I do not need to decide whether Micro Direct, Inc was an agent or a wholesaler.

11) A MicroGas nitric oxide and nitrogen dioxide monitor operating manual is exhibited. The cover indicates that the operating manual is revision 1.8, emanating from July 1998. Mr Lawson states that there have been continuous sales of MICROGAS products since he designed them. The products are for specialist medical markets, mainly for use in the intensive care of premature babies, for example during transport to intensive care units.

Mr Lawson states that MML has been put to much trouble and expense by the application for revocation; all upon the basis of an apparent misreading of the website. He states that a simple telephone call to MML was all that would have been required to establish the sale and availability of MICROGAS products.

12) Pages from the MML website (dated 11 March 2005) include the following:

“Micro Medical MicroGas system is designed for simple connection to side stream or in-line ventilator circuits to monitor inhaled Nitric Oxide concentrations. This is currently being used as a novel therapy for the treatment of ARDS and PPHN. The unique intelligent calibration and sensor drift detection makes MicroGas exceptionally easy to use. MicroGas may be used with a wide range of other gases including NO₂ and CO by changing transducers taking advantage of the automatic gas sensing facility.

MicroGas combines the latest electrochemical gas sensor technology with a sophisticated, intelligent Microprocessor to allow different gases to be detected using a single unit. In the ventilator circuit monitoring both NO and NO₂ concentrations may be required. By using two sensors MicroGas can easily accomplish this task.”

13) Details of invoices that have been exhibited are given below:

Name of purchaser	Date of Invoice	Number of products	Name of product
EME Limited Brighton (copy of order from is also attached).	17 March 1999	1	MICROGAS nitric oxide monitor serial no 0268 sensor no 0515
		1	MICROGAS nitrogen dioxide monitor serial no 0267 sensor no 0520
Air Liquide Hellas Athens (copy of order from is also attached).	16 June 2000	1	MICROGAS NO MG2000 serial no 0270(0559)
		1	MICROGAS NO ₂ MG2020 serial no 0271(0560)
Shin Chen Instrument Co Ltd, Taiwan (copy of order from is also attached).	19 May 2000	1	MICROGAS SYSTEM serial no 0268 sensor serial no 0515
		1	MICROGAS SYSTEM serial no 0267 sensor serial no 0520
St Georges Healthcare NHS	8 May 2001	1	MICROGAS nitric oxide monitor serial no 0273

Trust (copy of order from is also attached).			sensor no 0595
EME Limited Brighton (copy of order from is also attached).	12 November 2001	1	MICROGAS system serial no 274
Egrometrix SA Barcelona (copy of order from is also attached and postal receipt).	31 January 2002	1	MICROGAS system serial no 275
Shin Chen Instrument Co Ltd, Taiwan (copy of order from is also attached).	20 January 2003	1	MICROGAS MONITOR serial no 0276 sensor serial 0648
Egrometrix SA Barcelona (copy of order from is also attached).	3 April 2003	1 1	MICROGAS MONITOR serial no 0277 sensor serial no 0659 NO sensor serial no 0660
Brighton & Sussex Uni Hospital Trust (copy of order from is also attached).	15 May 2003	1	MICROGAS MONITOR serial no 0278 sensor serial no 0661
Ingenieria Biomedica/PH Medical Chile	25 July 2003	1	MICROGAS system serial no 0279 sensor serial no 0662
Micro Direct Inc USA (copy of order from is also attached).	19 September 2003	1	MICROGAS nitric oxide monitor serial no 280
Great Ormond Street Hospital	30 October 2003	1	MICROGAS analyzer monitor serial no 0279 sensor serial no 0670

It will be seen that the majority of the invoices are also accompanied by the order forms. Mr Lynd in his submissions refers to “the first so-called “invoice””. In my view, there is nothing “so-called” about the invoices. They are invoices. He attacks the invoices because the same serial number is used on some of them. All that this indicates to me is that there has been an error. (If one was inventing invoices it would be easy to avoid errors). He also comments upon the differences between price list prices and invoice prices. I cannot see that this amounts to anything. The price lists for the MICROGAS product is given on all of the price lists as £995; the charge for the product on a good number of invoices is below this, on some it is the listed price, on one (to Ergometrix SA) it is above this price. All this tells me that is the price for the goods is negotiable. Mr

Lynd is impugning the evidence of MML. Is he suggesting that the invoices and order forms are inventions for the purposes of these proceedings? If he is I consider that he needs something far more concrete than speculative accusation. The invoices have been issued to various health bodies in the United Kingdom, he could, and, in my view, taking into account the implication of his submissions, should have contacted these bodies to verify the sales. It seems to me that he is making very serious accusations against MML in relation to the evidence in this case.

14) A list of sales of MICROGAS products from 6 June 1997 to 9 August 2005 is exhibited. This shows regular, if not enormous, sales made in the United Kingdom and abroad from 6 June 1997 through to 9 August 2005. The list of sales also shows errors in relation to serial numbers, indicating errors rather than something sinister. Price lists are exhibited for 1 September 1996, 1 September 1997, 1 August 1998, 1 January 1999, 1 February 2000, 1 January 2003. All of the price lists show MICROGAS products.

15) The bulk of the evidence has come from Mr Jones. This has the disadvantage of being hearsay evidence; of course, under the Civil Evidence Act 1995 hearsay evidence is permissible in civil legal proceedings. However, I have based my considerations on the primary evidence of invoices, price lists, the product etc.

16) 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.”

In *La Mer Technology Inc v Laboratoires Goemar SA* Case C-259/02 the ECJ considered the extent of use, the amount of use and the types of use that can be considered when deciding whether there has been genuine use of a trade mark:

“20. It follows from those considerations that the preservation by a trade mark proprietor of his rights is predicated on the mark being put to genuine use in the course of trade, on the market for the goods or services for which it was registered in the Member State concerned.

21. Moreover, it is clear from paragraph 39 of *Ansul* that use of the mark may in some cases be sufficient to establish genuine use within the meaning of the Directive, even if that use is not quantitatively significant. Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark.

22. The question whether use is sufficient to preserve or create market share for those products or services depends on several factors and on a case-by-case assessment which is for the national court to carry out. The characteristics of those products and services, the frequency or regularity of the use of the mark, whether the mark is used for the purpose of marketing all the identical products or services of the proprietor or merely some of them, or evidence which the proprietor is able to provide, are among the factors which may be taken into account.

23. Similarly, as emerges from paragraphs 35 to 39 of *Ansul* set out above, the characteristics of the market concerned, which directly affect the marketing strategy of the proprietor of the mark, may also be taken into account in assessing genuine use of the mark.

24. In addition, use of the mark by a single client which imports the products for which the mark is registered 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 of the mark.”

In *Laboratoires Goemar v La Mer Technology Inc* [2005] ETMR 114 Mummery LJ held that a quantitative and qualitative test for market use and market share could not be erected when considering genuine use:

“32 Blackburne J. interpreted and applied the rulings of the Court of Justice as placing considerably more importance on the market in which the mark comes to the attention of consumers and end-users of the goods than I think they in fact do. I agree with Mr Tritton that the effect of Blackburne J.'s judgment was to erect a quantitative and qualitative test for market use and market share which was not set by the Court of Justice in its rulings. The Court of Justice did not rule that the retail or end-user market is the only relevant market on which a mark is used for the purpose of determining whether use of the mark is genuine.”

Neuberger LJ in the same judgment held the following:

“45 The notion that the use of the trade mark must be substantial or significant before it qualifies as "genuine" seems to me to run into two difficulties in any event. The first is that it does not involve attributing the word "genuine" its natural meaning, although this point of course potentially substantially weakened by the fact that the equivalent word used in the text in Art.10 in other languages may carry with it a slightly different meaning.

46 Secondly, once one imposes a requirement of significance or substantiality, it becomes potentially difficult, time-consuming, and expensive to decide whether, in any particular case, that requirement is satisfied. In this connection, Mr Tritton made a fair point when he suggested that the introduction of a test of significant use could lead to detailed arguments about the precise nature and extent of the market in which a particular trade mark is to be used, as well as a detailed enquiry in many cases as to the precise nature and extent of the use of the particular mark over the relevant five-year period. I do not regard that as a particularly desirable outcome.

47 Although the use of the instant mark within the jurisdiction can be said to be close to exiguous, I do not think it could be characterised as *de minimis*. Even if it could be so characterised, I do not consider that that concept would be a useful or helpful one to invoke or apply, even if it had not been effectively ruled out by the European Court.”

In *The Sunrider Corp v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-416/04 P the ECJ stated:

“72 It follows that it is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, to that effect, order in *La Mer Technology*, paragraph 25). Thus, when it serves a real commercial purpose, in the circumstances referred to in paragraph 70 of this judgment, even minimal use of the trade mark can be sufficient to establish genuine use (order in *La Mer Technology*, paragraph 27).”

Mr Lynd in his evidence refers to *de minimis* use and to use “on a commercial scale”. I cannot see that these are concepts which are supported by the case law; indeed, it seems to me, that the very opposite is the case. Use that is use to keep a trade mark “alive” is clearly not genuine use. I cannot see that there is any indication of this in this case.

17) *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.”

In this case one has invoices over a period of years with, for the most part, accompanying order forms. There is also a record of all sales of goods under the trade mark. Such evidence does not leave one with probabilities or suppositions but facts. There is certainly some weakness in the form of some of the evidence furnished. Ms Burrett was giving evidence born of and solicited for the purposes of this case; she should not have given evidence by letter but in the form required by Rule 55 of the Trade Marks Rules 2000 (as amended) (the Rules) eg by witness statement. Owing to this I have not relied on Ms Burrett's letters but the supporting “objective” evidence that came in with them.

18) Mr Lawson comments upon the specialist nature of the goods; this is clearly the case. There have been regular, if not frequent, sales both in the United Kingdom and abroad; except in the case of the sales to Micro Direct, Inc in the United States, there is nothing to suggest that these sales were not at arm's length. I find that there was genuine use of the trade mark between 3 November 1998 and 3 November 2003 in respect of nitric oxide and nitrogen dioxide monitors for medical use. (Consequently, it is not necessary to consider invoking section 46(3) of the Act.)

19) Some of the use has been in the upper case form registered and some in the form MicroGas. I consider that the latter form is 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.

20) This leaves the question of deciding upon a fair specification of the goods. There is solid basis of case law in relation to this matter:

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for

motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03

"42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a

mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

Animal Trade Mark [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

The use of the trade mark has only been for nitrogen dioxide and nitric oxide monitors; gas sensing apparatus. There is nothing to suggest that gas sensing apparatus for medical purposes is subject to sub-categorisation by the nature of the gas that is being monitored. To describe the goods by the nature of the gas that they have been used to monitor would be pernickety. Consequently, in my view the existing specification represents a fair specification of the goods.

21) The application for revocation is dismissed.

22) Studying the papers for this case I have been concerned by some of the language that has been used by Mr Lynd. He refers to “the first so called “invoice””, the “alleged export sales”, he even states that Mr Lawson is “said to be the Technical Director of the proprietors”. This all smacks of implying that there has been underhand dealing by MML in this case. I am most concerned that Mr Lynd has implied that invoices have been fabricated. How else does one interpret a “so called “invoice””? This despite the fact that sales orders have also been included. In the case of such serious impugning of the

evidence of MML, in my view, Linde should have requested a hearing and Mr Lawson and Ms Burrett called for cross-examination (rule 55(5) of the Rules would have allowed for the calling of Ms Burrett).

23) I have a good deal of sympathy with MML's complaint about the nature of the search for use of the trade mark that was made. This, from the evidence, was confined to a search of MML's website, some considerable time after the end of the alleged non-use period. It is not uncommon in proceedings before the registrar for parties to file Internet evidence using the web service, *Way Back Machine*. It would have been appropriate for Linde to use this service. Despite the evidence filed by MML, Linde continued with this action; in my view, clearly flying in the face of the evidence. It is the right of parties to file non-use revocation actions. However, if they have made little effort to establish whether there has been use and use is established, then the applicant should expect this to be reflected in costs.

24) On the other side of the coin, there was a good deal of time spent at the beginning of the proceedings in lengthy and ultimately fruitless arguments from Mr Jones in relation to an absence of a statement of truth on his original witness statement and the correction of a clerical error on Linde's application form.

25) MML having been successful is entitled to a contribution towards its costs. Taking into account my comments in paragraph 23, the costs should be considered by reference to the actual costs incurred by MML (although, taking into account my comments in paragraph 24). Consequently, MML has two weeks from the date of this decision to submit a detailed breakdown of its costs in relation to this case. I will, then, issue a supplementary decision in relation to costs. If such a breakdown is not received in two weeks, the award of costs will be based solely upon the scale.

Dated this 30th day of January 2007

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