

O-095-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 82089
BY G W PADLEY VEGETABLES LIMITED
FOR REVOCATION OF TRADE MARK No. 1193215
STANDING IN THE NAME OF
SOCIETE NATIONALE DES CHEMINS DE FER FRANCAIS SNCF**

BACKGROUND

1) The following six trade marks are registered in the name of Societe Nationale Des Chemins De Fer Francais SNCF. As they were merged they now appear under a single registration number, 1193215. However, the full details have been shown for each mark.

Mark	Number	Registration completed	Class	Specification
ORIENT EXPRESS The six registrations are merged under registration number 1193215	1193210	10.07.87	29	Meat; fish, poultry and game, none being live; other than for animals; meat extracts; fruits and vegetables, all being preserved, dried or cooked; jellies and dairy products, all for food; jams, eggs, milk, edible oils, edible fats; food preserves; pickles.
	1193211	10.07.87	30	Coffee, tea, cocoa, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery; ices, honey, treacle; yeast and salt, all for food; baking powder, mustard, pepper, vinegar, sauces, spices (other than poultry spices); ice.
	1193212	08.05.85	31	Fresh fruits and fresh vegetables.
	1193213	20.03.85	32	Beer, ale and porter; mineral waters, aerated waters, non-alcoholic drinks and preparations for making such drinks, and syrups, all included in Class 32.
	1193214	20.03.85	33	Wines, spirits (beverages) and liqueurs.
	1193215	20.03.85	34	Tobacco, whether raw or manufactured; smoker's articles included in Class 34; matches.

2) By an application dated 23 March 2005, subsequently amended, Oriental Express Frozen Foods Limited applied for the revocation of the registration under the provision of Sections 46(1)(a) & (b) claiming there has been no use of the trade mark in suit in the five years following registration nor in the five year periods prior to 18 June 2002 or 23 March 2005. The applicant requests revocation with effect from 18 June 2002, 23 March 2005 or from such earlier date at which the Registrar is satisfied that the grounds for revocation exist. The revocation was taken over by G W Padley Vegetables Ltd following an assignment of trade marks formerly owned by Oriental Express Frozen Foods Ltd. G W Padley Vegetables Ltd provided the necessary undertakings upon becoming the new applicant.

3) On 10 August 2005 the registered proprietor filed a counterstatement stating that it has used the mark in suit on all the goods registered through its licensees.

4) Both sides filed evidence. The matter came to be heard on 24 January 2008 when the registered proprietor was represented by Ms Szell of Messrs Venner Shipley LLP and the applicant was represented by Mr Tritton of Counsel instructed by Messrs Freeth Cartwright LLP.

REGISTERED PROPRIETOR'S EVIDENCE

5) The registered proprietor filed a witness statement, dated 5 August 2005 by Joanna Jane Clark the General Manager-Retail of Orient Express Hotels Ltd a position she has held since February 1997. Prior to this she was the Buyer and Merchandise Manager-Retail of her company from March 1992. She states that her company entered into a contract with the registered proprietor in May 1982 which referred to the licensing of the ORIENT EXPRESS trademark to her company. She states that the last, and current contract was concluded on 3 May 2001. Ms Clark states that the mark is used by her company and its subsidiaries. She states that her company has 49 leisure properties in 25 countries including 38 hotels, restaurants and five tourist trains. She states that:

“3. My Company runs a well-known train service under the name VENICE SIMPLON-ORIENT-EXPRESS on the Continent. In the UK, my company, through its subsidiary VSOE, operates two trains-“the British Pullman cars of the VENICE SIMPLON-ORIENT-EXPRESS” and “the Northern Belle – the Orient-Express of the North” (together, “the Trains”). Orient express gift boutiques feature on both of the Trains. The Orient Express gift boutique is visited by the vast majority of passengers on the Trains – the British Pullman has a mobile boutique in the form of a trolley. There are approximately 27,000 passengers on the Trains who either embark or disembark in the United kingdom each year.”

6) At exhibit 1 she provides photographs of items which she states have been sold in the train boutiques over the past five years. She states that all the packaging is branded with the company (VSOE) logo. The exhibit shows pictures of a case for a whisky bottle, a bottle of champagne, a box with the words “Genuine Turkish Delight” printed on it and a packet of “Euro sweets” all with the logo as shown below:



7) The whisky and Turkish delight have attached sheets which show price changes in 1998 and 2000 respectively. Exhibit 1 also shows:

- a gingerbread man with the letters “VSOE” piped on it.
- Artwork authorisation forms dated October 2004 with regard to labels for biscuits, toffees, fudge and mints with the VSOE crest and also the words “ORIENT EXPRESS TRAINS & CRUISES”. There is no price or corroborative evidence with regard to biscuits. There are purchase orders from the registered proprietor to suppliers dated April 2003 – November 2004 for toffees, fudge and mint humbugs. None of these orders, save one, mentions what labels are on the packaging. The exception being the last order, dated

November 2004, for toffee, mint imperials and fudge which is annotated “WITH ORIENT EXPRESS LABEL” after each of the items.

- A stock master sheet showing one bottle of virgin olive oil, which is undated, another stock master sheet showing a “date of last sale” of June 2005 with sixteen units sold in the “year to date” column. There is no indication of the label used on this item. The letter included with this item suggests putting the olive oil on the train at Venice railway station.
- Stock master sheets for two sizes of champagne bottles, these are undated and do not show any sales made. They do not indicate where the stock is held.
- A stock master list for “Euro sweets” with a “price effective” date of May 2000 and a “Date of last sale” of May 2001.

8) At exhibit 2 Ms Clark provides copies of printouts from her company’s website. This is headed up with the words “Orient-Express Gift Boutique” as well as the intertwined letters “VSOE”. These are dated 9 September 2004. These show fudge, humbugs and toffee for sale. The fudge has the logo mark shown at paragraph 6 above, whilst the humbugs and toffee appear to have the letters “VSOE” intertwined with the words “Orient Express Trains and Cruises” underneath, although they are very difficult to read.

9) Also included in exhibit 2 are copies of a publicity flyer which Ms Clark states was sent out to UK customers from 2003 onwards and also handed out on the trains. This provides details of hampers. These contain various items which are from a variety of manufacturers and carry the various trademarks of those manufacturers. Amongst the goods listed as being offered as part of the hampers are: Ginger beer, liqueurs, wine, cheese, biscuits, preserves (savoury and sweet), tea, coffee, cordials, fudge, chocolate powder, fruit juices, sauces, crisps, tinned fish, tinned soup, cake and chocolates. At the top of the flyer is a crown, with the intertwined letters “VSOE” underneath. Then the word “Collection” and, underneath again, “Venice Simplon-Orient Express”. In larger print just underneath are the words “Limited Edition Orient-Express Hampers”. These flyers are dated September 2004 and 5 August 2005. There is also a flyer which has at the top a crown, with the intertwined letters “VSOE” underneath. Then the word “Collection” and, underneath again, “Venice Simplon-Orient Express”. In larger print underneath this is the word “Hampers”. This is dated 5 November 2003.

APPLICANT’S EVIDENCE

10) The applicant filed a witness statement, dated 15 June 2006, by Katherine Cullen, the applicant’s Trade Mark Attorney. She comments that with regard to the documents provided for all of the commodities, none show actual sales in the UK of goods branded with the mark in suit. She states that the documents provided also appear to be internal documents and so do not provide evidence of use as per *Laboratoires Goemar SA v La Mer Technology Inc* [2005] EWCA Civ 978. In addition she comments that those goods shown do not show use of the mark in suit but use of the Venice Simplon logo as at paragraph 6 earlier in this decision. Ms Cullen states that the logo features an elaborate circular design and the words VENICE SIMPLON above the words ORIENT EXPRESS. She states that this “is use

in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered. As such it does not constitute genuine use of ORIENT EXPRESS.” Similarly, she comments that the reference to Collection Venice-Simplon Orient-Express on documents headed Buyer’s Copy shows use of a company name but does not constitute use of Orient Express as a trade mark as per *Orient Express* [1996] RPC 25.

11) Ms Cullen also comments specifically with regard to each of the goods as follows:

Whisky: The photograph shows a case but not a whisky bottle and does not provide conclusive proof of sales of whisky under the mark in suit in the UK.

Turkish Delight: the image is of a box of Turkish delight but no evidence of actual sales in the UK are shown.

Gingerbread Man: The image shows a gingerbread man with the initials VSOE upon it. There is no reference to Orient Express.

Olive Oil: The evidence does not show use or sales of olive oil under the mark in suit.

Confectionery: This contains artwork proofs and are internal documents. No evidence of the actual products has been provided. One image of a product that has been provided shows an item with the Venice-Simplon Orient-Express swing tag.

Champagne: The images are not legible, and so it is unclear whether champagne has been sold under the mark in suit.

Hampers: These contain third party branded products. The goods are not branded ORIENT EXPRESS. In any case hampers are in Class 20.

Pages from the Internet: The images are not clear enough to read the labels. No evidence of “hits” or sales to UK customers from the website is provided.

12) Ms Cullen seeks revocation from the earliest date possible with regard to all of the goods. In the alternative, she contends that if use is found with regard to whisky, Turkish delight, Gingerbread men, fudge, toffee, humbugs, olive oil, champagne and boiled sweets then the registration should reflect this in a reduced specification.

13) That concludes my review of the evidence. I now turn to the decision.

DECISION

14) The revocation action is based upon Section 46 of the Trade marks Act 1994, the relevant parts of which read as follows:

“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)
- (d)

(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.”

15) The applicant claims that the mark has not been used in the five year period following the completion of the registration process or in the five year periods ending 18 June 2002 or 23 March 2005 (strictly, the last five year period must be that ending on 22 March 2005, the day prior to the application for revocation). In this case the question of the date of completion of the registration procedure for this registration is complicated by the fact that it is the result of a merger of six separate registrations of the trade mark, the registration procedures for which were completed between 20 March 1985 and 10 July 1987.

16) This raises the question of which date is to be taken as the date of completion of the registration procedure in relation to the merged registration. Rule 20(6) of the Trade Mark Rules 2000 states:

“20(6) The date of registration of the merged registration shall, where the separate registrations bear different dates of registration, be the latest of those dates.”

17) Whereas section 40(3) of the Act states:

“40(3) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.”

18) I do not consider that Rule 20(6) affects the matter for this reason. It is clear from the wording of s.40(3) of the Act that the “date of registration” is not the same as the “date of the completion of the registration procedure.” Consequently, the former date is strictly irrelevant for the purposes of assessing a claim for revocation for non-use.

19) The merged registration in this case is a result of separate registrations of the trade mark at different dates in respect of different goods. For the purposes of assessing a non-use claim against such a merged registration, the five year period for the purposes of section 46(1)(a) of the Act must be calculated from the completion of the registration procedure of the mark in respect of each particular product. Further, for the purposes of section 46(1)(b) the mark is to be treated as having been registered for that product at all times since that date.

20) It does not arise in this case, but where the scope of the original registrations overlap and the merged registration therefore covers more than one registration of the trade mark for the same product or service, the relevant date for this purpose should be the date of the completion of the registration procedure in respect of the first registration of the trade mark for that product or service.

21) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. 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.”

22) I take into account the judgement in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-42:

“35. Next, as Ansul argued, the eighth recital in the preamble to the Directive states that trade marks must actually be used, or, if not used, be subject to revocation. Genuine use therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

36. Genuine use must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of origin of goods or services to the consumer or the end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

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 *viv-a-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 for 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.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular 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.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.

40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

41. That applies, *inter alia*, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paras [35] to [39] of this judgement. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services, which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services."

23) The evidence provided by the registered proprietor is somewhat scant. There is the assertion by Ms Clark that whisky, Turkish delight, Gingerbread men, fudge, toffee and humbugs, virgin olive oil, champagne, and boiled sweets have been sold on the UK trains over the past five years. To corroborate this she provides further evidence at exhibits 1 & 2. The evidence breaks down into:

a) olive oil for which no evidence of labelling was supplied;

b) gingerbread men which have only the intertwined letters “VSOE” on them;

c) toffees, fudge, humbugs, mints and biscuits which have the letters “VSOE” intertwined and the words “Orient Express Trains & Cruises” written underneath. Although this exhibit consists of artwork for the labels, there is no evidence as to whether such labels have actually been used, or if they have, when such use began. I note that Ms Clark states that the use has been in the past five years when her statement is dated six months after the end of the later relevant period and she does not comment on use within any of the relevant periods;

d) hampers which had, on the flyers, the intertwined letters “VSOE” and the words “Venice Simplon-Orient Express”. The flyer for September 2004 also had the words “Limited Edition Orient-Express Hampers”;

e) whisky, Turkish delight, champagne and boiled sweets with the logo mark as shown in paragraph 6 above;

f) use of the term “Orient-Express Gift Boutique” on the internet selling toffee, fudge and humbugs which had the mark “Orient Express Trains & Cruises” on their packaging.

24) In addition stock sheets were provided for all the listed goods. However, I did not find these of assistance as it was not clear from these documents where the goods were being offered for sale. The numbers also appeared to be very low, particularly as none of the items can be regarded as particularly expensive. Further, it was claimed that a number of the goods were sold on board the trains at “Orient-Express gift boutiques”. However, no evidence as to the signage used, either at the relevant area or on the trolleys also used to sell such items, was provided. It seems to me that neither the trolley nor the boutique would have signs with such lengthy wording. I very much doubt that the trolleys have any sign at all upon them, as it would be only too obvious what their purpose was, just as the, now defunct, duty free trolleys aboard aircraft. The area of the train used for selling gift items is more likely to carry the tag “boutique” or “gift shop” rather than “Orient-Express gift boutique”.

25) In considering the evidence of use provided I must consider whether the use of the marks as shown in the exhibits can be considered use of the registered mark. In considering this issue I look to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 25. In particular, I refer to the comments of Lord Walker at paragraphs 43-45 where he stated:

“40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal:

“...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.”

(This language is word for word the same as the English language version of Art.10.2(a) of the Directive).

41 The word “elements” can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) “elements” must have a weaker sense (of “features” or even, as Mr Bloch came close to submitting, “details”).

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark’s distinctive character was altered (not substantially altered).

43... The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin’d choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse the ‘visual, aural and conceptual’ qualities of a mark and make a ‘global appreciation’ of its likely impact on the average consumer, who:

‘normally perceives a mark as a whole and does not proceed to analyse its various details.’

The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

26) I also refer to the comments of Sir Martin Nourse, in the same *Bud* case where, at paragraph 12, he said:

“Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or to put it the other way round, the words have dominance which reduces to insignificance the other recognisable elements.”

27) Further, I have regard to the views expressed by the Hearing Officer in *New Covent Garden Soup Company Ltd v Covent Garden market Authority* [BL O/312/05] where he commented at paragraph 26:

“26. I do not think that it can be seriously argued that arranging the words into a roundel affects their distinctive character. It is possible for the addition of elements to alter the distinctive character of a mark. For example, I do not think that the mark JAMES has the same distinctive character as the mark JAMES & JOHNSON. But in this case I believe that the average consumer of soups would regard the words NEW COVENT GARDEN SOUP CO as having an independent distinctive role within the composite mark. These words have the same distinctive character when they are used as apart of a composite mark as they do when used alone. On that view of the matter, the use of the words as part of the composite mark shown above falls squarely within s46(2).”

28) I will firstly consider the use of the letters “VSOE”. These letters are usually intertwined and are very difficult to read. However, even if they were written in capital letters I am not convinced that the average consumer would know that these referred to the Venice Simplon-Orient Express. Therefore, any use of these letters, intertwined or not, cannot be taken as use of the mark in suit.

29) I now turn to consider the use of the logo mark which, for ease of reference I reproduce below:



30) The mark as registered is “ORIENT EXPRESS”. To my mind, the device element does not alter the distinctive character of the mark. However, the words “Venice Simplon” cannot be overlooked, and as they appear above the words “Orient Express” would be seen or enunciated first and would significantly affect the perception of the mark as well as making a very obvious visual and aural difference. They do not have an independent distinctive role within the composite mark. I therefore do not regard the use of this mark as use of the registered mark. Similarly, the use of the words “Venice Simplon-Orient Express” without the device element also cannot be regarded as use of the registered mark.

31) I next consider the use of “Orient Express Trains & Cruises”. I believe that the average consumer would view the words as identifying the trains and cruises that are operated by Orient Express and so in this context the words “Orient Express” have an independent distinctive role within the composite mark. This is therefore use of the registered mark. Moving onto “Orient Express Gift Boutique”, the applicant referred me to a decision of the ECJ in *Celine Sarl v Celine SA* [2007] ETMR 80. The instant case is on all fours with this as it is the name of a shop/boutique, where goods which have other marks are sold. I regard this as being non-trade mark use. The mark has not been used on goods and does not act as a badge of origin. It cannot be considered as use of the registered mark.

32) Lastly, I consider the use of the words “Limited Edition Orient-Express Hampers”. Clearly, when used on hampers the last word is purely descriptive. Similarly, the first two words “Limited Edition” merely inform the average consumer that this is an item which will only be available in restricted numbers or for a set period of time. The implication is that the item will soon be taken off the market. It is an inducement to purchase now for fear of losing the opportunity forever. Although the discriminating purchaser will be aware that usually the item will reappear in the near future in almost exactly the same format but different in minor details or maybe just name. Clearly, the distinctive and dominant element is “Orient-Express” which has an independent distinctive role within the composite mark identical to that when used alone. The hampers contained a large number of items which carried the trade marks of the various suppliers. At the hearing the applicant contended that this was equivalent to going into Sainsbury’s supermarket and leaving with your purchases in a Sainsbury’s bag. I was referred to the comments of Jacob J. (as he was then) in *Euromarket Designs Inc. v Peters & Crate & Barrel* [2001] FSR 20 where he said:

“57.For instance, if you buy Kodak film in Boots and it is put in a bag labelled “Boots” only a trade mark lawyer might say that Boots is being used as a trade mark for film.”

33) In my view the above case is not on all fours with the instant case. There the analogy was that an item which had its own trade mark was purchased and then placed into a bag which had the retailers trade mark upon it. In the instant case the consumer is purchasing a bag or hamper full of items which are being offered for sale under the trade mark Orient- Express. Although the items all carry the trade marks of their respective manufacturers, a fact made plain in the advertising flyer, they are grouped and offered for sale as a job lot under the registered proprietor’s mark. Therefore, use of this phrase must be taken as use of the registered mark.

34) I must now consider whether the evidence of use filed for those elements above which have been identified as being use of the mark in suit is sufficient for the purpose of staving off a non-use revocation action. For this purpose I take into account the comments of Jacob J.(as he was then) in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] ETMR 34. This was an appeal against a decision by the Registrar. In that case the question of whether a very limited amount of use in this country can be regarded as sufficient to be “genuine” was considered. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now, my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

35) Only two of the marks used are considered to be use of the mark registered. These are “Orient Express Trains & Cruises”, and “Limited Edition Orient-Express Hampers”. The mark “Orient-Express Gift Boutique” is, under the above test, also eligible for consideration. I am aware that I have dismissed this mark already in paragraph 31, but for the sake of completeness will include it in this section.

36) The mark “Orient Express Trains and Cruises” was shown on proposed labels for biscuits, toffee, fudge and mints. The correspondence was dated October 2004, which is inside the relevant period which ends 22 March 2005. Although it relates to internal documents and does not show that the goods were offered for sale with these labels it does show that the registered proprietor was, five months prior to the date of the revocation action being filed, taking steps to use its mark. There is also an invoice for “Orient Express label” toffee, mint imperials and fudge dated November 2004. This mark was also shown in use on Toffee, fudge and humbugs offered for sale via the internet site.

37) The mark “Orient Express Gift Boutique” was shown as being used on the internet. However, none of the items detailed had this mark on them, instead they had a variety of other trade marks. I do not believe that the mark has been used on any of the goods for which the mark in suit is registered. Instead it would appear to be used as a retail service indicator. However, this is not crucial as the items demonstrated as being for sale have already been included under paragraph 36 above.

38) Lastly, I consider the use of “Limited Edition Orient Express Hampers”. The flyer exhibited was dated September 2004. In her statement Ms Clark stated that the flyer was sent out to customers and also handed to passengers aboard the trains. Although doubts about Ms Clarke’s suitability as a witness on the basis of her position in the company was voiced at the hearing, the applicant did not seek to challenge her evidence by evidence of its own or by cross-examination. As such her evidence must be accepted as per *Extreme* BL O/161/07. Only one flyer bore this mark and so only the items contained in the two hampers offered for sale on this flyer can be taken in to account. These items were “crisps, cordials, tea, coffee, tinned fish, tinned soup, relish, salt, redcurrant jelly, honey, jam, marmalade, wine, liqueurs, chocolates, biscuits, cake and fudge”.

39) The correct approach to reducing a specification has been considered in a number of cases that have been before the High Court and Court of Appeal. Richard Arnold QC, sitting as the Appointed Person, considered and accumulated authorities in *Nirvana Trade Marks*, BL O/262/06. I gratefully adopt the following propositions

that he derived from his consideration of the case law:

(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

40) For ease of reference the original specification is shown below and alongside the goods upon which use has been shown:

Class	Specification Registered	Goods upon which use has been shown.
29	Meat; fish, poultry and game, none being live; other than for animals; meat extracts; fruits and vegetables, all being preserved, dried or cooked; jellies and dairy products, all for food; jams, eggs, milk, edible oils, edible fats; food preserves; pickles.	Tinned fish, soup, crisps, redcurrant jelly, jam and marmalade
30	Coffee, tea, cocoa, sugar, rice, tapioca, sago; mixtures of coffee and chicory, coffee essences and coffee extracts; chicory and chicory mixtures, all for use as substitutes for coffee; flour, preparations made from cereals for food for human consumption, bread, biscuits (other than biscuits for animals), cakes, pastry, non-	Coffee, tea, biscuits, cake, toffee, fudge, mints, chocolates, honey, salt, relish.

	medicated confectionery; ices, honey, treacle; yeast and salt, all for food; baking powder, mustard, pepper, vinegar, sauces, spices (other than poultry spices); ice.	
31	Fresh fruits and fresh vegetables.	
32	Beer, ale and porter; mineral waters, aerated waters, non-alcoholic drinks and preparations for making such drinks, and syrups, all included in Class 32.	Cordials
33	Wines, spirits (beverages) and liqueurs.	Wine, liqueurs

41) In my view, all of the items upon which use of the mark in suit has been shown fall within the original specification. I also note that the revocation action did not include the goods in Class 34 which therefore remain on the register intact.

42) Ms Szell accepted that the specification would be reduced and the following specifications reflect the suggested specifications at the hearing, and takes into account the comments of the parties on them.

Class 29	Preserved fish; soup; jellies; crisps; jams and marmalade
Class 30	Coffee; tea; biscuits (other than biscuits for animals); cakes; non-medicated confectionery; honey; salt and relishes.
Class 32	Cordials.
Class 33	Wines and liqueurs.
Class 34	Tobacco, whether raw or manufactured; smoker's articles included in Class 34; matches.

43) The applicant has succeeded against the balance of the specifications in each class with effect from the following dates, Classes 29 & 30 as of 11 July 1987, Class 31 as of 9 May 1985 and Classes 32 & 33 as of 21 March 1985.

44) As the applicants have been substantially successful they are entitled to a contribution towards their costs. I order the registered proprietor to pay the applicants the sum of £2,000. This sum 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 2 day of April 2008

**George W Salthouse
For the Registrar,
the Comptroller-General**