

O-255-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO. 2295213  
IN THE NAME OF 1-TO-Z LIMITED  
FOR THE TRADE MARK BUBBLES  
REGISTERED IN CLASSES 9, 41 AND 44**

**AND**

**IN THE MATTER OF AN APPLICATION FOR REVOCATION  
UNDER NO. 83316 IN THE NAME OF  
O2 HOLDINGS LIMITED**

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### **BACKGROUND**

1. On 13 March 2002, 1-to-Z Limited applied to register the trade mark BUBBLES in Classes 9, 41 and 44, and was registered on 22 November 2002 for the following specifications of goods and services:

**Class 09** Computers; computer hardware; computer software; educational computer software; electronic educational apparatus; electronic games apparatus; computer games, video games; telecommunications apparatus; apparatus for recording, transmission or reproduction of sound or images; computer programmes; computer software downloaded or downloadable via the Internet; computer software publications downloaded via the Internet; interactive entertainment software; interactive business software; interactive database software; data recorded electronically from the Internet; data recorded in machine readable form from the Internet; apparatus and instruments for recording, reproducing and/or transmitting sound and/or video information; sound and/or video recordings; sound and/or video recording media; CD ROM; virtual reality systems; scientific, nautical, surveying, photographic, cinematographic, optical, signalling, checking (supervision), life-saving and teaching apparatus and instruments; data-processing equipment and computers; magnetic data carriers, recording discs; parts and fittings for the aforesaid goods; all the aforesaid goods for use in, or relating to speech therapy; but not including encoded telephone cards.

**Class 41** Education services; language teaching; providing of training; entertainment services; sporting and cultural activities; organisation of meetings, seminars, lectures and forums relating to speech therapy and speech and language matters; educational services relating to speech therapy and speech and language matters; teaching services relating to speech therapy and speech and language matters; education and entertainment services in the form of electronic, computer and video games

provided by means of the Internet and other remote communications device; Internet games (non downloadable); organising of games; provision of interactive entertainment software services; education and entertainment services in the form of cinematographic, televisual, digital and motion picture films, radio and television programmes and shows and for the provision of information by computer networks, television, cable and other electronic means; preparation, editing and production of cinematographic, televisual, digital and motion picture films, radio and television programmes all included in Class 41; all the aforesaid services relating to speech therapy.

**Class 44** Speech therapy services; physical therapy services; mental therapy services; behavioural therapy services; services for the cognitive therapy of people; remedial tuition in speech; training services relating to speech; therapy services in relation to speech and language matters; therapy services in relation to behavioural matters; therapy services in relation to the health and wellbeing of people; but not including bubble therapy.

2. On 11 August 2008, O2 Holdings Limited filed an application under Sections 46(1)(a) and 46(1)(b) seeking revocation of the registration with effect from 23 November 2007 and 11 August 2008, respectively. The basis for the application is that the mark has not been put into genuine use by the proprietor within the period of five years following the date of completion of the registration procedure, and there are no proper reasons for non-use. Further, and in the alternative, the applicant applies for revocation on the basis that any use has been suspended for an uninterrupted period of five years in between 11 August 2003 to 10 August 2008, and there are no proper reasons for non-use. Revocation of the registration in its entirety is requested, from 23 November 2007 or, in the alternative, from 11 August 2008 or, in the alternative, in respect of all goods for which genuine use cannot be demonstrated in the relevant period, in accordance with Section 46(5).

3. The applicants filed a Counterstatement in which they assert that the mark has been put to genuine use in the relevant period and deny the grounds of the application.

4. Only the registered proprietors filed evidence. Neither party requested a hearing, the applicants for revocation instead filing written submissions. After giving careful consideration to the facts and circumstances of the case, and taking into account the established case law and the submissions I will now go on to write my decision.

## **DECISION**

### **Registered Proprietor's evidence**

5. This consists of a Witness Statement dated 19 November 2008 from Peter Mason, a solicitor at Briffa solicitors, the registered proprietor's representatives in these proceedings. As Exhibit PM1 Mr Mason exhibits evidence prepared and submitted on 13 November 2008 in relation to an opposition filed by the registered proprietors in these proceedings against the registration of an application by O2 Holdings

Limited. This opposition is based on the existence of the registration in suit, hereinafter referred to as the BUBBLES mark.

6. The first evidence is a Statutory Declaration dated 12 November 2008 from Dr Aubrey Nunes, the sole Director of 1 to Z Limited.

7. Dr Nunes begins by setting out the goods and services for which the BUBBLES mark is said to have been used which is the full extent of the specifications for which it is registered. He goes on to explain the origins of the BUBBLES mark which he says resulted from research undertaken in 1996 by Dr Nunes into the distribution of speech errors in children from the ages of four to eight. Dr Nunes describes the research as follows:

“The research involved the child selecting items against abstract shapes, which were eventually replaced with a disc. It was these discs, as well as the concept of a speech or thought bubble that inspired the creation of the Trade Mark.”

8. Dr Nunes says that software in the form of CD-ROMs “intended for entertainment of children and language and speech education and therapy have been sold at a price of £50 per unit. He specifically mentions a sale to Professor Carole FitzGibbon, Professor of Education at the University of Durham, and 2 copies at a community event in Romford, East London. Dr Nunes says that the product and services offered under the mark are intended for use both in the home and in structured learning, therapy and play environments, such as schools and clinics. He says that marketing of the product and services mostly took place in 2002 and 2003 in the form of demonstrations to persons of influence, but also to the public at large. Dr Nunes says the reason for the lack of current success of the products and services can be attributed to the fact that at the time when this promotion was taking place, software to be used like a book was a concept for which the market was not ready, but as the idea has become more accepted the marketing and promotional activities have increased.

9. Dr Nunes states that the products suffered commercially through having originated in research materials. At one point in the Declaration Dr Nunes says that work on a more photorealistic 3D version of the website has been carried on throughout the relevant period, with two programmers having been employed in the two years up to early 2004 incurring and expenditure of £40-£50,000 pounds.

10. Dr Nunes says that products and services are also promoted under the BUBBLES mark via the website at [www.1-to-z.co.uk/bubbles](http://www.1-to-z.co.uk/bubbles) which he says was registered by the opponents on 9 November 1999. Dr Nunes says that the website was substantially redeveloped in July and August 2003. Extracts from the website showing promotion of the various products and services offered under the BUBBLES mark are shown as Exhibits AN1 to AN5. The prints were taken on 11 November 2008. Each contains copyright statements from 2000 and 2001 which would be consistent with the registration date. The quality of the prints is not very good, but it is nonetheless possible to see the word BUBBLES in a stylised script on the top, and in a plain font in a site index in the top left-hand corner of each first sheet.

11. The first print shows the contents of the Activities section which has a series of interactive exercises. The page makes the offer to “Try Bubbles before buying it.” And “Get the feel of what there is in Bubbles.”

12. The second print is the Purchase section and offers for sale the “Bubbles Professional Edition” available as a “Multimedia educational package at a cost shown in £, \$USD and €Euro, available online, as a CD-ROM or a multi-user licence.

13. The Education section has a number of sub-headings; “Bubbles. Linguistics. Language. Acquisition, and multimedia”, “How Bubbles can help” and “Activities with Bubbles”. A section headed “Multimedia and language acquisition” refers to “How Bubbles can help, by Dr Aubrey Nunes, RMRCST, FRSA, PHD”. The Activities Plans section of the website headed “Activities with Bubbles” explains what BUBBLES is, and its methodology.

14. Dr Nunes says that computer software marketed under the trade mark has received a number of positive reviews. Exhibit AN6 is a print from the About.com website headed “English as a 2<sup>nd</sup> Language”. The sub-heading states “Top 4 English Learning Software for Young Learners”, the number 1 position mentions Bubbles describing it as “...fascinating software which puts the emphasis on teacher-learner participation. In contrast to other software programs, Bubbles is conceived as an aid to developing spoken communication skills between participants using software.”

15. Dr Nunes states that promotion has been through the website and “personal demonstrations to persons of influence” going on to mention the Chief Buyer of Mothercare, the Head of Foreign Languages at Pimlico School, DfES Officers, the Managing Director of Pinnacle Software, and Librarians from the Children’s Library Service in Lambeth. He says that at each of these and in other events such as academic talks, copies of the leaflet at AN7 were distributed. The leaflet is headed with the word BUBBLES with the letters TM in superscript. The leaflet describes the product as “The interactive multimedia package for child development.” The 1 to Z contact details are on the bottom of the cover. The leaflet contains many mentions of the word BUBBLES describing it as a “multimedia CD-Rom...” at a cost of £50.

16. Dr Nunes recounts having met Chris Barry, a Director of De Barra Publishing, an educational publishing company located in the Republic of Ireland with operations in the UK. Dr Nunes says that they discussed the possibility of De Barra distributing BUBBLES games and educational software and discussions have continued. A copy of a letter dated 4 November 2008, from Chris Barry to Dr Nunes (AN8) refers to “Sales of Bubbles Software in Northern and Southern Ireland” and to a meeting in February 2008. The letter mentions the need for the product to be “enhanced from a visual perspective” and expresses the hope that Mr Barry and Dr Nunes can meet again to continue the discussions about “bringing this product to the market.”

17. The second part of the evidence is a Witness Statement dated 12 November 2008 from Rene Kamova, a shareholder and employee of 1 to Z Limited. Mrs Kamova says that she is aware 1 to Z Limited is the proprietor of the registered UK trade mark for BUBBLES.

18. Referring to the requirement to show use, Mrs Kamova confirms that she conducted demonstrations of the software and connected services under the BUBBLES mark to Kathy Haywood, a NatWest Business Manager in 2004, Maria Dermendzhieva and other mothers of children attending the Bulgarian School at the Bulgarian Embassy, London in November 2005, the Ethnic Minority Coordinator for Hackney Free and Parochial Secondary School in December 2006 and Frances Thompson, the Grants Officer of the Cripplegate Foundation in January 2007. A letter relating to the meeting with the Cripplegate Foundation is shown as Exhibit RK1. The letter, dated 11 November 2008 is addressed "To whom it may concern" confirms the meeting and that Ms Thompson was given a copy of BUBBLES software on a CD-Rom.

19. Next is a Witness Statement dated 12 November 2008 from Quang Huy Dinh, a web and graphic designer currently employed with U-Dox Limited, who says that he is aware of I to Z Limited and that they are the proprietors of the registered UK trade mark BUBBLES.

20. He confirms that whilst completing his BSc in Computing at South Bank University from 2002 to 2004, he worked as a freelance web and graphic designer for Aubrey Nunes, a director of I to Z Limited, developing a website to promote speech and language educational services, children's entertainment services and speech therapy services, together with online games and software packages designed to deliver these services. Part of the responsibility was to supervise Din Ung, an unpaid volunteer who was working on the website. Quang Huy Dinh confirms that he was employed on the development of the website from July 2003 for a period of about six weeks.

21. The final Witness Statement is dated 9 November 2008, and comes from Maria Dermendzhieva. Ms Dermendzhieva says that she is aware of I to Z Limited and that they are the proprietors of the registered UK trade mark for BUBBLES.

22. Ms Dermendzhieva recounts being approached by Rene Kamova in November 2005 acting on behalf of I to Z Limited regarding educational software named "BUBBLES" and to being told that it may assist her son to learn English through the use of multimedia games, music and other interactive activities. Ms Dermendzhieva says that she was directed to the website of I to Z, stating that she and her son explored the website and found it useful.

23. Ms Dermendzhieva confirms that on 10 November 2005, Ms Kamova demonstrated the BUBBLES software to her and a number of other parents of children attending the Bulgarian school, after which she was given a CD-Rom containing BUBBLES software on 30 day approval.

24. That concludes my review of the evidence insofar as it may be relevant to these proceedings.

## Decision

### The Law

25. Section 46 reads 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 purpose 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).....

(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.”

26. Section 100 of the Act is also relevant and reads:

“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.”

### **The relevant five year periods**

27. The application for revocation is based on sections 46(1)(a) and (b) of the Act. The registration procedure for the trade mark in suit was completed on 22 November 2002. The relevant periods are therefore, under 46(1)(a): 23 November 2002 to 22 November 2007, with revocation to take effect from 23 November 2007. Under 46(1)(b) the applicants allege a period of non-use from 11 August 2003 to 10 August 2008, with revocation to take effect from 11 August 2008.

28. The two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5, from which I derive the following main points:

genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

the use must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of



the ECJ);

there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

29. So, with this in mind, the first thing is to decide whether there is evidence of use of the word BUBBLES, by the proprietor or with his consent, either as registered, or in a form that does not alter the distinctive character from it as registered.

30. The origins of the BUBBLES mark and the associated goods and services are said to stem back to research undertaken in 1996 although commercial use originated much later. The goods are described as software intended for entertainment of children and language and speech education and therapy. Dr Nunes confirms that promotion of the BUBBLES goods and services has been through personal demonstrations and via the company's website.

31. The proprietor's website [www.1-to-z.co.uk/bubbles](http://www.1-to-z.co.uk/bubbles) is stated to have been registered on 9 November 1999. The applicants challenge that the website was at any time used directly to promote the BUBBLES goods and services to would be customers in the UK. Ms Dermendzhieva recounts having been told about, and having explored the multimedia games, music and other interactive activities on the website of 1 to Z. Accepting that the evidence does not show the number of hits on the BUBBLES website, this is nonetheless clear and independent evidence that it was accessed from the UK by a potential customer within the relevant periods. I would add that if one was to "...step back and consider the evidence as a whole to see what facts it had established" it would seem somewhat unlikely that a website owned and maintained by a UK business, developed in the UK using UK based web developers, would not be available to consumers within the UK.

32. Extracts taken from the site (Exhibits A1 to A5) show the word BUBBLES on the top of the page, the lettering having an appearance that is similar to the surface of a bubble. This stylisation does not alter the recognition of the word or, in my view, the distinctive character from the word as registered. In any event, the word BUBBLES in a plain font is also used in a site index in the top left-hand corner of each first sheet, and within the body of the extracts. For example, the Activities section makes the offer to "Try Bubbles before buying it" and "Get the feel of what there is in Bubbles". The Purchase section offers the "Bubbles Professional Edition.", a "Multimedia educational package for sale online at a cost shown in £, \$USD and €Euro, available as a CD-ROM or a multi-user licence. The Education section has a number of sub-headings; "Bubbles. Linguistics. Language. Acquisition, and multimedia", "How Bubbles can help" and "Activities with Bubbles". A section headed "Multimedia and language acquisition" contains an account "How Bubbles can help, by Dr Aubrey Nunes, RMRC SLT, FRSA, PHD". The Activities Plans section of the website,

headed “Activities with Bubbles” explains what BUBBLES is and its methodology.

33. The applicants correctly mention that the prints were taken on 11 November 2008 but make no mention of the copyright statements from 2000 and 2001, possibly because these dates all fall outside of the relevant periods. That may well be so, but they are indicative of a website that has been in existence in the intervening period. Dr Nunes says that the site has been substantially redeveloped which makes it uncertain as to whether the use of BUBBLES shown on the prints is representative of the use at outset. However, Quang Huy Dinh states that the redevelopment work was done in the six weeks from July 2003, placing this use within the relevant periods. The applicants submit that in the event of the prints being deemed to show genuine use, they only show use in relation to “online educational software for use in speech therapy” and “educational CD-Roms for use in speech therapy”.

34. Dr Nunes mentions having made demonstrations of BUBBLES to Professor Carole FitzGibbon, to the Chief Buyer of Mothercare, the Head of Foreign Languages at Pimlico School, DfES Officers, the Managing Director of Pinnacle Software and Librarians from the Children’s Library Service in Lambeth. He says that copies of the BUBBLES CD-Rom were issued at some of these. Whilst Dr Nunes does not give the date that these took place, he does say that marketing in the form of demonstrations mostly took place in 2002 and 2003. If at the latter end they would fall within the relevant periods but given Dr Nunes’s use of “mostly” there is nothing that enables me to place them at any particular point in time.

35. There is the meeting between De Barra Publishing and Dr Nunes. That the meeting took place is confirmed by the letter at AN8 from Chris Barry (De Barra) to Dr Nunes. This refers to “Sales of Bubbles Software in Northern and Southern Ireland” and to a meeting that took place in February 2008. The letter also mentions the need for the product to be “enhanced from a visual perspective”, corroborating Dr Nunes’ given reason for limited sales, and to there being continuing discussions about “bringing this product to the market.” I take this as clear evidence of use with a view to creating or preserving an outlet for goods or services already marketed, or at the very least, about to be marketed to secure customers. That said, it only falls within the relevant period in respect of the allegation under Section 46(1)(b). It may well be only in respect of Northern Ireland (and export out of the UK to Southern Ireland) but is still, nonetheless, a significant market.

36. Further evidence of use is provided by Mrs Kamova, who confirms that in November 2005 she conducted demonstrations of the BUBBLES software and connected services to, amongst others, Maria Dermendzhieva and other mothers of children attending the Bulgarian School in London. Ms Dermendzhieva has provided a Witness Statement confirming her meeting with Rene Kamova at which Ms Kamova demonstrated the BUBBLES software to herself and other parents of children attending the school, and to having been given a CD-Rom containing BUBBLES software on 30 day approval. The applicants accept that this is not simply promotional use but question whether it is evidence of a sale. In my view being given something on approval is simply a sale with a deferred payment option.

37. Ms Kamova says that she also had a meeting with Frances Thompson, the Grants Officer of the Cripplegate Foundation in January 2007. The letter (RK1) from Ms

Thompson confirms her meeting with Ms Kamova, and that Ms Kamova gave her a copy of BUBBLES software on a CD-Rom.

38. Ms Kamova mentions other meetings that she says she had with the Ethnic Minority Coordinator for Hackney Free and Parochial Secondary School in December 2006, and Kathy Haywood, a NatWest Business Manager in 2004. Unlike the previous examples there is no corroborating evidence, but neither is there any reason to doubt that these meetings took place as stated.

39. Dr Nunes says that copies of the leaflet at AN7 are distributed at demonstrations and other events such as academic talks. The leaflet is headed with the word BUBBLES with the letters TM in superscript. The leaflet describes the product as "The interactive multimedia package for child development." The 1 to Z contact details are on the bottom of the cover. The leaflet contains many mentions of the word BUBBLES describing it as a "multimedia CD-Rom..." at a cost of £50.

40. In their written submissions the applicants refer to the small number of sales claimed, in particular by Dr Nunes, but do not challenge that these sales occurred. They point to the absence of invoices or records of sales, asserting that the case law requires such evidence of genuine use is to be established. In support of this contention they refer to the *Carte Bleu* trade mark case (BL 0-586-01, in particular the statement that "...the sort of evidence that one would normally hope to see is copies of brochures, catalogues pamphlets, advertisements, etc, all of which show use of the trade mark in question, together with some indication of the sales of goods, or the provision of services during the relevant period." That would, undoubtedly be the most convincing type of evidence, but as held by Mr Richard Arnold QC sitting as the Appointed Person in *Pan World Brands Ltd v Tripp Ltd*, the *Extreme* trade mark case, [2008] R.P.C 2:

(4) The standard of proof was the ordinary civil standard of proof upon the balance of probabilities. When applying this standard, the less probable the event alleged, the more cogent the evidence had to be to demonstrate that it did indeed occur. ([30])

*H (Minors)(Re)* [1996] A.C. 563, HL applied. *NODOZ Trade Mark* [1962] R.P.C. 1, Ch.D. considered.

(5) Whilst a bare assertion of use would not suffice as evidence of use, a statement by a witness with knowledge of the facts setting out in narrative form when, where, in what manner and in relation to what goods or services the trade mark had been used would not constitute bare assertion. It might be impossible for a witness to produce documentary evidence and there was nothing in the Trade Marks Directive, the Act or the Rules which required the proprietor to adduce evidence from an external witness, although it might be advisable to do so. ([31])

41. Mr Arnold QC held that in the absence of positive evidence of non-use it was not correct to impose a standard of proof requiring the appellant to provide "certainty" and "conclusive evidence". It must also be borne in mind that the evidence does not just originate from Dr Nunes. Corroboration is provided from several sources.

42. Dr Nunes acknowledges the limited extent of the sales which he largely attributes to the market not being ready for the then new concept of books in electronic form. Additionally (and as previously mentioned) the letter at AN8 highlights the need for the BUBBLES product to be “enhanced from a visual perspective”. The applicants refer to this in the context of not being “proper reasons for non-use”, but having found there to be use I do not need to consider that escape route. I would, however say that it must be borne in mind that the BUBBLES product is not something that could be termed “mass market”.

43. Consequently, the evidence is thin, but as I have highlighted above, use does not have to be quantitatively significant for it to be deemed genuine. It is use on the market that created an outlet for the BUBBLES goods or services, or at the very least was paving the way to secure sales. The manner of use seems likely to have established a link between the proprietor, its mark and the goods and services sold under it. In my view the proprietor’s use of BUBBLES satisfies the requirements for it to be considered genuine within the meaning of the law.

44. Having determined that there is acceptable use, the question is use in respect of what? It is quite clear that the use goes nowhere near to the full extent of the specifications for which BUBBLES has been registered, and that the provisions of Section 46(5) come into play. In *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“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?

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?

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.”

45. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“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 picky 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.”

46. The Court of First Instance in *Reckitt Benckiser (España), SL v OHIM*, Case T-126/03 held that:

“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.”

47. Throughout his evidence Dr Nunes describes the goods and services for which the BUBBLES mark has been used in terms such as “computer software” in the form of CD-ROMs intended for entertainment of children and language and speech education and therapy. The extracts from the website refer to the goods in terms such as multimedia educational package for sale online available as a CD-ROM or a multi-user licence. A review of the BUBBLES software on the About.com website under the heading “...English Learning Software for Young Learners” refers to BUBBLES as “...fascinating software which puts the emphasis on teacher-learner participation. In contrast to other software programs, Bubbles is conceived as an aid to developing spoken communication skills between participants using software.” The leaflet at AN7 describes the BUBBLES product as a “multimedia CD-Rom...” ....and “The interactive multimedia package for child development”. Quang Huy Dinh describes his involvement in developing a website to promote speech and language educational services, children’s entertainment services and speech therapy services, together with online games and software packages designed to deliver these services. The BUBBLES product was described to Ms Dermendzhieva as being educational software that could assist in learning English through the use of multimedia games, music and other interactive activities.

48. In specific terms the goods for which the trade mark has been used can be described as computer software for the education of children in language and speech through the use of multimedia games, music and interactive activities. Clearly the term “computer software” at large goes far wider than this use justifies. Qualifying the software as “educational” brings it much closer to the actual use and is a recognisable subset of software products, and would encompass education through use of games, interactive multimedia, or whatever. This must be considered in conjunction with the limitation attached to the specification in Class 9 which restricts such software to being “...for use in, or relating to speech therapy.” Accordingly, I arrive at a specification for Class 9 of:

“Educational computer software for use in, or relating to speech therapy.”

49. I accept that this has been provided in the form of CD-ROMs and/or available online, but in my view this is an unnecessary limitation.

50. The proprietors have used the BUBBLES mark via their website, according to Quang Huy Dinh, to promote speech and language educational services, children’s

entertainment services and speech therapy services and online games. The evidence does not show use to this extent, but in any event the specification in Class 41 (in which this service would fall) has a similar limitation attached to the specification restricting the services to being related to speech therapy. On this basis I consider the following specification would, in my view, accurately and adequately reflect the use made of the BUBBLES in respect of services in Class 41:

“Speech therapy services; organisation of meetings, seminars, lectures and forums; education and entertainment services in the form of electronic, computer and video games provided by means of the Internet and other remote communications device; Internet games (non downloadable); organising of games; provision of interactive entertainment software services; all relating to speech therapy and speech and language matters; educational services relating to speech therapy and speech and language matters; teaching services relating to speech therapy and speech and language matters.”

51. Class 41 covers speech and language therapy services that are for educational purposes. Where the therapy is a remedy, for example, to a medical or psychological disorder, this places the service in Class 44. This would be the case even if the service is provided online. In respect of Class 44 I consider the following to be an appropriate reflection of the use made:

Speech therapy services; remedial tuition in speech; training services relating to speech; therapy services in relation to speech and language matters.

52. The other services within the specification in Class 44, namely, “physical therapy services; mental therapy services; behavioural therapy services; services for the cognitive therapy of people; therapy services in relation to behavioural matters; therapy services in relation to the health and wellbeing of people.” Are, in my view, distinct and different subsets of services from those for which the BUBBLES mark has been used.

53. I therefore direct that the registration number 2295213 be revoked in respect of all goods and all services other than:

**Class 9** Educational computer software for use in, or relating to speech therapy.

**Class 41** Speech therapy services; organisation of meetings, seminars, lectures and forums; education and entertainment services in the form of electronic, computer and video games provided by means of the Internet and other remote communications device; Internet games (non downloadable); organising of games; provision of interactive entertainment software services; all relating to speech therapy and speech and language matters; educational services relating to speech therapy and speech and language matters; teaching services relating to speech therapy and speech and language matters.



**Class 44**      Speech therapy services; remedial tuition in speech; training services relating to speech; therapy services in relation to speech and language matters.

As there has not been any use in respect of any other goods or services within the five years following registration, the revocation will take effect from the earliest date requested, that is, 23 November 2007.

The application for revocation has therefore been successful in part. The applicants sought revocation of the registration in its entirety. The registered proprietors in turn sought to defend the whole registration. On this basis I consider it appropriate not to make an award of costs

Dated this 4<sup>th</sup> day of September 2009

**Mike Foley**  
**for the Registrar**  
**the Comptroller-General**