

O-396-12

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 1477530
IN THE NAME OF VIGLEN LIMITED IN RESPECT OF THE MARK:**

ENVY

AND

**AN APPLICATION FOR REVOCATION (No. 84046)
BY HEWLETT PACKARD COMPANY**

The background and the pleadings

1) Viglen Limited (“Viglen”) is the proprietor of trade mark registration 1477530 consisting of the word: **ENVY**. The trade mark was filed on 24 September 1991 and it completed its registration procedure on 13 December 1996. The mark is registered for the following class 9 goods:

Electric and electronic apparatus; computer installations and apparatus; apparatus and instruments for use with computers; parts and fittings for all the aforesaid goods; all included in Class 9; but not including computer software.

2) Hewlett Packard Company (“Hewlett”) seeks revocation of the registration on grounds of non-use based on sections 46(1)(a) and (b) of the Trade Marks Act 1994 (“the Act”). Viglen filed a counterstatement denying the claim in respect of the goods set out above. No reference is made to there being proper reasons for non-use; the defence rests on there being genuine use of the mark. It should be noted that the above goods represent a limitation of the goods as originally registered. The above specification resulted from Viglen making a partial surrender of the registration.

3) Both sides filed evidence. The matter was then heard before me on 7 September 2012 at which Mr Guy Tritton, of counsel, instructed by Taylor Wessing LLP, represented Hewlett; Mr Mark Engelman, also of counsel, instructed by Trade Mark Consultants Co, represented Viglen.

4) The relevant time periods relating to Hewlett’s claims are:

- i) Under section 46(1)(a): 14 December 1996 to 13 December 2001.
- ii) Under section 46(1)(b): 21 December 2001 to 20 December 2006.
- iii) Under section 46(1)(b): 14 April 2006 to 13 April 2011.

Revocation is sought with effect from the earliest possible date, namely, 14 December 2001.

Legislation and case-law

5) The relevant parts of section 46 of the Act read:

“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) 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.”

6) Section 100 is also relevant, which 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.”

7) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position¹ was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward

¹ Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28.

for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods 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: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

Viglen’s evidence

8) This is given by Mr George Myrants, a trade mark attorney at Trade Mark Consultants Co, the firm representing Viglen in this matter. Mr Myrants explains that his evidence is based on information and documentation provided by the proprietor as well as records and printed matter accumulated by Trade Mark Consultants Co during the many years that it has been acting for Viglen.

9) Mr Myrants refers to the specification as set out in paragraph 1 above which resulted from an amendment made by Viglen on 24 June 2011. He states that the mark ENVY is:

“used principally in respect of monitors which are electric and electronic apparatus forming part of, or for use with, computers and they can, and do, form part of computer installations provided by the Proprietor.”

10) Mr Myrants states that the mark was first used around August 1991, the application for registration then being made in September that year. He states that use has taken place extensively in all parts of the UK by way of corporate literature sent regularly to customers, and to potential customers requesting information, by way of sales, and by way of company web pages. Reference is then made to a number of exhibits as follows:

- GM1 – Viglen Magazine from May/June 1997. The magazine is “complimentary to Viglen customers”. There are references to a product called the Viglen Envy 15T. It is a computer monitor which, with a flick of a switch, can also display television signals. In the accompanying text the product is abbreviated as the ENVY 15T. It was available for the price of £279 with an additional £39 for the TV tuner. Various computer systems are also depicted in this magazine. The systems are part of Viglen’s “Contender” range. In terms of the system contents, the monitors are various ENVY monitors (Envy 14si, Envy 15ds, Envy 17e etc). The monitor may be upgraded to higher model Envy monitors or, indeed, other third party monitors (e.g. a Hitachi monitor).
- GM2 – a Viglen price list from February 1998. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable. The Envy monitors may also be supplied on their own.
- GM3 – a Viglen Price list from October 1998. The front page features information about new products including the new Viglen Envy Colour TFT LCD monitors. The accompanying information refers to the “Envy range”. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable. The Envy monitors may also be supplied on their own.
- GM4 - a Viglen Price list from January 1999. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable. The Envy monitors may also be supplied on their own.
- GM5 - a Viglen Price list from August 1999. The front page features information about new products including a new Viglen Envy 15HS monitor. It is referred to as the Envy 15HS in the accompanying information. This features information about Envy monitors supplied on their own. This exhibit contains a further price list from December 1999. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable.
- GM6 - This exhibit contains a further price list from December 1999. This features mainly servers – a reference is made to an Envy monitor which can be supplied with certain systems.
- GM7 - a Viglen Price list from February 2000. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable.

- GM8 - a Viglen Price list from November 2000. This features, again, various computer systems, the monitors of which are various Envy models as above. They are, again, upgradable.
- GM9 – this exhibit includes:
 - a Viglen Price list from February 2001. It lists monitor options as part of a Viglen System. Amongst others, various Envy monitors are listed with accompanying prices.
 - A similar price list from July 2001 which also details systems (with system prices) which include Envy monitors.
 - A Viglen price list from June 2002 similar to the one from February 2001.
 - A Viglen Schools Price list from Autumn term 2002. It includes computers systems for sale. The monitors are not identified other than by size. They can, however, be updated to certain Envy (or other) models.
 - A Viglen price list from December 2002. This features Envy monitors as part of an options list and complete systems which feature Envy monitors.
 - Another price list from August 2003. This features Envy monitors as part of an options list.
 - Another price list from April 2004. This features Envy monitors as part of an options list.
 - Another price list from September 2004. This features Envy monitors as part of an options list.
 - Another price list from March 2005. This features Envy monitors as part of an options list.
- GM10 – another price list from April 2007. This features Envy monitors as part of an options list. Further price lists are from:
 - October 2009 - This features Envy monitors (Viglen Envy) as part of an options list.
 - November 2009 - This features Envy monitors (Viglen Envy) as part of an options list.
 - March 2010 - This lists a Viglen Envy as part of a monitor upgrade. Monitor options are also listed but this information cannot be read.
 - November 2010 - This lists a Viglen Envy as part of a monitor upgrade.
 - January 2011 - This lists a Viglen Envy as part of a monitor upgrade.

11) Mr Myrants states that due to the large amount of company literature, the above documents are just a selected few of those produced. Mr Myrants exhibits under GM11 undated pages from catalogues relating to a public sector contract

which Viglen won in March 2000 and which is worth around £9 million per annum and another contract won in September 2009 worth around £3 million per annum. It is stated that supplies under these contracts include ENVY monitors. The catalogues refer to Viglen Envy monitors.

12) In terms of financial records, Mr Myrants states that Viglen destroys most records after a period of 6 years. Some older invoices have though been found. These, together with examples of more recent invoices are provided in Exhibits GM12 (from 15 August 1997 to 4 November 2002) and GM13 (from 18 December 2002 to 13 January 2011). Every invoice lists an Envy monitor.

13) Mr Myrants considers his evidence to demonstrate that use has taken place continuously and to a substantial extent. He consider the revocation (which he says was unannounced) to have been unnecessary. He says that some of this use was brought to Hewlett's attention before the start of the proceedings. He considers that Viglen is entitled to more than scale costs due to this.

Hewlett's evidence

14) This is given by Ms Rebecca Olds-Bartlett, a trade mark assistant at Taylor Wessing LLP, the firm with conduct of these proceedings on behalf of Hewlett. Her evidence provides screen prints from various online retailers showing the categorisation of computer monitors:

- PC World has a main heading of "Desktop PC & Monitors" with a sub-heading of "Monitors and Projectors" and a further sub-heading of "PC Monitors";
- Dixons has a main heading of "Computers, tablets and eReaders", a sub-heading of "Monitors and Projectors" and a further sub-heading of "PC Monitors";
- Amazon.co.uk has a main heading of "Computers and Accessories" with a sub-heading of "Monitors";
- Argos has a main heading of "Laptops & PCs", a sub-heading of "Computers & Monitors" and a further sub-heading of "PC Monitors".

15) Ms Olds-Bartlett provides definitions of the words "installation", "equipment" and "instruments"; I do not consider it necessary to detail the definitions here.

The matters left in dispute

16) By the time of the hearing, Hewlett no longer disputed that genuine use of the mark had been made in relation to certain goods. However, Mr Tritton, on Hewlett's behalf, submitted that genuine use had only been made in relation to

computer monitors, and that such a term reflected a fair and appropriate specification. On the other hand, Viglen argued that genuine use had been made not just in respect of products with computer monitor functionality, but also products with other functionality and purposes. In his skeleton argument (and stressed in submission before me) Mr Engelman stated at paragraph 5:

“5. This evidence of use comprises reference to the marks ENVY with various suffixes which I set out in Annex A. It is important to note that:

5.1 ENVY model 15T is described as a monitor which turns into a TV;

5.2 ENVY models 14 Si, 17Si, 15DS, 17SE, 17CS, 15HS, 17TS, 17CM all possess speakers;

5.3 ENVY model A14 is sold as a component part of a server.”

Mr Engelman considered that a fair specification should be wider than just computer monitors (or monitors per se) because of this additional functionality.

17) I should record at this stage that in respect of this claimed additional functionality, the functions described in 5.2 and 5.3 have been used on a number of occasions over the years, but the functionality in 5.1 has been used only once, in 1997, a date that relates only to the period claimed under section 46(1)(a) of the Act.

A fair specification

18) In terms of deciding upon a fair description, the description must not be over pedantic². It is necessary to consider how the relevant public would likely describe the goods³. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 (“Aladin”)* held:

“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

² See *Animal Trade Mark* [2004] FSR 19.

³ See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32

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 subcategories 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."

19) I also note the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“However, that does not appear to me to alter the basic nature of the required approach. As to that, I adhere to the view that I have expressed Page 23 of 68 in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

20) During his submissions, Mr Engelman referred me to a number of other decisions⁴ which I have borne in mind. Overall, his view was that a restriction to just “computer monitors” would be perverse as such an expression did not take into account the other functionality and purpose that the goods sold under the mark have been put to and that such a term was in fact narrower than the use actually shown (which he said should be the starting point). He argued that what Hewlett had put forward would be to adopt what *Aladin* warned against – stripping the registration of protection for goods not in essence different from a single group which cannot be sub-divided other than in an arbitrary manner. Having come to the view that the starting point was wider than just “computer monitors”, he argued that a fair specification must be a further category higher than computer monitors; for example, apparatus and instruments for use with computers.

21) Mr Tritton argued that “computer monitors” was a fair specification. He argued that regardless of any other functionality, the goods sold were all still computer monitors. The term put forward was not, therefore, arbitrary but a clear category of goods. He argued that broad terms should be sub-categorised until the description becomes arbitrary – in this case, he felt arbitrary descriptions would be, for example, 17 inch LCD monitors. The term “computer monitors” is thus far from arbitrary. Mr Tritton also highlighted Viglen’s own evidence whereby the goods are sold under the heading of monitors regardless of any additional functionality.

22) I will begin by considering the position in relation to the claimed periods of non-use under section 46(1)(b) of the Act. The reason for this distinction is that the use in respect of the television functionality does not apply. If genuine use was made on such goods in 1997, I do not consider, on the basis of this single use in a single brochure, that such use will have created or maintained a share in the market for such goods in the latter periods under section 46(1)(b). Therefore,

⁴ *Wisi Trade Mark* [2006] RPC 22, *Continental Shelf 128 Ltd’s Trade Mark & Pan World Brands Ltd v Tripp Ltd* [2008] RPC 2, *Daimler AG V Sany Group Co Ltd* [2009] ETMR 58

the factual starting point is that use has been made in respect of computer monitors, including computer monitors with speakers and computer monitors for use as part of servers.

23) From this starting point, I consider the answer to be reasonably straightforward. Whether the computer monitors in question have speakers or not, and whether they are sold as part of a server (a type of computer) or not, they are all still computer monitors. I do not consider that they would be described as anything else. Furthermore, I do not agree with Mr Engelman that “computer monitors” is narrower than the use that has been made. The term computer monitors will cover all types of computer monitor, including those which incorporate speakers and including those for use with servers. Computer monitors strikes me as a fair, reasonable, and accurate description reflecting the use shown. The specification as it currently stands is:

“Electric and electronic apparatus; computer installations and apparatus; apparatus and instruments for use with computers; parts and fittings for all the aforesaid goods; all included in Class 9; but not including computer software”.

24) The broad terms listed in the specification which Mr Engelman considered to reasonably exemplify the goods shown are, in my view, too broad by far having regard to the use shown. The broad terms would cover goods which are, in essence, different from computer monitors. Dividing such terms to computer monitors is not arbitrary, it is considered to be fair and reasonable. There is nothing to blue-line in the above specification, it needs to be recast. In doing so I consider it appropriate to retain parts and fittings for computer monitors and, also, to retain the exclusion in case the parts and fittings could be construed as covering computer software. I consider a fair specification to be:

“Computer monitors; parts and fittings for computer monitors; but not including computer software.”

That is my decision under section 46(1)(b).

25) I must also determine the matter under section 46(1)(a) because this may provide Hewlett with an earlier date of revocation. To this extent, the computer monitor with television functionality needs to be borne in mind. However, my view of the matter is no different. Even though the monitor has this additional functionality, it is still a computer monitor and, indeed, it is described as a monitor (albeit with this additional function). Therefore, my finding of a fair specification would be exactly the same.

Conclusion

26) The application for revocation is partially successful. Mr Tritton confirmed at the hearing that revocation was still sought from the earliest possible date – there are grounds to allow this. Viglen’s registration is hereby revoked with effect from 14 December 2001, except in relation to:

“Computer monitors; parts and fittings for computer monitors; but not including computer software.”

Costs

27) As both parties have achieved a measure of success, I do not propose to favour either with an award of costs. That Viglen’s use was brought to Hewlett’s attention early on is not a reason to depart from this approach. As can be seen, there was a dispute between the parties that required resolution which has required my substantive decision to resolve matters.

Dated this 12th day of October 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**