

O-053-14

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

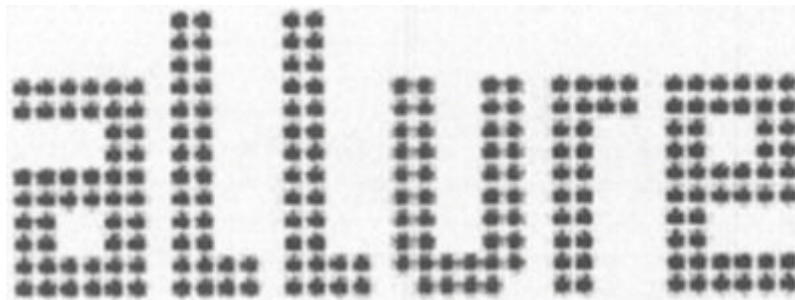
**APPLICATION 84376 BY EDIZIONI ESAV SRL  
FOR THE REVOCATION OF TRADE MARK REGISTRATION 1414193**

**ALLURE**

**IN THE NAME OF ADVANCE MAGAZINE PUBLISHERS, INC**

**AND**

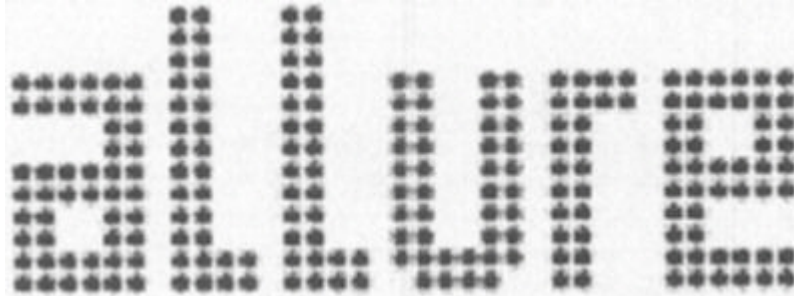
**THE REQUEST FOR PROTECTION OF INTERNATIONAL REGISTRATION  
1108825 IN THE NAME OF EDIZIONI ESAV SRL FOR THE MARK**



**AND THE OPPOSITION THERETO UNDER NUMBER 72431  
BY ADVANCE MAGAZINE PUBLISHERS, INC**

## Background

1. On 18 November 2011, Eidzioni Esav Srl (“Edizioni”) requested protection in the UK of its international registration (“the IR”) 1108825 for the mark and goods shown below:



*Class 9: Software; application software; electronic publications; downloadable electronic publications; downloadable digital publications for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices.*

*Class 16: Printed matter, newspapers, magazines, periodicals, books and photographs, particularly in relation to perfumery, cosmetics and beauty care.*

2. The request for protection of the IR was published in the Trade Marks Journal on 8 June 2012, following which Advance Magazine Publishers, Inc (“Advance”) opposed the request for protection on the basis of sections 3(6), 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994. The section 5(4)(a) ground is based on use of the sign ALLURE in the UK since 1991 on books and magazines. The section 5(1), 5(2) and 5(3) grounds are based on its earlier trade mark ALLURE, registered under number 1414193 for:

*Periodical publications, printed matter, stationery; all included in Class 16.*

3. Advance only relies upon “magazines; books” covered by its registration. Advance made a statement in its notice of opposition that it has used its mark on magazines and books. Advance’s mark completed its registration procedure on 24 July 1992, well over five years before Edizioni’s IR was published in the Trade Marks Journal. Consequently, Advance’s mark is subject to proof of its use under section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004). Edizioni requests such proof in its counterstatement, as well as denying the grounds of opposition. The period during which Advance is required to show genuine use of its mark for the purposes of the opposition is 9 June 2007 to 8 June 2012.

4. Prior to Advance opposing the IR, Edizioni had filed an application for the revocation of Advance’s mark, on 28 March 2012. Edizioni claims that the trade mark was not put to genuine use for any of the registered goods under sections 46(1)(a) and 46(1)(b) of the Act. Edizioni’s application form (TM26(N)) sets out four periods during which it claims that there was no genuine use of the trade mark:

(i) 25 July 1992 to 24 July 1997 (the 46(1)(a) period) (effective date of revocation 25 July 1997);

(ii) 25 July 1997 to 24 July 2002 (under 46(1)(b)) (effective date 25 July 2002);

(iii) 25 July 2001 to 24 July 2006 (under section 46(1)(b) (effective date 25 July 2006); and

(iv) the five years preceding the date of the application; i.e. 29 March 2007 to 28 March 2012, under section 46(1)(b) (effective date 28 March 2012).

5. The 'gap' between these periods and the proof of use period for the opposition is a matter of a few weeks, from 29 March 2012 to 8 June 2012. Advance denies the allegation of non-use in respect of "periodical publications namely magazines; printed matter, namely books; all included in class 16".

6. The proceedings were consolidated and I heard oral arguments at a hearing held on 28 November 2013, by video conference. Edizioni was represented by Mr Michael Edenborough QC, instructed by Harrison Goddard Foote LLP. Advance was represented by Mr Ian Bartlett of Beck Greener.

### **Preliminary points**

7. At the start of the hearing, there were two preliminary points. The first of these was Advance's request to file further evidence. The catalyst for the request was Mr Edenborough's submission in his skeleton argument that the use shown by Advance on magazines was a 'sham'. Mr Bartlett objected that this was an allegation not pleaded and not raised in Edizioni's evidence. He submitted that either Edizioni was not entitled to pursue the allegation, or Advance should be entitled to adduce a witness statement refuting the allegation. A short witness statement was sent to the Tribunal before the hearing. It was made by John Bellando, Advance's Vice President. Its essence is a denial of any allegation of sham use (i.e. use solely for the purpose of maintaining the registration).

8. It is for the Tribunal to decide whether the use made of a trade mark is genuine; whether that use is 'token' or 'sham' is for me to decide, along with other aspects of the assessment, such as whether there has been consent to use the mark; whether the use is of the mark as registered or a variant; the scale and frequency of the use, and how much or little of the specification may be retained. It is a subset of the wider genuine use question; as set out by the Court of Justice of the European Union ("CJEU"), in case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, the Tribunal must have regard to all the facts and circumstances of a case, including whether use is token or is sufficient to maintain or create a share in the market. I refused to admit the evidence because it did not take matters any further forward.

9. The second preliminary point related to the dates of non-use pleaded by Edizioni, set out in paragraph 4 of this decision. Again, the issue was foreshadowed by Mr Edenborough in his skeleton argument:

“(In passing, there is a typographical slip in the TM26(N), as the third period for alleged non-use ought to read 25 July 2002 to 24 July 2007 – and not 2001 to 2006 as currently indicated – and a corresponding mistake in the third allegedly effective date of revocation, which ought to read 25<sup>th</sup> July 2007, not 2006. There is another slip on the IPO’s letter of the 17<sup>th</sup> April 2012, where a 15 year period is recited erroneously. These are all obvious slips that would be automatically corrected by the reader.)”

10. It is not apparent to me that this is an obvious slip; there is nothing defective about the periods pleaded and it would be an inference too far to have assumed that the five year periods are meant to follow one another, rather than overlap. Having said that, Advance did file evidence for the entire period of alleged non-use, as originally and latterly pleaded, and Mr Bartlett said that he was content to have the amendments accepted. Added to that, nothing in this decision turns upon the amended dates. I will therefore proceed on the basis that the third period of non-use pleaded is 25 July 2002 to 24 July 2007, the effective date of revocation being 25 July 2007.

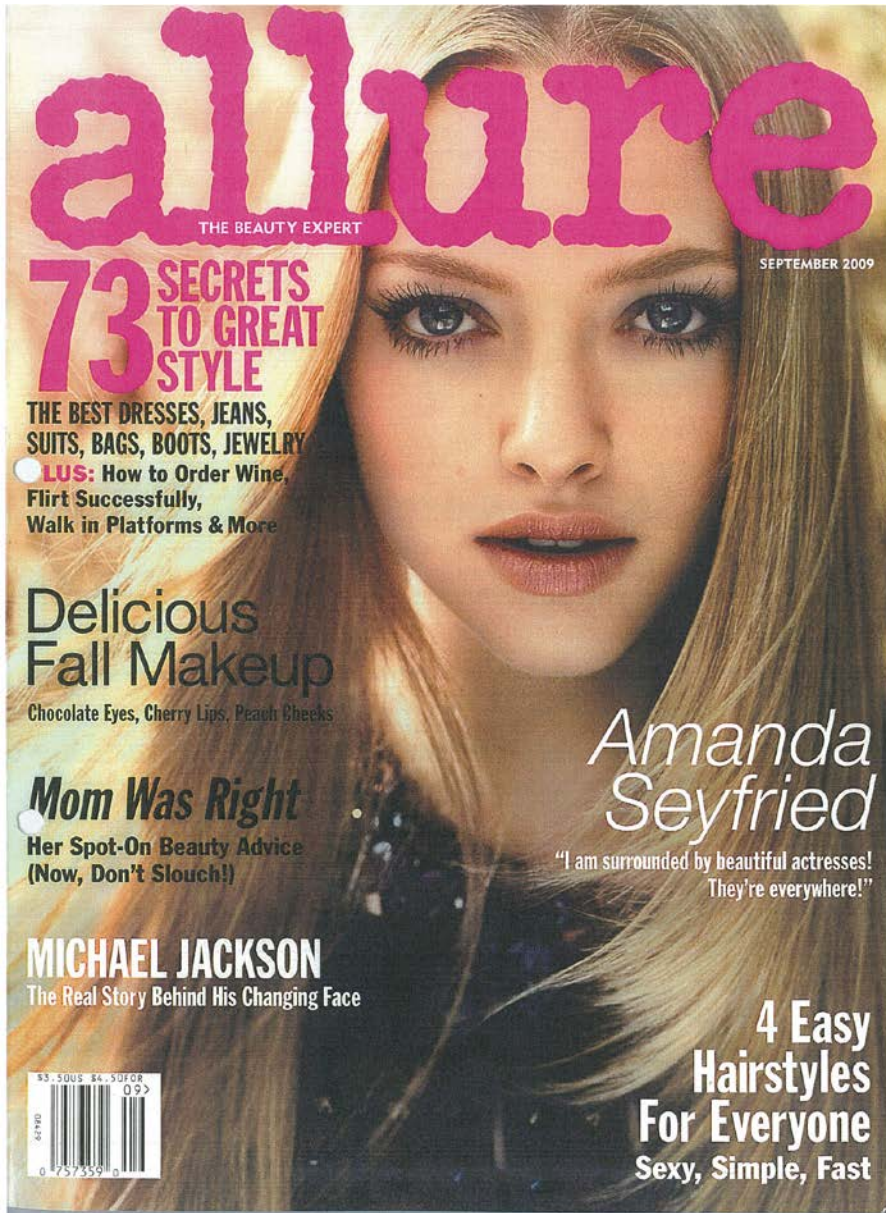
### **Evidence**

11. Advance has filed two witness statements from Pamela Raynor. Ms Raynor is Company Secretary and Finance Director of Conde Nast Publications Ltd (“Conde Nast UK”), which is owned and controlled by Advance. Ms Raynor handles legal issues on behalf of Conde Nast UK, including trade mark issues. Edizioni has filed two witness statements from Roberto Pissimiglia, who is Edizioni’s President of the Board of Directors.

12. Ms Raynor states that all the facts in her statement are within her own knowledge, or are obtained from Advance’s documents and information. She refers to the relevant period as being 28 March 2007 and 27 March 2012 (this is the fourth period of non-use pleaded and is the five year period, albeit for a day either side, immediately preceding the application for revocation). Ms Raynor gives the following information.

13. ALLURE magazine was first published in 1991 and has been continuously published, monthly, since that date. It focuses on beauty, health and fitness, but also features articles on food, travel and lifestyle. It is aimed at a female readership.

14. Exhibit PR1 is said to be a representative copy of an edition of ALLURE, dated September 2011, which was published, marketed and sold in the UK. Exhibit PR2 contains front covers of ALLURE dated September 2007, September 2008, September 2009 and September 2010. Ms Raynor states that these were published, marketed and sold in the US as well as in many other countries, including the UK. The prices on the magazine covers in exhibits PR1 and PR2 are in US dollars. An example appears below:



15. ALLURE magazine is distributed in the UK on behalf of Advance by Comag, a magazine distribution company established in 1977 by Conde Nast and The National Magazine Company to distribute their titles in the UK. Exhibit PR3 is a print from Comag's website (undated) which explains what Comag does. I note that the text refers to the distribution of a diverse range of magazines, including "many imported magazines", to retailers such as newsagents, convenience stores, supermarkets and petrol forecourts. Exhibit PR4 is a print from the 'Magazine Café' website, which is operated by Comag. Ms Raynor states:

"...there is a link from Comag's web site to Magazine Café for UK customers wishing to find or subscribe to our magazines, including ALLURE. These prints were taken recently, that is after the Relevant Period, but I confirm that that [sic] ALLURE has been promoted and offered to UK customers via the Comag/Magazine Café web sites for many years and in particular during the Relevant Period".

The print is shown below:

16. Ms Raynor states that ALLURE is US based, but is widely marketed and sold in the UK, including during the relevant period. Exhibit PR5 is a report compiled by Comag in relation to the distribution and sales of ALLURE in the UK from 2006 to 2012. In 2006, the cover price was £3.95, rising to £4.40 from 2010. In 2006, 9711 copies were sold in the UK, which represents 31.4% of the total amount ordered, the remaining unsold copies being returned to the distributor. In 2007, 7597 were sold (39.7%); in 2008, 6634 (43.7%); in 2009, 5927 (46.3%); in 2010, 5382 (42.1%); in 2011, 4936 (42.9%); and, until July 2012, 4934 (84.7%).

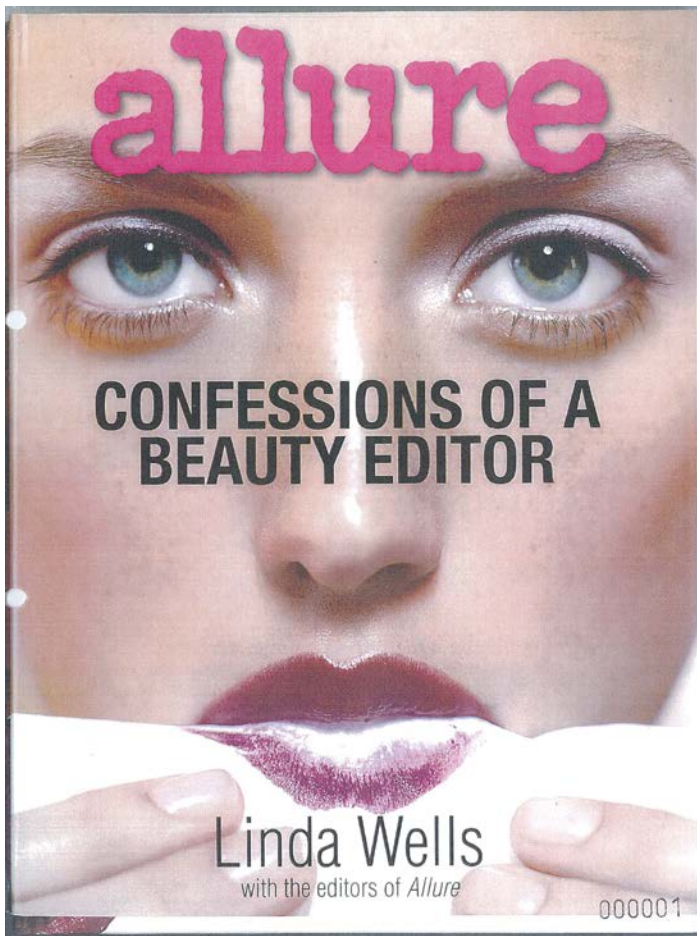
17. Ms Raynor states that ALLURE is sold, via Comag, to well known chains, such as WH Smith & Sons. It is also sold to independent retailers. Exhibit PR6 is a print from Comag's records, showing where UK sales of the July issue of ALLURE for the years 2007 to 2011 were made. For example, copies were ordered by a Londis in Birmingham, a WH Smith store in Crawley, a Londis in Slough, another in Stockport, Easons in Belfast and an independent store in Swansea. I note the same stores were making orders in more than one year. A feature of the report is that it shows how many copies were ordered, how many sold and how many returned. The Birmingham Londis store ordered one copy in July 2007 and returned it; the WHS Smith in Crawley sold the July 2007 copy which it ordered; the Londis in Slough sold the two copies of the July 2007 issue which it ordered, as did the Londis in Stockport; Easons returned all 10 of the July 2007 copies which it ordered; and the independent store in Swansea returned the two copies it ordered in July 2007. In July 2011, an independent store ordered 5 copies, sold 4 copies and returned one copy; Fenwicks in Newcastle ordered 8 copies, sold 5 copies and returned 3 copies; WH Smiths in Peterborough ordered a single copy and returned it, unsold; and the WH Smiths in Glasgow sold all 10 of the copies which it ordered in July 2011.

18. During this period, Comag obtained its UK supplies of ALLURE from Advance's worldwide distributor, International Circulation Services, LLC and, prior to that, from

Interlink International, LLC. Invoices showing Comag's purchase of ALLURE from these entities are shown in exhibit PR7. Purchases of ALLURE, amongst other magazines, are shown on invoices in February, March, April, May, June and July 2007, when 1900 copies were purchased each month. In July and August 2007, 1500 copies were bought. From September to December 2007, 1300 were bought. Similarly consistent, albeit lower, figures appear on the monthly invoices throughout 2008, 2009 and 2010.

19. Ms Raynor explains that, in addition to sales to Comag, which sells the copies onwards in the UK, ALLURE is also sold directly from the US, to UK subscribers. Exhibit PR8, taken from Advance's records, shows that there have been approximately 200 UK subscribers to ALLURE between 2007 to 2011, each subscriber receiving twelve copies per year of the monthly magazine. It is Ms Raynor's belief that subscription currently costs £30. Exhibit PR9 comprises copies of examples of subscriber documentation taken from Advance's records relating to UK subscriptions from 2007 to 2011. Exhibit PR10 shows print outs from UK websites which retail magazines, offering subscriptions to ALLURE. The prints are dated 19 April 2012, although one of them features a review of ALLURE from a customer in Manchester, dated 19 November 2010.

20. In relation to books, Ms Raynor states that ALLURE "has also consented to the use of its ALLURE trade mark in relation to a book by Linda Wells":



Ms Raynor states that the ALLURE book was first published in 2006 but continues to be marketed and sold in the UK and is available from Amazon UK, as shown in exhibit PR12. Ms Raynor states that although the print in PR12 was taken after the relevant period, she is sure that Amazon has been selling the book in the UK for a number of years, including the relevant period. She explains that Advance has not been able to obtain detailed information concerning UK sales of the book, but states that exhibit PR13 shows prints taken from various UK websites promoting the book and offering it for sale. Again, the prints were taken after the relevant period, but Ms Raynor states that she has no doubt that these websites were promoting and offering the book in the UK during the relevant period. Exhibit PR14 comprises web pages, in the form of blogs, which refer to the book; some of the comments about the book appear to be dated within the relevant period.

21. Ms Raynor ends her first witness statement by stating that Edizioni launched the revocation action without warning and that Edizioni was “perfectly well aware”, when it brought the action, of Advance’s UK use of ALLURE during the relevant period. She states that Edizioni brought the revocation proceedings for tactical reasons connected to a dispute with Advance in Italy.

22. Roberto Pissimiglia’s evidence, for Edizioni, contains background information regarding Mr Pissimiglia, Edizioni, its purchase of ALLURE magazine in Italy and disputes in other jurisdictions between Advance and Edizioni. Not all of this information will be summarised here, but has been noted. Mr Pissimiglia’s company is a publishing company in the hair and beauty sector, and he is also president of an international professional press trade association, representing 67 editors in the hair and beauty magazine sector. Mr Pissimiglia also gives his opinions about the scale of Advance’s sales; however, although noted, opinions are not facts which can be considered as evidence.

23. Mr Pissimiglia provides a description as to how the magazine publishing industry works. He states that magazines which have been very successful in the US have established and published “UK” editions. These are known as local editions; a common practice, according to Mr Pissimiglia, when publishers want to create a truly local business. He states:

“32. It is common practice for other publishers to follow a similar path in launching local versions of magazines if they want to create truly local businesses. Exporting small quantities of magazines established and published abroad can only act as a probe to test the water as to whether launching a local version is viable, but cannot otherwise give rise to any true and effective economic business.”

24. Exhibits RP7 and RP8 provide data from the website of the Professional Publishers Association in relation to the market size for women’s interest magazines. It is common knowledge that this is a large sector of the magazine market, with a large number of titles in circulation and high volume of sales of some of the various magazine titles (e.g. Cosmopolitan, Hello etc). Mr Pissimiglia states that ALLURE is very successful in the US. However, in respect of the UK, he states that no local edition has been developed nor has the US version been promoted as compared to other magazines (his own magazine, Estetica, has 12 international versions, and an



app for iPads and iPhones). Mr Pissimiglia contrasts the position with other of Advance's magazines, such as Vanity Fair, Vogue, GQ and Glamour, which do have local versions in other countries. He states that, in his experience, the contents of a UK or a US magazine are "reasonably different".

25. Mr Pissimiglia states that ALLURE has not developed a circulation in the UK nor has it developed any advertising revenues; although he points out that this is unsurprising, since the advertising in the US ALLURE magazines is addressed to the US market. Mr Pissimiglia states that the advertising revenues of his company account for just under 70% of total revenues, the remainder made up from magazines sales. He states, in relation to the volume of sales of ALLURE in the UK:

"...I doubt if the sales of the US ALLURE magazine makes economic sense. It is possible that this is not a profit making venture at all given the high costs of production, distribution and a high level of returned unsold magazines. For example, publishers will receive a proportion of the cover price of a magazine sold at the newsstand, on average, about 50/60% on the copies of the magazine actually sold. The sold copies of a magazine are generally significantly lower than the number of copies of such [sic] magazine introduced into the market for distribution. Therefore, given the minimal levels of sales of the US ALLURE magazine in the UK by Advance, the income from the magazine may well be negative".

26. Ms Raynor's second witness statement is in response to the criticisms and opinions given by Mr Pissimiglia. She accepts that the number of ALLURE copies sold in the UK has not been on the same scale as its UK specific titles, but she submits that the number is, nevertheless, significant and has been in the region of 4,000 to 9,500 copies per year since 2006. Sales are approximately £200,000. Ms Raynor states:

"7. There is a suggestion made by Mr. Pissimiglia in his statement that we do not make a profit out of our UK retail sales of ALLURE. Such a suggestion would be wrong. It is not our policy to give out profit figures. However, I understand from Mr Joe. Bertolino, who is Advance's Head of Circulation for ALLURE magazine that UK retail sales of ALLURE are profitable. The cost of the additional print run to satisfy this demand is proportionately small as are the distribution costs in view of the existing distribution channels which I explained in my earlier statement, are used. I should emphasise that ALLURE is sold to UK retailers such as W.H. Smith and Easons ... [i]f the magazine did not sell they would not carry it but would make room on their shelves for other titles."

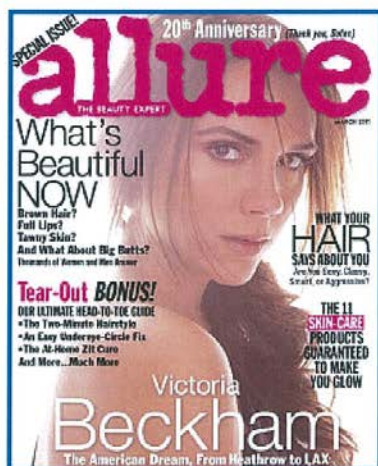
27. Mr Raynor points out that much of the advertising in ALLURE is for brands which are "international". She refers to exhibit PR1, the full copy of ALLURE from September 2011, which carries advertisements for e.g. Estée Lauder, Calvin Klein, DKNY, Clinique, Olay, Chanel, Fendi, Neutrogena, Dior, L'Oréal, Givenchy, Revlon and Lancôme. Ms Raynor believe that advertisers in ALLURE are well aware that the magazine has international readership. She refers to another of Advance's magazines, TATLER, which she states is also a showcase for international luxury goods: the UK edition of the magazines is sold internationally, particularly in English

speaking and Commonwealth countries. Ms Raynor states that Mr Pissimiglia is wrong to assert that the circulation of ALLURE outside of the US is irrelevant to the advertising income which Advance derives from ALLURE. She states that international brand owners have internationally coordinated campaigns and will ensure that their advertising has correspondingly international relevance. As regards US v UK content, Ms Raynor says that at one extreme, a 'what's on' guide to New York will be different to a similar magazine for London. However, she says that Advance's ALLURE magazine is at the other end of the spectrum because it concerns women's beauty, provides news concerning beauty products and treatments, many of which are available internationally.

28. In relation to publicity for ALLURE, Ms Raynor exhibits at PR19 a copy of a February 2011 press release by Comag, on the occasion of the 20<sup>th</sup> Anniversary edition of ALLURE, to UK retailers:

28 February 2011

**COMAG PRESS RELEASE**



## ALLURE

**Publisher:** Condé Nast U.S.

**Frequency:** Monthly

**On Sale:** 9 March 2011

**Price:** £4.40

**20<sup>th</sup> ANNIVERSARY ISSUE**

Describing itself as 'the' magazine for today's woman, ALLURE features serious advice on how to look fabulous and feel fantastic! With quality editorial and superb production in every issue, ALLURE is essential reading for the sophisticated woman interested in health, beauty and fashion.

To celebrate its 20<sup>th</sup> anniversary the March edition will be a special issue and the beautiful Victoria Beckham spices up the cover. Inside, 'Posh' talks about how her journey from Heathrow to LAX was more than just an airline flight.

As well as looking back at two decades of fashion and beauty, the March issue of ALLURE will unveil the biggest trends for 2011. The 'What's Beautiful Now' section highlights the sometimes surprising results from a national beauty survey, with both men and women giving their opinions on everything from full lips to big butts.

Featuring the hottest makeup colours for spring, the cult beauty products of the year as well as new ways to make your skin look radiant, the March issue brings readers all the top beauty advice from the U.S., written by experts.

Retailers are advised to display ALLURE prominently alongside VOGUE USA, ELLE USA and MARIE CLAIRE USA.

29. Exhibit PR20 shows listings on W.H. Smith's website and on Mag-Deals UK website:

W.H. Smith Magazines SEARCH BASKET (empty)

You are here: [FASHION & BEAUTY](#) > [Beauty & Hair](#) > [ALLURE Magazine Subscription](#)

### ALLURE MAGAZINE SUBSCRIPTION

OUR PRICE	PRICE PER ISSUE*	DURATION	ISSUES	PAYMENT METHODS	UK DELIVERY
<b>£70.00</b>	£5.83	12 months	12	Credit/Debit Card	<a href="#">Add to Basket</a>

\*PRICE PER ISSUE is the average price of each issue over the first 12 months of each subscription option

**Product description** ALLURE is the magazine for today's woman with features on health, beauty and fashion. There is serious advice on how to look fabulous and feel fantastic! Including quality editorial, superb production - ALLURE is essential reading for sophisticated women.

[Show international pricing](#)

Ms Raynor states that although the prints are recent, she believes that they are typical of the kind of third-party promotion which ALLURE has received in the UK for many years.

30. In relation to the ALLURE book, Ms Raynor exhibits details of royalty figures at Exhibit PR22. This, she says, proves that the book was sold in the UK during the relevant periods. I see from the figures that they relate to a combined total for the UK and Ireland, and that between 51 copies were sold from July to December 2007; 59 from July to December 2008; 14 were sold from July to December 2009, 15 from July to December 2010, and 12 from July to December 2011.

31. Ms Raynor states that Advance offers two ALLURE apps; the first of these was launched in April 2011 and is a preview of the digital version of the magazine available on the iPad. The second app was launched in September 2011, which is the ALLURE Best of Beauty iShopper. Ms Raynor states that between April 2011 and March 2012 there were 184 UK subscribers to the app and that there were 49 UK annual subscribers to the digital version of the magazine up to November 2011. Since November 2011, there have been more than 300 further UK subscribers. This is in addition to the purchase of one-off editions of the digital magazine which for the UK has been over 1000 since the magazine was launched.

32. Mr Pissimiglia filed a second statement, responding to some of these points. Some of the statement is taken up with an explanation of disputes between the parties in other jurisdictions, detail which is unnecessary to determine the current proceedings, save to note that the revocation action was filed to clear the way for Edizioni achieving protection in the UK for its IR. Mr Pissimiglia refutes Ms Raynor's points about content which is relevant to the US and the UK by listing a number of

pages in PR1 which are US specific, such as advertisements for New York locations. Other points he makes are in the nature of submissions, which I have borne in mind, but will not summarise here.

## Decision

33. Section 46 of the Act reads as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds—

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

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

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

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

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

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

34. Section 6A of the Act also applies to the opposition element of these conjoined proceedings, as set out earlier, because Advance’s mark is subject to proof of its use. The enquiry under section 6A is essentially identical to that set out under section 46, save that the period under scrutiny under section 6A is the five years prior to the publication of Edizioni’s IR. The gap between the section 46 and the section 6A period is from 29 March 2012 to 8 June 2012; these extra few weeks do not make a difference to the outcome of the genuine use assessment.

35. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority *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]; *Sunrider*, [70]; *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 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]; *Sunrider*, [70]-[71].

(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]; *Sunrider*, [72]"

36. The assessment can only be made on the basis of the evidence filed by Advance, because Section 100 of the Act states:

"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."

37. The effect of Advance's counterstatement in the revocation action, where it defends *periodical publications namely magazines; printed matter, namely books* is that the revocation succeeds for the goods which are undefended. Accordingly, Advance's mark is revoked at least for stationery, for periodical publications other than magazines, and for printed matter other than books, from 25 July 1997.

38. Edizioni's case is not that there has been no use on magazines: it expressly refers to Advance's use in Mr Pissimiglia's evidence and Mr Edenborough referred to it in his skeleton argument; i.e. that Advance's use was merely 'token', solely to

preserve the rights conferred by the registration. Edizioni's case is that the use on magazines, such that there is, is not genuine commercial exploitation of the mark because it is not the sort of use that is appropriate in the economic sector concerned for preserving or creating market share. In relation to books, Edizioni's case is that there is no probative evidence that there has been any use in the UK.

39. Although Mr Edenborough submitted that the assessment is not simply a numbers game, some of Edizioni's arguments do revolve around numbers, such as the proportion of the population which are subscribers (Mr Edenborough put it at people per million), and how many magazines are sold and returned. As per *Ansul*, I must consider all the facts and circumstances of the case:

"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 service 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 service concerned on the corresponding market."

40. The Comag report shows that between 30 to 40% of the magazines which were ordered were sold. Those sales were made to many different outlets, all over the country, including the likes of WH Smiths, Fenwicks, Londis and Easons. The same stores were ordering and selling copies of ALLURE year after year. There is a continuum of sales. Sometimes, only a single copy was ordered. This indicates to me that a single customer had placed an order for the monthly magazine with a particular newsagent. Returns of that single copy are likely to indicate a no-show by the customer. Comag's Magazine Cafe advertises the magazine, and Comag describes itself as distributing a diverse range of magazines, including many imported magazines. The WH Smiths online retail exhibit shows a picture of the magazines, with a small US flag in one corner (not present on the actual magazine). This indicates that WH Smith is highlighting the imported, US provenance of the magazine. Comag's 20<sup>th</sup> anniversary issue UK publicity (shown in paragraph 28), with the price in sterling, says:

"the March [2011] issue brings readers all the top beauty advice from the U.S., written by experts.

Retailers are advised to display ALLURE prominently alongside VOGUE USA, ELLE USA and MARIE CLAIRE USA."

41. There appears to be a UK market for US beauty and fashion magazines, not least because UK customers like to stay ahead of emerging trends across the Atlantic. The magazines are full of advertisements for international brands, celebrity

articles and photographs of celebrities. I have listed some of the international brands in paragraph 27 of this decision. I note that page 107 of exhibit PR1, the September 2011 issue of ALLURE, includes photographs of UK celebrities Stella McCartney, Helen Mirren and Florence Welch, whilst also including photographs of figures of transatlantic, if not global renown: Madonna, Beyoncé and Taylor Swift. The Comag 20<sup>th</sup> anniversary publicity shows a picture of Victoria Beckham. This indicates that whilst some of ALLURE's content will be of limited interest to the UK reader, such as New York advertisements, a great deal of it is relevant to a readership interested in celebrities, generic beauty advice and international brands of perfumes and cosmetics. In contrast to Edizioni's Estetica magazine being translated into 'local' editions (from Italian), ALLURE is already in English and is perfectly readable by UK citizens. It is not a foreign language magazine needing translation for Anglophone readers. In any event, foreign language magazines are sold in the UK to meet the needs of ethnic citizens; diversity is part and parcel of the magazine trade. There is a magazine for almost every conceivable hobby or interest, and the numbers sold may not be vast. It is an important feature of Edizioni's argument that it feels that the numbers sold by Advance cannot be profitable. That criticism was met by Ms Raynor. She states that it is not Advance's policy to state its profitability figures. Instead, quite detailed evidence as to outlets, numbers sold and numbers returned have been given. Distribution channels for getting all sorts of magazines from Advance and one of its competitors are in place, i.e. Comag. This distribution channel deals with the vast array of different titles being sent out to retailers. Mr Bartlett submitted that the cost of dealing with returns was not significant because there were all sorts of magazines going out from publishers and all sorts returning. Added to which, the price in sterling charged at retail is 50% or more above the cost of the magazine in the US. In the face of all the factors which are in Advance's favour, I do not regard them as being outweighed by any negative aspect to Advance's reluctance to divulge specific profitability figures.

42. Bearing in mind that the genuine use assessment is not concerned with assessing commercial success or economic strategy and, bearing in mind the total picture created by Advance's evidence, including the volume of magazine sales, the duration of the period of sales, the frequency of the sales, the stability of the mark used, the diverse nature of the magazine market and the nature of magazine distribution<sup>1</sup>, I find that Advance has made genuine use of its mark in relation to 'women's interest magazines'. It seems to me that a retention of the wider term magazines is not justified, because of the enormous range of magazine subject matter. Ms Raynor states that the magazine has a female readership, is focused on beauty, health and fitness, but also features articles about food, travel and lifestyle. This is apparent from the content in the full copy of the September 2011 issue, shown at PR1. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*<sup>2</sup>, Mr Geoffrey Hobbs QC, sitting as the appointed person said:

"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

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<sup>1</sup> CJEU case C-234/06 P *Il Ponte Finanziaria SpA v OHIM* and General Court Case T-334/01 *MFE Marienfelde GmbH v OHIM*.

<sup>2</sup> BL O/345/10.



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.”

It would be unduly restrictive to confine a description of Advance’s use to beauty magazines. ‘Women’s interest’ is a category often seen on magazine display stands. Accordingly, this is a fair description of the magazine part of Advance’s defended specification.

43. In relation to use on books, it is Edizioni’s position a) that the evidence lacks probity, because the figures, such as they are, include Ireland; and b) use as a book title is not trade mark use, it describes the content. Mr Edenborough likened it to “BP: Confessions of an Oil Company”. I do not think it is this straightforward; such matters are quite fact dependent. If all Advance had done was publish one book with limited sales, I consider that this would only be use as a book title and not trade mark use. However, I have accepted that ALLURE is used as the title of a periodical (i.e. a magazine). The book appears to be a spin-off from the periodical, which I think tends to colour the use as more than simply a book title. That may not matter if the established trade mark use is for something quite distinct, such as BP for fuel. However, where the products are as similar as books and magazines, the status of the mark as a trade mark for the one may colour the perception when it is used for the other. Added to that, the way the front cover is designed, it could be that “Confessions of a Beauty Editor” will be seen as the title, with ALLURE appearing as the trade mark, particularly because of the extra wording “with the editors of ALLURE”. I accept that, in theory, ALLURE has been used as a trade mark for books.

44. However, the evidence in relation to the book is much less compelling than that for the magazine. The book was published in 2006, which falls within the third, but not the final, period of non-use claimed. In Ms Raynor’s first witness statement, she states that she is “sure” that sales of the book took place on Amazon during the relevant period (which is the five years leading up to the date of the application for revocation). This is different from exhibiting a print showing the book offered for sales which post-dates the relevant period and then making a statement that the position was no different before. Ms Raynor stated that Advance had been unable to obtain detailed information concerning UK sales of the book. She gives royalty figures which relate to the UK and Ireland. The figures all fall within the final pleaded period for non-use, but they are not large: 51 from July to December 2007; 59 from July to December 2008, dwindling substantially to 14 from July to December 2009, 15 from July to December 2010, and 12 from July to December 2011. This is a combined total for the UK and Ireland, so there is no way of knowing how many were sold in the UK. This is important when the numbers are this small. It is not an answer for Mr Bartlett to submit that the majority of the sales will have taken place in the UK. That is a guess rather than an inference; but, even if it was an inference, the numbers involved, especially towards the end of the period may be de minimis.

45. In my view, the evidence does not build a picture of use warranted in the economic sector concerned to maintain or create a share in the market for books. It is for Advance to ‘show’ the use in the UK. In *Plymouth Life Centre*, O/236/13, Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.”

In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd* ('CATWALK'), BL O/404/13, Mr Geoffrey Hobbs QC, sitting as the appointed person, stated:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

In my view, Advance has not 'shown' genuine use on books and these are revoked from 25 July 1997.

### **Revocation outcome**

**46. Advance's mark may remain registered for *women's interest magazines*. It is revoked for all other goods in the specification from 25 July 1997.**

47. Section 5(1) of the Act states:

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

5(2) of the Act states:

“(2) A trade mark shall not be registered if because –


(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

48. My findings in relation to the revocation action mean that Advance may rely upon *women’s interest magazines* in its opposition to Edizioni’s IR. The findings transfer themselves to Advance’s requirement to prove use of the mark relied upon for the purposes of section 6A of the Act.

49. Advance’s opposition under section 5(1) and 5(2)(a) of the Act fails because the marks are clearly not identical<sup>3</sup>:

Advance’s mark	Edizioni’s IR
<p>ALLURE</p>	

There is no dispute between the parties that the marks are similar. Given that the same single words are involved, notwithstanding Edizioni’s presentation which is still clearly recognisable as the word ALLURE, the marks are highly similar visually. They are aurally and conceptually identical.

50. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union (‘CJEU’): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion*

<sup>3</sup> In *LTJ Diffusion SA v Sadas Vertbaudet SA* Case C-291/00 the European Court of Justice stated:“54 In those circumstances, the answer to the question referred must be that Art.5(1)(a) of the directive must be interpreted as meaning that a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

*AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Average consumer and purchasing process

51. The average consumer is reasonably well informed and reasonably circumspect and observant, but his or her level of attention is likely to vary according to the category of goods or services. The purchase of magazines will be overwhelmingly a visual process, although I bear in mind that there will also be an aural aspect if a customer is placing an order for a magazine with a newsagent. In relation to Edizioni’s class 9 goods, software will be subject to a higher level of attention. The remainder are electronic publications, which are likely to be given a comparable degree of attention by the purchaser as the paper versions of publications, as are photographs; no more or less than average.

Comparison of goods

52. I show below the competing specifications of the parties’ marks:

<b>Advance</b>	<b>Edizioni</b>
<i>Women’s interest magazines</i>	<p>Class 9: <i>Software; application software; electronic publications; downloadable electronic publications; downloadable digital publications for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices.</i></p> <p>Class 16: <i>Printed matter, newspapers, magazines, periodicals, books and photographs, particularly in relation to perfumery, cosmetics and beauty care.</i></p>

53. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary.”

‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking...”

54. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

55. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

56. As per the judgment of the GC in *Gérard Meric v OHIM* Case T-133/05, goods and services can be considered as identical when the goods of the earlier mark are included in a more general category, included in the specification of the trade mark application. Vice versa, if the goods or services of the application are included in a more general category included in the specification of the earlier mark, they must be identical. Applying this to the parties’ specifications, Edizioni’s *printed matter; magazines* are identical to Advance’s *women’s interest magazines*, because the latter is included within the former. ‘Periodicals’ is an alternative word for magazines, so Edizioni’s *periodicals* are also identical to Advance’s *women’s interest magazines*.

57. Newspapers, like magazines, are periodical publications. Some are published daily, others at greater intervals (such as Sunday papers). They frequently include magazines which are not available to buy independently (e.g. colour supplements). Their nature differs in the format and paper which are used, but their purpose is to provide information, entertainment, news, gossip, travel advertisements etc. The users are the same and they are sold cheek-by-jowl. Newspapers and magazines are highly similar. Advance’s goods are restricted to *women’s interest magazines*.

There is not a great deal of difference between the content of some aspects of newspapers and their supplements and the content of women's interest magazines (notionally beauty, fashion, travel, health, lifestyle and celebrity gossip). I find that Advance's *women's interest magazines* and Edizioni's *newspapers* are highly similar.

58. Books and women's interest magazines are different in nature. However, their purpose and method of use is to be read for information or pleasure. The users will be the same. As discussed above, some books may be a spin-off from a magazine, or vice versa, such as celebrity chefs' publications. Magazines and books are not sold on the same shelves, but they are often in the near vicinity of one another. There is a high degree of similarity between Advance's *women's interest magazines* and Edizioni's *books*.

59. In relation to photographs, Mr Bartlett submitted:

"The trade in photographs is a little odd, but there is such a trade actually. It is common for magazines to syndicate their photographs, especially those magazines which are known for the quality of their photographs. In my submission, a photograph which was used in relation to a beauty magazine, which was syndicated under the trade mark ALLURE, would be a similar product to a magazine called Allure."

In my view, this is not appropriate as a submission. This is evidence about how the trade works, but has not been given as evidence. If, as Mr Bartlett submits, the trade in photographs is a little odd, it is inappropriate to expect me to know how the trade works without evidence. It is still not clear to me how photographs and magazines can be similar within the parameters of the caselaw. They are not of the same nature, do not share a similar purpose, the end users are not the same, they are not sold side by side, the methods of use are different, they are not in competition and any complementarity is one-way (magazines requiring photographs). I would expect to purchase photographs from a photographer, not from a magazine. There is no similarity between *women's interest magazines* and *photographs*.

60. Edizioni has cover for *application software*. The commonplace, colloquial way to refer to such software nowadays is as 'apps'<sup>4</sup>. The evidence of both parties shows that they offer apps which relate to the content of their respective magazines. Although the nature of apps and magazines are different, one being paper and one being software, they involve the same end users, they are both read and share the same purpose, which is to provide and information about the subjects covered by the magazines. In Advance's case, it has two apps, one a preview of the digital version of its magazine; the other a beauty shopping guide. Application software is a subset of software at large, also covered by Edizioni's specification<sup>5</sup>. There is a reasonable degree of similarity between *women's interest magazines* and *software; application software*.

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<sup>4</sup> www.oxforddictionaries.com: "a self-contained program or piece of software designed to fulfil a particular purpose; an application, especially as downloaded by a user to a mobile device".

<sup>5</sup> *Gérard Meric v OHIM*

61. Edizioni's remaining goods are *electronic publications; downloadable electronic publications; downloadable digital publications for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices*. These are all electronic publications. Although the strict nature of paper magazines differs from electronic versions and the user will not buy electronic versions from the newsstand, there is clear similarity in other respects: the users are the same, they are in clear competition as formats, and the purpose is the same. In terms of method of use, they are both read for the information they contain, in whichever format. There is a high degree of similarity between *women's interest magazines* and *electronic publications*.

62. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>6</sup> the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

Although I have found that Advance has proven genuine use on women's interest magazines, the modest scale of that use does not entitle it to benefit from a claim of enhanced distinctive character. The mark is an allusion to beauty know-how giving the reader 'allure', but no more than that. Inherently, the mark ALLURE has a good degree of distinctive character for women's interest magazines.

63. A lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). However, where there is no similarity between the goods, neither identity between the marks nor a good degree of distinctive character in its earlier mark will help Advance's case. The CJEU said in *Waterford Wedgwood plc v OHIM* Case C-398/07:

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<sup>6</sup> Case C-342/97



“35 It must be noted that the Court of First Instance, in paragraphs 30 to 35 of the judgment under appeal, carried out a detailed assessment of the similarity of the goods in question on the basis of the factors mentioned in paragraph 23 of the judgment in *Canon*. However, it cannot be alleged that the Court of First Instance did not take into account the distinctiveness of the earlier trade mark when carrying out that assessment, since the strong reputation of that trade mark relied on by Waterford Wedgwood can only offset a low degree of similarity of goods for the purpose of assessing the likelihood of confusion, and cannot make up for the total absence of similarity. Since the Court of First Instance found, in paragraph 35 of the judgment under appeal, that the goods in question were not similar, one of the conditions necessary in order to establish a likelihood of confusion was lacking (see, to that effect, *Canon*, paragraph 22) and therefore, the Court of First Instance was right to hold that there was no such likelihood.”

64. Consequently, the section 5(2)(b) ground **fails** in respect of *photographs*.

65. The parties' marks are highly similar. In relation to those goods for which there is identity or a high degree of similarity, *electronic publications; downloadable electronic publications; downloadable digital publications for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices; printed matter, newspapers, magazines, periodicals, books, particularly in relation to perfumery, cosmetics and beauty care*, the nature of the purchasing process and the purchaser will not have an effect upon the outcome as there is nothing, or effectively nothing, with which to distinguish the marks. A likelihood of confusion is inevitable. In relation to *software; application software*, the high degree of similarity between the marks, the types of similarities which exist between the goods, and the modern explosion in the public's use of 'apps' means that there will be a belief or an expectation upon the part of the average consumer that the goods emanate from the same or economically linked undertakings<sup>7</sup>. This is often called 'indirect confusion', but it is, nevertheless, confusion within the meaning of section 5(2)(b) of the Act.

#### Partial refusal

66. In *Galileo International Technology, LLC v European Union (formerly European Community)* [2011] EWHC 35 (Ch) Floyd J stated:

“39. The unrestricted specification is of enormously wide scope. The Hearing Officer wisely reminded himself of what Laddie J had said about wide specifications for computer software in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J considered that:

“... there is a strong argument that a registration of a mark simply for “computer software ” will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is recorded, nor the fact that it controls the computer, nor the

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<sup>7</sup> *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

trade channels through which it passes but the function it performs. A piece of software which enables a computer to behave like a flight simulator is an entirely different product to software which, say, enables a computer to optically character read text or design a chemical factory. In my view it is thoroughly undesirable that a trader who is interested in one limited area of computer software should, by registration, obtain a statutory monopoly of indefinite duration covering all types of software, including those which are far removed from his own area of trading interest. If he does he runs the risk of his registration being attacked on the ground of non-use and being forced to amend down the specification of goods. I should make it clear that this criticism applies to other wide specifications of goods obtained under the 1938 Act. I understand that similar wide specifications of goods may not be possible under the 1994 Act."

40. That was a case decided under the Trade Marks Act 1938, but, like Laddie J, I see no reason why the views there stated should not apply under the [1994] Act."

67. Edizioni's software is unrestricted in scope. Tribunal Practice Notice (TPN) 1/2012 sets out the Registrar's practice where grounds for refusal of an application exist for some of the goods/services, but not others. The following paragraphs in the TPN are relevant to the current case and I have underlined the particular section which I wish to emphasise:

### **"3.2.2 Defended Proceedings**

In a case where amendment to the specification(s) of goods and/or services is required as the result of the outcome of contested proceedings the Hearing Officer will, where appropriate, adopt one or a combination of the following approaches:

a) Where the proceedings should only succeed in part, or where the proceedings are directed against only some of the goods/services covered by the trade mark and the result can be easily reflected through the simple deletion of the offending descriptions of goods/services, the Hearing Officer will take a "blue pencil" approach to remove the offending descriptions of goods/services. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

b) Where the result cannot be easily reflected through simple deletion, but the Hearing Officer can clearly reflect the result by adding a "save for" type exclusion to the existing descriptions of goods/services, he or she will do so. This will not require the filing of a Form TM21 on the part of the owner. If, however, any rewording of the specification is proposed by the owner in order to overcome the objection, then the decision of the Hearing Officer will take

that rewording into account subject to it being sanctioned by the Registrar as acceptable from a classification perspective;

c) If the Hearing Officer considers that the proceedings are successful against only some of the goods/services, but the result of the proceedings cannot be clearly reflected in the application through the simple deletion of particular descriptions of goods/services, or by adding a "save for" type exclusion, then the Hearing Officer may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording for a list of goods/services that reflects his/her findings and after considering the parties' submissions, the Hearing Officer will determine a revised list of goods/services. Subject to appeal, the trade mark will be, or remain, registered for this list of goods/services.

d) This third approach will be taken when a Hearing Officer considers that there is real practical scope to give effect to Article 13, having due regard to the factors in each individual case. For example, the original specification of the international trade mark registration which was the subject of *Giorgio Armani SpA v Sunrich Clothing Ltd* (cited above) was clothing, shoes, headgear. The successful opposition only opposed the registration to the extent that it covered "men's and boys' clothing", thereby leaving other goods covered by the specification as unobjectionable. Such an outcome could not be reflected in changes to the specification via either the 'blue pencilling' approach or the 'save for' type of exclusion. The specification was reworded and the international registration was eventually protected for a specification reading Clothing for women and girls, shoes and headgear. Generally speaking, the narrower the scope of the objection is to the broad term(s), compared to the range of goods/services covered by it, the more necessary it will be for the Hearing Officer to propose a revised specification of goods/services. Conversely, where an opposition or invalidation action is successful against a range of goods/services covered by a broad term or terms, it may be considered disproportionate to embark on formulating proposals which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business, as indicated by the evidence. In these circumstances, the trade mark will simply be refused or invalidated for the broad term(s) caught by the ground(s) for refusal."

68. In my view, paragraph 3.2.2(d) of the TPN bites in this particular case, especially the part which I have underlined. Consequently, there will be nothing to be gained from inviting submissions and I decline to do so.

### **Section 5(2)(b) outcome**

**69. The opposition is successful under section 5(2)(b) of the Act in relation to:**

***Class 9: Software; application software; electronic publications; downloadable electronic publications; downloadable digital publications***

**for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices.**

**Class 16: Printed matter, newspapers, magazines, periodicals, books, particularly in relation to perfumery, cosmetics and beauty care.**

**70. The opposition under section 5(2)(b) fails for *photographs*.**

71. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

72. Advance’s case under this ground is that use of Edizioni’s IR would take unfair advantage of and/or would be detrimental to the distinctive character and/or repute of Advance’s mark.

73. The conditions of section 5(3) are cumulative. Firstly, Advance must satisfy me that its earlier mark has achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by Advance will occur.

74. The first condition is reputation. Since the conditions are cumulative, if this is not satisfied, the ground cannot succeed. The CJEU gave guidance in relation to assessing reputation in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

75. The modest sales of Advance’s magazine come nowhere near to establishing a *Chevy*-type reputation. Although geographical extent and duration of use are in Advance’s favour, size of investment and intensity are certainly not. Additionally, there is no market share information, but it must be small in the context of women’s interest magazines. This does not undermine the finding of genuine use; reputation sufficient for a section 5(3) ground is a very different question to whether there has been genuine use. Without satisfying the first condition of reputation, Advance’s ground can go no further.

### **Section 5(3) outcome**

#### **76. The ground of opposition under section 5(3) fails.**

77. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

78. The requirements to succeed in a passing off action are well established and are summarised in *Halsbury’s Laws of England* 4th Ed. as being that:

i) the claimant’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant’s goods or services are those of the claimant;

and iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant’s misrepresentation.

79. As I have already decided that the section 5(2)(b) ground of opposition succeeds in relation to most of the contested goods, there is no need for me to decide whether the section 5(4)(a) ground also succeeds so far as those goods are

concerned. I will consider this ground against the goods for which I have rejected the opposition based on s.5(2): photographs.

80. At the relevant date, Advance had a modest but protectable goodwill<sup>8</sup> in relation to *women's interest magazines* sold under the sign ALLURE (in the UK from 1991). In *Lego System Aktieselskab and Another v Lego M Lemelstrich Ltd* [1983] FSR 155, the distance between the fields of activity, toys and irrigation equipment, was bridged by an enormous reputation, Lego being classed as a household word. Advance has only a modest level of goodwill.

81. As will be apparent from my earlier comments regarding the dissimilarities between women's interest magazines and photographs, the respective fields of activity are very different. This is an important consideration. It is one which is not in Advance's favour.

82. In *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5, Court of Appeal, Jacob LJ said:

"16 The next point of passing off law to consider is misrepresentation. Sometimes a distinction is drawn between "mere confusion" which is not enough, and "deception," which is. I described the difference as "elusive" in *Reed Executive Plc v Reed Business Information Ltd* [2004] R.P.C. 40. I said this, [111]:

"Once the position strays into misleading a substantial number of people (going from 'I wonder if there is a connection' to 'I assume there is a connection') there will be passing off, whether the use is as a business name or a trade mark on goods."

17 This of course is a question of degree—there will be some mere wonderers and some assumers—there will normally (see below) be passing off if there is a substantial number of the latter even if there is also a substantial number of the former.

18 The current (2005) edition of Kerly contains a discussion of the distinction at paras 15–043 to 15–045. It is suggested that:

"The real distinction between mere confusion and deception lies in their causative effects. Mere confusion has no causative effect (other than to confuse lawyers and their clients) whereas, if in answer to the question: 'what moves the public to buy?', the insignia complained of is identified, then it is a case of deception."

19 Although correct as far as it goes, I do not endorse that as a complete statement of the position. Clearly if the public are induced to buy by mistaking the insignia of B for that which they know to be that of A, there is deception. But there are other cases too—for instance those in the *Buttercup* case. A

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<sup>8</sup> A trivial goodwill will not accrue protection (*Hart v Relentless Records* [2002] EWHC 1984); however a small goodwill can give rise to protection (e.g. *Stannard v Reay* [1967] FSR 140 and *Lumos Skincare Ltd v. Sweet Squared Ltd and others* [2013] EWCA Civ 590).

more complete test would be whether what is said to be deception rather than mere confusion is really likely to be damaging to the claimant's goodwill or divert trade from him. I emphasise the word "really."

83. In *Multisys*<sup>9</sup>, Mr Alexander QC, sitting as the Appointed Person, observed that the "more limited the reputation on the part of the undertaking asserting the potential claim in passing off under s. 5(4)(a), the less likely that it will be able to show that a misrepresentation would be made by the use of a similar mark by a third party". I think it highly unlikely that the public would even wonder whether there was a connection, let alone a substantial number of the public assume that there is a connection between Advance's sign used on women's interest magazines and Edizioni's IR used for photographs. There is no misrepresentation "really likely to be damaging to the claimant's goodwill or divert trade from him".

#### **84. Section 5(4)(a) outcome**

##### **The section 5(4)(a) ground fails.**

85. Section 3(6) of the Act states:

"3.— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith."

86. The law in relation to section 3(6) of the Act ("bad faith") was summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

"130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see Case C-529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of

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<sup>9</sup> BL O/410/11, paragraph 28.

probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.



43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

87. Advance's complaint is that Edizioni, at the time of requesting protection in the UK of its IR, was fully aware of Advance's use and registration of ALLURE both in the UK and internationally. Advance claims that Edizioni must have known that such use would cause "widespread public confusion as well as substantial damage to its business.

88. Mr Pissimiglia states:

"I consider that the alleged proof of genuine use submitted by Advance is insubstantial and not convincing as regards the UK and elsewhere in various EU member states."<sup>10</sup>

"In addition, my Company has pursued various actions against Advance's trade mark and made its own trade mark applications because Advance has not developed an economic business for its US title ALLURE in the UK or in other EU countries."<sup>11</sup>

"The revocation actions and my Company's UK application have been made in good faith on the basis that my Company is entitled to register its "allure" logo trade mark."<sup>12</sup>

89. It is clear from the evidence and submissions filed by Edizioni in the revocation action that it considers that whilst Advance had made some use of ALLURE in the UK, it was not genuine use. Mr Pissimiglia refers to Advance's ALLURE magazine being a consumer women's magazine published on a monthly basis by Conde Nast in the United States. It does not dispute the US use and does not deny that it knows of ALLURE in the UK; what Edizioni disputes is that Advance has made genuine use of the mark in the UK. Edizioni's request to protect the IR in the UK must be seen in the context of the revocation action it has filed against Advance. As Mr Edenborough put it, "clearing the way is what proper businessmen do... [t]hat is not

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<sup>10</sup> First witness statement, paragraph 16.

<sup>11</sup> Second witness statement, paragraph 13.

<sup>12</sup> Second witness statement, paragraph 26.

falling below the standard of what you would expect honest and reasonably businessmen to do.”

90. In BL O/094/11 *Ian Adam*, the Appointed Person (Mr Geoffrey Hobbs QC) said at paragraph 33:

“The line which separates legitimate self-interest from bad faith can only be crossed if the applicant has sought to acquire rights of control over the use of the sign graphically represented in his application for registration in an improper manner or for an improper purpose.”

It seems to me that Edizioni’s request for UK protection of its IR was made against the background of its belief that Advance’s placing of its ALLURE magazine on the UK market was sham/token use, i.e. not genuine. In such circumstances, I do not consider that Edizioni crossed the line separating legitimate self-interest from bad faith. Advance has not made out its section 3(6) ground.

### **Section 3(6) outcome**

**91. The section 3(6) ground fails.**

### **Overall opposition outcome**

**92. The opposition succeeds in relation to**

***Class 9: Software; application software; electronic publications; downloadable electronic publications; downloadable digital publications for desktop computers, portable computers, laptops, PDA (personal digital assistant) and mobile phone devices.***

***Class 16: Printed matter, newspapers, magazines, periodicals, books, particularly in relation to perfumery, cosmetics and beauty care.***

**The IR is refused for these goods.**

**93. The opposition fails in relation to *photographs*. The IR may proceed to protection in the UK for *photographs*.**

94. I add here that if Advance had been able to rely upon *books*, it would not have made any difference to the outcome of the opposition.

### **Costs**

94. With the exception of its opposition to photographs, Advance has been successful in relation to the remainder of its opposition. Edizioni has been largely successful in relation to its revocation action, succeeding in reducing Advance’s registration to women’s interest magazines from a much wider specification of periodical publications, printed matter, and stationery. Mr Bartlett submitted that Advance should be awarded costs off the scale because the revocation action was “cooked up”, was never really viable, and that the trade mark application was not

filed in good faith. I found that the bad faith ground failed and that the revocation action succeeded, as described above. I would not call it “cooked up”. Applying a broad brush, I think this is a score draw. I direct each party to bear its own costs.

**Dated this 30th day of January 2014**

**Judi Pike  
For the Registrar,  
the Comptroller-General**