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TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 01550700 AND TRADE MARK NO 02183949B IN THE NAME OF FURNITURE VILLAGE LIMITED

AND IN THE MATTER OF CANCELLATION NUMBERS 00500653 AND 00500654 THERETO IN THE NAME OF FURNITURELAND.CO.UK LIMITED

DECISION

Introduction

1. This is an appeal concerning two consolidated applications for revocation on the grounds of non-use. It is an appeal against an interim decision dated 3 November 2015 of Mrs Ann Corbett, acting for the Registrar and against her subsequent substantive decision, dated 20 January 2016, (O-032-16).
2. In the interim decision the Hearing Officer refused the application on behalf of Furnitureland.co.uk Limited:
 - (1) To admit evidence; and
 - (2) To cross-examine (a) the registered proprietor's witness Mr Wynne; (b) a Mr Duggan whose evidence from previous proceedings was referred to by Mr Wynne; and (c) a representative of the Registrar.
3. In the substantive decision the Hearing Officer ordered that:
 - (1) Trade Mark Registration Nos 01550700 and 02183949B be revoked from 11 March 2011 insofar as they are registered for '*parts and fittings therefor*' but remain registered in respect of '*Furniture*'.
 - (2) Furnitureland.co.uk Limited should pay Furniture Village Limited the sum of £4000 as a contribution towards its costs.

Background

4. Trade Mark Registration No. 1550700 is for the trade mark FURNITURELAND. The mark was filed on 15 October 1993 and was entered into the register on 17 February 1995. It was registered in respect of '*Furniture and parts and fittings therefor; all included in Class 20*'.

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5. Trade Mark Registration No. 2183949B is for a series of six trade marks as shown below:



The mark was filed on 8 December 1998 and was entered into the register on 11 June 1999. It was registered in respect of ‘*Furniture and parts and fittings therefor*’. The colours blue, yellow and red are claimed in the first, third and fifth marks of the series.

6. Both registrations are in the name of Furniture Village Limited.
7. On 16 October 2014 Furnitureland.co.uk Limited applied to revoke both trade mark registrations. The applications were brought under section 46(1)(b) of the Trade Marks Act 1994 (“*the Act*”). The periods of non-use relied upon and the date from which revocation was sought were identified by Furnitureland.co.uk Limited as follows:

Trade Mark Registration	Period of non-use	Date of revocation claimed
1550700	11 March 2006 to 10 March 2011	11 March 2011
2183949B	17 October 2009 to 16 October 2014	17 October 2014
2183949B	18 July 2009 to 17 July 2014	18 July 2014
2183949B	11 March 2006 to 10 March 2011	11 March 2011

8. In the supporting statement at Section C of the TM26(N) filed in respect of Trade Mark Registration No. 1550700 it was stated as follows:

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Non-use by the Registrant for the trade mark FURNITURELAND has been established for the 5 year period ending 10 March 2011. (Decision of the Appointed Person Geoffrey Hobbs QC O-128-14). No evidence (sic) of use of this mark during that non-use period was tendered (sic) in those proceedings.

This application would have been brought at the same time had the register properly shown the existence of this registration.

9. In the supporting statement at Section C of the TM26(N) filed in respect of Trade Mark Registration No. 2183949B it was stated as follows:

Non-use by the Registrant for the trade mark FURNITURELAND has been established for the 5 year period ending 10 March 2011. (Decision of the Appointed Person Geoffrey Hobbs QC O-128-14). No evidence (sic) of use of this mark during that non-use period was tendered (sic) in those proceedings.

10. On 30 December 2014 Furniture Village Limited filed counterstatements. In respect of Trade Mark Registration No. 1550700 it was denied that there had been no genuine use of the mark in the relevant period. In the alternative it was claimed that the use of the mark had resumed after the expiry of the five year period ending 10 March 2011 and before the application for revocation was made such that the mark could not be revoked pursuant to section 46(3) of the 1994 Act. In respect of the Trade Mark Registration No. 2183949B the same grounds of defence were relied upon together with the additional defence under section 46(2) of the 1994 Act which was expressed as follows *'To the extent that the trade mark has not been used in the exact form as registered, it has been used in a form differing in elements which do not alter the distinctive character of the mark as registered'*.
11. The two revocation proceedings were consolidated. Furniture Village Limited filed evidence in the form of the witness statement of Eamon Wynne dated 27 March 2015 together with exhibits. On 20 April 2015 the UK IPO wrote to Mr Davies, who represents Furnitureland.co.uk Limited, allowing him until 22 June 2015 to file evidence or submissions in support of the application. Nothing was filed on behalf of Furnitureland.co.uk Limited and accordingly by letter dated 22 July 2015 the parties were advised by the UK IPO that the evidence rounds were concluded. The parties were further informed that the parties would have the option to request either an oral hearing or a decision on the papers.
12. Having engaged in correspondence with the UK IPO Furnitureland.co.uk Limited requested to be heard. By way of letters dated 29 September 2015 the parties were advised that the date appointed for the hearing was 2 November 2015. In that letter

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the parties were also requested to inform the Registrar within 14 days from the date of the letter who would be representing their clients at the hearing.

13. In the event it was not until 28 October 2015 that Furniture Village Limited indicated that it would be represented by Mr Guy Tritton of Counsel instructed by Bracher Rawlins LLP.
14. On 29 October 2015 i.e. two working days before the hearing Mr Davies on behalf of Furnitureland.co.uk Limited made a number of telephone calls and sent a number of emails to the Registrar. A summary of this contact was set out in the Hearing Officer's Decision at paragraphs 14 to 17 as follows (there seems to be no dispute that this is an accurate summary):

14. On 29 October 2015, i.e. two working days before the hearing, Mr Davies began a flurry of correspondence with and telephone calls to the registrar. His first email contained the following:

“..we were not aware [until receiving its letter of yesterday's date] that the registrant intended to attend the hearing...We would ask for leave to adduce evidence that calls into question the credit of the registrant's witness in this matter. We would also ask for leave to cross examine the registrant's witness at the hearing.

Further, we confirm that our client intends to question the absence of certain documents that should have been retained by the registrar and the absence of which resulted in an apology from UK IPO; as well as the status of one of the marks on the register during the relevant period. We would also ask that the author of that apology be made available for questioning at the hearing.”

15. A response to that email was sent by the IPO the same day. In relation to Mr Davies' requests to file evidence and cross examine the registered proprietor's witness, it noted that they had been made just two working days before the hearing and were not supported by any reasons or justification. In relation to the alleged absence of the unidentified documents, he was asked to provide further information. The parties were advised that the hearing would go ahead as planned.

16. Mr Davies sent a further email the following day. It contained the following:

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“We confirm that we relied on the registrant’s failure to respond to the requirement set out in your letter of 29 September 2015 who (if anyone) would be representing their client within 14 days; and took that to mean that they would not be appearing...

It is relevant to consider that materially the same marks and same facts have already been considered by both yourselves and then by Mr Geoffrey Hobbs QC, sitting as an appointed person...The outcome of that dispute was that the marks were removed from the register. We therefore took the registrant’s silence on appearing in that context; and took it to mean that they were not intending to fight an apparently hopeless cause.

Instead they left it to the last possible moment (and long after the deadline set in your letter) to confirm (as we had done by requesting the hearing) that they did in fact intend to appear; and are doing so through experienced and learned counsel. The other side are well aware that I would be representing our client and that I am based in Australia. They know this, not least because I appeared at the previous hearings of the related matter and flew from Australia to London for those hearings to appear in person on behalf of the client.

We are also now in possession of further evidence (which we did not have at the previous hearing) which is material to the issues in dispute and which contradicts evidence filed by the registrant. When it appeared to us that there would not be a contested hearing, there appeared to be no need to rely on that evidence. Now that we hear, outside of the timetable that you sent to the parties, that the other side are appearing, we need to file and rely on that evidence.

Since it is directly at odds with, and goes to the credit of, the other side’s witness evidence; we also need to apply to have those witnesses available for cross examination.

Further, we engaged in correspondence from your office that shows that documents that may be important (depending on the approach taken by the other side) apologizing for the loss and/or destruction of a document relevant to at least one of the trade marks in issue. Again, we wish to rely on this document (and correspondence related to it) in the event that it proves relevant in argument; and possibly question those involved at the hearing.

...

We apologise for the timing of these requests, but stress that they arise directly from the late notice by the other side that they intended to appear at the hearing...”

17. Mr Davies asked for the hearing to be postponed. Again, Mr Davies was advised, by telephone, that the hearing would not be postponed but that I would deal with his requests as preliminary points at that hearing and then adjourn it if necessary.

15. On the morning of the hearing Mr Davies filed further written materials.
16. At the hearing Mr Jim Davies of Elevation Legal represented Furnitureland.co.uk Limited and Furniture Village Limited was represented by Mr Guy Tritton of Counsel instructed by Bracher Rawlins LLP.
17. At the start of the hearing the Hearing Officer heard submissions of the applications made on behalf of Furnitureland.co.uk Limited for: (1) permission to cross-examine certain individuals; and (2) for permission to file evidence out of time. Having heard the submissions the Hearing Officer adjourned the hearing. On 3 November 2015 the Hearing Officer issued her decision refusing the applications made on behalf of Furnitureland.co.uk Limited and re-fixed the substantive hearing for 15 December 2015.
18. The substantive hearing took place via video link on 15 December 2015. As before Mr Jim Davies of Elevation Legal represented Furnitureland.co.uk Limited and Furniture Village Limited was represented by Mr Guy Tritton of Counsel instructed by Bracher Rawlins LLP. Approximately 1 hour before the start of the hearing Mr Davies filed a supplementary skeleton of argument. At the start of the hearing Mr Davies made an application for the case to be transferred to the Court for determination. That application was refused and the hearing went ahead.
19. Subsequently on 20 January 2016 the Hearing Officer issued her Decision (O-032-16). A copy of her interim Decision was included at Annex A to that Decision.

The Hearing Officer’s Interim Decision

20. The Hearing Officer issued an interim decision on the applications made on behalf of Furnitureland.co.uk Limited by letter dated 3 November 2015 (and re-iterated in paragraph [19] of her substantive Decision).

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21. In that interim decision the Hearing Officer refused the applications made on behalf of Furnitureland.co.uk Limited for: (1) permission to cross-examine certain individuals; and (2) for permission to file evidence out of time.
22. In summary, she did so on the basis that:
 - (1) Furnitureland.co.uk Limited could not rely upon the notification that the other party to the proceedings intended to appear at the hearing as a basis for filing late evidence. It was at all times clear that Furniture Village Limited was defending the applications. It had filed Counterstatements and had filed evidence in the proceedings in accordance with the time table set down by the Registrar. Despite being aware of this, Furnitureland.co.uk Limited had chosen not to file any evidence at the appointed time and had made no requests for an extension of time to file evidence.
 - (2) There was no prejudice to Furnitureland.co.uk Limited as the applications for cancellation of the registrations were on the grounds that the mark had not been used within the relevant periods and on that basis the further evidence was entirely irrelevant. In any event, the allegation that one of the marks had been ‘removed’ and then ‘restored’ to the register was not credible.
 - (3) That the contents of the evidence which Furnitureland.co.uk Limited sought to have admitted did not call into question the credibility of Mr Wynne who had provided evidence of use that was to be relied upon in the proceedings.
 - (4) The request for cross-examination of an officer from the UK IPO, Mr Wynne and Mr Duggan (who had given a witness statement in earlier proceedings which was exhibited by Mr Wynne) were wholly without merit.

The Hearing Officer’s Substantive Decision

23. As set out in the Hearing Officer’s Decision at paragraph [21] at the start of the substantive hearing Mr Davies made an application for the case to be transferred to the Court. He did so on the basis of what he called the ‘novel’ aspects of the case relating to the allegation that one of the marks in suit had been ‘removed’ and then ‘restored’ to the register. The Hearing Officer declined to refer the matter to the Court on the basis that she ‘*considered the substantive actions to be those of normal revocation actions*’ (paragraph [21]).
24. The Hearing Officer then turned to assess each of the applications for revocation. First the Hearing Officer dealt with Trade Mark Registration 1550700 for the word mark FURNITURELAND (“*the 1993 mark*”).

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25. On the basis of the position of the parties taken at the hearing before her (see paragraphs [29], [37], [38] and [41] of the Decision) the issue that the Hearing Officer was left to consider was the scope of specification that should be retained for the 1993 mark.
26. At paragraphs [34] and [35] the Hearing Officer identified the range of furniture in respect of which use had been established as follows:

34. Trade under the mark did not “prove to be as commercially successful as had been hoped” but the registered proprietor amended its trading style and a FURNITURELAND collection of furniture was launched in April 2012 in the registered proprietor’s 40 stores. At this date, there were said to be two dining room and one bedroom furniture ranges (which included tables, chairs, cupboards, sideboards, display units, bookcases, mirrors, wine racks, bedsteads and wardrobes) being sold under the mark. It is said that £1.1m worth of furniture was sold under the mark in the four months to August 2012 (Wynne1).

35. Since that time furniture products, again including dining tables, chairs, display units, sideboards, coffee/lamp tables, bookcases, beds, wardrobes and chests of drawers are said to have been sold under the mark in all 40 of the stores operated by the registered proprietor throughout the UK as well as via its websites furniturevillage.co.uk and furnitureland.uk.com. Sales figures, inclusive of VAT, for each month from September 2012 to February 2015 are given and vary from a low of £83,311 in June 2014, (the next lowest being £130,348 in March 2014) to a high of £470,826 in January 2013. Figures of the number of items sold from September 2013 range from a low of 376 in June 2014 to a high of 1801 items in August 2014 (Wynne2).

27. On the basis of those findings the Hearing Officer concluded as follows:

38. Whilst the registered proprietor’s evidence is not without fault, it is sufficient, as the applicant now accepts, to show genuine use of the mark FURNITURELAND. Despite his comments on the extent of use, Mr Davies does not deny that the use has been made in relation to a wide range of furniture as set out above. I reject Mr Davies’ submission that the specification should be limited to wooden furniture. I also reject his later submission that it should be limited to whatever other type of furniture the evidence shows.

39. Mr Tritton submitted that it is not appropriate to limit a specification on the basis of a characteristic of goods. He went on to submit:

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“...furniture is not only a fair specification, there has been wide use across that range of furniture and that it would be unfair, and indeed an artificial distinction, to start trying to split this specification into, for instance, tables, chairs, cupboards, sideboards, display units, etc., etc. “

40. I agree with Mr Tritton. Whilst the evidence shows furniture that could be described as being for a specific use e.g. dining tables, the evidence shows a much wider range of goods being offered for sale. Whilst I am sure that it is possible to name some specific items of furniture which have not been shown in the evidence, the range of furniture shown, and now accepted to have been sold under the mark, is a wide one. I do not consider the relevant consumer would refer to the goods on which genuine use has been shown as anything other than furniture which is a fair specification for the use shown.

41. The application to revoke registration No 1550700 fails in respect of furniture but, given the registered proprietor's concession, succeeds in respect of parts and fittings therefor.

28. The Hearing Officer then turned to consider the application for revocation of Trade Mark Registration No. 2183949B (“*the Device Marks*”).

29. The crux of the dispute as between the parties with respect to the Device Marks was as summarised by the Hearing Officer in paragraph [42] of her Decision and there has been no suggestion on this appeal that the position is otherwise:

42. On behalf of the applicant, Mr Davies submitted that no use has been made of any of the marks within the series as registered. There is no mention in the evidence that I can see to the use of any of these marks and Mr Tritton did not refer to me any whether during any of the relevant periods or at any later date. Indeed, in his skeleton argument he accepted that the registered proprietor “acknowledges that it has not made use of the Device Marks in precisely the form registered...” Again, that is not the end of the matter, as the registered proprietor makes the alternative claim under section 46(2) of the Act that there has been use of a mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered. In making this claim, it relies on the use made in the form as registered under no 1550770.

30. The Hearing Officer went on to conclude at paragraphs [49] and [50] as follows:

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49. As shown on the front cover of this decision, the six marks consist of a number of elements. Each is presented on a rectangular background made up of a darker and a lighter section (whether in colour or not). The word 'Furniture' is presented on the darker section, the word 'land' on the lighter section. In the first two marks, the two sections are positioned beside each other and there is a contrasting cursive swirl under the letters 'reland'. In the remaining four marks, the darker and lighter sections are placed one on top of the other with the contrasting cursive swirl appearing in the lighter section and extending almost the full width of it. As indicated above, the colours blue, yellow and red are claimed in three of the marks. The 6 marks each have the dual coloured rectangular background and swirl device which are elements not present in the mark for which use had been shown. Whilst these other elements are part of the marks and may be noticed by the relevant consumer, they are not distinctive elements and, in the context of the marks as wholes, are wholly subordinate to the words appearing on them. I do not consider that the fact that the words 'Furniture' and 'land' could be said to have a degree of separation, either by their different coloured backgrounds or by the fact that, in respect of marks 3-6 they appear one word above the other, alters the fact that the distinctive character of the mark rests in the combination of the words "Furnitureland".

50. Consequently, I find that use of the mark FURNITURELAND is use in a form differing in elements which does not alter the distinctive character of the six marks in the form in which they were registered and therefore the registered proprietor succeeds in its defence brought on grounds under section 46(2) of the Act.

31. On the basis of these findings and the findings noted above the Hearing Officer found that the revocation in respect of the Device Marks failed in respect of '*furniture*'.
32. On the question of costs the Hearing Officer ordered Furnitureland.co.uk Limited to pay Furniture Village Limited the sum of £4000 as a contribution towards its costs.

The Appeal

33. On 17 February 2016 Elevation Legal on behalf of Furnitureland.co.uk Limited (hereinafter "*the Appellant*") filed an appeal against the Decision under section 76 of the Act.
34. The Grounds of Appeal are in substance:
 - (1) An appeal against the 'procedural' or case management decisions namely: (a) the decision to refuse the application to file evidence; (b) the decision to refuse

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the application for cross-examination; and (c) the decision not to refer the case to the Court.

- (2) An appeal against the decision to treat the applications as ‘normal’ applications for revocation and not finding that: (a) the register had been defective, on or around 20 June 2011, in not showing the 1993 mark; (b) the state of the Registry files for the 1993 mark had been defective; and (c) Furnitureland.co.uk Limited had been adversely prejudiced as a result of (a) and (b).
 - (3) An appeal against the finding of the Hearing Officer that the evidence of use was sufficient to satisfy the use requirements for the purposes of the Device Marks notwithstanding that the none of the Device Marks had been used.
 - (4) An appeal against the finding that ‘furniture’ was a fair specification.
 - (5) An appeal against the order as to costs made by the Hearing Officer.
35. No Respondent’s Notice was filed by Furniture Village Limited (hereinafter “*the Respondent*”).
 36. On 1 April 2016 Mr Hobbs QC issued directions as to the further conduct of the appeal in which the Appellant was required to file a skeleton of argument in support of the Grounds of Appeal on or before 2 May 2016.
 37. On 20 April 2016 the parties were notified pursuant to section 76 of the Act that the hearing of the Appeal would take place on 23 June 2016.
 38. The deadline to file a skeleton of argument was not complied with and on 11 May 2016 a default notice was issued providing that the appeal would be deemed withdrawn unless as skeleton or argument was filed, in accordance with the direction of Mr Hobbs QC, by 20 May 2016. On 20 May 2016 a skeleton of argument was filed on behalf of the Appellant and subsequently a skeleton of argument was filed on behalf of the Respondent.
 39. By email timed at 14.45 on 20 June 2016 an application was made on behalf of the Appellant for an adjournment of the hearing of the appeal. That application was heard on 23 June 2016 and for the reasons given in my Decision (O-363-16) the application was refused. The hearing of the appeal followed on from the rejection of that application.
 40. At the hearing of the application for the adjournment and the hearing of the appeal the Appellant was represented by Mr Jim Davies of Elevation Legal and the Respondent

was represented by Mr Guy Tritton and Mr Jamie Muir Wood of Counsel instructed by Bracher Rawlins LLP.

The standard of review

41. As correctly recognised in the Respondent’s skeleton of argument and not apparently disputed by the Appellant the appeal is by way of review. Neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.
42. In Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said:

50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant’s complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge’s decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann’s statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416 , 2423:

‘Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge’s decision unless he has erred in principle.’

43. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lewison LJ said:

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties

and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

44. Moreover, when considering an appeal against the exercise of a discretion, for example in the context of a case management decision (or what is referred to as a ‘procedural’ decision by the Appellant) the Court of Appeal in Broughton v. Kop Football (Cayman) Limited (Lewison LJ with whom McCombe and Tomlinson LJJ agreed) stated at paragraph [51]:

51. Case management decisions are discretionary decisions. They often involve an attempt to find the least worst solution where parties have diametrically opposed interests. The discretion involved is entrusted to the first instance judge. An appellate court does not exercise the discretion for itself. It can interfere with the exercise of the discretion by a first instance judge where he has misdirected himself in law, has failed to take relevant factors into account, has taken into account irrelevant factors or has come to a decision that is plainly wrong in the sense of being outside the generous ambit where reasonable decision makers may disagree. So the question is not whether we would have made the same decisions as the judge. The question is whether the judge's decision was wrong in the sense that I have explained.

45. In the present case it is necessary to have these principles firmly in mind.

The Decision

The appeal against the case management or ‘procedural’ grounds

(a) The decision to refuse the application to file evidence

46. As noted above case management decisions, including the admission of late evidence, is a matter of discretion.
47. As not disputed by the Appellant following close of the pleadings directions were given by the Registrar as to the conduct of the applications for revocation. Pursuant to those direction the Respondent, who bears the burden of proof in revocation

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proceedings on the basis of non-use, filed evidence of use in the form of the witness statement of Mr Wynne dated 27 March 2015. The Appellant was required to file evidence or submissions in answer on 22 June 2015. No evidence was filed. No requests for an extension of time were made for the purpose of filing evidence.

48. As the Hearing Officer correctly pointed out at that stage the question of whether the applications would be determined on paper or at a hearing was not in issue i.e. the decision not to file evidence could not have been influenced by whether or not the Respondent intended to appear at the hearing in the event one was requested.
49. In such circumstances it seems to me that the Hearing Officer was entirely correct to reject the submission that it was the indication that the Respondent would be represented at the hearing of the applications that led to the request to file evidence which it had previously been considered was unnecessary. As the Hearing Officer correctly said '*that argument is a non sequitur and the submission is, at best, misguided*'.
50. Secondly, it was maintained that the Appellant would be unfairly prejudiced in the event that the evidence was not admitted as the evidence went to whether or not the application for revocation of the word mark would have been brought on 20 June 2011 had the register properly shown the existence of the word mark registration and that if such proceedings had been brought then the Respondent would not have been permitted to rely upon use after that date.
51. The Hearing Officer rejected that submission. The applications for revocation for non-use of the trade mark registrations pursuant to section 46 of the Act in these proceedings were filed on 16 October 2014. Those applications required the Hearing Officer as a matter of harmonised trade mark law to consider whether the Respondent had proved use of the trade marks in suit for the goods specified either in the periods specified in the applications *or subsequently*. The relevant cut-off date for the purposes of considering whether or not the Respondent had established the requisite proof of use was therefore 16 October 2014 (subject to the proviso in paragraph 46(3) of the Act which is not applicable in the present case). It was on that basis that the Respondent filed evidence of use in the form of the witness statement of Mr Wynne.
52. The evidence, the subject of the Appellant's application, was that of a witness statement of Mr Davies and a number of exhibits. That evidence did not answer the evidence of use contained in the witness statement of Mr Wynne but was said to be directed to the question of whether or not on or about 20 June 2011 the register had shown the existence of the word mark registration which had subsequently been 'restored' to the register and whether or not there were defects in the contents of various registry files. In this connection it is to be noted that the enquiries of the UK IPO with regard to the defect of the Register took place by way of exchanges of emails and letters in the early part of 2014.

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53. As is recorded in the transcript of the hearing this evidence the subject of the application was the subject of submissions by Mr Davies on behalf of the Appellant before the Hearing Officer at the hearing on 2 November 2015.
54. I am not persuaded that the Appellant is correct in its criticism of the Hearing Officer on the basis that the Appellant would be unfairly prejudiced if permission to rely upon the further evidence was refused. As was expressly accepted by Mr Davies on behalf of the Appellant at the hearing before me both the marks, the subject of the present proceedings, were and are registered. As such they were and are registrations that could be subject to an order for revocation by the Registrar in the exercise of the powers conferred by him by section 46 of the Act. Such applications were made by the Appellant on 16 October 2014.
55. It therefore seems to me to be entirely correct for the Hearing Officer to find that these proceedings were 'normal' revocation proceedings and that the issue that was before her was whether or not the Respondent had established that the use of the marks in suit during the periods of non-use relied upon by the Appellant or that such use had commenced or recommenced at some later date prior to the application for revocation.
56. The question of whether or not the word mark was shown on the register at an earlier date does not seem to be of any relevance to this question. Further and in any event the maintenance of the register is a matter for the Registrar (see section 63(1) of the Act) and is not, it seems to me, a matter with which the Respondent is concerned.
57. In those circumstances the Hearing Officer was entitled to refuse to admit the evidence to the proceedings on the basis that it was not relevant to the issue of whether or not the Respondent's use was or was not sufficient to prevent the marks or either of them from being revoked.
58. In any event, although it seems to me that she did not need to do so, the Hearing Officer considered the submissions that had been made to her at the hearing of the application on the issue of whether the register had properly shown the existence of the word mark registration the word mark on or around 20 June 2011. Those submissions were rejected. On appeal the Appellant in essence repeated those submissions which were based on the premise that it was to be inferred from the absence of reference to the word mark in various bits of correspondence and proceedings between the parties and the absence of documents from the UK IPO file that the mark had not been shown on i.e. had been 'removed' from the register on or around 20 June 2011. I have considered the findings of the Hearing Officer as recorded in the letter of 3 November 2015 and paragraph [19(ii)] of the Decision and the materials that were before me and it seems to me that the Hearing Officer was entitled to make findings that she did.

59. In this connection, it was confirmed at the hearing of the appeal that the reference to ‘*Undertaking enquires independent of the hearing and parties into the status of the register and file*’ for the 1993 mark in paragraph 5 of the Grounds of Appeal referred to the consideration by the Hearing Officer of the further evidence after the hearing on 2 December 2015 in the form of a witness statement of Mr Davies that was the subject of the application.
60. The Hearing Officer made clear both in the interim decision and also paragraph [19 (iii)] of the Decision that she had considered the further evidence *de bene esse* after the hearing in particular in order to satisfy herself whether such evidence called into question the credibility of the evidence given by Mr Wynne as had been submitted on behalf of the Appellant.
61. It seems to me that no criticism can be made of the course adopted by the Hearing Officer. The evidence that was the subject of the application was not provided either to the Hearing Officer or the Respondent until very shortly before the hearing on the 2 November 2015. It is clear from the transcript of the hearing on 2 November that:
- (1) Mr Davies had ample opportunity and did make submissions on the content of the evidence that was the subject of the application; and
 - (2) That the Hearing Officer made it clear in the course of the hearing (and no objection was raised) that given that she had received the material only shortly before the hearing and that she had not had an opportunity to go through all of it that she would be considering the material before issuing her decision on the applications.
62. It also seems to me clear that the evidence the subject of the application did not answer the evidence of use filed by Mr Wynne on behalf of the Respondent and therefore could not have any bearing on his credibility as a witness. That is all the more the case given the subsequent acceptance of his evidence by the Appellant with regard to the use made of the 1993 mark.
63. In the circumstances, the Appellant has not persuaded me that the Hearing Officer was wrong to exercise her discretion in the way that she did in refusing to admit the evidence.
- (b) The decision to refuse the application for cross-examination*
64. Turning to the request for cross-examination. This request fell into two parts (1) the request to cross examine an official from the UK IPO; and (2) to cross examine Mr Wynne and Mr Duggan.

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65. The power to order cross-examination is contained in section 69 of the Act and Rule 65 of the Trade Mark Rules 2008. Guidance with regard to applications for cross-examination in the UK IPO is provided in both Tribunal Practice Notice (TPN 5/2007) and in the Trade Marks Manual which provides that an applicant for permission to cross-examine a witness must:
- (1) Make the request at the earliest opportunity;
 - (2) Give the name of the witness they wish to cross-examine;
 - (3) Give reasons why cross-examination of each witness is requested;
 - (4) Set out the specific issues to which cross-examination would, if allowed, be directed;
 - (5) Explain the relevance of those issues to the matters to be decided;
 - (6) Give an estimate of the time any cross-examination is expected to take; and
 - (7) Copy the request to any other party to the proceedings.
66. As is apparent from the above the Appellant did not comply with this guidance. In particular the application was made very late. It was made just prior to the hearing on 2 November. No explanation was given as to why the application was not made earlier.
67. On this appeal it is said that the basis for the application for cross-examination was to establish ‘*what had happened to the [word] mark . . . on its renewal date in 2010*’ and ‘*why the mark had been ignored*’ i.e. not referred to in earlier proceedings as between the parties. It seems to me that these are matters that are wholly irrelevant to the determination of the present proceedings, for the reasons set out above.
68. Moreover, with respect to the evidence of Mr Wynne and Mr Duggan the evidence contained in their witness statements was confined to evidence of use of the marks. It was for this reason that the Hearing Officer, in my view rightly, regarded the application as a fishing exercise and dismissed the application for cross-examination as being without merit.
- (c) The decision not to refer the applications to the High Court*
69. In the skeleton of argument, served on the morning of the substantive hearing of the applications before the Registrar, the question of whether the proceedings should be referred to the High Court was raised. It was said that this was on the basis of the ‘novel’ aspects of the case.

70. Section 46(4)(b) of the Act gives the Registrar the power to refer the proceedings to the Court at any stage. The Hearing Officer therefore considered the application at the start of the hearing.
71. It seems to me that given: (1) the procedural background; (2) the timing of the application; and (3) the Hearing Officer's finding as to the irrelevance of the 'novel' aspects of the case to the issues that were before her i.e. that the proceedings were 'normal' revocation proceedings she was entitled to refuse the application as she did in paragraph [21] of her Decision.
72. Further in this connection I note that: (1) it was the Appellant who chose to bring the proceedings in the UK IPO in circumstances where the so called 'novel' point was referred to in the Form TM26(N) used to commence such proceedings; (2) on this appeal the Appellant accepted that other than the 'novel' point the proceedings were 'commonplace' revocation proceedings; and (3) it would appear that the Appellant continues to maintain on this appeal that the Court is the appropriate forum for these proceedings to be determined but nonetheless chose not to appeal to the Court but rather to the Appointed Person under section 76 of the Act. It therefore seems to me that the Appellant itself did not regard the Court as the appropriate forum for the determination of the issues at a number of significant stages of the proceedings both at first instance and on appeal.

The appeal against the decision to treat the proceedings as 'normal' applications for revocation

73. For the reasons already set out above at paragraphs 50 *et seq* above the Hearing Officer was entitled to treat the proceedings as 'normal' applications for revocation i.e. that the issue she had to determine was whether or not the Respondent had established genuine use for the purposes of defeating the applications for revocation under section 46 of the Act. It was unnecessary for that purpose for her to consider the issue of whether or not there had been at some earlier date a 'defect' on the register with respect to the 1993 mark.

The appeal against the finding of the Hearing Officer that the evidence of use was sufficient to satisfy the use requirements for the purposes of the Device Marks notwithstanding that the none of the Device Marks had been used

74. The Device Marks are a registration for a series of marks as shown in paragraph 5 above. The registration of series marks is provided for in section 41(2) of the Act which states that 'A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark'.

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75. The nature of series marks was recently the subject of a Court of Appeal judgment in Comic Enterprises Ltd v. Twentieth Century Fox Film Corpn [2016] Bus LR 849. With regard to what the nature of a registration of series of trade marks the judgment makes clear that a trade mark registration for a series trade mark ‘*gives rise to a series of different trade marks, each of which is registered, albeit under a single registration number*’ (see paragraphs [36] and [37]).
76. At paragraph [43] Kitchin LJ (who gave the judgment on behalf of the Court) went on to consider how the provisions of section 46 of the Act should be applied to such marks and stated as follows:

43 Seventh, I have given careful consideration to the submission made by Mr Purvis QC for Fox that the interpretation urged by the Comptroller is unworkable. How, said Mr Purvis, are the non-use provisions of section 46 to be applied? I am not persuaded this presents any difficulty. Once it is appreciated that a registration of a series of trade marks is a registration of a series of different trade marks, each of which is registered under the same number, the non-use provisions can be applied just as they are for any registered trade mark. If some of the trade marks in the series have been used and others not, then it may be that none is susceptible to revocation as a result of the saving conferred by section 46(2) in respect of use of the mark in a form differing in elements which do not alter its distinctive character. If, however, some of the trade marks in the series which have not been used for some reason do not satisfy the section 46(2) test then the registration of those trade marks may be revoked.

77. In paragraph [58] having reviewed the case law summarised the requirements imposed by section 46(2) of the Act Kitchin LJ stated as follows:

58 Pausing here, the requirements imposed by section 41(2) may be summarised as follows. In order to qualify as a series the trade marks must resemble each other in their material particulars. Any differences between the trade marks must be of a non-distinctive character and must leave the visual, aural and conceptual identity of each of the trade marks substantially the same. These matters must be assessed from the perspective of the average consumer of the goods or services in question.

78. With these points in mind I turn to the assessment made by the Hearing Officer in the present case. As found by the Hearing Officer at paragraph [42] of her Decision, and not challenged by the Respondent to this appeal, there was no mention of any use of any of the Device Marks in the evidence of use filed on behalf of the Respondent. Instead what it is relied upon is section 46(2) of the Act that there has been use of mark in a form differing in elements which do not alter the distinctive character of the

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mark in the form in which it was registered. In making that claim the Respondent relied upon the use made in the form registered under the 1993 mark.

79. In the present case, where the Device Marks are presumed to have been validly registered as a series, the differences between each are of a non-distinctive character and the visual, aural and conceptual identity of each of the trade marks is substantially the same. That is to say the difference between the images in monochrome and those the subject of '*The colours blue, yellow and red*' claim must be regarded as immaterial: see paragraph [78] of the judgment of Lewison J. in O2 Holdings Ltd, O2 (UK) Ltd v Hutchison 3G Ltd [2006] RPC 29.
80. The marks that make up the series are all figurative marks. Each conforms to a particular template namely:
- (1) The word 'Furniture' in each case appears on a dark background and the word 'land' on a contrasting lighter background (in the case of the marks for which there is a colour claim the dark background is blue and the lighter background is yellow). Such background contrast gives visual accentuation to the words thereby compartmentalised;
 - (2) There is a cursive swirl device under the words (in the case of the marks for which there is a colour claim this device is shown in red); and
 - (3) The background, words and cursive swirl device are within a rectangle.
81. The use that is relied upon by the Respondent is use of FURNITURELAND. It seems to me that phonetically this is no different from any of the Device Marks. However visually the mark, as used, has substantial differences from each of the Device Marks. In particular the uses of the mark as shown in the evidence do not in any way conform to the template referred to above which represents the specific individualisation of the figurative Device Marks in the series.
82. Therefore in the particular circumstances of the present case, I do not agree that it is appropriate for the non-word aspects of the Device Marks to be, as in effect the Hearing Officer found, reduced to insignificance.
83. In my view, the evidence of use of FURNITURELAND relied upon by the Respondent differs distinctively from each of the figurative Device Marks. I therefore do not agree with the Hearing Officer's assessment that the use of FURNITURELAND relied upon is properly to be regarded as an immaterial variant from any of the Device Marks for the purposes of section 46(2) of the Act.

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84. In the premises, I find that the Respondent has not satisfied the requirements of proof of use under section 46 of the Act and that the Device Marks should be revoked with effect from 11 March 2011.

The appeal against the finding that ‘furniture’ was a fair specification

85. The appeal against the finding that ‘furniture’ was a fair specification is made against the background where on this appeal:

- (1) It is accepted that the list of items identified by the Hearing Officer in paragraphs [34] and [35] of her Decision are items in respect of which the Respondent has made genuine use of the word mark;
- (2) The Appellant maintains that the correct specification would be to list such goods individually as opposed to allow registration for ‘furniture’; and
- (3) The Appellant does not seek to pursue the submission made at first instance that such goods should be ‘*limited to wooden furniture*’.

86. No specific error of principle is identified by the Appellant in its Grounds of Appeal or skeleton of argument. It was not suggested that the legal approach to the specification set out in paragraph [30] of the Decision was incorrect. Instead my attention was drawn the judgment of the Court of Appeal in Maier v. ASOS plc [2015] EWCA Civ 220. That case had also been drawn to the attention of the Hearing Officer.

87. In Maier v. ASOS plc Kitchin LJ summarised the position as follows:

63 The task of the court is to arrive, in the end, at a fair specification and this in turn involves ascertaining how the average consumer would describe the goods or services in relation to which the mark has been used, and considering the purpose and intended use of those goods or services. This I understand to be the approach adopted by this court in the earlier cases of *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2002] EWCA Civ 1828; [2003] R.P.C. 32 ; and in *West v Fuller Smith & Turner Plc* [2003] EWCA Civ 48; [2003] F.S.R. 44 . To my mind a very helpful exposition was provided by Jacob J (as he then was) in *H Young (Operations) Ltd v Medici Ltd* [2003] EWHC 1589 (Ch); [2004] F.S.R. 19 . He said at [20]:

“... I do not think there is anything technical about this: the consumer is not expected to think in a pernickety way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. ... Thus the ‘fair description’ is one which would be given in the context of trade mark

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protection. So one must assume that the average consumer is told that the mark will get absolute protection ('the umbra') for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ('the penumbra'). A lot depends on the nature of the goods – are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

64 Importantly, Jacob J there explained and I would respectfully agree that the court must form a value judgment as to the appropriate specification having regard to the use which has been made. But I would add that, in doing so, regard must also be had to the guidance given by the General Court in the later cases to which I have referred. Accordingly I believe the approach to be adopted is, in essence, a relatively simple one. The court must identify the goods or services in relation to which the mark has been used in the relevant period and consider how the average consumer would fairly describe them. In carrying out that exercise the court must have regard to the categories of goods or services for which the mark is registered and the extent to which those categories are described in general terms. If those categories are described in terms which are sufficiently broad so as to allow the identification within them of various sub-categories which are capable of being viewed independently then proof of use in relation to only one or more of those sub-categories will not constitute use of the mark in relation to all the other sub-categories.

65 It follows that protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider belong to the same group or category as those for which the mark has been used and which are not in substance different from them. But conversely, if the average consumer would consider that the goods or services for which the mark has been used form a series of coherent categories or sub-categories then the registration must be limited accordingly. In my judgment it also follows that a proprietor cannot derive any real assistance from the, at times, broad terminology of the Nice Classification or from the fact that he may have secured a registration for a wide range of goods or services which are described in general terms. To the contrary, the purpose of the provision is to ensure

that protection is only afforded to marks which have actually been used or, put another way, that marks are actually used for the goods or services for which they are registered.

88. It seems to me that the approach of the Hearing Officer was entirely in line with the approach set out by Kitchin LJ in Maier v. ASOS. On the basis of the unchallenged evidence of the Respondent the Hearing Officer found that there had been use in relation to a wide range of different products. The Hearing Officer went on to find that all such products would be referred to by the average consumer as furniture and in those circumstances the fair specification was for 'furniture'. It seems to me that this was a value judgment that the Hearing Officer was entitled to make. In the circumstances this ground of appeal is dismissed.

The appeal against the order for costs

89. Paragraphs 11 and 12 of the Grounds of Appeal refer to the appealing of the Order as to costs. However, no argument was put forward as to why the Hearing Officer's order should be overturned other than: (1) the proceedings had been incorrectly decided; and (2) the costs order was too high and that an insufficient discount had been given for the fact that there had been a partial success on the basis that non-use was conceded with respect to '*and parts and fittings therefor*'.
90. In my view it is clear that the Hearing Officer when making her assessment of costs had in mind that the marks had been revoked for '*and parts and fittings therefor*': see paragraph [53] of her Decision. As to the level of costs that the Hearing Officer ordered, these were assessed on a standard scale and made provision, quite rightly, for both the adjourned hearing on 2 November and the hearing on 15 December 2015. The Appellant has not pointed to any particular figure in the breakdown of costs set out in paragraph [58] of her Decision as being too high or provided any reasons as to why such costs are to be regarded as outside the scope of the standard scale.
91. However, in the light of my findings with regard to other aspects of this appeal the question of the appropriate apportionment of costs from the hearing at first instance will need to be re-visited on the basis of the directions set out below.

Conclusion

92. In summary I find that:
- (1) The appeal against the Hearing Officer's interim decision dated the 3 November 2015 is dismissed;
 - (2) The appeal against the Hearing Officer's findings in relation to the application for revocation against Trade Mark Registration No 1550700 is dismissed; and

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- (3) The appeal against the Hearing Officer's findings in relation to the application for revocation against the Device Marks is allowed. I will therefore order that Trade Mark Registration No 2183949B be revoked with effect from 11 March 2011.
93. Both parties have had a measure of success on this appeal.
94. In relation to the application for costs in the present appeal the Respondent had previously indicated that it would wish to make the costs of the appeal be awarded off the scale. No such indication has been given by the Appellant. Neither side has appealed the decision of the Hearing Officer to award costs on the standard scale. In those circumstances I direct as follows:
- (1) On or before 4 pm on 11 November 2016 the parties must confirm in writing whether or not they are claiming costs other than on the standard scale in respect of both the application to adjourn the appeal and the costs of the appeal.
- (2) In the event that either party confirms that they intend to seek an order for off scale costs then on or before 4 pm on 18 November 2016 that party must: (a) provide a bill itemising the actual costs upon which they intend to rely for that purpose; and (b) provide a reasoned statement in support of their request for costs to be awarded on an off scale basis.
96. Thereafter I shall give further directions for submissions in response to any application for off scale costs and for submissions with respect to the costs of the hearing below before considering and then issuing a decision as to costs on the basis of the papers before me.

EMMA HIMSWORTH QC

Appointed Person

28 October 2016