

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No.84489
BY THE BRITISH BROADCASTING CORPORATION
FOR REVOCATION OF TRADE MARK No. 2234432
STANDING IN THE NAME OF
WAYNE FORWARD**

BACKGROUND

1) The following trade marks are registered in the name of Wayne Forward (hereinafter WF).

Mark	Number	Registration Date	Class	Specification
DESERT ISLAND MOVIES DESERT ISLAND FILMS A series of two marks	2234432	29.12.00	41	Entertainment, providing information on movies and the movie industry via the World Wide Web, TV and other media.

2) By an application dated 11 July 2012, The British Broadcasting Corporation (hereinafter BBC) applied for the revocation of the registration under the provisions of Section 46(1)(a) claiming there has been no use of the trade marks on the services for which they are registered in the five year period post registration. A revocation date of 30 December 2005 is sought.

3) On 2 October 2012, WF filed a counterstatement. WF states that the marks in suit have been used in respect of the registered specification. He states that the marks were used, under licence, on a website from January 2002 until March 2008. A copy of the license agreement was filed, however, this appears to be a letter signed only by WF granting a license to an unspecified party although the letter is addressed as follows: "Attn: desertislandmovies.com".

4) Both sides filed evidence. The matter came to be heard on 31 July 2013 when the BBC was represented by Mr Walsh of Messrs Bristows LLP. WF did not attend and did not provide any written submissions.

WF'S EVIDENCE

5) WF filed a witness statement dated 19 December 2012 in which he describes himself as a free lance photographer. He states that a website went live in January 2001 and enabled visitors to post their top ten movies, view other user's choices and discuss movies. He states that no sales have been made in connection with the website and that he has financed the operation himself. He states that the purpose of the website was not to generate profit but because he has an interest in movies. He provides screen shots which show use of the mark [www.desertislandmovies](http://www.desertislandmovies.com) and the device of a circle of green and a stylised palm tree in a sea of blue; these are not dated. He also provides examples of postings made by members of the public of their top ten movies, which overlay the website address and device described above; again these are not dated. As an exhibit he also provides an invoice from Ripe design regarding "For initial meetings, developing Desert Island Movie logo, preparing artwork and advising on the website homepage etc". This is dated 31 October 2001 and is for £650.

BBC'S EVIDENCE

6) This consists of submissions and two witness statements attached as exhibits to the submissions. The first witness statement, dated 7 March 2013, is by Pamela Diane Hamer a trade mark lawyer working for the BBC. She states that she made a search for www.desertislandmovies.com using the Way Back Machine website. This site provides archived web pages from 1996 to the present day. She states that there were eleven extracts in the files but she was only able to access four of these pages (dated 7 April 2001, 19 May 2001, 2 February 2011 and 23 January 2013) although she cannot say why she was unable to access the other dates. These show only the website name and the device element of a desert island and stylised palm tree. She also searched for www.desertislandmovies.co.uk but only got one hit which is dated January 2013. She also searched for www.desertislandfilms.co.uk but this did not retrieve any results with the message "the Way Back Machine does not have this URL" being received.

7) The second witness statement, dated 7 March 2013, is by Pamela Rosemary de Spon an investigator with Francombe International Ltd. She was engaged to investigate the use of the trade mark in suit. She attaches a copy of her report which states:

- The company Desert Island Movies Ltd was incorporated in February 2000 and has filed dormant accounts every year until 2011. Mr Forward is the sole Director and shareholder of this company. The company is located at the same address as Mr Forward's photographic business.
- Mr Forward is the registrant of the domain names desertislandfilms.co.uk, desertislandmovies.co.uk, wayneforwardphoto.co.uk and desertislandmovies.com all registered in 2000.
- www.desertislandmovies.com reaches, as it has since 2001, a holding page which features the mark and a device and the words "coming soon".

WF'S EVIDENCE IN REPLY

8) WF provides another witness statement, dated 13 April 2013. He states that setting up and running the site is genuine use of the mark. He points out that the Way Back Machine is not totally reliable and does not archive all websites. He accepts that he has not used the mark Desert Island Films as there is a US company registered under this name. He has therefore developed the mark Desert Island Movies. He repeats that he has not used the mark for commercial ends but still maintains that he has used the mark.

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

DECISION

10) The revocation action is based upon Section 46(1)(a) of the Trade Marks Act 1994, the relevant parts of which read as follows:

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

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

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

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

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

11) BBC alleges that the mark has not been used in the five years subsequent to its registration i.e. 30 December 2000 – 29 December 2005.

12) Where WF claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13) In *Laboratories Goemar SA's Trade Mark (No. 1)* [2002] F.S.R. 51 Jacob J (as he was then) said:

“Those concerned with proof of use should read their proposed evidence with a critical eye — to ensure that use is actually proved — and for the goods or services of the mark in question. All the t's should be crossed and all the i's dotted.”

14) In determining the issue of whether there has been genuine use of the mark in suit I look to case O-372/09 (*AMBROEUS*) where Ms Anna Carboni acting as the Appointed Person set out the following summary:

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

(b) 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].

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

(d) 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].

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

(ii) 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].

(e) 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].

(f) 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].”

15) I also take into account the views of the CJEU in Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft ‘Feldmarschall Radetzky’* [2009] ETMR 14 in which it was asked to consider the following question:

“Is Article 12(1) of [the directive] to be construed as meaning that a trade mark is put to (genuine) use to distinguish goods and services of one undertaking from those of other undertakings in the case where a non-profit-making association uses the trade mark in announcements for events, on business papers and on advertising material and that trade mark is used by the association’s members when collecting and distributing donations inasmuch as those members wear badges featuring that trade mark?”

16) The answer was as follows:

“16 With regard to the question whether a non-profit-making association, carrying on activities such as those described in paragraphs 7 and 9 of the present judgment, may be regarded as making genuine use of a trade mark within the meaning of *Ansul*, it should be pointed out that the fact that goods or services are offered on a non-profit-making basis is not decisive.

17 The fact that a charitable association does not seek to make profit does not mean that its objective cannot be to create and, later, to preserve an outlet for its goods or services.

18 In addition, as the Radetzky-Orden admitted in its written observations submitted to the Court, paid welfare services exist. In modern society, various types of non-profit-making association have sprung up which, at first sight, offer their services free but which, in reality, are financed through subsidies or receive payment in various forms.

19 It cannot be ruled out, therefore, that trade marks registered by a non-profit-making association may have a *raison d’être*, in that they protect the association against the possible use in business of identical or similar signs by third persons.

20 As long as the association in question uses the marks of which it is the proprietor to identify and promote the goods or services for which they were

registered, it is making an actual use of them which constitutes 'genuine use' within the meaning of Article 12(1) of the Directive.

21 Where non-profit-making associations register as trade marks signs which they use to identify their goods or their services, they cannot be accused of not making actual use of those marks when in fact they use them for those goods or services.

22 In any event, in accordance with the finding of the Court in paragraph 37 of *Ansul*, and as the Advocate General pointed out in point 30 of his Opinion, use of a trade mark by a non-profit-making association during purely private ceremonies or events, or for the advertisement or announcement of such ceremonies or events, constitutes an internal use of the trade mark and not 'genuine use' for the purposes of Article 12(1) of the directive.

23 It is for the national court to ascertain whether the BKFR has used the trade marks of which it is the proprietor to identify and promote its goods or its services to the general public or whether, on the contrary, it has merely made internal use of them.

24 In the light of the foregoing considerations, the answer to the question referred must be that Article 12(1) of the Directive is to be construed as meaning that a trade mark is put to genuine use where a non-profit-making association uses the trade mark, in its relations with the public, in announcements of forthcoming events, on business papers and on advertising material and where the association's members wear badges featuring that trade mark when collecting and distributing donations."

17) WF conceded in evidence that no use has been made of the mark Desert Island Films because of the presence of an American company of that name. Regarding the mark Desert Island Movies it is clear that WF paid for a company to design a website and that the website was launched in 2001. However, there is no evidence that the website was ever accessed, or indeed did or offered anything. Whilst it is acceptable for non-profit making organisations to register trade marks they are expected to be used. The onus is squarely upon WF, once challenged, to provide evidence that the mark has been used. This could have been achieved by reference to the number of visitors to the site, advertising either online or in magazines or newspapers. He has singularly failed to discharge this burden.

18) Section 46(6) states:

"46. (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.

19) In the instant case the BBC sought a revocation date of 30 December 2005.

CONCLUSION

20) In my decision I have found that WF has not shown use of the marks in suit on any of the services in class 41 for which they are registered. Trade mark 2234432 must therefore be regarded as being revoked with effect from 30 December 2005.

COSTS

21) The BBC has been completely successful in revoking WF's trade marks and as the successful party is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side's statement	£200
Preparing evidence and considering and commenting on the other side's evidence	£200
Preparing for and attending a hearing	£300
TOTAL	£900

22) I order Wayne Forward to pay The British Broadcasting Corporation the sum of £900. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 14th day of August 2013

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