

Class 20: *Shelves, shelf supports, baskets, boxes and bins; plastic bin markers; work counters; cabinets, work stations; parts and fittings for all the aforesaid goods all included in Class 20.*

Merger of registrations

2. Trade mark 177062, as specified above, came into being as a result of the merger of four registrations (Nos. 177062, 177063, 177064 and 177065, each being registered separately for goods in classes 6, 10, 12 and 20 respectively) into a single registration bearing the registration number 177062; the date of merger being 19 January, 2011 and recorded on the Register on 25 January, 2011. This merger was effected after the date of the Applications for Revocation and accounts for references to multiple such applications and Notices of Opposition below.

The application for revocation

3. On 23 December, 2009 MIP METRO GROUP INTELLECTUAL PROPERTY GmbH & Co. KG, of Metro-Strasse 1, 40235 Dusseldorf, Germany, made applications for the revocation of the registrations, on the grounds of non-use, pursuant to the provisions of Section 51 of the Trade Marks Act, 1996 (“the Act”), in respect of ‘*ironmongery; small items of metal hardware*’ (concerning the original registration No. 177062) and ‘*medical and surgical apparatus*’ (concerning the now merged registration No. 177063).

Statement of Grounds

4. In its two Statements of Grounds, which for the sake of brevity and clarity I have merged the wording of, the Applicant claims that:

“Investigations conducted on behalf of the Applicant have failed to establish any use of the trade mark METRO, the subject of Registered Trade Marks Nos.177062 and 177063 in relation to ironmongery and small items of metal hardware and medical and surgical apparatus. Consequently the Applicant contends as follows:

- a. *That within the period of five years following the date of publication of the Registration, the said trade mark was not put to genuine use in the State, by or with the consent of the Proprietor, in relation to ironmongery and small items of metal*

hardware, and medical and surgical apparatus and that there are no proper reasons for such non-use.

b. That use of the said trade mark in relation to ironmongery and small items of metal hardware, and medical and surgical apparatus has been suspended for an uninterrupted period of five years prior to the date of the present applications and there are no proper reasons for such non-use.”

Notices of Opposition

5. On 18 November, 2010 the Proprietor filed Notices of Opposition to the applications together with Statutory Declarations of John Nackley, President of Metro Industries Inc. Both Declarations contained details of sales figures for products bearing the METRO mark in the State for the years 2005 to 2008 and a list of products bearing the METRO mark sold in Ireland for the years 2004 to 2009. Attached to each Declaration were ‘Exhibit 1’, containing printouts from the Proprietor’s website www.metro.com featuring the history of the METRO mark; ‘Exhibit 2’, which contained copies of various invoices dated from 2005 to 2009, addressed to Irish companies and relating to sales in Ireland, all featuring products bearing the METRO mark; and ‘Exhibit 3’, which contained printouts from the metro.com website containing details of product codes used on the invoices.
6. No further evidence, statements or counter-statements were filed. The matter became the subject of a hearing before me, acting for the Controller, on 4 August, 2011.
7. I decided to allow the application in respect of the goods ‘*medical, surgical apparatus*’ in Class 10 and revoked the registration in relation to those goods with effect from 29 December 2009, in accordance with Section 51(6)(a) of the Act. The parties were informed of my decision by way of letter dated 1 September, 2011. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Proprietor in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996, filed on 23 September, 2011.
8. At the Hearing the Proprietor was represented by Ms. Niamh Hall, Trade Mark Agent of FRKelly and the Applicant by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson.

Arguments of the parties

9. At the outset Ms. Hall claimed that the merger of trade mark Registration No. 177063 (against which an Application for Revocation was filed prior to the merger) with Registration No. 177062 and the resultant removal from the Register of Registration No. 177063 rendered the Application for Revocation fatal in respect of '*medical, surgical apparatus*'. The basis of Ms. Hall's claim lay in the absence of any guidance in Rule 29 (which deals with the merger of separate applications or registrations) of the Trade mark Rules, 1996 (the "Rules") as to what happens to any actions which may have been commenced against a registration which has subsequently been removed from the Register.

10. Ms. Hall argued that the only circumstances where the Controller can proceed with, and issue a decision on, an application for revocation in respect of a registration which has been removed from the Register are set out in the Trade Marks Act, 1996 (Community Trade Mark) Regulations, 2000 (S.I. No. 229/2000), Regulation 4; which deals with the revocation of a removed trade mark, which, prior to its removal, formed the basis of a claim to seniority for a Community Trade Mark. As the matter at hand does not reflect these circumstances there is, in her opinion, no legislative provision upon which the Controller can allow the transfer of an application for revocation from a removed registration to a live registration.

11. For his part Mr. Kennedy suggested that the absence of any direct provisions in the Act or Rules does not prevent the Controller from bringing common sense and fairness into play and does not mean that the Application for Revocation cannot follow the registration.

12. This issue, though novel, required little consideration. The Application for Revocation is in relation to a particular proprietor's particular mark for particular goods. The fact that a particular number, assigned to the mark for purely administrative purposes, is changed for the sake of expediency by the Controller while carrying out an administrative procedure (in this case a merger), cannot in any way render an attack on it fatal. The status of 'removed' as recorded on the Register in this case, being the result of a merger, is in reality, in respect of the removal of the administrative number from the Register not the removal of the Proprietor's trade mark rights from the Register. While the original number is removed the proprietor's rights were not removed, but continued to exist and

were merely transferred to and merged with those of another mark, albeit now recorded under a different number. The Register entry for the removed number clearly indicates this. In equity it must be held that any action by a third party initiated against those rights must also be transferred to the new number. Therefore, the Application for Revocation is very much alive and must be decided.

13. Ms. Hall argued that while certain goods included in Classes 6 and 10 were challenged in the revocation actions, “*parts and fittings*” for those goods were not so challenged and, therefore, whatever the decision regarding the goods challenged, protection for “*parts and fittings*” for those goods should remain. Mr. Kennedy was silent on this matter.

Use of the Trade Mark

14. Both Ms. Hall and Mr. Kennedy submitted that the principles to be followed to determine use in this case are those defined by the Court of Justice of the European Union in *Ansul*¹, which are as follows:

“36. Genuine use must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial raison d’être, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed to about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

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.

¹ *Ansul BV v Ajax Brandbeveiliging* Case C-40/01

39. Assessing the circumstances of the case may thus include giving consideration, inter alia, to the nature of 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.”

15. In his Statutory Declaration John Nackley details the level of turnover generated by products sold under the METRO mark in the State in the years 2005-2008 (i.e. the four years prior to the date of application for revocation) as US\$821,400, US\$782,500, US\$557,400 and US\$608,200 respectively. However, there is no breakdown or itemisation of the amounts in relation to the actual goods under attack.
16. The Statutory Declaration also includes a list of products sold in Ireland that bear the METRO mark. The list is lacking in meaning and detail, and in this regard, I agree with Mr. Kennedy’s assessment at the hearing that it offers little in the way of discharging the onus of proof of use which is on the Proprietor. However, the exhibits attached to the Statutory Declaration are more revealing. They contain scores of invoices, all produced on company headed paper, emblazoned with the Metro company logo that includes the word METRO. The invoices are not entirely self-explanatory as many are drafted in terms of product codes without any explanation as to what the codes stand for; but they are supported by pages from the company’s brochure, all also emblazoned with the same Metro company logo, and which, to a sufficiently large extent, fills in the blanks.
17. While the invoices in themselves are not very enlightening, the reality is that companies do not formulate invoices with a view to adducing them as evidence in defence of an attack on a trade mark (though they can be an important weapon in such a defence). They are typically drawn up for the sole purpose of charging for goods or services rendered, and in that regard so long as the addressee understands the contents to such an extent that a payment is triggered; then they serve that purpose. In the present case there is nothing to suggest that the invoices submitted in evidence were incapable of performing this basic function.
18. The list of products, the invoice details and the brochure information all contain references to other of the Proprietor’s trade marks (STARSYS, SUPER ERECTA,

LIFELINE, METROMAX, METROBASIC, SES, SASE etc.). At the hearing Mr. Kennedy argued that few if any of the goods sold by the Proprietor into Ireland are branded with the METRO mark, but rather with these other brands. In reply Ms. Hall argued that those brands are sub-brands, which are all used in conjunction with the house brand METRO. In my opinion, in the evidence submitted, the METRO mark has the necessary prominence to indicate that goods were sold under it, albeit accompanied by various sub-brand marks. For that reason I am satisfied that the mark was used during the relevant period.

19. I must consider whether that use was in respect of the goods under attack, namely *'ironmongery; small items of metal hardware; medical and surgical apparatus'*.
20. In his submission Mr. Kennedy argued the basic point that the goods in respect of which the application for revocation was made are extremely broad descriptions and cover a huge range of items. He contended that the evidence filed by the Proprietor related primarily to goods which the Applicant has not applied to have removed.
21. Ms. Hall maintained that, provided genuine use has been shown for even some of the goods falling into these terms, the Controller should not alter the specification. Ms Hall referred to the LELLIKELLY² decision where the Controller, in considering an application for the total revocation of that mark, found that there was genuine use in respect of goods falling within one term of the specification and did not find it necessary to limit the specification to the specific goods in respect of which the Proprietor had shown use.

Decision

22. Having considered the arguments of the parties and the relevant guidance from the courts, I find no evidence of use of the METRO mark in relation to *'medical and surgical apparatus'*. There are invoices which relate to *'inhalation therapy carts'*, but on examination of the function and purpose of these carts, I find the description fanciful. These *'inhalation therapy carts'*, despite their name, are no more than a trolley which is configured to store or transport cylinders of gas. While I am satisfied that the carts are

² Decision of the Controller in *Travel Hurry Projects Limited v Stefcom SpA* [2005] ETMR 82

used in a hospital setting, this does not mean they can be described fairly as a ‘*medical or surgical apparatus*’. In my opinion they would perform the same function in any industry or environment that required gas cylinders to be stored or transported. They may deliver an oxygen cylinder to a theatre, clinic, or patient’s bedside but they, in themselves, have no medical or surgical function. I find they are no more a ‘*medical or surgical apparatus*’ than the cart or trolley used in a hospital to bring meals to patients. I am satisfied totally that the Proprietor’s trade mark METRO has not been used in respect of ‘*medical and surgical apparatus*’ goods in Class 10, and therefore I have decided to grant the application for revocation in respect of these goods.

23. Turning now to ‘*ironmongery; small items of metal hardware*’. At the hearing Mr. Kennedy argued that ‘ironmongery’ is an extremely wide term covering anything made of iron, and highlighted one particular dictionary’s definition of ‘ironmongery’ as ‘the stock of a hardware store’. He went further by adding that ‘small items of metal hardware’ encompass anything made of metal which is small. These definitions are reasonable. But it is not necessary for an undertaking to have to prove use of a trade mark in relation to all possible goods falling within the general definitions of the specification in order to maintain the registration. So I must look beyond raw definitions.

24. The courts have provided ample guidance on the issue, in particular in ALADIN³, where at paragraphs 45 and 46 of the judgement, the Court of First Instance (CFI) found as follows:

“45. ... if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46. Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of

³ Reckitt Benckiser SL v OHIM, Court of First Instance, Case T-126/03

which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

25. The view of the consumer and the purpose of use must be considered also in terms of what would be regarded as a sub-category, and at paragraph 29 of its judgement in RESPICUR⁴ the CFI found:

"29. ...since consumers are searching primarily for a product or service which can meet their specific needs, the purpose or intended use of the product or service in question is vital in directing their choices. Consequently, since consumers do employ the criterion of the purpose or intended use before making any purchase, it is of fundamental importance in the definition of a sub-category of goods or services."

26. The UK courts have also considered the issue at length and in that jurisdiction the courts are bound to follow accepted principles forged from a number of UK decisions. There are no more than nuanced differences between the approach adopted by the Court of Justice of the European Union and the principles followed in the UK in dealing with applications for partial revocation; those principles being as follows:

- (1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period.
- (2) Next the tribunal must arrive at a fair specification having regard to the use made.
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording.
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark.
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used.

⁴ Mundipharma AG v OHIM, Court of First Instance, Case T-256/04

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description.

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved.

(8) The exercise of framing a fair specification is a value judgment

27. I am satisfied that these principles provide a sound basis on which to decide this matter.

In applying these principles to the question of whether or not the average consumer of the Proprietor's goods, traded under the METRO mark and protected in Class 6, would define reasonably such goods as falling within his or her definitions of '*ironmongery*' or '*small items of metal hardware*', I have arrived at the following conclusions:

- a. Sufficient evidence was produced by the Proprietor to satisfy me that its METRO mark was used, during the relevant period, on metal shelving, shelf ledges, metal hooks, metal brackets, metal posts and supports, clamps, foot plates, casters, metal baskets, metal drawer handles; and that such use was genuine (i.e. use to create or preserve an outlet for the goods that bear the mark and to distinguish those goods for the like goods of other undertakings).
- b. The aforementioned goods are common and the average consumer would understand their purpose instinctively. The goods are typically found in a hardware store (also known as an ironmongery), and, in my opinion, the average consumer would describe them fairly as 'hardware' or 'ironmongery'.
- c. Use of the adjective 'small' is subjective. There are no rules that must be applied to describing something as small, medium or large. Before describing the size of an object one automatically makes a comparison between the actual size of the object being observed and the size of the average version of such objects one keeps in one's mind. Where one is dealing with general terms - metal hardware in this case - making a judgement on what constitutes 'small' depends on one's understanding of what goods are covered by the general term is. For the purposes of these proceedings the term is to be considered only in relation to goods that are proper to Class 6, which includes items such as metal screws and metal ladders. There are small screws and large screws, and small ladders and large ladders. Irrespective of their relative sizes, in my opinion, the average consumer would describe a screw as a small item of metal

hardware and a metal ladder as a large item of metal hardware. As such, I have no doubt that the average consumer would put metal hooks, brackets and handles into the 'small' category. Therefore, I am satisfied that the METRO mark was used on '*small items of metal hardware*' within the relevant period.

28. In drawing these conclusions it is important to point out that, in my opinion, goods bearing a trade mark do not have to have their classification restricted so that they are referred to in one, and only one, category of terms, or one sub-category of terms or a single term. While the market place must be protected by not allowing unjustifiably broad specifications to remain on the Register, it cannot be the case that specifications must be so narrow so as to deny protection for similar goods. What is important is that the specification is such that the average consumer would deem it fair for the goods or services traded. For example, in my opinion, the average consumer who uses violins, violas, cellos and double basses would not see use of the general term 'musical instruments' in a trade mark specification as unfair for an undertaking that trades in those goods. The specification should not be restricted to the lowest possible common denominator of 'stringed musical instruments played predominantly with a bow' - a sub-category of the sub-category 'stringed musical instruments'. However, a different view may be taken if an undertaking uses the same 'musical instruments' general term but only ever trades in a single type of musical instrument (say pianos); then the average consumer might associate the trade mark solely with pianos and the general term may be too broad and might be altered following an action for revocation in respect of all other types of musical instruments.

Decision

29. In light of all the above I have decided to reject the Application for Revocation in respect of the goods '*Ironmongery; small items of metal hardware*' in Class 6 and to grant the application in respect of the goods '*Medical, surgical apparatus*' in Class 10.

30. The Proprietor has registered rights in respect of '*parts and fittings for medical, surgical apparatus*' which were not attacked in the Application for Revocation and therefore these rights must remain intact. In this regard, it may seem to some that I am being quite lenient towards the Proprietor, but I am satisfied that there is an absolute onus on the Applicant

for Revocation to ensure its application for partial revocation is clearly defined and precise in terms of the goods being attacked.

31. Accordingly the Class 10 specification will be amended to read as follows:

'Hospital crash carts, catheter carts; surgical case carts and suture carts; catheter baskets; all the aforesaid goods included in Class 10; parts and fittings included in Class 10 for all the aforesaid goods; parts and fittings for medical, surgical apparatus.'

Dermot Doyle

Acting for the Controller

28 November, 2011