

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for the revocation of the registration of Trade Mark No. 219362 and in the matter of the registered proprietor's opposition thereto.

Nutrichem Diät + Pharma GmbH

Applicant

COMPAGNIE GERVAIS DANONE

Proprietor

The registered trade mark

1. COMPAGNIE GERVAIS DANONE of 17 Boulevard Haussmann, 75009 Paris, France is the registered proprietor of the trade mark 'ACTIVIA'.
2. The mark is registered under No. 219362 in Classes 29, 30 and 32 in respect of the following specification of goods:

Class: 29

Meat, fish, ham, poultry, game, delicatessen meats; dried, preserved and/or cooked fruits and vegetables, compotes, jams fruit purees, jellies, soups, stews; preserves entirely or partially containing meat, fish, ham, poultry, game and/or delicatessen meats; prepared, dried, cooked, canned, deep-frozen dishes, dishes consisting entirely or partially of meat, fish, ham, poultry, game and/or delicatessen meats; salted or sweet aperitif products made from potatoes, flavoured or plain, potato chips, mini-delicatessen meats for aperitifs; milk, powdered milk, gelled flavoured milk, milk preparation; dairy products, namely milky desserts, yoghurts, drinking yoghurts, mousses, creams, desserts creams, fresh cream, butter, hard and soft cheeses, cheeses, matured cheeses, matured cheese with mould, fresh mild cheeses, cheeses in brine, white cheese, strained cheeses, fresh cheeses sold in paste or liquid form, plain or flavoured beverages consisting mostly of milk or of dairy products, beverages consisting mostly of milk starter cultures, milky beverages with fruits; plain or flavoured fermented milk products; food oils, olive oil, edible fats.

Class: 30

Coffee, tea, cocoa, chocolate, coffee-based beverages, cocoa-based beverages; sugar, rice, puffed rice, tapioca; flours, tarts and pies (sweet or salty), pizzas; plain or flavoured and/or stuffed noodles, dishes made from cereals, breakfast cereals; prepared foods consisting entirely or partially of noodles; prepared foods consisting entirely or partially of tart pastry; bread, toasted breads, cookies (sweet or salty), wafers, waffles, cakes, pastries; all of these products are plain and/or coated and/or stuffed and/or flavoured; salty or sweet aperitif products with baking, cookie or pastry dough; sweets, ice cream, ice cream consisting entirely or partially of yoghurt, ice cream, sorbets (ice water), frozen yoghurts (ice cream), frozen flavoured water, honey, salt, mustard, vinegar, sauces (condiments), sweet sauces, pasta sauces, spices but not including enzymes and enzyme preparations for use in cooking and transglutaminase for use in cooking.

Class: 32

Beers (alcoholised or alcohol free), still or aerated waters (mineral or not mineral waters); fruit or vegetable juice, fruit or vegetable based drinks; lemonades, sodas, ginger beers, sorbets (drinks); preparations for making drinks, syrups for drinks, fruit or vegetable extracts without alcohol; alcohol free drinks consisting partially of dairy products, alcohol free drinks consisting partially of milk starter cultures.

3. The application for registration of the mark was filed under the Trade Marks Act, 1996 (the “Act”) on 19 September, 2000 which is deemed to be the date of registration. Publication of the registration of the mark appeared in Journal No. 1936 on 17 January, 2002.

The application for revocation

4. On 5 September, 2011 Nutrichem Diät + Pharma GmbH, of Am Espan 1-3, D-91154 Roth Germany, made an application for the revocation of the registration pursuant to the provisions of Section 51 of the Trade Marks Act, 1996 (“the Act”). On 8 March, 2012 the Proprietor filed a Notice of Opposition to the application together with evidence of use of the mark. The evidence consisted of a Statutory Declaration of Jill McCarron, Health Affairs Director, of Danone Limited, a company incorporated in Ireland and a member of the French corporate group, Groupe Danone, to which the following were attached:

Attachment	Contents
A	Extract from the Irish Trade Marks Register corresponding to this trade mark
B	Example copies of yogurt packaging dated from 2002 to 2011 bearing the trade mark.
C	Copies of the media advertising plans for Ireland for the ACTIVIA® brand from 2000 to 2011.
D	Samples of print advertisements which ran between 2002 and 2010 which promote yogurt products under the trade mark.
E	Samples of promotional coupons and a photograph of point of sale material on display in a store in south county Dublin which was taken in November 2010
F	A CD ROM which contains a representative sample of [36 different] television adverts which were aired between January 2008 and December 2011.
G	An Advertising Media Timings spreadsheet detailing the time period each advertisement was aired between January 2008 and December 2011.
H	“Screengrabs” from three Irish websites promoting the trade mark – www.activia.ie , www.tlcpn.ie and www.danone.ie/products/activia/websites .
I	“Screengrabs” from the Facebook profile at www.facebook.com/activiaireland#!/activiaireland
J	Results of market research that was carried out by Millward Brown in quarter 4 of 2011, which examined the awareness levels of consumers to the trade mark.
K	Results of the ACTIVIA Usage and Attitude Survey conducted by TNS in 2010.
L	Sales value of products sold bearing the trade mark in tonnes between 2007 and 2010.

5. The Application for Revocation became the subject of a hearing before me, acting for the Controller, on 24 May, 2012. The parties were notified on 19 June, 2012 that I decided to grant a partial revocation and to revoke the mark in respect of all goods in Class 30 and Class 32, and for all goods in Class 29 with the exception of ‘*dairy products, namely, yoghurts, drinking yoghurts, mousses, milky desserts*’. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) filed on 3 July, 2012.

Statement of Case

6. The Applicant’s Statement of Case, which accompanied its application for revocation, can be summarised as follows:
- a. That within the period of five years following the date of publication of trade mark registration No. 219362, the said trade mark was not put to genuine use in the State, by or with the consent of the Proprietor in relation to the goods in Classes 29, 30 and

32 for which the said trade mark is registered and that there are no proper reasons for such non-use.

- b. That use of the said trade mark has been suspended for an uninterrupted period of five years prior to the date of the present application and that there are no proper reasons for such non-use.
- c. The revocation should take effect from the date of filing of the application or from an earlier date if the Controller is satisfied that the grounds for revocation existed at that date.
- d. Where grounds for revocation exist only in respect of some of the goods for which the trade mark is registered, then the specification of the goods of the registration should be restricted to reflect only those goods, if any, for which genuine use can be shown.

Notice of Opposition

7. In its Notice of Opposition the Proprietor identified the following grounds:

- (i) The trade mark has been put to genuine uninterrupted use in the State by or with the consent of the proprietor in relation to Class 29 and Class 32 within the period of five years following the date of publication of the registration of trade mark No. 219362.
- (ii) The registered proprietor of the trade mark, Compagnie Gervais Danone, has authorised Danone Limited to use the mark in Ireland.
- (iii) The evidence set out in the Statutory Declaration of Jill McCarron demonstrates that the trade mark has been used consistently by Danone Limited with the consent of Compagnie Gervais Danone as stated at (ii).

8. No further evidence was filed and the parties were, in due course, invited to elect whether to attend a hearing or to file written submissions in lieu of attending at a hearing. Both parties elected to attend a hearing.

The Hearing

9. At the Hearing the Applicant was represented by Ms. Bernadette Walsh, Trade Mark Agent of MacLachlan & Donaldson and the Opponent (Proprietor) by Mr. Alistair Payne, Trade Mark Agent of Matheson Ormsby Prentice.

Arguments of the parties

10. Ms. Walsh's submission at the Hearing can be summarised as follows:

- i. The Proprietor did not offer any evidence to defend its registration for any goods in Class 30 and therefore the registration should be revoked in respect of all goods in Class 30.
- ii. The issue to be determined is whether there has been genuine use of the challenged trade mark in respect of any goods in Classes 29 and 32 during the relevant period. If it is established that there has been genuine use of the mark, then the Hearing Officer must identify in respect of what goods that genuine use has been made and formulate a fair specification to reflect those goods.
- iii. It is clear from the evidence that the ACTIVIA trade mark has not been used in respect of all the goods for which the mark is registered. The only products in respect of which use is claimed are identified by Jill McCarron in her Statutory Declaration as: "*Yoghurts, drinking yoghurts, milky desserts, desserts creams, plain or flavoured fermented milk products, plain or flavoured beverages consisting mostly of milk or of dairy products, beverages consisting mostly of milk starter cultures*" in Class 29, and "*alcohol free drinks consisting partially of dairy products and alcohol free drinks consisting partially of milk starter cultures*" in Class 32. Therefore a partial revocation must be ordered in respect of all other goods in Classes 29 and 32.
- iv. It is clear from Ms. McCarron's own evidence that the only product which Danone Limited is authorised to use the ACTIVIA trade mark in Ireland is yoghurt.
- v. It is clear also from Ms. McCarron's own evidence, where she describes the contents of Attachment B (packaging of ACTIVIA products) as "*example copies of yoghurt packaging*", that the only product sold under the ACTIVIA brand is yoghurt.

- vi. While the ACTIVIA range includes 36 varieties of yoghurt, marketed in different flavours and textures, it is clear that “yoghurt” is an accurate description for every one of these products, and that is how consumers would refer to them.
 - vii. There is no evidence of use of the trade mark for any goods other than yoghurt. Yoghurt is yoghurt, whether it is thick and eaten with a spoon or thin and pourable.
11. Ms. Walsh stated that the European Court of Justice has provided ample guidance on how a fair specification should be arrived at where use of a trade mark is established in respect of only a part of the specification covered by the registration. In the ALADIN¹ case the Court held at paragraphs 45 and 46, 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 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

¹ Reckitt Benckiser SL v OHIM, Court of First Instance, Case T-126/03

goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

12. Ms. Walsh stated that the European Court of Justice held in *RESPICUR*² that the purpose or intended use of the product or service in question is vital to consumers when searching for a product and it is fundamental in defining categories or subcategories of goods or services.

13. Mr. Payne’s submission can be summarised as follows:

- i. The trade mark has been put to genuine use in Ireland since 2000, consistently and extensively for goods in Class 29, namely *yoghurts, drinking yoghurts, milky desserts, dessert creams, plain or flavoured fermented mild products, plain or flavoured beverages consisting of milk or of dairy products, beverages consisting mostly of milk starter cultures, milky beverages with fruits*, and for goods in Class 32, namely *alcohol free drinks consisting mostly of milk or of dairy products, beverages consisting mostly of milk starter culture, milky beverage with fruit*.
- ii. The ACTIVIA mark has an established reputation and goodwill in Ireland since 2000.
- iii. It is over-simplistic to classify all ACTIVIA products as yoghurts. All ACTIVIA products are yoghurt or yoghurt based, but they are not all yoghurts. “*ACTIVIA Intensely Creamy Caramel*”, “*ACTIVIA Single Pots*” and “*ACTIVIA Snack Pots*” are not yoghurts.
- iv. ACTIVIA pouring yoghurt is a beverage in its own right and can be used as a substitute for milk (for example, on cereals) or as a base for “smoothie” beverages and alcohol-free drinks.
- v. Survey results show that the ACTIVIA mark is recognised by over 91% of consumers as a brand for yoghurts, fresh cheeses, fermented milk and dairy desserts, while 85% of consumers recognise the ACTIVIA brand for yoghurt or yoghurt drinks.

² *Mundipharma v OHMI - Altana Pharma*, Court of First Instance, Case T-256/04

The law

14. The relevant section of the Act is Section 51, which is written in the following terms:

- “(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 publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;*
 - (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;*
- (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 State includes affixing the trade mark to goods or to the packaging of goods in the State solely for export purposes.*
- (3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) 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; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and 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.”*

Decision

15. The Proprietor confined its evidence of use to goods in classes 29 and 32. The application for revocation was not contested in respect of any goods in Class 30. As such I must revoke the registration in respect of all goods in Class 30.

16. It is abundantly clear that the ACTIVIA mark has been used extensively in the State during the periods in question and that the mark has gained a strong reputation and a high level of goodwill. But reputation and goodwill are not sufficient to overcome an

application for revocation that is grounded on non-use. The proprietor must put the mark to use for each good for which it is protected, failing which the mark is liable to be revoked in respect of goods for which use has not been demonstrated. So, in these proceedings, the issue is, on what goods has the trade mark been used and what is a fair specification for those goods?

17. The evidence submitted in defence of the registration, particularly the Statutory Declaration of Ms. McCarron, proves that the mark was used in respect of yoghurt or yoghurt based products. These products are proper to Class 29 of the Nice Classification, which is used in Ireland (as well as the majority of other national competent authorities) for the purposes of the registration of trade marks. Therefore, certain of the registration in respect of Class 29 must remain on the Register. I will consider a fair specification for Class 29 goods later.
18. Firstly, I wish to deal with the goods in Class 32 for which the mark is registered and for which evidence of use was submitted. Material was offered in respect of the following goods only in Class 32 '*alcohol free drinks consisting partially of dairy products, alcohol free drinks consisting partially of milk starter cultures*'. The only possible good, for which evidence of use has been adduced, that could fall into either category of alcohol-free drink, is pouring yoghurt.
19. However, the trade mark registration system is based on classifying goods into fields to which, in principle, the goods belong. It is not the case that goods must be classified according to all possible descriptions or uses – the classification must be based on a fair and reasonable categorisation, according to the normal purpose or function, as defined by the Nice Classification. This does not preclude the possibility that a multipurpose composite product may correctly be classified in all the classes that correspond to any of its functions. For example, it would be proper to classify a clock-radio in the two different classes that deal with radios and clocks.
20. However, these proceedings are not concerned with any multipurpose composite products. While yoghurt is also used as a facemask in beauty treatment it is not, *per se*, a beauty product. Therefore yoghurt does not appear in the list of goods covered in Class 3

of the Nice Classification which deals with beauty products. In essence yoghurt is yoghurt no matter what use is made of it.

21. As regards multiple descriptions, while milk clearly is an alcohol-free drink it does not belong in Class 32, which is specific to other types of non-alcoholic drinks (e.g. mineral and aerated waters and fruit juices). Milk belongs in Class 29 which concerns itself, *inter alia*, with milk and milk products. Likewise, while a “pouring yoghurt” does not contain alcohol and may be drinkable, it is fundamentally a yoghurt and, for classification purposes, it is proper to Class 29 not Class 32. Therefore, I am satisfied that no use of the trade mark has been made on any goods which are particular to and proper to Class 32 and accordingly I must revoke the registration in respect of all goods in that class.
22. Turning again to the goods in Class 29 for which the mark is registered. The specification contains a number of beverage types (i.e. plain or flavoured beverages consisting mostly of milk or of dairy products, beverages consisting mostly of milk starter cultures, milky beverages with fruits; plain or flavoured fermented milk products). The only good, for which evidence of use was offered, that could, in any way, be described using any of these beverage types is ACTIVIA Pouring Yoghurt. But as “pouring yoghurt” is itself mentioned in the specification (and there is no better way of describing pouring yoghurt) these other descriptions are redundant.
23. In deciding on a fair specification I must consider the nature of the trade and how the product is, as a practical matter, regarded for the purposes of trade. I cannot envisage a consumer going into a shop and asking for a ‘*beverage consisting mostly of milk starter cultures*’. In my opinion, the average consumer would use either the terms ‘pouring yoghurt’ or ‘drinking yoghurt’ (both fundamentally being yoghurts) when referring to the ACTIVIA Pouring Yoghurt product. Nor can I envisage the trade mark proprietor marketing or advertising its pouring yoghurt principally as a ‘*beverage consisting mostly of milk starter cultures*’. As no evidence of use in relation to any other possible beverage was offered, allowing the retention of ‘pouring yoghurt’ alone in the specification is, in my opinion, fair, reasonable and appropriate.
24. I agree with Mr. Payne that defining all the ACTIVIA products as yoghurts is over simplification. While Ms. McCarron, in her Statutory Declaration, refers to “36 separate

yogurt products” and “example copies of yoghurt packaging”, she also refers to the ACTIVIA products as, *inter alia*, beverages, milky desserts and dessert creams. Some of the sample packaging, advertisements or point of sale material entered into evidence does not bear the word yoghurt. The ‘single pot’ range can, in my opinion, be described as a dessert. Likewise can the ‘intensely creamy’ range, which actually bears wording on the packaging describing the product as a dessert. These products could reasonably be described as milky desserts or mousses and I have decided that it is appropriate to allow the registration to stand in respect of these goods.

25. Accordingly, I have decided that trade mark registration No. 219362 should stand revoked for all goods for which it is registered, with the exception of the following goods in Class 29: ‘*dairy products, namely, yoghurts, drinking yoghurts, mousses, milky desserts*’.

26. By virtue of Section 51(6) of the Act, the revocation of the registration of a trade mark has the effect that the rights of the proprietor shall be deemed to have ceased from (a) the date of the application for revocation, or (b) if the Controller is satisfied that the grounds for revocation existed at an earlier date, that date. In the present case I am satisfied that the appropriate effective date of revocation for the affected goods is the date of application for the revocation - 5 September, 2011.

Dermot Doyle

Acting for the Controller

23 August, 2012