

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF CONSOLIDATED APPLICATIONS NOS 8190 AND 8191
BY HACHETTE FILIPACCHI PRESSE FOR RECTIFICATION OF
THE REGISTER OF TRADE MARKS IN RESPECT OF
REGISTRATIONS NOS 1216164 AND 1216166 STANDING
IN THE NAME OF ELETTRONICA SpA**

**TRADE MARKS ACT 1938 (AS AMENDED) AND
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**IN THE MATTER OF Consolidated Applications Nos 8190 and 8191
by Hachette Filipacchi Presse for rectification of
the register of trade marks in respect of
Registrations Nos 1216164 and 1216166 standing
in the name of Elettronica SpA**

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DECISION

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Trade Mark No 1216164 is registered in respect of

“Electrical and electronic apparatus and instruments; parts and fittings included in
Class 9 for all the aforesaid goods.”

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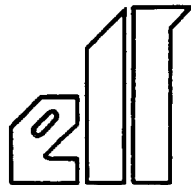
The same mark is registered under No 1216166 in respect of

“Electrical and electronic apparatus and installations; parts and fittings for all the
aforesaid goods; all included in Class 11.”

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A representation of the mark appears below

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Both registrations stand in the name of Elettronica SpA.

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By applications filed on 6 September 1994 Hachette Filipacchi Presse of France applied for
rectification of the register of trade marks by the part-cancellation of these registrations. In
summary the grounds are

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- i that the marks were registered without any bona fide intention on the part of
the proprietors to use them in the United Kingdom other than in relation to
goods for military, civil aviation and/or marine application. This goes to
Section 26(1)(a) of the Act.

ii that up to the date one month before the date of the applications a continuous period of five years elapsed during which there has been no bona fide use other than in respect of the aforesaid goods. This goes to Section 26(1)(b) of the Act.

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The applicants for rectification are themselves applicants for registration of the mark ELLE in logo form in Class 9 and ELLE DECORATION in Class 11 and have had the marks at issue cited against them. They, therefore, claim to be persons aggrieved by the registrations.

10 The registered proprietors filed counterstatements denying both the grounds for rectification and the applicants' claim to be persons aggrieved.

15 Only the applicants filed evidence and the matter came to be heard on 28 January 1998. At the hearing the registered proprietors were represented by Mr M J P Deans of Lloyd Wise Tregear & Co, their Trade Mark Attorneys and the applicants by Mr C Birss of Counsel instructed by Field Fisher Waterhouse, their solicitors.

20 By the time this matter came to be heard, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

25 Applicants' evidence

The applicants filed an affidavit dated 27 August 1996 by Patrick Lantz who is in charge of the Trademark Department of Hachette Filipacchi Presse, a position he has held since 1979. He confirms that he understands English.

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Mr Lantz says that his company first became aware of Elettronica in 1989 when Trade Mark No 1216164 was cited against his company's application to register a trade mark in Class 9. Elettronica gave consent at the time to registration of ELLE for "pocket calculators and portable adding and calculating machines". Mr Lantz says that his company now has wider interests and he sets out a range of goods in Classes 9 and 11 reflecting this fact.

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He goes on to say that

40 "Since 1989 there have been various discussions between my company and Elettronica through our respective trade mark agents and lawyers. We have received from Elettronica a brochure in Italian which is now produced and shown to me marked Exhibit PL1 which describes the range of Elettronica products on which I believe their mark is in use. Having reviewed this document, I believe that none of these goods are goods which are in any way similar to my company's goods.

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To the best of my knowledge and belief and as a result of careful enquiries made by my company and on its behalf, which has included trademark and company information searches and enquiries made direct with Elettronica's United Kingdom subsidiary, there has been no disclosure of any use of the Elettronica mark for any of the goods covered by [my] company's application Nos. 1493198, 1400150 and 1400156. In the circumstances, I believe that the mark is not in use on any of these goods and that these goods should, therefore, be deleted from the specification of the Elettronica marks."

That completes my review of the evidence. I now go on to consider the grounds for rectification.

Section 26 of the Act, so far as is relevant, reads as follows:

"26.- (1) Subject to the provisions of the next succeeding section, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, on the ground either -

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being."

Although there are two legs to the applicants' case based on the sub-sections referred to above the matter was for practical purposes dealt with as a single issue at the hearing for reasons which will be apparent and I propose to take the same approach in my decision. I should also record that Mr Birss qualified the nature of the applicants' case by saying that the attack was not on the bona fides of the registered proprietors as such but that their intention to use and actual use had been within the confines of their business which he described as being essentially military electronics systems. I will come back to this later in the decision when I consider whether the applicants have made out a prima facie case for rectification.

The first matter I have to consider is whether the applicants to rectify are persons aggrieved. The registered proprietors in their counterstatement denied that the applicants had the necessary status. Their position is that, whilst admitting the applicants approached them seeking consent to the registration of their marks, the requests were in such all embracing

form having regard to the circumstances of trade and the past trading history and bona fide intentions of the applicants that the registered proprietors felt unable to give such consent.

5 At the hearing Mr Deans submitted that the mere filing of trade mark applications was not
enough to establish the necessary locus and that the applicants' claim in so far as it was based
on use of their own mark was not supported by evidence. Mr Birss, for the applicants, took
me to Kerly's Law of Trade Marks and Trade Names (12th Edition) and in particular Chapter
11-08 where in dealing with the issue of "person aggrieved" it is said that "a mere application
to register a mark for such goods (other than a conflicting mark) will not suffice". In his view
10 the bracketed words indicated the basis on which I could decide the matter.

The normal consideration for "persons aggrieved" is that set down by Lord Herschell in the
Powell-v-Birmingham Vinegar Company case (Vol 1894) 11 RPC 4 at page 7 line 44 which
reads as follows:

15 "The respondents are in the same trade as the appellant; like the appellant, they deal
amongst other things in sauces. The courts below have held that the respondents are
"persons aggrieved". My lords, I should be very unwilling unduly to limit the
construction to be placed upon these words, because, although they were no doubt
20 inserted to prevent officious interference by those who had no interest at all in the
Register being correct and to exclude a mere common informer, it is undoubtedly of
public interest that they should not be unduly limited, inasmuch as it is a public
mischief that there should remain upon the Register a mark which ought not to be
there, and by which many persons may be affected who nevertheless would not be
25 willing to enter upon the risks and expense of litigation.

Wherever it can be shown as here, that the applicant is in the same trade as the person
who has registered the trade mark, and wherever the trade mark if remaining on the
Register would or might limit the legal rights of the applicant so that by reason of the
30 existence of the entry upon the Register he could not lawfully do that which but for
the appearance of the mark upon the Register he could lawfully do, it appears to me
that he has a locus standi to be heard as a "person aggrieved".

This guidance was quoted in the KODIAK trade mark case 1987 RPC 269, headnote 1 of
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"1 a locus was conferred on an applicant for rectification if his application for
registration was blocked by the presence on the register of an allegedly unused
mark."

40 In the present case the applicants wish to register marks similar to those belonging to the
registered proprietors and say in their statements of grounds that the Registrar has cited the
latter's registrations against their own applications. The registered proprietors say that they
have no knowledge of this and, accordingly, put the applicants for rectification to proof. It is
45 true that the applicants have filed no documentary evidence to support their claim as to the
position taken by the Registry in relation to their own applications (for instance in the form of

a copy of the examination reports) but it appears to be a matter of record that approaches have been made to the registered proprietors in relation to the question of possible consent to registration. The registered proprietors do not deny that these approaches were made. Somewhat different views exist as to the merits of the requests but I do not think that this
5 need concern me in considering the underlying issue. The fact of the matter is that the registrations at issue are regarded as constituting a barrier to the progress of the applicants for rectification's own applications. Given also the breadth of the registered proprietors' specifications and the goods said to be of interest to the applicants it seems to me that the applicants satisfy the test laid down by Lord Herschell as quoted above. I have no hesitation,
10 therefore, in reaching the conclusion that they are persons aggrieved.

The next matter I have to consider is whether the applicants have made out a prima facie case in relation to lack of intention to use or non use during the relevant period.

15 Mr Birss based his case principally on the scope of the registered proprietors' specifications which he argued were very broad indeed. I have given these specifications earlier in this decision and have no great difficulty in agreeing with Mr Birss' comments in this respect. In the light of this he said that the material filed by the applicants was intended as evidence of the nature and extent of the registered proprietors' business. He developed this theme by
20 reference to the exhibit filed with Mr Lantz's affidavit, namely an Elettronica brochure. I should say at this point that the brochure exhibited to the evidence is in Italian but a translated version was made available at the hearing and with the agreement of the representatives present was used as the basis for submissions. For ease of reference I will also refer to the English text of the brochure in what follows with the necessary caveat as to its status so far as
25 the formal evidence is concerned. In the event of an appeal from this decision I would recommend that the parties consider regularising the position by having the translated brochure introduced to the proceedings as a formal part of the evidence.

I do not think I need to review all of the submissions that were made in the context of the
30 brochure. Briefly Mr Deans, for the registered proprietors, pointed to the broad range of goods offered and the fact that many of the goods would have civilian as well as military applications. Mr Birss drew my attention to statements such as "Elettronica ... is one of the world's leading manufacturer[s] of electronic warfare equipment. It is one of the very few companies almost exclusively dedicated to this highly specialised field of activity" and
35 references throughout to armed forces along with supporting photographs of military equipment. In his view this demonstrated that the registered proprietors were essentially electronic warfare equipment manufacturers and, therefore, their specifications of goods should be restricted to reflect this fact. In support of his position he referred me to Mercury Communications Limited v Mercury Interactive (UK) Limited 1995 FSR 850 where Laddie J
40 made a number of remarks about the width of the registered proprietors' specification in the case before him. In particular he referred to the following passage:

45 "... in my view there is a strong argument that a registration of a mark simply for "computer software" will normally be too wide. In my view the defining characteristic of a piece of computer software is not the medium on which it is

recorded, nor the fact that it controls a computer, nor the trade channels through which it passes but the function it performs.”

I will come back to the Mercury case later in my decision.

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Before I draw my own conclusions from the evidence and submissions at the hearing it is worth setting out the main considerations and tests which I must apply in reaching my view. It is well established that, only if a prima facie case of non use is made out, does the burden of proof of showing actual user shift to the registered proprietor (see TRINA Trade Mark 1977 RPC 131 which in turn refers to NODOZ Trade Mark 1962 RPC 1). I should say that, whilst neither side referred directly to these cases at the hearing they are mentioned in the footnotes to Kerly’s Law of Trade Marks and Trade Names (12th Edition) which was referred to in submissions. In particular Kerly’s has this to say about the nature of the evidence required in support of an applicant for rectification’s case:

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“The applicant for removal may make out a prima facie case by inquiries in the trade failing to show any knowledge of use of the mark; it is then for the proprietor to provide evidence of use. But the prima facie case calls for more than just the evidence of one man, unless someone apparently particularly knowledgeable such as an official of a trade association.”

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(Chapter 11-41)

The last sentence in the above extract draws its authority from the REVUE Trade Mark case 1979 RPC 27. The circumstances there were that the prima facie claim of non use was supported by declarations from the then Managing Directors of the applicant company and a supporting declaration from someone in the (photographic) trade. The Hearing Officer held that the declarations from the Managing Directors were not substantiated by supporting information on the nature and extent of the enquiries made and that the single declaration from the trade suffered from lack of independent corroboration. In particular the Hearing Officer had this to say (my parentheses):

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“Mr Platts-Mills argued that the applicants’ evidence did not establish a prima facie case of non-user by the registered proprietors and that the applicants had accordingly failed to discharge the onus which is on them. Had the matter rested on the evidence of Messrs Schmechtig and Bels [the Managing Directors], I should have had no hesitation in agreeing with this submission. However, the evidence of Mr Ford [the trade declarant], which just covers the whole of the relevant period, is that he has no experience of the registered proprietors’ use of the name REVUE in the photographic trade. He knew of the applicants’ use of the name although, as their evidence in reply shows, that use was not on any large scale. It would, I think, have been better if Mr Ford’s evidence had received some independent corroboration, since I am unable to view the evidence of Messrs Schmechtig and Bels as providing any sort of confirmation. Mr Ford states that he has been associated with the photographic trade for upwards of 6 years. His declaration was made on 20th November 1974 so that his experience would appear to date from some time late in 1968 which is only just before

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the relevant period began. While his evidence goes some way toward discharging the onus that is on the applicants I do not consider it sufficient to shift that onus onto the registered proprietors. If a registered proprietor is to be made to assume the burden of showing the extent to which he has used his mark over a 5-year period and of showing, in appropriate cases, that other goods within his registration are of the same description as those in relation to which he is able to show use, it should, in my opinion, rest on more than the testimony of one individual, unless he were a person particularly well-placed and knowledgeable in the trade, such as, for example, an official of the relevant trade association might be?"

I take the above considerations into account in considering the applicants' case.

These cases are somewhat unusual in that the applicants rely substantially on evidence showing what they regard as the registered proprietors' real area of activity and invite me to extrapolate from this to a conclusion that the marks at issue have not been used on other goods that would fall within the broad specifications concerned. Mr Birss made out a persuasively argued case for partial rectification based on the material submitted. However I have a fundamental problem with the applicants' position in so far as they rely on the brochure obtained from Elettronica SpA. The brochure (as formally filed in evidence) is in Italian and there is no indication that it is intended for anything other than the company's domestic market. The purpose in filing it is, of course, to establish the scope of the registered proprietors' activities. In practice I find it of little assistance in relation to the position in the United Kingdom. It seems to me to be neither evidence of use or non use in this country without corroborative material of some kind to support it. To that extent I find the applicants' case to be flawed at the outset.

However even if I were to attach more significance to the brochure than I am in practice prepared to, the applicants prima facie case is not, it seems to me, made out. Whilst their central claim that Elettronica is first and foremost a military electronics firm may be correct, there are indications in the brochure that their interests go wider. I note the following, for instance, on page 23 of the brochure.

"To meet its diversified industrial requirements and its international commitments, ELETTRONICA has established a number of subsidiaries, both in Italy and abroad. These companies operate in the fields of:

- Environmental protection and monitoring
- Satellite communications ground environment
- Software engineering for military and civil applications
- Self-service and betting systems
- Television systems and equipment
- Broadcasting systems
- Integrated logistic support
- Special microwave sub-assemblies and components"

Clearly many of these wide ranging activities are outside the military field. There is also specific reference in the brochure to a subsidiary in this country, Elettronica (UK) Ltd. I do not say that this is in any way conclusive as to use or non use in this country. I do, however, draw from it the need for great care in interpreting the contents of the brochure. On its own the brochure does not, in my view discharge the burden on the applicants of establishing the claim of non use.

I will comment at this point on the Mercury case which Mr Birss relied on in constructing his case. This was a request for summary judgement on an infringement action and, inter alia, a counter-claim by the defendants regarding the validity of the registration. The latter involved a claim that in so far as the registration covered computer software it should be restricted to the particular application concerned (telecommunications in that case). As indicated in the extract quoted earlier Laddie J was of the view that the particular term “computer software” was too wide. In the circumstances of the case before him he was, it seems to me, indicating how he would approach the matter of dealing with an unrestricted computer software specification. He was not of course dealing with the substantive issue and I note that just after the extract quoted earlier that he says:

“... whether it [the defendant] will be able to force restriction [of the specification] to the extent necessary to exclude its own products from the remaining scope of the plaintiff’s registration will depend on the evidence adduced at the trial.”

(my parentheses)

He was not of course suggesting that his general proposition, if followed, would in any way displace the need for formal evidence to be brought forward in accordance with the requirements of the law applicable at the time. In the context of the proceedings before me I do not, therefore, think it is sufficient for the applicants to simply point to the breadth of the registered proprietors’ specifications without also discharging the burden on them of making out a prima facie case of non use in the light of the provisions of the 1938 Act and the established tests referred to in Kerly’s.

I go on to consider other aspects of the applicants’ case. Mr Lantz refers to “careful enquiries made by my company and on its behalf, which has included trademark and company information searches and enquiries made direct with Elettronica’s United Kingdom subsidiary”. In my view this is open to a number of criticisms

- it lacks any form of detail as to who made the enquiries, what sections of the market the enquiries were directed towards, or what the results were
- there is no indication as to when the enquiries were made or what period they relate to
- the applicants have established that Elettronica have a presence in this country through a subsidiary company but give no indication of the outcome of enquiries with that company, whether it is a trading body or what range of

goods and services it offers. Furthermore the evidence is silent on the name or position of the individual(s) with whom contact was made.

5 All of these criticisms are directed at the comments in the evidence filed. What is, however,
also singularly lacking is any reference to, or evidence from, independent sources such as
other traders, trade associations or other industry bodies, or commercial investigation reports.
The REVUE case referred to above, pointed to the care that needs to be exercised in
10 considering uncorroborated trade evidence but it seems to me that by failing to provide any
supporting evidence the applicants here have not brought themselves to a position where I
have a case to consider. It has of course been said on many occasions that the 1938 Act
places applicants in the sometimes difficult position of having to “prove a negative” in non
use rectification actions (see for instance paragraph 4.30 of the White Paper on Reform of
Trade Marks Law). That is particularly the case where broad specifications are concerned
15 though Mr Deans was quick to point out that the applicants in these cases lay claim to
similarly broad specifications of goods. It would be unreasonable, for the purposes of making
out a prima facie claim of non use, to expect applicants to establish a case against each and
every item covered by a broad specification as opposed to groups of goods or areas of trade.
Equally, however, there must in my view be some basis in evidence if the applicants are to
20 transfer the onus to the registered proprietors. On the basis of the evidence filed in these
proceedings I do not consider that the applicants have discharged that responsibility. Their
case, therefore, fails under both Section 26(1)(a) and (b).

25 Finally there is the matter of the Registrar’s discretion. In view of my decision above I see no
need for any exercise of that discretion.

As the registered proprietors have been successful in these proceedings they are entitled to a
contribution to their costs. I hereby order the applicants to pay them the sum of **£570**.

30 **Dated this 27th day of April 1998**

M REYNOLDS
For the Registrar
the Comptroller General