

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 9767
BY SOCIÉTÉ ANONYME DES EAUX MINÉRALES D'EVIAN
FOR REVOCATION OF TRADE MARK NUMBER 880971
IN THE NAME OF EVIAN (GB) LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF an application
under number 9441 by**

5 **Société Anonyme Des Eaux Minerales D'evian
for revocation of trade mark number 880971
In the name of Evian (GB) Limited**

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DECISION

Trade mark number 880971 for the mark EVIAN is registered in Class 9 in respect of:

15 Clothing and headgear for protection against accident or injury; wireless receiving sets,
instruments and apparatus for recording, receiving, transmitting, reproducing, generating
and amplifying sound, measuring instruments and apparatus included in Class 9; and speed
indicators

20 The registration currently stand in the name of Evian (GB) Limited

By an application dated 24 September 1997, Société Anonyme Des Eaux Minerales D'evian
applied for the registration to be revoked under the provisions of Section 46(1) on the grounds
that:

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the mark has not been put to bona fide use in the United Kingdom for an uninterrupted
period of five years prior to the making of the application for all of the goods for which
it is registered.

30 The registered proprietor filed a counterstatement in which they say that the mark has been used
within the relevant five year period.

The registered proprietor and the applicants for revocation both ask for an award of costs in their
favour.

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Only the Registered Proprietors filed evidence in these proceedings. Neither party took up the
offer to be heard, although both the applicants and the registered proprietors filed written
submissions in lieu of a hearing. Acting on the Registrar's behalf and after a careful study of the
submissions and evidence filed I now give this decision.

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Registered proprietors evidence (Rule 31(3))

This consists of a Statutory Declaration dated 18 December 1997, and comes from Philip Maurice
Merody, the Managing Director of R.S.I. (Cycles & Motors) Limited, and also Evian (GB)
45 Limited and Evian (Holdings) Limited. Mr Merody confirms that the Declaration contains
information derived from his own knowledge or comes from the records of the two Evian
companies.

Mr Merody says that the trade mark EVIAN was first used by Evian (GB) Limited and Evian (Holdings) Limited in June 1965 in relation to bicycle speedometers, and has been used continuously since that date. He states that his company (R.S.I. (Cycles & Motors) Limited) were originally a wholly owned subsidiary of Evian (GB) Limited who in turn later became a subsidiary of Evian (Holdings) Limited, his company becoming an independent company authorised to use the EVIAN trade mark by Evian (GB) Limited.

Mr Merody goes on to set out details of sales of EVIAN computer/speedometers, which are as follows:

Year	Unit sales
1993	1,526
1994	2,662
1995	1,321
1996	721
Total	6,320

He says that the average price of each unit is £11.84 which equates to sales of £73,763 for the given period. Mr Maurice says that the trade mark is printed on the mask under the clear glass of the LCD electronic display, and refers to exhibit PM1 which consists of a photograph of a speedometer bearing the word EVIAN on the face above the display. He confirms that the speedometer shown is that sold between 1993 and 1996.

Mr Merody refers to exhibit PM2 which consists of invoices from R.S.I. (Cycles & Motors) Limited. These are dated October 1993, September 1994, September 1995 and October 1996 and relate to the supply of various cycle components, including an EVIAN cycle computer.

Mr Merody sets out the amounts spent on advertising bicycle products in the years 1992 to 1997 in Cycling Weekly, Mountain Bike Rider and Cycle Sport magazines, and which ranges from over £14,000 in 1992 to £7,710 in 1997. He does not say whether this relates only to goods sold under the EVIAN trade mark.

Registered proprietors' evidence (Rule 13(6))

This consists of a Statutory Declaration dated 17 June 1998 from Philip Maurice Merody, who confirms that he also made the Declaration dated 18 December 1997.

Mr Merody says that the mark has been used in the relevant period in relation to protective clothing for cyclists, and refers to exhibit PM2 which consists of a photograph of a helmet bearing the word EVIAN. He says that the mark has also been used in respect of measuring instruments, and refers to exhibit PM1 to his earlier Declaration.

Decision

Section 46(1) of the Act, insofar as it is relevant, reads as follows:

5 **46-(1)** The registration of a trade mark may be revoked on any of the following grounds:-

10 (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;

15 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

15 The applicants have not stated under which part of section 46 they object, the wording used indicates that the matter falls to be considered under subsection (b) of Section 46.

20 The registered proprietors have claimed use of the mark within the relevant period and do not rely on there being any proper reasons for non-use. Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him.

25 The application for revocation was made on 30 December 1997, so the question is whether the registered proprietors have established that the mark was in use on, or after 30 December 1992. From the wording of sub section (a) it is clear that the first question to be determined is whether there has there been any use of the mark by the proprietor (or by his consent) within the relevant period, and assuming the answer is in the affirmative, whether the use made has been “genuine” and in relation to all, or at least some of the goods for which the mark is registered.

30 The registered proprietors give details of unit sales from 1993 to 1996 and have supported this with invoices from within this period showing the mark in use by R.S.I.(Cycles) Limited who are stated as using the mark with the permission of Evian (GB) Limited, the registered proprietors. I am satisfied that the evidence establishes use of the mark within the relevant period.

35 Turning to the question of whether the use can be construed as “genuine”. In relation to the meaning of the term genuine use and issues to do with substantiality of use, I refer to the ZIPPO Trade Mark case (1999 RPC 173) which in the head note says:

40 “(4) The word “genuine” as used in section 46 of the Trade Marks Act 1994 was not intended to have a material effect on previous practice in relation to non-use of a trade mark. Substantiality (or degree) of use continues to be a factor in deciding whether use of a mark was genuine. However, where it was established that a mark had been used, and the genuineness of use was not in question, detailed consideration of substantiality served no purpose.”

45 and the following extract from the same case which in turn refers to BON MATIN:

“Mr Alexander submitted that the use must not only be genuine, but it must also be substantial as judged by commercial standards. Not surprisingly Mr Purvis disagreed, and he referred me to the following passage from *BON MATIN Trade Mark* [1989] RPC 537 at 543 where Whitford J. dealt with this very issue:

5 “The main argument on the appeal centred around the question as to the extent to which one must consider the substantiality of the use. Various authorities can be cited, pointing in different directions. I suppose in the interest of Mr Morcom’s clients perhaps one of the earliest and most favourable approaches is that which is to be found in Official Ruling 61 RPC which was concerned with the question of a despatch to the United Kingdom of a sample of the product to be sold under the registered trade which it was held might be regarded as a use of the trade mark in the United Kingdom. I was not taken to the Official Ruling as such but it is to be found referred to in a judgement which was given by Dr R G Atkinson, then acting for the Registrar in *VAC-U-FLEX Trade Mark* [1965] FSR 176. There is no doubt that Dr Atkinson did consider a number of earlier authorities. To my mind what plainly emerges from the authorities is this, and Mr Morcom did not attempt to shirk the point, *the substantiality of the use is undoubtedly a relevant factor to be considered* and at the end of the day one has got to consider every relevant factor. It must always be remembered that what one is directed to by section 26 of the Act is the question as to whether there has been bona fide use. Although the extent of the use is one factor which may be of significance, some of those factors may lead to the conclusion that although the use could not in the commercial sense be described as anything other than slight, nonetheless it may be appropriate to reach a conclusion, in the light of the circumstances as a whole, that the use ought to be regarded as bona fide. (My emphasis).

This is of course a case that was decided under the old law where the requirement was for bona fide use. Nevertheless I think it is accepted that the word “genuine” as used in section 46 of the Trade Marks Act 1994 is not intended to have a material effect on practice in this area, other than to clarify the position by reflecting in the statute what the previous language had come to mean after decades of decided cases under the old law. In so doing it also follows the construction found in the trade marks Directive.

Having regard to the judgment of Whitford J. in *BON MATIN Trade Mark*, and in particular the words (above) which I have underlined, I conclude that the substantiality (or degree) of use is one factor that must be considered in deciding whether use of a mark is genuine. But where, as in this case, it is established that a mark has been used, and the genuineness of such use is not in question, detailed consideration of the substantiality of that use serves no purpose.”

The evidence shows sales, year on year, over a four year period from 1993, and in my view this is a clear indication that the use made has been on a genuine commercial basis. However, the use relates almost entirely to sales of bicycle speedometers and bicycle computers. The registered proprietors say that they have also used the trade mark in connection with protective clothing for cyclists, and by way of example have provided a photograph of a helmet bearing the word EVIAN. In the *NODOZ* trade mark case (1962 RPC 1), Wilberforce J said:

5 “The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the 5 year period. It may well be, of course, that in a suitable case one single act of user of the trade mark may be sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established.”

10 I regard that statement of the position as being as applicable to the new law as it was in relation to the old.

15 The circumstances in NODOZ were that an order (with payment) had been placed with a United States firm from an address in the United Kingdom and goods (tablets) were subsequently dispatched. Company documents from the suppliers giving instruction for shipment of the goods were filed in evidence along with the remittance advice recording receipt of the payment, correspondence dealing with cost of postage and insurance of the goods and an invoice note.

Wilberforce J said:

20 “Those, then, are the documents and nothing more is stated by the deponent who exhibits the documents beyond the fact that the documents have been taken from the records of the company. There is no evidence given that the tablets were in fact delivered to any post office, there is no evidence anywhere that the tablets or the invoice arrived in this country or that they reached Mr Tracy or that they arrived at the General Post Office and
25 awaited delivery to Mr Tracy.”

and

30 “..... it does not seem to me that the evidence which I have heard, which is that an order was received many thousands of miles away in San Francisco or Missouri, and that steps were taken within the company to have the order executed, is sufficient evidence to satisfy the onus which is required. I repeat that, if there had been some more definite evidence of postage or receipt by the post office, I might have been inclined to take a different view; but the matter stops at the internal files and records of the respondent
35 company, and I cannot feel that, where so many steps had to be taken before the goods actually arrived in this country, and where there are so many possibilities of non-delivery, I ought to hold that the arrival of the goods in this country has been established with sufficient certainty.”

40 There is nothing in the evidence to show that any helmets, or indeed any other items of clothing falling within the scope of the specification of goods have ever been sold, and in the circumstances, I do not see how I can conclude that there has been use of the mark in respect of any goods other than bicycle speedometers and bicycle computers.

45 The registered proprietors sought to defend the registration in respect of all of the goods for which it is registered on the basis that they are suppliers of cyclists’ accessories, and that some goods could be regarded as similar to cycle computers. Trade marks on the register are intended

5 to be used, not sit there unused as an impediment to others. As far as similar goods are concerned, these are protected by Section 5 and Section 10 of the Act. In the Invermont trade mark case ([1997] RPC 130) the Hearing Officer said “..the emphasis which is, and has always been placed on the requirements to use a trade mark or lose it.”. I dismiss the arguments advanced by the registered proprietors.

10 I therefore find that the application for revocation is successful, albeit in part, and under the provisions of Section 46 order that the registration be revoked in respect of all goods other than:
Bicycle speedometers and bicycle computers.

15 The application for revocation having succeeded only in part, the applicants are nonetheless entitled to a contribution towards their costs. The registered proprietors sought to defend the registration in respect of all of the goods for which it is registered and I consider therefore that the applicants should be awarded the full costs. I order the registered proprietor to pay the applicant the sum of £835 within seven days of the expiry of the period allowed for filing an appeal or, in the event of an unsuccessful appeal, within seven days of this decision becoming final.

20 **Dated this 12 Day of June 2000**

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Mike Foley
For the registrar
30 **The Comptroller-General**