

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 9952  
BY PLANET SMOOTHIE, LLC  
FOR REVOCATION OF  
TRADE MARK NO 518567 IN THE NAME OF  
JIMMY NICKS PROPERTIES LIMITED**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Application No 9952**

**by Planet Smoothie, LLC**

5 **for Revocation of Trade Mark**

**No 518567 in the name of**

**Jimmy Nicks Properties Limited**

**DECISION**

10

Trade mark number 518567 is for the mark PLANET and is registered in Class 32 in respect of:

Mineral and aerated waters; non-alcoholic beverages.

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The registration currently stands in the name of Jimmy Nicks Properties Limited.

By an application dated 8 January 1998, Planet Smoothie, LLC applied for this registration to be revoked under the provisions of Section 46(1)(b) on the grounds that:

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the registered proprietor for registration No. 518567 or a permitted user has failed to use the trade mark in suit in respect of the goods for which the trade mark is registered during the period of 5 years preceding the date of this application for revocation,

as a consequence of which the applicants ask that the mark be removed from the register.

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The registered proprietors filed a counterstatement in which they say that they have used the trade mark within the relevant period, as proprietor and with the consent of the previous proprietor.

Both sides ask for an award of costs in their favour.

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Both sides have filed evidence in these proceedings, and although neither party took up the offer of a hearing the agent acting for the applicants made submissions in writing in lieu of attending a hearing. Acting on the Registrar's behalf and after a careful study of the evidence and submissions filed, I now give this decision.

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**Registered proprietors' evidence (Rule 33)**

This consists of two Statutory Declarations. The first is dated 17 April 1998, and comes from James Paul Milligan, a Director of Jimmy Nicks Property Company Limited.

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Mr Milligan says that his company is the owner of trade mark registration No. 518567 by assignment from Allied Domecq Retailing Limited, effective from 19 December 1997. He says that he was aware that A.G.Barr plc stood as the registered proprietor, but his company was satisfied that Allied Domecq was the correct owner, and on 6 May 1997 they approached Allied Domecq to request assignment of the PLANET trade mark. Mr Milligan says that his company was not aware of the applicants' interest in the PLANET trade mark until the revocation was filed.

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Mr Milligan says that following Allied Domecq's agreement in August 1997 to assign the mark, his company made preparations to use the mark, and did so from the beginning of September 1997 in relation to bottled soft drinks. He says that the trade mark PLANET FOOTBALL is used on cocktails. Mr Milligan refers to exhibit P1 which consists of:

5 photographs of bottles marked as containing lemonade and bearing the word PLANET and device of a football.

10 a menu from Café Cini in Glasgow, which, under Cocktails has a logo with the words "PLANET FOOTBALL full time" with the device of a football.

Mr Milligan concludes his Declaration saying that the mark has been put to genuine use in relation to the goods covered by the registration, from September to 19 December 1997 with the implied consent of Allied Domecq, and thereafter by his company as the proprietor.

15 The next Statutory Declaration is dated 8 October 1999, and comes from Simon Richard Reeves, Head of Trade Marks at Allied Domecq PLC. He confirms that he has been employed in this company's group trade marks department since 26 April 1993, and has held his present post since 1 December 1995. Mr Reeves says that he is responsible for the trade marks of Allied Domecq PLC and of its subsidiary and affiliate companies, including Allied Domecq Retailing Limited.

20 Mr Reeves says that the trade mark registration which is the subject of these proceedings was formerly owned by Allied Domecq Retailing Limited who had acquired it by assignment from Tizer Limited on 9 September 1993. He says that he was aware that the official records of the United Kingdom Trade Marks Registry incorrectly showed A.G. Barr plc as the registered proprietor. He goes on to set out the chronology of events relating to the trade mark registration, which are as follows:

30 November 1996 trade mark agents acting for Jimmy Nicks Properties Limited contact Allied Domecq to enquire about adopting the trade mark.

6 May 1997 trade mark agents acting for Jimmy Nicks Properties Limited contact Allied Domecq with offer to purchase the trade mark.

35 16 May 1997 terms of transfer agreed subject to rectification of the register to show trade mark Allied Domecq Retailing Limited as registered proprietor.

40 16 July 1997 application for rectification filed by Allied Domecq Retailing Limited.

19 December 1997 Allied Domecq Retailing Limited assign trade mark registration to Jimmy Nicks Properties Limited.

45 9 September 1998 Registrar issues decision to rectify the register to show Allied Domecq Retailing Limited as registered proprietor (exhibit AD1).

Mr Reeves says that in preliminary discussions he confirmed that Allied Domecq Retailing Limited were not using the mark on the goods covered by the registration. He says that when the financial terms for the transfer were settled on 16 May 1997, it was agreed, pending the outcome of the rectification action, that Jimmy Nicks Properties Limited could use the trade mark for the goods for which it is registered, which he says they did from September 1997. He concludes his Declaration by stating that use of the mark by Jimmy Nicks Properties Limited from September 1997 was with the permission of Allied Domecq Retailing Limited.

### Applicants' evidence

This consists of four Statutory Declarations. The first is dated 5 February 1999, and comes from Jennifer Maddox, a partner in W.P. Thompson & Co, the applicants' trade mark attorneys in these proceedings.

Ms Maddox says that her firm was instructed by the applicants to conduct an availability search for the trade mark PLANET, which revealed the existence of registration No. 518567 (then in the name of A.G. Barr plc) details of which are shown at document 1 of exhibit JMM, and subsequently, to investigate whether, and to what extent the mark may have been used, the results of which are shown at document 2 of exhibit JMM. The investigations to determine whether any use had been made of the mark were carried out by Probe International, Inquiry Agents in November 1997. The report confirms that the proprietors (A.G. Barr plc) are primarily a manufacturer of soft drinks, that they sell one range of mineral water under the brand name Findley, and that they do not currently, and had not, at least in the past, made a drink under the PLANET name.

Ms Maddox goes on to give details of contacts with her clients, the agents of record for the PLANET registration, and Allied Domecq plc, copies of the correspondence being shown as documents 3 to 5 of exhibit JMM. Ms Maddox details her investigations into the history of the registration which she says shows:

an assignment from A.G.Barr plc to Allied Domecq Retailing Limited effective from 24 March 1998 (document 6 of exhibit JMM)

the assignment to Allied Domecq Retailing Limited was found to have been wrongly entered because of an earlier assignment between Tizer Limited and Allied Domecq Retailing Limited on 9 September 1993 (decision of the Registrar in Rectification No 9671 dated 9 January 1998,document 7 of exhibit JMM)

that the Form TM16 (document 8 of exhibit JMM) filed to record the assignment of the registration from Allied Domecq Retail Limited to Jimmy Nicks Properties Limited, in which they claim ownership of the mark from 19 December 1997 did not include a copy of an assignment document, and there is no evidence to substantiate the transfer of title.

Ms Maddox notes that the Registrar's decision in the rectification was issued on the day after the application for revocation was filed, and consequently, that at the date that the application was filed the registered proprietors were A.G. Barr plc. She refers to the fact that the counterstatement filed refers to use of PLANET made by Jimmy Nicks Properties Limited and

that there is no reference to this use being with the permission of the proprietor of record. Ms Maddox states that to establish the ownership of the mark will require evidence of a succession of assignments.

5 Ms Maddox refers to the Declaration of James Paul Milligan filed on behalf of the registered proprietors. She comments that he does not say why he believed Allied Domecq to be the true owner of the trade mark, and that there is nothing in the evidence to support his statement that Allied Domecq's agreement to assign the registration implied consent to the use of the PLANET mark by Jimmy Nicks Properties Limited. Ms Maddox states that in any event, Allied Domecq were not the proprietor.  
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Ms Maddox asserts that the evidence does not support Mr Milligan's statement that Jimmy Nicks Properties Limited started to use the PLANET trade mark at the beginning of September 1997 referring in particular to photocopies of photographs of drinks bottles filed as part of the applicants' evidence, and also as document 9 to exhibit JMM.  
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Ms Maddox goes on to refer to the trade mark PLANET FOOTBALL which Jimmy Nicks Properties Limited have applied to register, details of which are shown at document 10 of exhibit JMM, saying that this is the mark that they are, in fact, interested in. She asserts that Jimmy Nicks Properties Limited have acquired the PLANET registration to give them precedence over a co-pending application to register PLANET FOOTBALL, details of which are shown at document 11 of exhibit JMM. She gives her views on the intentions of Jimmy Nicks Properties Limited in relation to the use of the PLANET trade mark, alleging that the evidence filed does not show that genuine or bona fide use has been made of the mark in the relevant period, be it in relation to all, or some of the goods for which it is registered.  
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Ms Maddox says that the registration inhibits fair use of PLANET and similar marks in relation to goods which are not pop, and in particular, by her clients. She concludes her Declaration by describing Jimmy Nicks Properties Limited's rights in the PLANET mark as inequitable based on the use that has been made of the mark.  
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The next Statutory Declaration comes from Robert A Brand IV, Executive Vice President of Planet Smoothie, LLC.

35 Mr Brand says that PLANET SMOOTHIE started up in Atlanta in the United States in August 1995, and consists of stores which prepare made to order beverages from blended ingredients such as fruits with added minerals and vitamins. He refers to exhibit PS1 which consists of brochures relating to the PLANET SMOOTHIE business saying that they intend to expand the business into the United Kingdom. He refers to investigations carried out prior to his company filing their application to register the trade mark PLANET SMOOTHIE, which revealed the existence of the PLANET registration which is the subject of these proceedings, but not that this mark was being used.  
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The next Statutory Declaration is dated 5 May 1999, and comes from Stephen A Keith, a Consultant of Probe International, a firm of inquiry agents.  
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Mr Keith refers to exhibit SAK1, which consists of:

a menu, wine list and till receipt (dated 7 February 1999) from Café Cini.

5 a plastic bottle labelled as containing an orange drink and bearing the word PLANET with the device of a football. The label has been placed over the top half of another label, obscuring the trade mark below. The bottle cap is marked “ BB17 Mar99” which I take to mean “best before 17 March 1999”.

10 a compliment slip and an order list for KRYSTAL KLEAR soft drinks obtainable from Struthers (Lochwinnoch) Ltd..

15 Mr Keith refers to his being instructed to conduct investigations into whether Jimmy Nicks Property Company Limited were selling soft drinks under the trade mark PLANET. He says that he contacted Café Cini and was told that the café stocked PLANET soft drinks which they obtained from a local cash and carry.

20 Mr Keith next recounts a conversation with Richard Cleary, Assistant to the Managing Director of Jimmy Nicks Property Company Limited, in which he was told that in the past year the company had used PLANET in relation to soft drinks which are sold at some of its outlets.

25 Mr Keith says that on 4 February 1999, he was further instructed to obtain a specimen of a PLANET soft drink, ascertain the level of stocks held by Café Cini, and the use made of the PLANET FOOTBALL trade mark by Jimmy Nicks Properties Limited. He recounts a visit to Café Cini in Glasgow on 6 February 1999, stating that behind the bar were approximately 12 bottles of soft drinks bearing the PLANET trade mark. Mr Keith says that on the following day he again visited Café Cini and spoke with the bar manager who confirmed that the PLANET labelled soft drinks were for children and that they did not sell many of them. He says that he bought two bottles and goes on to give his views on the labelling which gave the manufacturer as Struthers (Lochwinnoch) Limited.

30 Mr Keith gives an account of contacts with two other premises operated by Jimmy Nicks Properties Limited in Glasgow, neither of which stocked PLANET soft drinks. He gives details of a telephone call to Struthers (Lochwinnoch) Limited from which he obtained the list of their beverages shown as an exhibit. Mr Keith says that he was told that the company supplies drinks to licenced premises but they were not aware that Jimmy Nicks Properties Limited or Café Cini were clients. Mr Keith gives his views on the actions of Jimmy Nicks Properties Limited.

The final Declaration is a second Statutory Declaration dated 4 May 1999 from Jennifer Maddox.

40 Ms Maddox refers to the PLANET drinks bottle filed as an exhibit by Stephen Keith, the inquiry agent engaged to carry out investigations into the use of the PLANET trade mark. She comments on the origins and manner in which the PLANET label has been applied stating that it does not constitute genuine commercial use. She says that the PLANET drink had been sold through Café Cini only, and that those on the shelf at that establishment were left over from the batch prepared for the photographs. She gives her views on the likelihood that Café Cini stocking cheap bottles of pop and why the bottles had been re-labelled, concluding that this was not commercial use but  
45 a ploy to prevent the registration from being removed on grounds of non-use.

### **Registered proprietors' evidence (Rule 13(6))**

This consists of two Statutory Declarations. The first is dated 3 November 1999, and is a second Declaration of James Paul Milligan.

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Mr Milligan refers to the trade mark registration which is the subject to these revocation proceedings, and sets out details of the chronology of events leading to the assignment of the registration to Jimmy Nicks Properties Limited. He says that prior to the application for revocation his company was unaware of the interest of Planet Smoothie, LLC.

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Mr Milligan gives details of his company's business, which he says involves the operation of pubs, bars, café bars and night clubs in the Greater Glasgow area. He says that some of these venues hold licences which enables children to accompany their parents, and that his company is interested in developing family orientated bars and restaurants and an appropriate range of soft drinks for use in his company's premises and for general distribution.

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Mr Milligan gives his views on the suitability, and possible uses of PLANET as a trade mark for non-alcoholic beverages aimed at children, inter alia, by the use of novelty containers. He says that his company does not manufacture its own soft drinks, but in August 1997 made arrangements to obtain supplies from Struthers (Lochwinnoch) Limited with whom they had an agreement that the drinks would be re-labelled with the PLANET trade mark. He refers to exhibit P1 which consists of copies of photographs of bottles of lemonade bearing the PLANET name with the device of a football. Mr Milligan says that the first supplies were obtained in September 1997 and "tested" at Café Cini and three establishments owned by third parties, and that PLANET drinks continue to be sold at these venues. He says that between September 1997 and 8 January 1998 his company sold 25 cases of PLANET drinks, and 75 cases in total.

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25

Mr Milligan says his company decided to proceed with the development of novelty containers for PLANET soft drinks, and that discussions took place with George B Frew, Sales Manager of Struthers (Lochwinnoch) Limited (a later Declarant) for the supply of drinks, with a German designer of novelty containers (who has submitted prototypes) and with Scot Stern a design and marketing consultancy. Mr Milligan gives reasons why his company has not proceeded with the production of novelty containers, namely, other business ventures, costs of development and the pending action to revoke the trade mark.

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Mr Milligan concludes his Declaration saying that his company has put the mark into genuine use and has built up an appreciable goodwill in the Greater Glasgow area in relation to non-alcoholic beverages sold under the PLANET trade mark, and has plans to develop this use further.

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The final Statutory Declaration is dated 3 November 1999, and comes from George B Frew, Sales Manager of Struthers (Lochwinnoch) Limited, who confirms that he has been with this company for 25 years.

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Mr Frew says that his company has been supplying soft drinks to Jimmy Nicks Properties Limited to be sold under the trade mark PLANET since September 1997. He refers to discussions with that company in August 1997 regarding the supply of a range of soft drinks to be marketed as PLANET soft drinks, saying that he was told that the drinks would be market tested by Jimmy

Nicks properties Limited, and if successful, the company would consider developing a novelty container to market drinks to children.

5 Mr Frew says that while the test launch was underway, it was agreed that Jimmy Nicks Properties Limited would apply their own label to the drinks supplied by his company, ensuring that the food labelling content of the original label remained visible. He refers to exhibit P1 which he says shows examples of the manner in which Jimmy Nicks Properties Limited is using the trade mark on drinks with the approval of his company. The exhibit consists of copies of the same photographs of bottles of lemonade bearing the PLANET name with the device of a football referred to as exhibit P1 by Mr Milligan.

15 Mr Frew confirms the date of the first delivery of soft drinks to Jimmy Nicks Properties Limited, and corroborates the volume of sales given by Mr Milligan. He says that he understand the company were satisfied with the reaction to its PLANET drinks and decided to proceed with the development and launch of its novelty containers, and that in 1998 discussions took place between himself and Jimmy Nicks Properties Limited for the supply of drinks. Mr Frew says that his company recommended a German designer of novelty containers, and that he understands some designs ave been produced, but because of the high costs Jimmy Nicks Properties Limited have postponed the development and the general launch of PLANET drinks. He concludes his Declaration saying that his company continues to supply Jimmy Nicks Properties Limited with beverages to be re-labelled PLANET.

### Decision

25 That concludes my review and I turn to consider the respective grounds upon which the application for revocation has been brought. The Statement of case refers to Section 46(b) which, from the wording, I take to mean Section 46(1)(b) of the Act, which reads as follows:

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

40 The attack is made under (b) of the above, but I have included (a) because it tells us what “such use” means.

45 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. In this case the registered proprietors claim that there has been genuine use of the mark in the relevant period and do not, therefore, seek to rely on the defence of there being “*proper reasons for non use*”.

The proviso in subsection (3) to Section 46 discounts any use made within the three months prior to the application for revocation being made, that is, unless preparations to use the mark commenced earlier and before the proprietor became aware that the application may be made. In this case the application was made on 8 January 1998, which means that to save the registration the use or preparations for use must have been made prior to 8 October 1997, and before they became aware of the applicants' interest.

Turning first to the question of the ownership of the registration. Although the decision in the rectification number 9671 is dated the day after the date of filing of the application for revocation, the decision deemed the assignment to A.G.Barr plc as having never been made, and that with effect from 9 September 1993 the registration was owned by Allied Domecq Retailing Limited. Consequently, I am satisfied that that company was entitled to consent to the use, and ultimately, transfer the ownership of the registration to Jimmy Nicks Properties Limited.

The mark is registered for mineral and aerated waters and non-alcoholic beverages. However, the only use claimed by the registered proprietors is in respect of soft drinks and even without a detailed consideration of the evidence it is clear that the revocation must succeed, at least in part. In relation to soft drinks, the registered proprietors say that some 25 cases have been sold at four locations in the Greater Glasgow area. There is no indication of the number of bottles in each case or the value of these sales, but I do not think this is of any great importance, for if it is shown that the mark has been used, and the genuineness of the use is not in question (substantiality being one factor) then a consideration of the extent of the use serves no useful purpose.

What is meant by "genuine use"? In the *Crate & Barrel* case (2000 All ER (D) 1050), Jacob J considered the matter in the following passages:

"Assume, however there were these three things, namely the packaging on a few items posted at the US customer's request to the UK, gift registry sales, and a tiny amount of spillover advertisements in what the reader in the UK would know are US journals. Do they individually or collectively amount to "genuine use" of the UK registered mark? Miss Vitoria contends they do. She says the reference to "genuine" is merely in contradistinction to "sham". Small though the use may have been, there was nothing fake about it. The mark appeared in the UK in connection with genuine transactions and that is enough.

I disagree. It seems to me that "genuine use" must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be "sham." This to my mind shows that Miss Vitoria's gloss on the meaning of "genuine" is not enough. And the only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in the US."

Section 46 does not specify any restrictions on the type of use that can qualify. Kerly's Law of Trade Marks and Trade Names, Thirteenth Edition, comments as follows at 9-50:

5 "Furthermore, it is suggested that, to constitute genuine use, the use relied upon must be use in the course of a trade. In this context, the proviso to Section 46(3) draws a clear distinction between use and preparations for use. That is a powerful indicator that preparations for use do not constitute use, although it may be quite difficult to fix the line between the two. It is suggested that a trade in the goods or services in question must have commenced. Test marketing ought to be sufficient. Orders placed on component  
10 suppliers using the mark were held bona fide use under the 1938 Act, but that is probably too thin to constitute "genuine use" under the 1994 Act. Equally, purely internal deliberations about use of the mark should not be sufficient. In all cases, the decision is whether genuine use has been established."

15 In the NODOZ, trade mark case (1962 RPC1) Wilberforce J said:

20 "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. ...."

25 and

30 "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 awaited delivery to Mr Tracy."

35 and

40 "..... 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 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  
45 sufficient certainty."

Although that case was decided under the Trade Marks Act 1938, I regard those statements as being as applicable to the issue of use under new law. Briefly, the circumstances in the NODOZ case were that an order (with payment) had been placed with a US firm from a UK address. Goods (tablets) were subsequently dispatched. Internal 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.

The registered proprietors say that on 16 May 1997 they reached agreement in principle with Allied Domecq Retailing Limited to have the registration for the mark PLANET assigned to them, in August 1997 they began preparations to put the mark into use, and did so with effect from early September 1997. The assignment subsequently took effect from 19 December 1997. It is not known whether Allied Domecq had ever used the mark; there is no evidence that they did. What is known is that in May 1997, and possibly as far back as November 1996 the mark was not in use.

The registered proprietors are given some support by the Declarations of George Frew, Sales Manager of Struthers (Lochwinnoch) Limited and Simon Reeves, Head of Trade Marks at Allied Domecq PLC. In his Declaration Mr Frew says that in August 1997 his company agreed to supply soft drinks to Jimmy Nicks Properties Limited to test the market reaction to drinks sold under the PLANET mark, and that they have done so since September 1997. He does not, however, say (perhaps because he is not in a position to do so) that any of these drinks were put on sale in September 1997, or in fact, that they have been on sale at any time within the relevant period. Mr Reeves in turn says that he is aware that Jimmy Nicks Properties Limited commenced use of the trade mark from September 1997, but does not say how he knows this to be the case. He also describes the use as being in respect of non-alcoholic beverages, whereas it is clear from the evidence that at best, Jimmy Nicks Properties Limited may have used the mark in connection with a limited variety of soft drinks, somewhat narrower than the term “non-alcoholic beverages”. Whilst I have no reason to doubt the veracity of Mr Frew’s and Mr Reeves’ Declarations, I find them to be too lacking in detail to be of much if any assistance.

The applicants are critical of the labels affixed to the bottles, saying that they appear to be a computer generated version of the registered proprietors’ PLANET FOOTBALL trade mark but with the word FOOTBALL deleted. That may well be the case, but so what? The labels may have the appearance of something produced in a hurry which could be taken to be an indication that they were cobbled together to get the mark into use and fend off any attack on the registration, but in the absence of evidence I am reluctant to draw this inference, at least, not solely from the quality of the labels.

The registered proprietors say that they felt free to use the mark from 16 May 1997. The labels are unsophisticated and with today’s technology could have been quickly and easily produced, particularly so given that the design is clearly part of the registered proprietors’ existing PLANET FOOTBALL trade mark. Supplies of the soft drink seem to have been readily available yet they did not begin their preparations to use the mark until mid-August, and did not put the mark into use until September of that year. No explanation is given for this delay.

I am also slightly troubled by the unusual vagueness of the date of the meeting said to have taken place between Mr Frew, Mr Milligan and Mr Boyle in “August 1997”, and of the date of the first

supply of the beverages which must have been obtainable from invoices or stock records. These are, however, issues which could have been dealt with in cross examination, but in the absence of which I take the evidence at face value, and for what it is worth.

5 There is a total absence of any credible corroborative evidence such as appointment books, correspondence, minutes, delivery notes, till receipts etc, all records routinely produced by a business, to support the claim to having commenced preparations in August 1997, and apart from some undated photographs of bottles in a chilled cabinet (which proves very little) there is nothing which establishes that there has been any use of the mark, at least not within the relevant period.  
10 The most that the registered proprietors could say is that at best, some 7 or 8 weeks before the start of the three month “exclusion” period prior to the date of application, they sold an unspecified quantity of some soft drinks in Glasgow. As Wilberforce J. said in *Nodoz*, “ .....the fewer the acts relied on the more solidly ought they to be established.“. In this case the registered proprietors have not demonstrated that they have put the trade mark in suit into genuine use in  
15 relation to any of the goods for which it is registered, and I have no difficulty in finding the application for revocation to be successful.

In this case the registered proprietors claim that there has been genuine use of the mark in the relevant period and do not, therefore, seek to rely on the defence of there being “*proper reasons for non use*”.  
20 However, in their evidence in defence of the registration they mention the preparations that they made to use the mark, including the testing of the product on the market, and give three reasons to explain why they have not gone ahead, namely; the owner being busy with other ventures, development costs and the pending revocation action.

25 In the *Invermont* trade mark case [1997] RPC 130, the Registrar's Hearing Officer considered the meaning of the words “proper reasons for non use”, and drawing a distinction between the wording of Section 26(3) of the Trade Marks Act 1938 and the provisions of Section 46(1)(a) of the 1994 Trade Marks Act said:

30 “Moreover, the word “proper” appear, rather than the slightly more restrictive word “special”. The reasons do not have to be special, it seems merely “proper”. As can be seen in any English dictionary, “proper” is a word with many meanings. But bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirements to use a trade mark  
35 or lose it, I think the word proper in the context of Section 46 means:-“apt, acceptable, reasonable, justifiable in all the circumstances

“.....He describes difficulties which by his own admission are normal in the industry concerned and in the relevant market place. I do not think that the term “proper” was  
40 intended to cover normal situations or routine difficulties. I think it much more likely that it is intended to cover abnormal situations in the industry or market, or even in perhaps some temporary but serious disruption affecting the registered proprietor's business. Normal delays occasioned by some unavoidable regulatory requirement, such as the approval of a medicine might be acceptable but not, I think, the normal delays found in the  
45 marketing function. These are matters within the businessman's own control and I think he should plan accordingly....”.

The Hearing Officer concluded that distinct from the decision in James Crean & Sons [1921] 38 RPC 155, the wording of Section 46 of the 1994 Trade Marks Act did not restrict the circumstances to those affecting the trade as a whole, and that disruptive situations affecting the registered proprietor's business alone could be proper reasons within the meaning of this section of the Act. In the Bali trade mark case [1966] RPC 387 at 406, Ungood-Thomas J gave consideration to the matter of "special circumstances" saying:

"A trade mark is a commercial asset intended to be used commercially by businessmen, and "special circumstances" have to be understood and applied in a business sense.

The Hearing Officer in Invermont adopted a similar approach saying ".bearing in mind the need to judge these things in a business sense.". It seems to me that any business proposing to launch a new product will be aware that there will be development costs, and I cannot see that this can be a proper reason for non use.

Whilst I can have some sympathy with the registered proprietor's reluctance to commit to the expense of launching the product until the outcome of these proceedings is known, I cannot accept this as a proper reason for non use. To do so would in my view give an unjustifiable straw for this, and other owners of trade marks to cling to. As for the proprietors being busy on other ventures I can do no better than to endorse the comments of the Hearing Officer in Invermont where he said "...use a trade mark or lose it."

For the reasons set out above I find that the registered proprietors have not discharged the onus placed upon them in establishing that there are proper reasons for non use of the trade mark, and consequently, that the application for revocation under section 46(1) succeeds.

The applicant for revocation, having been successful they are entitled to a contribution towards their costs. I order the registered proprietors to pay to the applicants for revocation the sum of £635, the costs are 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 2<sup>nd</sup> Day of April 2001**

**M Foley**  
**For the registrar**  
**The Comptroller-General**