

## TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 10679  
BY D. JACOBSON & SONS LIMITED  
FOR REVOCATION OF TRADE MARK No 1420776  
**ROY OF THE ROVERS**  
STANDING IN THE NAME OF  
EGMONT FONDEN

### **DECISION**

1) The trade mark **ROY OF THE ROVERS** is registered under number 1420776 in respect of:

Class 9: "Electric, photographic, teaching, telephonic, audio, video and cinematographic apparatus and instruments; computers, computer programs, apparatus for recording, transmission or reproduction of sound or images; automatic slot machines; amusement machines and apparatus; animated cartoons; spectacles, spectacle cases and frames; films; computer games; apparatus for games adapted for use with television receivers; helmets; holograms; juke boxes; identity cards; kaleidoscopes; mirrors; phonograph records; magnetic tapes; protective clothing; radios; record players; sirens; alarms; parts and fittings for all the aforesaid goods; all included in Class 9."

Class 16: "Printed matter; books, magazines, newspapers; playing cards; photographs; stationery; instructional and teaching material (except apparatus); parts and fittings for all the aforesaid goods; all included in Class 16."

2) The mark has a disclaimer which states; "Registration of this mark shall give no right to the exclusive use of the word "Roy"".

3) The application for registration was made on 2 March 1990 and the mark was placed on the register on 11 September 1992. The registration stands in the name of Egmont Fonden of Vognmagergade 11, DK- 1148, Copenhagen K, Denmark following an assignment from the original proprietor, Maxwell Consumer Publishing & Communications Limited, on 3 December 1992.

4) By an application dated 14 April 1999, D. Jacobson & Sons Limited applied for the revocation of the registration. The grounds were in summary that the mark has not been used in the UK for a continuous period of five years up to the date of three months before the date of the application for revocation and that there are no proper reasons for non-use.

5) On 21 July 1999 the registered proprietor filed a counterstatement denying the allegations.

6) Included with the counterstatement was a declaration, dated 20 July 1999, by Michael Main a director of Egmont Fleetway Limited which is a wholly owned subsidiary of Egmont Holding Ltd, which in turn is a wholly owned subsidiary of Egmont International A/S of Denmark, which in turn is a wholly owned subsidiary of Egmont Fonden, the proprietor of the mark in suit.

7) Mr Main confirms that he has access to all relevant records of his company and those of Egmont Fonden relating to use of the mark in suit in the UK.

8) Mr Main states that the best known use of the mark in suit has been in relation to a character in a comic strip. He also states that “over the past five years there has been extensive use of the trade mark in the United Kingdom in relation to a variety of products”. He then provides the following list of licensees and goods:

Licensee	Contract term	Articles
Gremlin Graphics	1/10/88 - 30/9/91	Computer Games
Leisure Company	1/7/91 - 30/6/92	Football Shirts
Scottish TV	01/12/92	Use of Material for TV Programme
Sam Tam Publishing	1/1/92 - 31/3/93	Football Kit, Shirts, Socks Gloves
Palcom Ltd	1/4/92 - 30/6/93	Board Game
Egmont World	1/1/93 - 31/12/93	Hardback / Paperback Story Books
Ravette Publishing	1/1/93 - 31/12/94	Comic Strip Books
Lennard Associates	1/7/94 - 30/6/99	Official Autobiography

9) Mr Main also claims that:

- A magazine entitled “Roy of the Rovers - The Playing Years” was published in 1994
- A character known as “Roy of the Rovers” was used on the front cover and inside the magazine “Playstation” in 1997
- Since 1996 there has been a two page picture strip each month in the BBC’s worldwide “Match of the Day” magazine. The shirt worn by this character has been sponsored by McDonalds since 1996. As part of the McDonalds sponsorship a Father’s day card was given away with “Shoot” magazine in June 1998, and then on a Father’s day card given away by McDonalds’ restaurants in June 1999. Both cards featured the mark in suit.

10) At exhibit MM1 is a “Match of the Day” magazine dated June 1999 which has a comic strip entitled “Roy of the Rovers”. In addition there is a “Play station” magazine with the date May 1997 handwritten on it which has a cartoon footballer on the front cover who is referred to as “Roy” by another character. Lastly in this exhibit is a page entitled “Roy of the Rovers - The Playing Years” again hand dated 1994 which shows simply a drawing of a football scene.

11) Exhibit MM2 shows an exert from The Evening Standard hand dated 4 May 1999 referring to a McDonald’s competition “to feature in the Roy of the Rovers”.

12) Both sides ask for an award of costs. Both sides filed evidence and the matter came to be heard on 28 March 2001, when the applicant was represented by Mr Marsh of Messrs Wilson Gunn M’Caw. The registered proprietor was represented by Ms O’Rourke of Messrs Dechert.

## APPLICANT'S EVIDENCE

13) The applicant for revocation filed a declaration, dated 19 November 1999, by Harvey Jacobson the Managing Director of D Jacobson and Sons Ltd a position which he has held for seventeen years.

14) Mr Jacobson makes a number of points regarding the proprietors' counterstatement:

- As the application for revocation was filed on 13 April 1999 any usage of the mark in suit prior to 13 January 1994 is not admissible.
- The first six licences listed by the proprietor are prior to the relevant date. Only the licences to Lennard Associates and Ravette Publishing are within the relevant period. No corroborative evidence is supplied relating to use by these licensees. These two licences refer only to comic strip books and an autobiography (presumably a book).
- None of the alleged use refers to goods in Class 9. What use is claimed refers only to printed publications and the exhibits at MM1 and MM2 do not demonstrate trade mark usage as defined under Section 1 of the Trade Mark Act 1994.

## REGISTERED PROPRIETOR'S EVIDENCE IN REPLY

15) Mr Main filed a second declaration, dated 25 February 2000, which contained a number of exhibits.

16) At exhibit MM1 to this declaration are copies of the cover and introductory pages of the autobiography "Roy of the Rovers - The Playing Years". This shows that the book was first published in the UK in 1994.

17) At exhibit MM2 is a copy of a book entitled "Roy of the Rovers - Eastern Promise". Published by Ravette Publishings the book was first published in 1993.

18) At exhibit MM3 is an invoice from the proprietor to BBC Publications which is for the McDonald's sponsorship of the "Roy of the Rovers" strip in the BBC's "Match of the Day" magazine dated July / Aug 1999.

19) At exhibit MM4 is a comic strip from 1997 which shows the players in the cartoon strip with shirts sponsored by McDonalds.

That concludes my review of the evidence. I now turn to the decision.

## DECISION

20) With all of the evidence in mind I now turn to consider the grounds of revocation. These are found in Section 46(1) which, in so far as it is relevant, reads as follows:

*"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;*

21) Section 100 of the Act is relevant as it clarifies where the overall burden of proof rests in relation to the question of use. It reads:

*“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”*

22) Where it is claimed 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 the registered proprietor, or failing this the onus, in my view, stays with the registered proprietor to establish that there are “*proper reasons for non-use*” if the mark is to remain registered.

23) The relevant period has been explicitly specified in this case and is the five years prior to the date of the application for revocation 13/1/94 - 13/1/99.

24) The registered proprietor has not sought refuge under Section 46(1)(b), providing no arguments as to reasons for non-use. At the hearing Ms O’Rourke acknowledged that the proprietor sought only to defend “Protective Clothing” in Class 9, and “Books, magazines stationery and printed matter” in Class 16.

25) I have to determine whether the proprietor has shown evidence of use of the mark in suit within the relevant period and also whether such use amounts to “genuine use” as required by Section 46(1). In *BON MATIN* [1989] RPC 537 at page 543 Whitford J. commented:

“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 applications 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 name 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 any bona fide use. Although the extent of the use is a 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.”

26) I accept that the *Bon Martin* case was concerned with the Trade Marks Act 1938 where the statutory language in Section 26 focussed on whether or not the use had been “bona fide”, whereas under the new law the reference in Section 46 of the 1994 Act is to “genuine use”. However, in my view no substantial change in the law has been brought about by the different use of language and the above remarks are still apt in relation to the new law. Therefore, substantiality is a factor to be considered within the overall test of genuineness and not a separate hurdle that a registered proprietor must overcome.

27) I also take into account the comments of Wilberforce J. in *Nodoz* Trade Mark [1962] RPC1 where at page 7 he said:

“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 five 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 upon it does seem to me that the 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....”.

28) Again, although this statement relates to the position under the old law it is still apt under the 1994 Act. I must therefore consider whether evidence provided constitutes use in the relevant period, and if it does whether the use shown is in relation to the goods at issue and of a nature and scale that amounts to “genuine use” in relation to the goods for which the mark is registered.

29) I will first consider the evidence relating to protective clothing. Ms O’Rourke asserted that the proprietor had shown use of the mark in suit in relation to football shirts. The evidence for this was stated to be the sponsorship deal with McDonald’s for the “M” logo to appear on the shirts of the players in the “Roy of the Rovers” cartoon strip. I was referred to the invoice from the proprietor to BBC publications relating to the sponsorship of the “Roy of the Rovers” cartoon strip in the “Match of the Day” magazine. In addition I was referred to the Evening Standard article, at exhibit MM2, dated 4 May 1999 which refers to “a mounted Roy of the Rovers kit.....and it was signed by Roy Race himself”. The shirt is clearly similar in design to that worn by the cartoon character Roy Race and had the McDonald’s “M” logo and a badge showing MRFC which presumably stands for Melchester Rovers Football Club. There is no indication of the mark in suit on the shirt.

30) I do not accept that the sponsoring of a football shirt in a cartoon strip constitutes use on football shirts. The press article actually is in relation to a competition run by McDonald’s and is not genuine use of the mark. Further, despite the assertions of Ms O’Rourke, football shirts do not come under the heading of “protective clothing” as they offer no more protection than an ordinary shirt.

31) The registered proprietor has therefore failed to show use of the mark on “Protective Clothing” in Class 9.

32) With regard to the Class 16 registration the registered proprietor asserted that the mark had been used on a number of products. I shall consider each assertion of use in turn.

33) Firstly, the claim of use on “Father’s Day” cards in June 1998 and 1999, when they had been given away firstly by “Shoot” magazine and then by McDonald’s restaurants. No corroborative evidence was provided to show whether or how the mark appeared on the cards or how many were handed out and whether the offer was in any way limited geographically. In my view the onus placed on the registered proprietor by Section 100 requires more than the simple assertion of use in a declaration.

34) Aside from assertions of use the proprietor has provided six exhibits in total in this case. Of these only two have dates which are within the relevant period. These are exhibits MM1 and MM4 attached to the second declaration provided by Mr Main. MM1 is an autobiography of “Roy Race” and is entitled “Roy of the Rovers - The Playing Years” which has a “first published” date of 1994. Whilst exhibit MM4 is a comic strip titled “Roy of the Rovers” and is from a “Match of the Day” magazine. The only date on this exhibit is a copyright date of 1997.

35) The book was produced under licence by Lennard Associates. However, no sales figures or even royalty details have been provided. It is not clear that the book was offered for sale in the UK as no details of stockists or publicity being provided. Similarly, it is not clear which edition of the “Match of the Day” magazine the comic strip was printed in. No sales or circulation figures are provided.

36) The Registrar would normally expect the registered proprietor to provide details of turnover or profit from sales, circulation figures, advertising and promotional expenditure, details of where and when the goods were offered for sale or even declarations from the third parties involved such as the licensee or BBC publications in defence of their registration. None of these has been provided in these proceedings.

37) In my view the registered proprietor has failed to show genuine use of the mark on goods in Class 16 during the relevant period.

38) In the event, therefore I conclude that the application should be allowed. Registration No 1420776 will be revoked in its entirety from the date of the application for revocation.

39) There remains the matter of costs. Both sides agreed that there was no reason to go beyond the normal Registry scale. The application for revocation having succeeded the applicant is entitled to a contribution towards costs. Therefore, I order the registered proprietor to pay the applicant the sum of £1035 as a contribution towards costs. This sum 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 30<sup>TH</sup> day of April 2001

George W Salthouse  
For the Registrar  
The Comptroller General

