

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No 922508
STANDING ON THE REGISTER IN CLASS 16
IN THE NAME OF KONINKLIJKE TALENS B.V.**

AND

**IN THE MATTER OF APPLICATION FOR REVOCATION No 10193
IN THE NAME OF LIDL STIFTUNG & CO KG.**

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in the name of Koninklijke Talens B.V.**

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**IN THE MATTER OF Application for Revocation No 10193
in the name of Lidl Stiftung & Co KG.**

BACKGROUND

1. Trade Marks Registration No. 922508 was entered onto the Register on .
The trade mark is as shown below:



and is registered in respect of the following:

Class 16:

Stationery, adhesive materials (stationery), artists' materials (other than colours or varnish), paint brushes and office requisites (other than furniture).

2. The registration stands in the name of Koninklijke Talens BV of Apeldoorn, Holland.

3. In an application dated 30 June 1998, Lidl Stiftung & Co KG of Neckarsulm, Germany have, under the provisions of Section 46 of the Trade Marks Act 1994, sought the complete revocation of the registration, or the limitation of the registration to the specific goods on which the trade mark has been used. The applicants for revocation state that they are not aware that the registered proprietor's have used the trade mark in relation to any of the goods covered by the registration in the last five years.

4. The registered proprietors denied the allegations and in a Statutory Declaration dated 30 September 1998, Johannes Gesinus Bax, the registered proprietors' Managing Director stated that the trade mark in suit had been used by his company since 1935 and that the goods upon which it was used were "stationery, artists' materials and paint brushes". He exhibited price lists showing use of the trade mark together with copies of various invoices in support of the claim to use of the trade mark in suit. The applicants subsequently stated in a letter to the Trade Marks Registry dated 14 June 1999 that they were seeking the revocation of the registration insofar as it covered 'artists materials' (other than colours or varnish) and paint brushes.

5. Both sides subsequently filed further evidence and, under the Trade Mark Registry's Practice, the case was reviewed by a Hearing Officer who determined that an oral hearing was not necessary in order that the dispute between the parties could be determined. Neither Elkington & Fife on behalf of the applicants' for revocation or Trade Mark Owners Association Limited on behalf of the registered proprietors' demurred. Therefore, after a careful review of the pleadings, evidence filed by the parties, and written submissions provided by Elkington & Fife on behalf of the applicants for revocation I give this decision.

DECISION

6. In response to the registered proprietor's evidence of use filed with their Counterstatement the applicants for revocation filed evidence, this consisted of a Statutory Declaration dated 27 May 1999 by Jacqueline Lake a Director of Farncombe International Limited, a firm of investigators. She states that she was instructed by Elkington & Fife to conduct an investigation into the use made in the United Kingdom of the trade mark the subject of these proceedings.

7. Jacqueline Lake's firm conducted an investigation by approaching Royal Sovereign Limited, the registered proprietor's distributor in the United Kingdom. Royal Sovereign subsequently supplied a "Royal Sovereign Creative Art Supplies Price List" dated 1 February 1999 shown as Exhibit JL1. Ms Lake goes on to state that the various brochures contained within the price list showed various ranges of products, and I will return to these later.

8. The registered proprietor's then filed evidence. There are two Statutory Declarations from Mr Mahomed Hussein Daud, a Trade Mark Attorney working for Trade Mark Owners Association Limited and dated 4 December 1998 and 10 December 1998. Mr Daud makes the declarations on the basis of information provided by Mr Phoet, the Marketing Manager of the registered proprietors. Mr Daud states that he is informed that the goods covered by registration 922508 and which have been sold in the United Kingdom are considered to be covered by the general term "stationery, artists' materials and paint brushes". He then goes on to list specific products shown in Exhibit MHD1. Again, I will come back to these later. Mr Rudolf Gerardus Wilmer, Director Marketing and Sales of the registered proprietor's filed an Affidavit dated 19 June 2000. He too sets out details of the products upon which the trade mark in suit has been used. Shown in Exhibits A, B, C and D.

9. That concludes my summary of the evidence insofar as it is relevant at this point.

Section 46(1)(a) and (b) state:

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;

10. In this case the applicants for revocation states that, in their view, they are not aware that the proprietor's have used the registered trade mark in relation to the goods of the registration "in the last five years". Thus, I take that to mean from the date of the application for revocation and thus the five year period goes back to 30 June 1993. Both the applicants for revocation evidence and the registered proprietors' evidence shows, in my view, that the trade mark in suit has been used in the United Kingdom within the relevant period. Thus, there are no grounds as far as I can see for the complete revocation of the trade mark as acknowledged, I think, by the applicants subsequent limitation of the scope of the action. I go on to ask myself therefore what goods the trade mark has been used upon bearing in mind the limited scope of the application. As stated earlier in the decision the specification of goods is as follows:

Stationery, adhesive materials (stationery), artists' materials (other than colours or varnish), paint brushes and office requisites (other than furniture).

11. In my view, the term 'stationery' is very wide. In *Deacon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293 Mr Justice Pumfrey, quoting a line of authorities, indicated that in proceedings such as those before me, a registration should be limited to those goods (or services) upon which the registered proprietor has actually shown use. In those circumstances and taking into account the evidence before me, and in particular, the lists of goods provided by both the registered proprietors (in the exhibits attached to the Statutory Declarations of Mr Daud and Mr Wilmer) and in the evidence of the applicants for revocation (Jacqueline Lake's Statutory Declaration) I reach the view that the registered proprietor has not shown use of the trade mark across the whole of the specification of their registration. The exhibits which are catalogues and price lists indicate clearly that the registered proprietor trades in artists materials. There is no indication that they trade in any items which could be termed stationery or office requisites. Thus there is no case for not removing from the specification of goods covered by the registration, those items. Section 46(5) therefore which states:

46.-(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

12. I therefore order the registration the subject of these proceedings, No. 922508, to be revoked in part by the removal of the terms stationery, adhesive materials (stationery) and office requisites (other than furniture) because the registered proprietor has not shown use on all of these goods and for which the trade mark is registered. Thus, the specification of goods should be limited to the following upon which use has been shown.

Artists' materials (other than colours or varnish); crayons, brush mats, water colour saucers, liquid masking film, brushes, palette knives, palette cup, paper, water colour pads, water reservoir, pencils, natural sponges, palettes, charcoal, ink, ink wells, drawing pads, paint boxes.

13. In accordance with Section 46(6) this registration is revoked in part with effect from the date of the application for revocation.

14. The applicant for revocation has succeeded in their action and are thus entitled to an award of costs. I therefore order the registered proprietor's to pay to the applicants for revocation the sum of £600. This sum is 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 13 day of November 2001

**M KNIGHT
For the Registrar
the Comptroller-General**