

TRADE MARKS ACT 1994

IN THE MATTER of Trade Mark Nos 1479665 & 1479350 in the name of Michael Lefort trading as M L Associates

and

IN THE MATTER OF consolidated proceedings, applications for revocation Nos 11420 & 11421 by Formula One Licensing B.V.

Background

Trade Mark 1479350

1. On 12 October 1991, Parfums Lefort applied for the trade mark FORMULA ONE. The application was accepted, published and proceeded to registration on 15 October 1993. The registration carries the following disclaimer, "Registration of this mark shall give no right to the exclusive use, separately, of the words "Formula" and "One". The specification of goods reads:

Class 3

Toiletries; cosmetics; body sprays; anti-perspirants; deodorants; cosmetic preparations for skin care; perfumes; perfumeries; eau-de-cologne; after shave preparations; pre-electric shaving preparations; all included in Class 3

Trade Mark 1479665

2. On 16 October 1991, Parfums Lefort applied for the trade mark shown below. The application was accepted and published and proceeded to registration on 8 April 1994. The specification of goods reads:

Class 3

Toiletries; cosmetics; bath preparations; body sprays; anti-perspirants; deodorants; cosmetic preparations for skin care; perfumes; perfumeries; eau-de-cologne; after shaving preparations; pre-electric shaving preparations; all included in Class 3.



3. On 4 December 1997, Urquhart-Dykes & Lord filed Form TM16 requesting that the registrar record a change of proprietor for both registrations as set out in the accompanying documentation. Attached to the Form TM16 was a document which purported to record the assignment of trade marks 1479350 and 1479665. The assignor is shown as PARFUMS LEFORT and the assignee as MICHAEL LEFORT T/A ML ASSOCIATES. The assignment was duly recorded and so both registrations stand in the name of Michael Lefort T/A ML Associates.

4. On 2 February 2000, Formula One Licensing BV filed an application for revocation on Forms TM26 against each registration. The statement of grounds accompanying each Form TM26 set out a single ground of revocation in respect of each registration. That ground of revocation can be summarised as follows:

that there has been no genuine use of the trade mark registrations 1479350 and 1479665 by the proprietor or with his consent in relation to the goods for which the marks are registered for an uninterrupted period of five years preceding the date of the application for revocation. The applicants' seek revocation under the provisions of section 46(1)(a) of the Trade Marks Act 1994.

5. The registered proprietors filed counter-statements and notices of the same on Form TM8 denying the ground of revocation. In accordance with the requirements of rule 31(3) of the Trade Mark Rules 1994, if the registered proprietor intended to defend his registrations he was required to file evidence of use of the trade mark. In accordance with rule 31(3), the registered proprietor filed two witness statements by Mr Michael Lefort, the registered proprietor, both are dated 16 May 2000. I summarise this evidence below.

6. A period was set for the applicants for revocation to file evidence in support of their application. The applicants sought consolidation of these proceedings and the proceedings were consolidated in the Official letter of 27 February 2001. The applicants' evidence consists of a witness statement by Mr Laurence Leader dated 12 October 2000. In so far as it is necessary, I summarise this below. A period was set for the registered proprietor to file evidence in support of his registrations this period was extended but no evidence was filed.

7. The matter came to be heard before me on 15 January 2002. The applicants were represented by Mr McLeod of McDermott Will & Emery. The registered proprietor, Mr Michael Lefort, represented himself.

Evidence

Registered Proprietor's Evidence filed under rule 31(3)

8. As noted above, the registered proprietor filed a witness statement dated 16 May 2000 in support of the registrations. Although the proceedings were not consolidated at that time, the content of the witness statement and accompanying exhibits are substantially the same. I should note here that the witness statements are not originals but appear to be facsimile copies. Evidence in proceedings before the registrar should be the original documents. As will become clear, whether they were originals or copies is not relevant to the outcome of these

proceedings and I have therefore considered the evidence as if it had been properly filed.

9. Mr Lefort states that he is the proprietor of both trade marks and that both registrations were originally filed in the name of Parfums Lefort which was his trading style in 1991. Therefore, as at the date of application for each registration, the application was filed in the name of a trading style. This may or may not call into the question the whole basis and validity of both registrations. The applicants made no issue on this point and I will not express any further views on the issue, save to say that I find it strange that the assignment referred to above and filed on 4 December 1997 purports to make an assignment of two registered trade marks from a trading style to Mr Lefort.

10. Mr Lefort in his witness statement states that both marks have been used in the United Kingdom on a range of perfumed body sprays. He states that the goods bearing the mark were produced and sold to Superdrug Stores Plc. He states that this company has 800 stores throughout the UK and these goods had a presence within these stores. He refers to copies of invoices recording some of the sales which took place in 1996 attached to his witness statement. Mr Lefort states that he has not at present been able to locate sales records for other years. He states that the goods were sold with his consent, by Pizaz Toiletries Limited of whom he is a Managing Director.

11. There are five invoices attached to Mr Lefort's witness statement. They are all addressed to Superdrug Stores PLC, 118 Beddington Lane, Croydon, Surrey. They all originate from PIZAZ TOILETRIES LIMITED, 186B THE BROADWAY, BROADSTONE, POOLE DORSET. As noted above, Mr Lefort states that the use made by this company was with his consent and that he was the managing director of PIZAZ TOILETRIES LIMITED. I will look at each of the invoices in the order they appear in his statement:

- the first is dated 23/05/96; it is invoice number 160. It shows:

PIZAZ FORMULA . ITALIA BODYSPRAY 150ml 792 UNITS	419.76
PIZAZ FORMULA . BRAZILIA BODYSPRAY 150ml 792 UNITS	419.76
PIZAZ FORMULA . BODYSPRAY BROOKLANDS 150ml 792 UNITS	419.76

- the second is also dated 23/05/96; it is numbered 161. It shows the same wording as invoice 160 but with sales of 2772 UNITS of each of the products listed above.
- the third is also dated 23/05/96; it is numbered 159. It too has the same wording as invoice 160 and is for 1188 UNITS of each of the products
- the fourth is dated 13/08/96 and is invoice number 216. It shows the following wording:

GENERATION X BODYSPRAYS 150ml 1080 UNITS	776.52
PIZAZ FORMULA 1 BODYSPRAY BROOKLANDS 720 UNITS	439.20
PIZAZ FORMULA 1 BODYSPRAY ITALIA 360 UNITS	219.60

- the fifth and last invoice is also dated 13/08/96; it is numbered 217. It shows:

PIZAZ FORMULA 1 BODYSPRAY BROOKLANDS 360 UNITS	219.60
PIZAZ FORMULA 1 BODYSPRAY BRAZILIA 360 UNITS	219.60
PIZAZ FORMULA 1 BODYSPRAY ITALIA 360 UNITS	219.60

Applicants' Evidence

12. I need not summarise much of Mr Leader's evidence. He gives information concerning the applicants for revocation and the reason for them seeking revocation. This was in response to the comments made in the registered proprietor's counter-statements that the applicants had no interest in goods in class 3. However, this is not relevant as there is no requirement for a person seeking to revoke a trade mark to have an interest or 'locus standi', an application for revocation may be made by any person; section 46(4).

13. Mr Leader refers to a search performed by a private detective firm, Kroll Associates Deutschland GmbH. A redacted copy of the report is at exhibit LL4. Mr Leader goes on to make various comments concerning the registered proprietor's evidence. I need not summarise these and will deal with them as part of my decision.

14. That concludes my review of the evidence.

Decision

15. The relevant parts of section 46 of the Trade Marks Act 1994 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;
- (c)
- (d)

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from -

- (a) the date of the application for revocation, or
- (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

16. In addition Section 100 of the Act is relevant. 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."

Preliminary Points

17. The applicants' representative, Mr McLeod, filed a skeleton argument some four days before the hearing. This was copied to the address of Mr Lefort as shown on the file. Unfortunately, Mr Lefort's address had changed and so he did not receive the skeleton argument until the start of the hearing. I gave him time to read through the skeleton. I would like to say that I am grateful to Mr McLeod for trying to get his skeleton to the registered

proprietor well before the hearing.

18. Mr McLeod's skeleton raises a number of potentially new issues. Firstly, in paragraph 5 he questions the *bona fides* of the registered proprietor with reference to previous applications said to have been made by him and companies with which he is associated. I do not think that it was helpful to bring this issue up at this late stage and during the hearing Mr McLeod did not push this point at all and I will not refer to it further.

19. Secondly, in paragraph 7 he questions whether an extension of time for filing evidence should have been granted to the registered proprietor by the registrar. At the hearing I expressed my view that the time for raising such objections had passed. The applicants were informed of the registry's preliminary view to grant the registered proprietor's request in a letter dated 24 May 2001. This letter gave the applicants fourteen days to provide arguments against the granting of the extension or to request a hearing on the matter. They did neither and the matter is in my view closed.

20. Thirdly, the applicants' sought leave to amend their statement of grounds to add the ground of revocation under section 46(1)(b) in addition to that pleaded under section 46(1)(a). I heard submissions from Mr McLeod on this request. I questioned him as to how it would assist the applicants. He described it as a belt and braces approach. In this particular case, it seems to me that it is of no consequence. The use which the registered proprietors claim to have shown is in 1996. Whether the applicants rely on section 46(1)(a), the five years following registration, or 46(1)(b), the five years preceding the date of application, the dates of use shown by the registered proprietors fall within that period. I have set out the dates below:

Trade Mark 1479665		Relevant period
46(1)(a)	Five years following registration	08/04/94 - 08/04/99
46(1)(b)	Five years preceding date of application	02/02/95 - 02/02/2000
Trade Mark 1479350		
46(1)(a)	Five years following registration	15/10/93 - 15/10/98
46(1)(b)	Five years following registration	02/02/95 - 02/02/2000

21. It seemed to me that to allow the request to introduce the ground under section 46(1)(b) might needlessly complicate these proceedings; either the use shown by the registered proprietors in 1996 satisfies the provisions of the Act or it does not. Therefore I directed that we should move forward and consider the applicants' ground of revocation as pleaded, under section 46(1)(a).

Substantive Points

22. The applicants' grounds of attack go to sections 46(1)(a) of the Trade Marks Act 1994. Once this application was made, the effect of section 100 was to place the onus on the registered proprietors to show the extent and nature of the use made by them of the mark; see

comments of Mr Clarke Q.C., sitting as the Appointed Person in *FLORIS* [2001] R.P.C. 19. The registered proprietor has not sought to rely on any proper reasons for non-use and so I need not consider that point further.

23. Mr Lefort argued at the hearing that he was a genuine trader and not a trade mark squatter. As such, he questioned why the applicants should be allowed to seek revocation of his mark when no opposition was filed against it. As I have stated above, there is no requirement for the applicants to have an interest in the mark, any person may apply for revocation of a trade mark. Mr Justice Jacob has made some comments concerning revocation actions in a recent case, *Laboratories Goemar SA v. La Mer Technology Inc* (19 December 2001). He stated at paragraph 19:

“19...what amount and kind of use will suffice to prove that a mark has been *put to genuine use* within the meaning of Art.10 [of the Directive - section 46(1) of the Trade Marks Act 1994]? It is worth stating in some detail why the question is so important. There are a number of reasons:

- (a) There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.
- (b) The 8th recital of the Directive gives express recognition of that public interest. It says: “Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade mark must actually be used or, if not used, be subject to revocation.....”.

24. Earlier in the same case, Mr Justice Jacob, commenting on the provisions of section 100 set out above stated at paragraph 9:

“9. In the present case, use was not proved well. Those concerned with proof of use should read their proposed evidence with a critical eye - to ensure that use is actually proved - and for the goods or services of the mark in question. All the t’s should be crossed and all the i’s dotted.”

25. With these facts in mind I go on to consider the evidence submitted by the registered proprietor in support of the claim to use of the trade marks.

Trade Mark 1479665



26. Looking at the evidence that has been filed by the registered proprietor, I could not see any evidence of use of this mark which includes the device of the racing car. At the hearing, Mr Lefort conceded that this mark had not in fact been used. **As such, the ground for revocation is made out and the registration is revoked.** I will deal with the effect of my decision below.

Trade Mark 1479350

27. Mr Lefort asserted that this mark had been used. During the course of his submissions he made many reference to use of this mark. Whilst I was anxious to allow him to present his case to me, I can only decide this case on the evidence that has been filed in the proceedings. That consists of Mr Lefort's own witness statement and the invoices. Mr Lefort produced a sample of the product in question and indicated that he thought that this had been submitted with his evidence. It had not and therefore I cannot take that into account, nor can I take into account his verbal assurances that the mark was used. Mr Lefort was free to make submissions based on the evidence that was before me and he did so.

28. The only use that has been put in evidence before me is that contained in the five invoices. There are several questions that fall to be answered.

- (1) Do these invoices show use of the mark FORMULA ONE?
- (2) If not can the proprietor rely on the provisions of section 46(2)?
- (2) If use is shown, is the use "genuine use"?
- (3) Is it by the proprietor or with his consent?
- (4) Has use been shown "in relation to the goods or services for which it is registered....."; section 46(1)(a)?

Does the evidence show use of the mark FORMULA ONE?

29. There is no evidence before me as to how the mark has been applied to the goods in question. The invoices put in evidence describe the products as, for example,

PIZAZ FORMULA 1 BODY SPRAY BROOKLANDS

30. It seems to me that on any view, this does not show use of the mark FORMULA ONE. Mr Lefort stated that the way in which the mark was used was with each element shown separately. I take this to be an assertion that PIZAZ would appear as a 'housemark'. In that way, FORMULA ONE or 1 would be a separate trade mark and I presume that BROOKLANDS or ITALIA would be a sub-brand and carry different smells. That may or may not be so. The fact of the matter is that I have no evidence to show how the mark has been used other than these invoices. From these invoices I cannot tell how the mark was used and it is not for me to speculate on this issue. I appreciate that in Mr Lefort's view I may be taking a strict line but it is for the registered proprietor to show what use that has been made of the trade mark. In my view, no use has been shown of the mark FORMULA ONE.

Can the registered proprietor rely on section 46(2)?

31. The provisions of section 46(2) provide:

“46(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered....”

32. The use that has been shown is of FORMULA 1 together with other elements. Dealing firstly with the issue of the use of FORMULA 1, Mr McLeod in his skeleton argued that use of FORMULA 1 would not constitute use of the mark FORMULA ONE. In their view it did not show use in “a form differing in elements which do not alter the distinctive character” of the mark FORMULA ONE. At the hearing I provided both parties with a copy of my decision in the case *Second Skin* [2001] R.P.C. 30. In that case, I determined that use of the mark 2ND SKIN was use of the mark SECOND SKIN within the meaning of section 46(2). On that basis, I think that Mr McLeod was prepared to accept that use of FORMULA 1 would also fall with the provisions of this section. However, I also referred both parties to the recent decision of Mr Simon Thorley, Q.C. sitting as a Deputy High Court judge in the case of *Re Anheuser-Busch Inc* [2001] All ER (D) 08 (Dec). Referring to the section 46(2), Mr Thorley stated:

“22. Next, it is to be noted that the language of section 46(2) does not use a comparative when defining alterations that can be accepted. It does not state that the alteration must not “substantially” alter the distinctive character. The requirement is that the alternative form may only differ in elements which do not alter the distinctive character of the mark. In my judgment this is indicative that the subsection is of narrow scope. Alterations which would be immaterial for the purpose of infringement, in that the alleged infringing mark was confusingly similar to the registered mark, are irrelevant. It is thus necessary for any Tribunal seeking to apply section 46(2) to determine what is the distinctive character of the mark and which are the elements that, in combination, contribute to that distinctive character. Thereafter, it must enquire whether any alteration to any of those elements is of sufficient immateriality as not to alter that overall distinctive character.

23. In this way the objective of the Directive will be met. In the light of the 8th Recital, it cannot be the intention to clutter up the Register with a number of marks which differ from each other in very minor respects because the proprietor of an earlier mark has subsequently seen fit to change that mark only in some minor way which nonetheless preserves its distinctive character.....”

33. It seems clear from Mr Thorley interpretation of section 46(2) that in his view, it is of narrow scope. If I apply the test set out by Mr Thorley does use of FORMULA 1 satisfy section 46(2)? As I will set out below, I need not answer this question and I choose not do so.

34. On the facts before me, the use shown is of “PIAZZ FORMULA 1 BODYSPRAYS BROOKLANDS” or “ITALIA” or “BRAZILIA”. On any reading of section 46(2) it seems to me that such use cannot be use of a trade mark in a form differing in elements which do not

alter the distinctive character of the mark FORMULA ONE. Mr Lefort stated at the hearing that this was not how the mark was used on the products. As set out above, I have no evidence before me as to how the mark was used in the market place. The only evidence I have is of the use of the mark on invoices.

35. It seems to me that the distinctive character of the mark as registered is made up of the two words FORMULA and ONE. As noted by Mr McLeod, the registration gives no right to the exclusive use separately of the words FORMULA and ONE. The mark as shown in use on the invoices appears to be made up of a number of elements and includes the words PIZAZ and ITALIA. It seems to me that the addition of these words before and after the words FORMULA 1 alters the distinctive character of the mark as registered. They are not of “sufficient immateriality as not to alter that overall distinctive character”.

36. As such, I find that the registered proprietor has failed to show use of the mark within the meaning of section 46(1) or 46(2). The mark therefore, stands to be revoked.

Other issues

37. As I have found that the registered proprietor has not shown use of the mark I need not go on and consider whether the level of use shown is sufficient to satisfy the requirement for “genuine” use. Mr Justice Jacob in *La Mer Technology Inc* has asked for the question of genuine use to be referred to the European Court of Justice. In the event that this case fell to be determined on that issue, I indicated at the hearing that I would stay these proceedings pending that reference. In the event, I find that the question does not need to be addressed.

38. Further, the use shown by the registered proprietor is only in respect of a product described on the invoices as BODYSPRAY. Mr Lefort stated at the hearing that the mark had been used on other products but that is not shown in the evidence before me. The specification of the registered mark includes body sprays but also includes many other goods in class 3. In accordance with the provisions of section 46(5), if I was wrong in my conclusions concerning use of the mark then the mark would, in any event, be revoked for all goods save body sprays.

39. I express no view as to whether the use provided by the registered proprietor shows that such use was by the proprietor or with his consent.

Conclusions

40. The registered proprietor has failed to show use of either of the registered trade marks in dispute in these proceedings. The applicants asked for the revocation to take effect from a date earlier than the date of the application for revocation. In *Plantex (SRIS O/446/00)* I found that where the applicant relies on the provisions of section 46(1)(a) and the registered proprietor fails to show use of the mark, the mark should be revoked from the date when the relevant five year period expired. As such, I order that:

Trade mark registration number 1479665 is revoked in its entirety with effect from 8 April 1999.

Trade mark registration number 1479350 is revoked in its entirety with effect from 15 October 1998.

Costs

41. The applicants for revocation have been successful and are entitled to a contribution towards their costs. I heard submissions on costs from both parties. Mr Lefort explained that his financial position made a payment of an award of costs difficult. Whilst I sympathise with Mr Lefort's position, he has chosen to defend his two registrations one of which he admitted he had not used. A standard award, for an application for revocation, taken from the scale in force when these proceedings were launched would be £835-00. Here there are two sets of proceedings but they were consolidated before the applicants' evidence was accepted into the proceedings. Mr McLeod asked for an award of cost off the established scale. The registrar can in appropriate cases make such an award. However, in the circumstances of this case, I do not think that an award of costs outwith the scale is justified. The registered proprietors filed very little evidence and the applicants' own evidence is, for the most part, irrelevant.

42. In deciding on an award of costs, I have allowed for the fact that the applicants had to file two sets of proceedings, for this I would award the following costs from the scale:

£600-00	For the official fees and filing of statements of case
£ 70-00	For perusing the registered proprietor's counter-statement
£100-00	For perusing the registered proprietor's evidence
£100-00	For the applicants' own evidence
£200-00	For attendance at the hearing

43. Therefore, I order that the registered proprietor, Mr Michael Lefort, pay to the applicants the sum of £1070-00. 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 19 day of March 2002

S P ROWAN
For the Registrar
the Comptroller General