

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 11443  
BY KALA NIKETAN (UK) LIMITED FOR  
REVOCATION OF REGISTRATION No. 1529867  
STANDING IN THE NAME OF  
KALA NIKETAN (PARTNERSHIP)**

## TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 11443  
by Kala Niketan (UK) Limited for revocation  
of registration No. 1529867 standing in the  
name of Kala Niketan (Partnership)**

1. The following trade mark is registered in the name of Kala Niketan (a partnership) of Bombay:



2. It is registered in respect of the following specification of goods in Class 24:

“Textile piece goods; sarees; textile materials for making up into dresses”

3. The registration is numbered 1529867. The application was filed on 17 March 1993 and the mark was entered on the register on 16 December 1994. Confirmation of the latter can be found in Trade Marks Journal No 6063 published on 22 February 1995.

4. On 9 February 2000 Kala Niketan (UK) Limited of Middlesex applied for this registration to be revoked under the terms of Section 46 of the Act on the basis that there had been no use of the trade mark for an uninterrupted period of five years by the proprietors or with their consent in relation to the goods for which the mark is registered. They further submit that there are no proper reasons for non-use. The applicants seek an award of costs in their favour.

5. The registered proprietors filed a Form TM8 and evidence but no counterstatement as such. The absence of the latter prompted a number of exchanges of correspondence between the applicants' representatives and the Registry. The Registry eventually concluded that the action should proceed on the basis of the material that had been filed by the registered proprietors. The combined effect of the TM8 and evidence was, it seems to me, that the registered proprietors intended to defend the registration and that they placed reliance on use of their mark rather than any proper reasons for non-use (I will come to the detail of the evidence below).

6. The papers were reviewed by a Hearing Officer and the parties were advised that an oral hearing did not appear to be necessary in order to reach a view on the matter. The parties were, nevertheless, reminded of their right to be heard. Both sides indicated that they were content for a decision to be issued on the basis of the papers filed and did not wish to make

written submissions. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

### **The Law**

7. The relevant statutory provisions are to be found in Section 46(1) of the Act which reads:

“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;”

and Section 100:

“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.”

The burden of proving use thus rests with the registered proprietors.

### **The relevant period**

8. The applicants have not said whether their attack is under sub-paragraph (a) or (b) of Section 46(1). They simply refer to non-use in an uninterrupted period of five years. I infer that they are referring to the five years preceding the filing of the application for revocation, that is to say 9 February 1995 to 8 February 2000.

### **The evidence**

9. The evidence filed in this case is as follows:

#### **Registered Proprietors' Evidence of use:**

Statutory Declaration by Shailesh Nathwani with exhibit SN1.

#### **Applicants' Evidence in chief:**

Statutory Declaration by Sandhya Patel with exhibit SP1;  
Statutory Declaration by Reshma Patel (no exhibits);  
Statutory Declaration by George Myrants with exhibit GM1;  
Statutory Declaration by Rakesh Patel with exhibit RP1.

Mr Nathwani is a partner of Kala Niketan (the Bombay partnership), a position he has held since 1972. His evidence is brief so I will record the substance of it in full:

“2. My Company exports textile piece goods, sarees, dress materials and ready made garments (hereinafter referred to as “the goods”) under the Trade Mark to the United Kingdom. My Company first commenced to use their Trade Mark in the United Kingdom in relation to the goods in 1970 and such use has been continuous since that date. The foreign buyers attend the showroom of my Company and select the goods they require and my company exports the goods to the United Kingdom through Kala Darshan, a sister concern division of exports. Details of three of my Company’s customers are set out below:

Roop Shringar Ltd  
520 Kingsbury Road  
Kingsbury  
Middlesex NW9 9HE

(Turnover figures are available for the years 1997-1998, 1998-1999)

Radha Sarees Ltd  
188 Ealing Road  
Wembley  
Middlesex HA0 4QD

(Turnover figures are available for the years 1994-1995, 1995-1996)

Warris Vianni & Co  
85 Globorne Road  
London W10 NL

(Turnover figures are available for the years 1994-1995, 1995-1996, 1996-1997, 1997-1998, 1998-1999)

3. There is now produced and shown to me marked “SN.1” a copy of an advertisement appearing in IGCC (Indo-German Chamber of Commerce) Membership Privileges 2000 which has wide circulation to all its members, hotels and establishments throughout the world.”

10. I do not propose to offer a full summary of the applicants’ evidence. Suffice to say that Sandhya Patel is the wife of one of the directors of Kala Niketan (UK) Ltd. She and Reshma Patel, a friend, conducted enquiries at the three customers referred to in Mr Nathwani’s evidence to establish any use of the mark in issue. They were unable to find any use of the mark. Radha Sarees had goods bearing their own mark as well as garments labelled Rehmanis; Warris Viani & Co knew of the owners of the Indian company but claimed not to sell their goods but did have sarees with the shop’s own name on them; and Roop Shringar Ltd also sold goods under the shop’s own name. Rahesh Patel is a director of the applicant company. He gives evidence about the setting up of his own business. This is of marginal relevance only in the context of this action. He does, however, say that he has been resident in this country since 1968 and has a good knowledge of the clothing trade but has never seen the

mark at issue in use except by his company. Mr Myrants, the fourth declarant, is the applicants' representative in this matter. He gives evidence on the background to the case and submissions in relation to the substance of the case.

## Decision

11. Guidance on what constitutes genuine use of a mark can be found in *Euromarket Designs Incorporated v Peters & Another* [2000] ETMR 1025 where Jacob J said:

“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.”

12. In *Laboratoires Goemar SA v La Mer Technology Inc*, [2002] ETMR 34, Jacob J also said:

“In the present cases, 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.”

13. The registered proprietors’ claims here are based on little more than assertion. The turnover figures in relation to the three retail customers are referred to but not supplied or explained. I assume the turnover figures are in respect of goods supplied to those customers rather than the turnover of the retailers themselves. If the information was available it should have been supplied. Further questions would arise in relation to the mark or marks used and whether all goods supplied were under the mark at issue. The applicants’ evidence resulting from their own enquiries with these UK customers casts further doubt on the position though the applicants’ evidence is not in my view crucial to the outcome given the onus that is on the registered proprietors by virtue of Section 100.

14. There are further fundamental difficulties for the registered proprietors. There are no examples of the mark in use on products or on product labeling. There is no invoice evidence. There is but a single piece of advertising or promotional material. This is the advertisement (Exhibit SN1) appearing in *IGCC Membership Privileges 2000*. There is no date on the advertisement. It may or may not emanate from before the filing date of the application for revocation (9 February 2000). IGCC is said to stand for Indo-German Chamber of Commerce. The publication itself is said to have a wide circulation to all its members, hotels and establishments throughout the world. Whether any of them are in the UK or whether sales resulted is not made clear. On the face of it it is difficult to see why a publication from the Indo-German Chamber of Commerce should have a circulation in the UK. Evidence could, of course, have established that contrary to appearances it does but none has been filed.

15. The registered proprietors' position appears to be untenable on the strength of the extremely limited evidence that has been filed. The application for revocation must, therefore, succeed. I do not, in the circumstances, need to deal with the further question raised by Mr Myrants as to whether the proprietors' declarant is in fact a partner of Kala Niketan (Bombay).

16. Section 46(6) reads:

“(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.”

17. In the absence of a more specific claim by the applicants I am treating this action as being under Section 46(1)(b). Revocation will, therefore, be in accordance with Section 46(6)(a). The registration will be revoked in its entirety with effect from 9 February 2000.

18. The applicants have been successful and are entitled to a contribution towards their costs. Taking all the circumstances of the case into account I order the registered proprietors to pay the applicants for revocation the sum of £700. 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 25<sup>th</sup> day of November 2002**

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