

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO  
REVOCATION NO: 80176 BY FORMULA ONE LICENSING BV TO TRADE  
MARK REGISTRATION No: 1445879 IN THE NAME OF CAMBRIDGE OPTICAL  
GROUP LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF** an Interlocutory Hearing held in relation to Revocation no: 80176 by Formula One Licensing BV to Trade Mark Registration no: 1445879 in the name of Cambridge Optical Group Limited

### **Background**

1. On 10 December 2001, Formula One Licensing BV of The Netherlands, applied to revoke trade mark registration No: 1445879 standing in the name of Cambridge Optical Group Limited. The trade mark consists of the words FORMULA ONE and FORMULA 1 (series of two) and stands registered for the following specification of goods:

“Spectacle frames; spectacles; cases for spectacles; all included in Class 9.”

2. The application for registration was filed on 1 November 1990 and the registration procedure completed on 12 June 1992.

3. The applicants for revocation express their attack in the following terms:

“1. UK trade mark registration No: 1445879 (the registration) is for the trade mark FORMULA ONE/FORMULA 1 (series of two marks) covering “Spectacle frames; spectacles; cases for spectacles; all included in Class 9”. It is registered in the name of Cambridge Optical Group Limited (the proprietor).

2. The applicant for revocation, Formula One Licensing BV (FOL), is the applicant for registration of a number of Community trade mark applications which have been opposed by the proprietor on the basis of the registration.

3. FOL has conducted an investigation into use of the mark the subject of the registration. This has revealed that the mark has not been used by the proprietor or its predecessor in title in relation to the goods for which it is registered for between 7 and 8 years.

4. The proprietor has been put on notice on 26 September 2001 in accordance with Section 46(3) of the Trade Marks Act 1994 (the Act) that an application for revocation of the registration might be made.

5. FOL requests that the registration be revoked in its entirety under Section 46(1)(b) of the Act.

6. FOL further requests that the registration be revoked in its entirety from the earliest date of non-use, i.e. from a date earlier than this application for revocation, if applicable.”

4. In an Official letter dated 18 December 2001, the Trade Marks Registry served the Form TM26(N) on Baron & Warren who are the registered proprietors’ professional representatives

in these proceedings; they were allowed until 18 March 2002 to file Form TM8 and counterstatement together with either evidence of the use made of the trade marks or, alternatively, reasons for the non-use of the trade marks.

5. On 18 March 2002, Form TM8 and counterstatement together with a witness statement of Irena Maria Kantor dated 18 March 2002 and exhibits IMK1 to IMK6 thereto were provided. In their counterstatement, the registered proprietors either agree or admit paragraphs 1, 2 and 4 of the applicants' Statement of Grounds. In relation to the remaining grounds they comment as follows:

“3. The contents of paragraph 3 are denied. In particular, it is denied that the mark, the subject of the registration, has not been put to use within the period identified by the applicant for revocation; namely either December 1993 or December 1994 through to December 2001. The proprietor asserts that its predecessor in title made use of the mark from 1994/95 to at least 1996/97.

4. The proprietor asserts that the relevant period to consider must cover the entire period identified by the applicant for revocation in its pleadings and not merely the 5 year period preceding the filing of the application.

6. The use made by the proprietor's predecessor in title is FORMULA 1. The proprietor asserts that such use applies equally to the mark FORMULA ONE in that the marks would be regarded as one and the same.

7. The proprietor denies that the mark should be revoked under the provisions of Section 46(1)(b) of the Act and asks that the application for revocation be refused.”

6. From the above, it is clear that the registered proprietors are seeking to defend the application for revocation on the basis of the use made of the trade marks within the relevant period. This evidence is provided in the witness statement and exhibits of Ms Kantor mentioned above. Having examined the evidence provided, the Trade Marks Registry, in an Official letter dated 25 March 2002, wrote to McDermott Will & Emery who are the applicants' professional representatives in these proceedings and sent them the Form TM8, counterstatement and evidence of use made of the trade marks as required under rule 31(2). The applicants for revocation were allowed until 25 June 2002 to file evidence in support of the application.

7. In a letter dated 12 April 2002, McDermott Will & Emery wrote to the Trade Marks Registry. Their comments in so far as they are relevant are as follows:

“We refer to your letter of 25 March 2002 enclosing the evidence filed on behalf of the registered proprietor. We wish to point out that the evidence filed does not discharge the onus on the registered proprietor to file evidence of use under Section 46(1)(b). This subsection of the Act was specifically pleaded in the statement of grounds filed in the application for revocation. As the registrar will be aware, Section 46(1)(b) provides for revocation where use of a trade mark has been suspended for an uninterrupted period of five years.

The application for revocation was filed on 10 December 2001. Accordingly, the five year term is from 10 December 1996 to 10 December 2001. The only dated evidence filed in support of the registration is dated September 1996 and is therefore outside the relevant five year term. Recent case law regarding applications for revocation is clear on the fact that the smaller the quantity of evidence filed, the greater attention to quality of evidence is required. In this case, there are only two items of dated evidence, namely the Frame Catalogue and the Price List, both of which are dated outside the five year period.

The applicants for revocation therefore submit that the registered proprietor has not at all discharged the onus of proof of use under Section 46(1)(b). The unsupported claim that the dated evidence would have been available and valid well into 1997 should be ignored because it does not constitute proof of use inside the relevant five year period.”

8. In an Official letter to the parties dated 7 May 2002, the Trade Marks Registry explained that the comments in McDermott Will & Emery’s letter of 12 April 2002 had been considered. However, notwithstanding those comments, it was the Trade Marks Registry’s preliminary view that the evidence provided by the registered proprietors was sufficient to comply with the provisions of rule 31(2) of the Trade Marks Rules 2000; a period ending on 21 May 2002 was allowed for a Hearing to be requested; in a letter dated 9 May 2002 McDermott Will & Emery sought a Hearing.

9. An Interlocutory Hearing to determine the matter took place before me on 29 August 2002. At the Hearing the applicants for revocation were represented by Mr Chris McLeod of McDermott Will & Emery; the registered proprietors were represented by Mr Max Stacey of Baron & Warren. In a letter dated 30 August 2002 I wrote to the parties reporting the decision I took at the Interlocutory Hearing; the relevant portion of my letter (addressed to Mr McLeod) is reproduced below:

“Having considered the parties skeleton arguments and authorities together with the oral submissions at the Hearing, my decision was to reverse the preliminary view expressed in the Trade Mark Registry’s letter of 7 May 2002. The consequence of this decision, is that the Registered Proprietors’ opposition to the application for revocation is treated as having been withdrawn.

In so far as costs are concerned, I made an award of costs to your clients in the amount of £1000. As indicated at the Hearing, this figure was arrived at from the official scale of costs included in Annex A of Tribunal Practice Notice 2 of 2000 and includes £200 as a contribution towards the costs incurred by your clients in these interlocutory proceedings. This costs award will not of course become payable until the proceedings are finally concluded.”

10. On 30 September 2002 Baron & Warren filed Form TM5 requesting a statement of grounds of my decision which I now set out below.

## Grounds of Decision

### The Act and Rules

11. The action is brought under Section 46 of the Trade Marks Act 1994 and the relevant parts of Section 46 and Section 100 of the Act, together with rule 31 of the Trade Marks Rules 2000 are reproduced below:

“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;

(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.

(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.”

12. Section 100 of the Act reads as follows:

“**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.”

13. Rule 31 of the Trade Marks Rules reads as follows:

“**31.** - (1) An application to the registrar for revocation under section 46(1)(a) or (b) of the registration of a trade mark shall be made on Form TM26(N) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within three months of the date on which a copy of the notice and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8 and either:

(a) two copies of evidence of use made of the mark; or

(b) reasons for non-use of the mark.

Where such a notice and counter-statement, and evidence of use of the mark or reasons for non-use of the mark, are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement, and the evidence of use of the mark or the reasons for non-use of the mark, to the applicant.

(3) Where a counter-statement, in conjunction with a notice of the same, on Form TM8, and evidence of use of the mark or reasons for non-use of the mark, are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within three months of the date upon which a copy of the Form TM8 and counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such further

evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within three months of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the Hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.”

#### **The registered proprietors' evidence of use**

14. This consists of the witness statement of Irena Maria Kantor dated 18 March 2002 and exhibits IMK1- IMK6 thereto. In her witness statement Ms Kantor explains that she is a trade mark attorney employed by Baron & Warren. She states that Baron & Warren have represented the registered proprietors, Cambridge Optical Group Limited (hereafter COGL) in trade mark matters from as early as 1996. Ms Kantor confirms, that she is authorised to make her statement, has full access to her firms files, and that the information in her statement comes from her research and/or these files; she adds that the examples of use of the trade mark in suit were previously provided by Geoff Johnson of COGL.

15. COGL is, says Ms Kantor, a well known manufacturer of spectacle frames and sunglasses as well as ophthalmic lenses. Exhibit IMK1 consists of an extract (dated 18/3/02) taken from the registered proprietors' website - [www.cambridge-optical.com](http://www.cambridge-optical.com). I note from the extract that the registered proprietors design and manufactures frames to be sold under a number of different brands with Studio, Cambridge Collection, Pringle, Paul Costelloe and Harrods mentioned; there is however no mention of the Formula One1/Formula 1 trade marks.

16. Ms Kantor explains that COGL is currently the subject of insolvency proceedings initiated as a Corporate Voluntary Arrangement under the supervision of Peters Elworthy & Moore. Exhibit IMK2 consists of extracts taken from The Registrar of Companies website (dated 18/3/02) which appear to support this contention. COGL, says Ms Kantor, continues to trade. Ms Kantor goes on to say that the registration in suit was assigned to COGL from Invicta Frames Limited (hereafter IFL), with the effective date of the assignment being 29 August 1997. Exhibit IMK3 consists of an extract taken from the Trade Marks Register (dated 18/3/02); Ms Kantor observes that the trade marks were assigned “in full” which would in her

view have included any goodwill in the trade marks.

17. Ms Kantor states that IFL used the trade mark in relation to frames within the relevant period, namely late 1996. Exhibit IMK4 consists of a brochure entitled Frame Catalogue September 1996. Ms Kantor notes that reference to FORMULA 1 are to be found at the index page and on pages 3, 4 and 25. Exhibit IMK5 is a copy of an "All In One Price List September 1996" which I note is the same price list which appears on page 28 of the brochure mentioned at IMK4 above. Exhibit IMK6 consists of an undated sample pair of spectacles bearing the FORMULA 1 trade mark.

18. Ms Kantor concludes her witness statement in the following terms:

"9. I believe that the foregoing demonstrate use of the mark within the relevant period. As asserted in the accompanying counterstatement, the relevant is December 1993 or December 1994 through to December 2001. Even if we are wrong in this regard, I believe that the foregoing exhibits demonstrate use with the period December 1996 to December 2001. It is acknowledged that the brochure and price lists are dated September 1996. However, this would be the release date of the publications. Clearly, such a document would not be released month by month. Therefore, it is reasonable, from this evidence, to infer that the publications would have been available and valid well into 1997. In consequence, even within this alternative time frame, I believe that the evidence filed herewith demonstrates that the registered mark was put to genuine use in relation to the goods covered by the registration within the five year period prior to the filing of the application for revocation."

### **Skeleton Arguments/Submissions at the Hearing**

19. The parties submissions at the Hearing were, for the most part, based closely on their skeleton arguments, the relevant portions of which are reproduced below.

### **Registered Proprietors**

"2. The registered proprietor, the subject of Voluntary Liquidation (exhibit IMK2 refers) asserts that summary judgement would be inappropriate in these particular proceedings.

3. The registered proprietor accepts that the onus is on itself to produce evidence - under the provisions of Section 46 and 100. It further accepts that the Registrar has the power to grant summary judgement under Rule 31.

4. Section 46(1) requires a mark to be put to genuine use within the prescribed period.

5. Evidence of genuine use has been filed in the form of a brochure (dated September 1996).

6. The purpose of rule 31(2) is for the filing of an arguable defence - CARTE BLEUE [2002] RPC 31@Pg 599 applies - paragraph 31.



7. Paragraph 3 of the application for revocation pleads that the mark has not been used for 7-8 years. The period for the tribunal to assess is as a minimum December 1994 to December 2001 - see approach taken by the Registrar in 0/128/02 (Rev No: 11244 by EMAK S.P.A. - TM No 1109421 DYNAMARK). Applicant for revocation pleaded 5 years non-use ending three months prior to the date for revocation. This had material effect on the relevant period under consideration.

8. Even if wrong in this regard, it is commercially inconceivable that the brochure dated September 1996 would not have been in circulation subsequent to December 1996. It is therefore appropriate to draw inference from the initial evidence in this instance that the mark would have been exposed to the relevant public with [sic] the 5 year period prior the application for revocation.

9. Rule 31(8) allows registrar discretion for filing of further evidence to be filed during the proceedings.

10. See 0/018/02 - Rev No: 12046 by EMITECH GESELLSCHAFT FUR EMISSIONSTECHNOLOGIE MBH - TM No: 1380020 (OMITEC). Registered proprietor was in liquidation and was granted extension by Appointed Person for late filing of evidence. In this instance initial evidence has been filed.

11. The registered proprietor asserts that the request for summary judgement be refused and that the applicant for revocation should now substantiate its allegations of non-use allowing for further evidence to be supplied by the registered proprietor in due course.”

### **Applicants for revocation**

“The applicant for revocation will argue that:

(i) the registered proprietor has not discharged the onus upon it by virtue of s.100.

(ii) the evidence filed is outside the relevant term.

(iii) the relevant term is 10 December 1996 to 10 December 2001.

(iv) the relevant term is not longer than five years.

(v) the statement of case filed by the applicant for revocation explicitly pleads s. 46(1)(b).

(vi) S.46(1)(b) is clear on the five year suspension term.

(vii) The relevant case law is clear that, while there is no minimum level of evidence below which it is not genuine use for the purposes of s.46, the smaller the amount of evidence filed, the more care should be taken to ensure that it proves the case.

(viii) the registered proprietor has one chance to file evidence to discharge the onus of s.100, i.e. with the counterstatement.

(ix) unsubstantiated claims that evidence dated outside the relevant term under s.46(1)(b) would have been available within the relevant term should be disregarded.”

20. In reaching my decision in these proceedings I had to determine:

(1) What was the relevant period? And

(2) Dependant on that decision, is the evidence of use supplied by the registered proprietors sufficient to meet the requirements of rule 31(2) of the Trade Marks Rules 2000?

21. I shall deal with point (1) above first. Section 46 of the Act which is set out earlier, provides the criteria to be applied when determining from what date a trade mark should be revoked.

22. In paragraph 3 of their Statement of Grounds, the applicants for revocation indicate that investigations conducted by them suggest that there has been no use of the trade marks the subject of the registration in suit for between 7 and 8 years; however, I note that no precise date is mentioned. What the applicants do specifically request (at para. 5 of their Statement of Grounds) is revocation under the provisions of Section 46(1)(b) of the Act - the text of which is set out above. Notwithstanding the registered proprietors' comments in respect of the relevant dates in their counterstatement and Mr Stacey's comments in his skeleton argument and at the Hearing, in the absence of an explicit alternative date being specified by the applicants for revocation, the provisions of Section 46(6)(a) must be held to apply. Consequently, the relevant Section 46(1)(b) period for the purposes of these proceedings is the five year period prior to the filing of the application for revocation i.e. 10 December 1996 to 9 December 2001.

23. I now turn to point (2) above. In answering this particular question, I am guided by a decision of one of the Trade Marks Registry's Hearing Officers (Mr M Knight) in *Groupement Carte Bleue v CB Richard Ellis Inc* [2002] RPC 31. In that case, the Hearing Officer was asked, as am I in these proceedings, to grant summary judgement. In his skeleton argument Mr Stacey accepts that the Registrar has such a power and as such I need make no further mention of this point.

24. Sections 46 and 100 of the Trade Marks Act 1994 and rule 31 of the Trade Marks Rules 2000, combine to place the onus (when challenged) on the proprietor of a registered trade mark to show what use has been made of it. In these proceedings the registered proprietors rely on the witness statement of Ms Kantor and the exhibits thereto to discharge the burden placed upon them by the combined effects of the statutory provisions mentioned above and set out earlier in this decision.

25. The registered proprietors are relying on the use that has been made of the trade marks during the relevant period identified above. In the *Carte Bleue* case the Hearing Officer

considered the purpose and type of evidence that a party may consider filing under the provisions of rule 31(2). He made the following comments:

“In my view, taking the Act and the Rules together, they seem to me to envisage that when challenged there is an onus upon the registered proprietor at the outset to provide some evidence that the trade mark the subject of the application for revocation was in use during the relevant period. In that connection, in particular I note that the word "show" is used in section 100 which suggests in revocation proceedings evidence must be more than mere assertion that the trade mark in question has been used, but must be actual evidence which shows how the trade mark is used.”

And:

“I do not consider therefore that the regime requires the registered proprietor to submit within the three-month unextendable period allowed for filing the form TM8, counter-statement and evidence of use, the entirety of their evidence. In many respects that would be unrealistic in a number of cases. For example, as I indicated during the hearing, if the registered proprietor had licensed use of the registered trade mark which may be registered for, say, tinned fruit, on the basis of exclusive licences, to half a dozen others who each produced a particular type of tinned fruit then it may take more than three months to gather together evidence or, should I say, complete evidence of use of the trade mark. Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used. Mr Engelman pointed out to me that the Trade Marks Registry Work Manual sets out the sorts of material that might be acceptable. There has also been a decision by one of the registrar's hearing officers in a case known as ADRENALIN Trade Mark O/336/99 which also sets out examples of the sorts of things that the registrar, or, more particularly, the other side might accept and consider as evidence of use of the trade mark. From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc., all of which show use of the trade mark in question, together with some indication of the sales of goods, or the provision of services during the relevant period. Clearly this cannot be an exhaustive list and is merely an example of the material which might be sent in.”

26. The Hearing Officer's comments in the *Carte Bleue* case clearly indicate that in order to satisfy the requirements of rule 31(2) (and to allow revocation proceedings to continue to the further evidential rounds) it is not necessary for a registered proprietor to submit the entirety of their evidence at the outset. However, what is required is for the registered proprietors to show “use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used.” In addition the Hearing Officer points out that given the use of the word “show” in Section 100 this “suggests in revocation proceedings evidence must be more than mere assertion that the trade mark in question has been used, but must be actual evidence which shows how the trade

mark is used.”

27. In these proceedings the only evidence “showing” use of the trade mark FORMULA 1 (and device) are to be found at exhibit IMK4, which consists of a copy of Invicta Frames (who were the current registered proprietors’ predecessors in title) Frame Catalogue dated September 1996, exhibit IMK5 which consists of a copy of page 28 of the catalogue exhibited at exhibit IMK4 entitled All In One Price List September 1996 and exhibit IMK6 which consists of an undated sample pair of spectacle frames. In his skeleton argument Mr Stacey said:

“Even if wrong in this regard, it is commercially inconceivable that the brochure dated September 1996 would not have been in circulation subsequent to December 1996. It is therefore appropriate to draw inference from the initial evidence in this instance that the mark would have been exposed to the relevant public with the 5 year period prior the application for revocation.”

28. In his skeleton argument and at the Hearing, Mr McLeod urged me to ignore “unsubstantiated claims that evidence dated outside the relevant term under s.46(1)(b) would have been available within the relevant term....” He argued that, for example, no independent evidence from others in the optical trade had been provided to indicate the frequency of such publications. In the *Carte Bleue* case the Hearing Officer indicated the sort of evidence which would normally be expected to satisfy both the Trade Marks Registry and the applicants for revocation that a defence to the application could be mounted i.e. “the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc., all of which show use of the trade mark in question, together with some indication of the sales of goods, or the provision of services during the relevant period.” Quite correctly the Hearing Officer points out that these are only examples and that in certain circumstances other evidence may be considered sufficient.

29. In these proceedings the only evidence I have to consider are the three exhibits mentioned above. All bear the Formula 1 (and device trade mark) and relate to spectacles and spectacle frames. Exhibit IMK6 is undated and clearly of no assistance. What then do I make of exhibits IMK4 and IMK5 (the latter of which is included in the former)? While the brochure is dated September 1996 (i.e before the relevant period), Mr Stacey asked me to draw the inference that the publication would have been available within the material period; Mr McLeod said that such an inference was inappropriate. In the *Carte Bleue* case the Hearing Officer was also required to consider when an inference was appropriate he said:

“I note also the decision of Mr Geoffrey Hobbs Q.C. in *CORGI Trade Mark* [1999] R.P.C. 549, and I quote: "I appreciate that the registrar is frequently required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. Even so, it is necessary to remember that there is a distinction to be drawn between inference and conjecture."

“This was a point which figured in the speeches in the House of Lords in *Jones v. Great Western Railway Co.* (1930) 144 L.T. 194. The question in that case was whether the plaintiff had adduced evidence from which it could reasonably be inferred

that the death of her husband had been caused by negligence on the part of the defendant. Lord MacMillan (dissenting on the facts, but not as to the applicable principles of law) said at page 202: "The dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible but it is of no legal value, for its essence is that it is a mere guess. An inference in the legal sense, on the other hand, is a deduction from the evidence, and if it is a reasonable deduction it may have the validity of legal proof."

30. The registered proprietors have provided no evidence of any sales under the trade mark FORMULA 1 (and device) in the material period or indeed at all. In use, the words FORMULA 1 are always accompanied by what appears to be a device of a chequered flag; there is no use shown of the trade mark FORMULA ONE. For the purposes of this decision, it is not necessary for me to consider whether or not use of the trade mark FORMULA 1 (and device) would qualify as an acceptable variant (within the meaning of Section 46(2) of the Act) of the trade marks FORMULA 1 (solus) and FORMULA ONE and I prefer not to do so.

31. In view of the guidance provided in *Carte Bleue* in relation to when an inference is appropriate, I was not prepared in the circumstances of these proceedings to infer that the Frame Catalogue dated September 1996 was available within the material period because as Mr McLeod pointed, I had not been provided with any relevant or corroborative information; a decision in the registered proprietors' favour in this regard, would have amounted to no more than a guess on my part; it is clear from the guidance provided above that such an approach would not be appropriate.

32. Of course that is not an end to the matter as I also have the provisions of rule 31(3) to consider. This reads as follows:

“31 (3) Where a counter-statement, in conjunction with a notice of the same, on Form TM8, and evidence of use of the mark or reasons for non-use of the mark, are not filed by the proprietor within the period prescribed by paragraph (2), the registrar may treat his opposition to the application as having been withdrawn.”

33. In *Carte Bleue* the Hearing Officer commented on the provisions of rule 31(3) in the following terms:

“The consequence of my decision above is that the registered proprietors, whilst they may have filed a form TM8 and may have filed a counter-statement in relation to all three cases, have not provided evidence of use as required..... However, it seems to me that failure on the part of the registered proprietor to file evidence showing use of the trade marks may not be a fatal blow to a registered proprietor because, as a result of the use of the word "may" in rule 31(3) the registrar does not have to treat the opposition to the applications for revocation as having been withdrawn, but may # do so.”

34. This passage recognises that the Registrar may exercise her discretion in the registered proprietors favour to allow proceedings to continue notwithstanding the fact that they have

failed to comply with the requirements of the Act and rules. In his skeleton argument Mr Stacey mentions the Registrar's discretion in the following context:

“Rule 31(8) allows registrar discretion for filing of further evidence to be filed during the proceedings.”

As the Hearing Officer pointed out in *Carte Bleue*:

“Mr Thompson, in a further letter, admitted that the evidence could not be said to fail to show use of the trade mark, and that the registered proprietor will have an opportunity to file evidence later in the proceedings. As I have set out already, I believe the registered proprietors only have a second opportunity once they have joined the proceedings by filing evidence of use which can be supplemented at a later stage by further evidence.”

35. Consequently, that is not an appropriate basis on which I can exercise my discretion in the registered proprietors' favour. In his skeleton argument and at the Hearing, Mr Stacey appeared to suggest that the fact the registered proprietors were currently the subject of insolvency proceedings made the process of obtaining fuller evidence much more difficult, with the implication being that this may be a matter on which I could exercise my discretion in the registered proprietors' favour. If I indeed understood him correctly, this would not, in my view, be an appropriate reason to exercise my discretion in the manner indicated. The Act and rules are quite clear, that when challenged, it is for the registered proprietors to “show” what use they have made of their trade mark. The type of evidence required to satisfy rule 31(2) is not intended to be the entirety of the registered proprietors' evidence but simply evidence sufficient to demonstrate that a defence can be mounted; in the absence of proper reasons for non-use or such evidence being filed and in the absence of a suitable justification for the Registrar to exercise her discretion under rule 31(3), the consequences of such a failure are clear from the outset ie. the opposition to the application will be treated as withdrawn.

36. As a consequence of my decision above I have to deem the registered proprietors' opposition to the application for revocation as having been withdrawn. Therefore the application for revocation succeeds; under the provisions of Section 46(6)(a) the trade mark will be revoked from the date of the application for revocation.

37. Finally I heard submissions on costs with Mr McLeod requesting an award in the amount of £200 (in addition to costs in the proceedings) as a contribution towards his costs in attending this Interlocutory Hearing. The applicants for revocation have been successful and are entitled to a contribution towards their costs. These proceedings commenced on 10 December 2001; as such, I have calculated costs by reference to Annex A of Tribunal Practice Notice 2 of 2000. I order the registered proprietors to pay to the applicants for revocation the sum of £1000, this sum being calculated on the following basis: £300 in respect of the application for revocation, £200 in respect of the statutory fee, £300 for considering the

statement of case in reply and the associated evidence and £200 in respect of attendance at the Interlocutory Hearing. 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 28<sup>th</sup> day of November 2002**

**C J BOWEN  
For the Registrar  
The Comptroller-General**