

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 12494  
BY STARCASE (UK) LIMITED  
FOR REVOCATION OF TRADE MARK No 2202113

**VISITOR**  
STANDING IN THE NAME OF  
VECTORVIEW LIMITED

## **DECISION**

- 1) The trade mark VISITOR is registered under number 2202113 in Class 9 of the register in respect of “Electrical connectors and adaptors; electrical plugs and sockets; electrical reels and extension reels; parts thereof; but not including parts and fittings for telecommunications apparatus and instruments, or for desktop video conferencing and multimedia communications apparatus and instruments”.
- 2) The application for registration was made on 3 July 1999 and the mark was placed on the register on 18 February 2000.
- 3) By an application dated 1 May 2001, Starcase (UK) Limited of Starcase House, New Road, Pershore, Worcs, WR1 1BY applied for the revocation of the registration under the provisions of Section 46(1)(c) of the Trade Marks Act 1994. The grounds state that “in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for the products for which it is registered”. The applicant requests that if this ground is made out only in respect of some of the goods then the registration in respect of those goods should be revoked under Section 46(5) of the Trade Marks Act 1994.
- 4) On 30 August 2001 the registered proprietor filed a counterstatement denying all the grounds.
- 5) Both sides seek an award of costs. Both sides filed evidence.
- 6) At the hearing, on 30 October 2002, the registered proprietor was represented by Mr Mitcheson of Counsel instructed by Messrs Anthony Burrows. The applicant for revocation was represented by Mr Caulfield the Chief Executive Officer of the applicant company.

## **APPLICANT’S EVIDENCE**

- 7) The applicant filed a declaration, dated 9 November 2001, by Brian Caulfield. He states that his company “first commenced use of the name and trade mark VISITOR in 1996 in relation to travel plugs and travel accessories and such use has been continued up to and including the present time”. He states that his company sells approximately 10,000 pieces per annum under the trade mark VISITOR and these sales are made via leading multiple retailers such as House of Fraser, Debenhams and Rolling Luggage. At exhibit BC1 he provides a catalogue which shows products under the mark SAMONSITE. The brochure shows photographs of the various products on offer. Amongst a large selection of items there is a product shown as “UK Visitor’s Adaptor Plug”. On the same page there

are three other “adaptor plugs” labelled “American/South Pacific”, “Worldwide” and “European”. Mr Caulfield states that his company’s common law rights therefore predate those of the registered proprietor.

8) Mr Caulfield states that a number of other manufacturers of adaptor plugs and sockets also use the trade mark VISITOR, he names them as Go, Carlton, Travellers Plus and Masters. At exhibit BC2 he provides six examples of other companies products. Two different versions are from GO Travel Emporium. These are “The Foreign Visitor” and “The USA Visitor”. Both have the word VISITOR in very large print with the other part of the title above but in much smaller print. Another is from Carlton International. This is labelled “The ‘Tourist’ Travel Adaptor” with underneath “For all visitors to Great Britain”. A Boots plug has the term “Tourist Adaptor” in large print above the words “For visitors to the UK”. There are also two Samsonite products. One has Samsonite in large print with the words “Visitor to the UK ADAPTOR PLUG” underneath. The other is headed “Royal Traveller by Samsonite”. Beneath the plug it has “Visitor to the UK adaptor plug”.

9) Mr Caulfield states that as other manufacturers and sellers are using the word “Visitor” in a descriptive manner and as a generic name that registration number 2202113 should be revoked. He claims that the word “Visitor” is a generic name and “is absolutely paramount to the explanation of the item, i.e. this plug is solely for the use of visitors coming to the United Kingdom”.

10) At exhibit BC3 Mr Caulfield provides the result of an internet search for the words “visitor plug”. This is dated 11 February 2001. The result shows that the words are widely used not only for adaptor plugs but also plugs for computer access. Mr Caulfield states that the word “visitor” is generic for all types of plugs. At exhibit BC4 he provides details of another internet search, dated 11 May 2001, which shows that others offer products under the “visitor” name.

#### REGISTERED PROPRIETOR’S EVIDENCE.

11) The registered proprietor filed a statement, dated 25 April 2002, by Lindsay Stephen Groves the Managing Director of Vectorview Ltd, the registered proprietor. He states that his company first used the mark in suit in 1990 in respect of electrical connectors in the form of electrical adaptors. At exhibit LSG1 he provides the following:

- photographs of two plugs which it is claimed have the word “visitor” moulded into them, although it is only visible on the second plug said to have been sold by the registered proprietor since 1992;
- a copy of the card from a blister pack for a travel plug by “GO” under the name “The Visitor”, which was supplied by the registered proprietor;
- a photograph of a plug called “The visitor” marketed by Go in 1995/96 which was also supplied by the proprietor;

- a copy of the 1995 catalogue from Dencon Accessories Limited which shows a “visitor” adaptor supplied by the registered proprietor;
- a photograph of the front page of a 1997 brochure issued by Go which shows a plug supplied by the registered proprietor under the name “The Visitor”;
- a test certificate issued in 1990 by Rowland Laboratories Ltd referring to the “Visitor” travel adaptor.

12) Mr Groves states that his company supplies “visitor” travel adaptors to distributors who may use the VISITOR mark with the consent of the registered proprietor. He states that his company supplies plugs to companies such as GO, Dencon Accessories Ltd, Travel Accessories (UK) Ltd (subsequently Masters Ltd, then Cork Limited).

13) He states that:

“Travel Accessories (UK) Ltd (subsequently Masters Limited) and subsequently Cork Limited have, in the last ten years, supplied “Visitor” adaptors to Travel Plus, a trading name of Cometform Limited. Dencon Accessories Limited have supplied Carlton with “Visitor” adaptors since around 1999 and, before that date, Carlton were supplied by Cometform Limited. Travel Accessories (UK) Limited and subsequently Masters Limited up to approximately 1998 and then Carole Group Limited (trading as Carole Plus) from approximately 1999 to 2000 supplied “visitor” adaptors to the applicants for revocation, who are the distributors for Samsonite Corporation.”

14) Mr Groves states that the companies identified by the applicant as using the VISITOR mark have been supplied by the Registered Proprietor, either directly or indirectly. He provides turnover and promotion figures for travel adaptors supplied by the proprietor under the name VISITOR as follows:

Year	Units sold	Value £	Promotion £
1996	105,000	170,000	2,000
1997	170,000	260,000	3,000
1998	145,000	240,000	3,500
1999	90,000	140,000	4,000
2000	245,000	370,000	4,000
2001	235,000	350,000	9,000

15) Mr Groves points out that the search list provided by the applicant has two providers of adaptors who are both supplied by the registered proprietor, the other “hits” relate to “visitor plug ins” which

are computer programmes that work with a web browser programme to increase functionality, typically adding sound and animation. These have nothing to do with adaptor plugs or travel accessories and he asserts they “are certainly not plugs for computer access as wrongly declared by Mr Caulfield in his statutory declaration”. Mr Groves then refers to the second list supplied by the applicant in its’ evidence. He claims that the three adaptor plugs shown for sale are all supplied by his company.

#### APPLICANT’S EVIDENCE IN REPLY

16) The applicant filed a second declaration by Mr Caulfield, dated 26 June 2002. Mr Caulfield states that he does not dispute that the registered proprietor has used the mark, but that many others, including his company have also used the mark. He reiterates his view that the mark “visitor” in relation to a travel plug for visitors is generic that is vital to the description of that type of plug.

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

#### DECISION

18) The grounds of revocation are based on Section 46(1)(c) which reads:

46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

(a)...

(b)....

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

19) The question under Section 46(1)(c) is whether as a result of acts or omissions by the trade mark proprietor, the trade mark has become commonly used in the trade as the name of the products for which it is registered. It is clear that products can have more than one name. For example alloy wheels are wheels but are often known as “alloys”. “Alloys” is a common name for those goods.

20) In the statement of grounds the applicant contended that they had used the word, VISITOR, in relation to travel plugs/adaptors and accessories since 1996. These adaptors enable visitors to the UK to use small electric appliances such as shavers which have two pin or round pin plugs. The applicant also claimed that a number of other manufacturers also used the word VISITOR on similar items. However, at the hearing the applicant accepted that all of the other manufacturers identified are supplied with their adaptors by the registered proprietor. When looking at the examples of adaptors provided and their packaging it is clear that not all of them are using the term “visitor” as a trade mark. The examples of plugs provided at exhibit BC2 shows Boots selling a plug under the name “Tourist Adaptor”. The product is described as being for “visitors to the UK”, but the word VISITOR is not

used as the name of the product but as a description of its intended purpose. The example from Carlton International is the same. The two examples from Samsonite show the primary name of the product as “adaptor plug” and the kind of plug is described as being “visitor to the UK”. The two examples from “GO” carry the names “The Foreign Visitor” and “The USA Visitor”. In both cases the word “visitor” is presented in a larger typeface. It is ambiguous whether this is trade mark use of VISITOR or descriptive use of the phrases mentioned above. The examples of the trade mark use provided are irrelevant to my decision because they are, by definition, not examples of the word VISITOR being used as the name of the product.

21) It is not fatal to the applicant’s case that the registered proprietor has supplied all the products in question. If the proprietor has consented to the use of VISITOR by other parties, but has not controlled how the name is used, with the result that it becomes the common name of the product in trade, the proprietor’s inactivity can present a ground for revocation.

22) In the instant case the examples provided in exhibit BC1 are equivocal as to whether VISITOR has become customarily used in trade as a secondary name for travel adaptors. The closest example of this is the use made by Samsonite, for whom, the applicant appears to act as a distributor. The example in the Samsonite brochure in BC1 is an even clearer example, but by the same party. The internet hits in exhibit BC3 are not of any assistance because they provide only abstracts of the web pages found, from which it is impossible to tell whether the word “visitor” is being used as a trade mark or as the name of the product. The exhibit BC4 is the same except it includes one copy of an actual web page showing “The Visitor” being used either as the name or as a trade mark for an adaptor plug. It is not entirely clear which, although judging from the adjacent entries it looks likely to be used as the name of the product. This use is again by Samsonite.

23) The evidence provided is ambiguous and leaves me in a state of uncertainty as to whether VISITOR has become the common name of a type of adaptor plug in the trade. However, the legal onus under Section 72 of the Trade Marks Act 1994 is placed on the applicant. The applicant has failed to show that the mark in suit, VISITOR, has become the common name in the trade for adaptor plugs. The request for revocation therefore fails.

24) The application for revocation fails. I order the applicant to pay the registered proprietor the sum of £1500. 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 23<sup>rd</sup> day of December 2002

George W Salthouse  
For the Registrar  
The Comptroller General