

O-380-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 81507
BY SAPROTEX INTERNATIONAL (PROPRIETARY) LIMITED
FOR REVOCATION OF REGISTRATION No. 1422809
STANDING IN THE NAME OF HACHETTE FILIPACCHI PRESSE**

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**IN THE MATTER OF Application No. 81507
by Saprotex International (Proprietary) Limited
for Revocation of Registration No. 1422809
standing in the name of Hachette Filipacchi Presse**

Background

1. Trade mark No. 1422809 is registered in the name of Hachette Filipacchi Presse (HFP) for “Lace and embroidery; ribbons and braid; artificial flowers; all included in Class 26”.
2. The mark itself is as follows:

ELLE

3. On 11 November 2003 Saprotex International (Proprietary) Limited (Saprotex) applied for this registration to be revoked under the provisions of Section 46(1)(b) of the Act on the basis of non-use (and no proper reasons for non-use) for an uninterrupted period of five years in relation to the goods for which it is registered. In the alternative, if the proprietor can show genuine use, the applicant requests that the registration be limited to those specific goods under Section 46(5) of the Act.
4. The applicant makes two further points. Firstly, it contends that any use of the mark ELLE on promotional products associated with the proprietor’s magazine, ELLE, serves only to generate goodwill in the magazine itself, and not in relation to the promotional products. It is also contended that the advertisement or promotion of third party products in ELLE magazine does not constitute use of the mark ELLE in relation to those goods.
5. The registered proprietor filed a counterstatement denying the above ground. HFP asserts that it has made genuine use of the mark (or a form of it falling within Section 46(2)) in relation to the goods at issue. In the alternative HFP asserts that it made preparations for use during the five years ending on 10 November 2003 and that, at the time when such preparations took place, it was not aware that an application for revocation might be filed. It is also asserted that HFP’s use has been in relation to ‘stand-alone’ ELLE goods and merchandise.

6. Both sides ask for an award of costs in their favour.

7. Only the registered proprietor filed evidence. The matter came to be heard on 13 December 2004 when HFP was represented by Ms A R Chaudri of Bristows and Saprotex by Mr M Vanhagen of Counsel instructed by Urquhart-Dykes and Lord.

Evidence

8. HFP has filed a witness statement by Fabienne Sultan, Assistant Director of the proprietor's Intellectual Property Department.

9. Ms Sultan explains that HFP and its subsidiary companies are responsible for publication and distribution of the ELLE magazine. This was first published in France in 1945 and in the UK in 1985. Exhibited at FS1 is a copy of HFP's 1998/99 brochure entitled "ELLE, THE BRAND BUSINESS" which contains a section giving the history of the magazine and ELLE merchandising. A copy of the front cover of the first issue of the magazine is at FS2.

10. Ms Sultan says that:

"4. ELLE magazine in all its editions throughout the world is designed to appeal to women. It is principally a fashion and beauty magazine with a strong focus on women's issues and interests, fashion goods such as women's clothing, shoes and fashion accessories, cosmetics and beauty products and household goods such as those covered by the Registration. ELLE magazine is principally directed to and read by an audience of 18 to 35 year old, sophisticated, educated, career-orientated, upmarket women with significant disposable income. Sales of ELLE magazine have been extremely high. In 1996 for example, 60 million copies of the ELLE magazine (all editions) were sold worldwide, ELLE magazine had 20 million regular readers (including through direct subscriptions to the magazine) and a total audience coverage of 80 million. Consolidated sales figures for ELLE magazine for the year 1997 / 1998 total approximately £69.8 million.

5. As mentioned above, the UK edition of ELLE magazine was launched in 1985 and has enjoyed enormous success with an average monthly circulation in recent years of 200,912. Both the UK edition and the French edition of ELLE magazine have regularly offered ELLE-branded goods for sale through a market section featured in the magazine. The French edition of ELLE magazine has been distributed for many years and continues to be distributed in the UK market.

It is widely read by the UK public who have regularly ordered products featured in the market section of the French magazine, initially named BON MAGIQUE and subsequently ELLE PASSIONS, through the mail order system organised by one of HFP's subsidiaries, EXPLOITATION COMMERCIALE D'EDITIONS DE PRESSE (ECEP). Goods are ordered from ELLE magazine using order forms which appear in the magazines themselves. Where the magazine concerned is the French edition, payment is possible in Euro and French francs. I attach as Exhibit FS3 an example of a completed

order form from the UK for various artificial flowers which were advertised for sale in the 7 January 2002 issue of the French edition of ELLE magazine. Copies of the front cover of that magazine and the advertisement/offer for sale of artificial flowers are also included in Exhibit FS3. The 7 January 2002 issue of the French edition of ELLE magazine was circulated in the UK in common, as mentioned above, with other issues of the French edition of ELLE magazine. I attach as Exhibit FS4 exportation sales sheets established by the independent organisation NMPP showing the extent to which the French edition of ELLE magazine was distributed worldwide including in the UK during some part at least of the five years prior to 10 November 2003. The UK is referred to variously as “Royaume Uni” and “G. Bretagne”. The column headed “Vente Ex” shows the number of copies of the magazine sold in each country. I attach as FS5 copies of the front cover of the UK edition of ELLE magazine dated September 2002 and an offer, within that magazine, for sale of ELLE-branded hair clips; I refer to the “barrette” which is item number 5 – “barrette” in English denotes a pin/clasp for holding the hair in place and in French translates as the English word “hairslide”. Given that the average monthly circulation of ELLE magazine (UK edition) in the UK has been 200,912 in recent years, at least 200,912 members of the UK public will have seen this offer for sale.

6. On 24 January 2003, HFP appointed Lafolie Sarl (hereinafter “Lafolie”) as licensee for the class 26 goods covered by the Registration and other goods throughout Europe, including the UK, with effect from 1 March 2002. I attach as Exhibit FS6 a copy of a catalogue produced by HFP entitled “ELLE European Licensing Guide 2003”. This was distributed to licensees of ELLE. It refers to Lafolie on page 41 and states “Together with ELLE, Lafolie has created a new and exciting concept for the Hair and Beauty Accessories” and “Launched in October 2002, the ELLE collection is now available in large European department stores such as ... Harrods”.

7. I attach as Exhibit FS7 copy statements setting out sales figures for hair and fashion accessories in Europe by Lafolie during the periods 1 January 2003 to 31 March 2003, 1 April 2003 to 30 June 2003 and 1 July 2003 to 30 September 2003. Sales figures for the UK are shown against the sub-heading “Grande Bretagne” and are 4259.84 Euro, 892.20 Euro and 6409.08 Euro for each of the periods, respectively, mentioned above.

8. I attach as Exhibit FS8 copies of invoices issued by Lafolie to Soustiel (UK) Ltd in the UK during the years 2002 and 2003. These show sales in the UK of hair bands / braids – referred to as “All over fait main” pony tail, “Fleur pop” pony tail, Elastiques logo metal, Carte de 12 Elastiques pm/mm, Carte de 6 Elastiques gm. The French word “elastique” is commonly used to denote hair bands.”

The Law

11. Sections 46 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;
- (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;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(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.”

12. Section 100 is also relevant and 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.”

Leading authorities

13. I was referred to and accept that I must be guided by the following main authorities in dealing with the issues before me. In relation to what constitutes genuine use of a mark the European Court of Justice (ECJ) has indicated in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40:

“36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *visa-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as

warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

14. In *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38 the ECJ gave supplementary guidance in relation in particular to small or minimal use of a mark and the issue of the relevance of use after the filing date of revocation:

“When assessing whether use of the trade mark was genuine, regard had to be had to all the facts and circumstances relevant to establishing whether the commercial use of the mark was real in the course of trade, particularly where such use was viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of the use of the mark. When it served a real commercial purpose, in the circumstances cited above, even minimal use of the mark or use by only a single importer in the Member State concerned could be sufficient to establish genuine use within the meaning of the Directive.

(2) While the Directive made the classification of use of the trade mark as “genuine use” consequential only on consideration of the circumstances which pertained in respect of the relevant period and which predated the filing of the application for revocation, it did not preclude, in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing. It was for the national court to determine whether such circumstances confirmed that the use of the mark during the relevant period was genuine or whether, conversely, they reflected an intention on the part of the proprietor to defeat that claim.”

15. I also bear in mind that the English Courts have emphasised the need for registered proprietors to prove their case with great care particularly where a few items or small amounts of use are relied on (see *Philosophy Di Alberta Ferretti Trade Mark* [2003] RPC 15 and *Laboratoires Goemar SA’s Trade Marks* (in the High Court) [2002] ETMR 34).

Dates

16. The application for revocation was filed on 11 November 2003 and has been made under Section 46(1)(b). In the absence of a request for revocation with effect from an earlier date, the relevant five year period is, therefore, 11 November 1998 to 10 November 2003.

Decision

17. Mr Vanhegan submitted that no evidence had been filed to support use of the ELLE mark in relation to lace and embroidery and that the evidence filed did not establish use in relation to ribbons, braid and artificial flowers. I do not understand Ms Chaudri to resist the position on lace and embroidery. There is in any case no use shown for these goods. She sought to defend HFP's position in relation to the remaining goods on the basis of the evidence filed. I, therefore, turn to consider that evidence in more detail.

18. Exhibit FS3 is the only one dealing specifically with artificial flowers. It consists of a copy of an advertisement from the 7 January 2002 issue of the French edition of ELLE magazine along with a single completed order form from a customer with a London address (Exhibit FS4 gives circulation figures for the French edition of the magazine). The advertisement is in French with French franc and euro prices. There is nothing to indicate that the offer is restricted to France or any countries in particular. Equally there is no indication as to whether this was an isolated order or even whether it was fulfilled. The evidence is, therefore, thin and is scarcely compelling support for the claim that the use shown was intended to maintain or create a market for the goods.

19. But, there is a further reason why this use cannot assist in defending this part of the specification. As Mr Vanhegan pointed out the French text which supports the offer for sale describes the goods as "fleurs en trompe l'oeil d' Hervé Gambs". I infer that this individual is the creator/designer of the flowers. It is not possible to say how, whether, or in what way the goods or their packaging were marked. I note, too, that the offer appears to be made by Boutique ELLE-PASSIONS. The latter also acts as the contact point for orders. References in the text are consistently to ELLE-PASSIONS or BOUTIQUE ELLE-PASSIONS. If this is intended to show use of the mark then the question arises as to whether it can be said to be in "a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered" (Section 46(2)). In my view the answer to that is plainly not. ELLE-PASSIONS is presented as two elements conjoined by a hyphen. PASSIONS is clearly an element that is not present in the registered mark and must be taken to make a material difference to the mark as registered. For this reason also HFP cannot succeed in defending "artificial flowers".

20. HFP's position in relation to ribbons and braids is supported by four exhibits. Paragraph 5 of Ms Sultan's witness statement refers to Exhibit FS5 being an offer of a variety of goods in the September 2002 issue of the UK ELLE magazine. Ms Sultan refers to an item called a barrette which is said to mean a hairslide or clasp. That accords with the item pictured in the offer. Although a hairslide may be an alternative to a ribbon or such like for tying the hair back it would be stretching the ordinary meaning of ribbons and braid to breaking point to suggest that the item in question would fall within such a definition.

21. The remaining exhibits relate to Lafolie Sarl(Lafolie), HFP's European licensee for Class 26 goods.

22. FS6 is a copy of the ELLE European Licensing Guide 2003 which was distributed to licensees. The document is thus internal in character. Lafolie is referred to on page 41 as having

created a new and exciting concept for the hair and beauty accessories. No further information is given as to the precise nature of the products (I bear in mind that beauty accessories may be found in a number of Classes). A number of photographs of products or parts of products are shown on the facing page. Most appear to be Class 3 cosmetic items. None appears to be ribbons or braid.

23. The Lafolie sales figures for various periods in 2003 (Exhibit FS7) suffer from the same deficiency as is noted above. The sales, which are in any case small, are said to relate to ‘hair and beauty accessories’. There is no further breakdown between product types and no information specifically bearing on sales of ribbons and braid.

24. That leaves the invoices at FS8. The goods are referred to by their French names on the invoices. Ms Sultan says that “These show sales in the UK of hair bands/braids – referred to as “All over fait main” pony tail, “Fleur pop” pony tail, Elastiques logo metal, Carte de 12 Elastiques pm/mm, Carte de 6 Elastiques gm. The French word “elastique” is commonly used to denote hair bands.”

25. This seems to me to be altogether too imprecise for me to be confident that the goods referred to in the invoices fall within the terms ribbons and braid. Firstly, even Ms Sultan does not describe the goods as ribbons. Secondly, the term bands/braids are used as if they are interchangeable. I am not so sure that they are. Hairbands may be of quite different composition to ribbons and/or braid. Thirdly, the imprecision is compounded by the fact that ‘elastique’ is said to be commonly used to denote hair bands. That may be so but if elastique has its obvious meaning it must surely refer to an elasticated hairband which does not seem to fit well with the terms ribbons and braid. Further information may have shed more light on the position but I can only base my decision on the material available to me. Fourthly, the term in the specification is braid (singular). That rather suggests a material for making up into something as opposed to the sort of products that are said to be the subject of the invoices. As *Jacob J* (as he was then) said in *Laboratoires De La Mer Trade Marks*:

“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.”

26. I conclude that HFP’s evidence does not substantiate their claim to have used their mark. Nor does it support a claim that preparations for use were in hand in relation to the goods of the registration.

27. Ms Chaudri’s skeleton argument invited me, were I minded to revoke or part revoke, to exercise discretion in HFP’s favour. The issue of whether the tribunal enjoys a residual discretion was considered in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 with the judge finding that there is no such discretion under the 1994 Act. That decision is binding on me.

28. Accordingly, the registration falls to be revoked in relation to all the goods for which it is registered. Revocation will take effect from the filing date of the application. That is to say 11 November 2003.

Costs

29. This is one of five revocation actions launched on the same day involving the parties. I heard submissions at the hearing in relation to the costs arising from the material available to me at the hearing. I was also told that there had been a certain amount of 'without prejudice save as to costs' correspondence that might need to be considered. The parties' representatives invited me to defer a decision on costs so that they could assess their position in the light of my decisions on the substantive issues. Exceptionally, I agreed to do so. The parties will, therefore, have fourteen days from the date of this decision to either indicate that they are content to bear their own costs in the light of the overall outcome of the cases or to file copies of the 'without prejudice save as to costs' correspondence along with their submissions in relation thereto. In the latter case I will issue a separate decision on costs which will also take account of the submissions on costs made at the hearing.

Dated this 30th day of December 2004

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