

O-381-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATIONS Nos. 81508, 81509 AND 81510
BY SAPROTEX INTERNATIONAL (PROPRIETARY) LIMITED
FOR REVOCATION OF REGISTRATIONS Nos. 2022323B, 1241260
AND 1072225 STANDING IN THE NAME OF
HACHETTE FILIPACCHI PRESSE**

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**IN THE MATTER OF Applications Nos. 81508, 81509 and 81510
by Saprotex International (Proprietary) Limited
for Revocation of Registrations Nos. 2022323B, 1241260 and 1072225
standing in the name of Hachette Filipacchi Presse**

Background

1. Trade Mark No. 2022323B is registered in respect of:

Spectacles; spectacle frames, eye glasses, sun glasses, lenses and spectacle cases and other spectacle containers, chains for spectacles, accessories and parts and fittings for spectacles and like goods. (Class 9).

All leather articles and baggage, namely bags handbags, tote bags, travelling bags, evening bags, backpacks, toilet bags, make-up pocket bags, pouches, envelopes, beach bags, game bags, school bags, satchels, shopping bags, cling bags for carrying infants, wheeled shopping bags, waist bags, purses, billfolds, chequebook cases, card cases, briefcases, vanity cases (not fitted), key cases (leatherware), trunks and valises, suitcases, travelling sets (leatherware), luggages including soft and hard case luggages, wallets, toilet kits, make-up kits, umbrellas and parasols, walking sticks, canes, leather and imitation leather and more generally articles made of these materials not included in other Classes; skins, furs and fur-skins, hides, whips, harness and saddlery. (Class 18).

Clothing including boots, shoes and slippers and headgear for women, but not including socks, stockings or tights. (Class 25).

2. The mark in question is as follows:

E L L E

3. Trade mark No. 1241260 is registered in respect of:

Clothing for women, but not including socks, stockings, body stockings or tights (Class 25).

4. The mark in question is as follows:

ELLE

5. Trade Mark No. 1072225 is registered in respect of:

Outer clothing for women, but not including stockings, body stockings, tights or swimwear (Class 25). The registration details record that 'socks' have been cancelled from the registration.

6. The mark in question is:

ELLE

7. All the registrations stand in the name of Hachette Filipacchi Presse (HFP).

8. On 11 November 2003 Saprotex International (Proprietary) Limited (Saprotex) applied for these registrations to be revoked (or revoked in respect of Class 25 goods in the case of No. 2022323B) 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 they are registered. In the alternative, if the proprietor can show genuine use, the applicant requests that the registrations be limited to those specific goods under Section 46(5) of the Act.

9. 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.

10. The registered proprietor filed counterstatements denying the above grounds. The counterstatements are couched in identical terms so far as the substance of HFP's case is concerned. 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.

11. Both sides ask for an award of costs in their favour. 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 Vanhegan of Counsel instructed by Urquhart-Dykes and Lord.

12. This decision deals with three out of five related revocation actions involving HFP and Saprotex filed on the same day. The two further cases involve goods in Classes 24 and 26 where, for obvious reasons, separate evidence needed to be filed. The three cases involving Class 25 goods have had near common-form evidence filed.

The evidence and Saprotex's position

13. HFP has filed witness statements by Abida Rifat Chaudri who is employed by Bristows solicitors, HFP's representatives in this matter. Her evidence goes to the use of the ELLE marks on a range of clothing items. In the light of this evidence Mr Vanhegan, in his skeleton argument and in submissions at the hearing, invited me to dismiss both the 81509 and 81510 proceedings. In relation to the 81508 proceedings his position was that the registration should be partially revoked in respect of slippers and headgear. Strictly, the applicants for revocation have not withdrawn or partially withdrawn their applications but it seems to me that by inviting me to dismiss the proceedings to the extent indicated above they are in effect conceding the position. That appears to me to be a realistic and sensible concession in relation to the previously contested goods in the light of the substantial use shown by HFP. In the circumstances I do not propose to offer the normal summary of the evidence but will instead deal with individual exhibits that relate to slippers and headgear in my decision below.

The Law

14. 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.”

15. 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

16. 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 vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d’être*, 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.”

17. In *La Mer Technology Inc v Laboratoires Goemer 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.”

18. 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

19. 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 in relation to 81508

20. I turn at this point to HFP's evidence in relation to slippers and headgear. There is little evidence in relation to the first of these. The ELLE European Licensing Guide for 2003 at Exhibit ARC8 (page 35) refers to ID Line, one of HFP's licensees, developing a range of casual and sporting shoes. The key markets are said to be France, Spain and Portugal. There is no specific mention of the sale of slippers under the mark ELLE in the UK. Exhibit ARC17 consists of a number of pages taken from the ELLE website along with a further site that deals with sales generated through the main site. There are, in addition, a number of copies of confirmation of orders. The latter show UK addresses but the order details are in French and clearly cover a wide range of goods. It has not been suggested that any of these orders relate to slippers. In fact the only evidence that such items have ever been offered for sale is in a website page from www.elleshop.com dated 22 February 1999 in ARC17. A number of items are advertised, one of which bears the text 'Slippers to add elegance to your every step, at home or in the city'. It is not possible to say from the accompanying small photograph quite what the nature of the goods are. As Mr Vanhegan not unreasonably pointed out the advertisement refers to use 'in the city' which suggests outdoor use. Whether the goods in question were slippers within the normal meaning of that word in the UK is not clear. The price is given in French francs. It is not possible to say what mark was applied to the goods (was it, for instance, ELLE or elleshop in

line with the website?). Ms Chaudri also referred to sale of moccasins but I do not regard such items as being slippers in the conventional sense. On the basis of the solitary advertisement and without further information on the nature of the goods, the regularity with which the advertisement appeared, and evidence as to its impact, I am of the clear view that there has not been genuine use in relation to slippers.

21. So far as headgear is concerned the relevant exhibits are as follows:

- ARC9 - showing two baseball caps on two separate pages of the ELLE Spring/Summer 1998 catalogue. Both carry the catalogue reference HA6219 and so are clearly the same item. However, as the relevant period commences in November 1998 this would appear to place this material outside the scope of what may legitimately be considered;
- ARC9 - a reference in the Spring/Summer 1999 ELLE catalogue to a 'cap with raised embroidery'. Unlike the baseball caps referred to above which are depicted in the catalogue there is no picture of the cap. It is not possible to say what mark might have appeared on the goods. It might be thought that it is reasonable to infer that it would be the ELLE mark but I note from other material in ARC9 that other marks are also used so the position needed to be established with some care;
- ARC9 - the ELLE Autumn/Winter 2002 catalogue produced and distributed by D B Actif, one of HFP's licensees. On facing pages of what seems to be a spirally-bound catalogue are two baseball caps, two cord bucket hats and one knitted stripe beanie hat. In common with all other items in the catalogue no prices are given. The final page of the catalogue deals with pack ordering and marketing support (showcards, posters, paper and drawstring bags, stickers, window stickers etc). I infer that this particular catalogue was not intended for public use but would have been made available to distributors/retail outlets/concessions/stores etc as an ordering tool. It does not seem to me to confirm that all or any of the goods shown in the catalogue would have been ordered and offered for sale by any of the outlets through which HFP operated at the time. In short it appears to be the sort of internal use which *Ansul* cautions against accepting as genuine use;
- ARC9 - also contained in this Exhibit are a number of sweatshirts with hoods. I do not think Ms Chaudri relied on such items as a main part of HFP's defence of the term headgear. For my part I do not accept that such goods would be considered as headgear in the conventional sense;
- ARC18 - this is a catalogue entitled "ELLE Promotional Items Collection 2001 – 2002". It depicts a range of ELLE goods including on page 9 a floppy hat (possible a sun hat). The document is in English and French and is said to have been circulated in both countries. It is a photocopied document and

is indistinct in parts. Catalogue reference numbers are given but not prices. The title of the document rather suggests that the items listed were intended as promotional give-aways but I accept that that may be too narrow a view of the matter. What is clear is that the exhibit is of limited value on its own. It calls for further information on its intended purpose, to whom it was sent, whether it was available to customers, whether it resulted in sales etc.

22. Making the best I can of this material and for the reasons given above I find that it does not establish genuine use of the mark within the terms of the guidance set down in the *Ansul* case.

23. 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.

24. Accordingly, the registration falls to be revoked in respect of slippers and headgear (pursuant to Section 46(5)). Revocation will take effect from the filing date of the application. That is to say 11 November 2003. For the avoidance of doubt I confirm that the other two actions (Nos 81509 and 81510) stand dismissed.

Costs

25. This decision has dealt with three 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**