

O-350-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 82013
BY BIBA + PARISCOP DAUD GMBH
FOR REVOCATION OF TRADE MARK NO. 1016773
IN THE NAME OF HACHEL INTERNATIONAL FOUNDATION**

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**IN THE MATTER OF Application No. 82013
in the name of BIBA + Pariscop Daub GmbH
For revocation of trade mark No. 1016773
in the name of Hachel International Foundation**

BACKGROUND

1. Trade mark No.1016773 is registered in respect of the following goods in Class 14:

Articles included in Class 14 made of precious metal or coated therewith,
jewellery; watches and clocks, and parts and fittings for watches and clocks.

2. The trade mark is as follows:



*Registration of this trade mark shall give no rights to the exclusive use
of the word "Biba"*

3. The trade mark is registered in the name of Hachel International Foundation.
4. By an application dated 20 January 2005, BIBA + Pariscop Daub GmbH applied for the registration to be revoked under the provisions of Section 46(1)(b) of the Act, on the basis that the trade mark has not been put into genuine use in the five years immediately preceding the filing of the action, or in the five years preceding 21 August 2003, in relation to the goods for which it is registered, either by the registered proprietors or with their consent, and there are no proper reasons for non-use.
5. In a Counterstatement filed on 9 May 2005, the registered proprietors claim that the mark has been used.

6. Both sides ask that an award of costs be made in their favour.

7. Both sides filed evidence in these proceedings, which, insofar as it may be relevant I have summarised below. Neither party took up the offer of an oral hearing so after a careful study of the papers and the written submissions I give my decision.

Registered proprietor's evidence Rule 31(3)

8. This consists of a Witness Statement dated 5 May 2005, from Carmel Levy, President of the Board of Hachel International Foundation, and Biba Corporation of America. Mr Levy confirms he has full access to the books and records of his company.

9. Mr Levy states that the name BIBA was first used in October 1964 when Barbara Hulanicki, one of the originators of the name, opened a shop in London. He recounts that in April 1966, Time magazine crowned London as "The City of the Decade", citing BIBA as "The most in shop" for girls". Mr Levy recounts that in 1971, BIBA opened a boutique in New York, concessions in stores in Paris, Milan and Tokyo, and BIBA cosmetics went on sale in more than 300 Dorothy Perkins stores throughout the UK, Dorothy Perkins being a major shareholder. In 1973 BIBA was sold to British Land, and shortly after closed, although Dorothy Perkins continued to sell BIBA cosmetics. There is no evidence to corroborate either the date of opening of the shop, the claimed accolade from Time magazine, or the sales by Dorothy Perkins.

10. Mr Levy goes on to say that in 1977 his company purchased all rights in the BIBA name, in 1978 opening a store in London selling BIBA branded clothes, cosmetics, fashion items and jewellery. The store remained open for around two years. He goes on to make various claims, such as to the "iconic" status of the BIBA name, referring to a book entitled "BIBA: The BIBA Experience", published in 2004 to mark the 40th anniversary of the BIBA shop. The book itself has not been provided as an exhibit.

11. Mr Levy states that his company has licensed third parties to manufacture and sell BIBA branded goods on their behalf, naming in particular Ecker Investments Limited, who, between 1994 and 1999 operated a BIBA shop in London selling articles of clothing, footwear, headgear, jewellery and cosmetics, and at some unspecified time, operated a concession in Selfridges selling articles of clothing, cosmetics and bags. Exhibit CL1 is stated to consist of photographs of the store. Exhibit CL2 being photographs of the concession. The photographs show shop signage (both internal and external) bearing the BIBA name in conjunction with an art-deco style device, and also this device on its own. The interior views show BIBA being used specifically in relation to cosmetics, but also that clothing was available for purchase. Some photographs are marked "97 9 19" recorded by the camera, and presumably is the date, 19 September 1997, on which the photographs were taken.

12. Exhibit CL3 consists of photographs of BIBA branded products, namely, cosmetics, footwear, a jar of whole chillies, a handbag and a newspaper with the title BIBA, and a headline "Welcome to the new BIBA". The photographs show the BIBA name with various graphical elements, including the art-deco style design, and other similarly styled images that are more likely to be taken as decoration rather than

part of the brand. But as with the other photographs, in all but one case there is nothing by which to date them. The exception is the photograph of the handbag, which shows the date 31/03/2005, this seeming to have been recorded by the camera, and is presumably the date on which the photograph was taken. The BIBA name can just be made out on the clasp of the bag.

13. Exhibit CL4 consists of various advertisements and features relating to BIBA clothing and cosmetics. Many do not indicate the date from which they originate or even the publication in which they appeared. Of those that can be dated, three show use of BIBA in relation to cosmetics, in magazines and newspapers that were available in the UK in August 1997 and April 1999. The products bear the BIBA name and “Celtic swirl” device, the accompanying text simply referring to BIBA. The remaining parts of the exhibit consists of features referring to the establishment of the BIBA name in the 1960s and 1970s, referring to the re-launch of the brand described as a “fashion leader” in connection with a range of cosmetics, but as the article itself cannot be dated, it is not possible to pinpoint when this re-launch was taking place. Another article, marked as being from the August 1996 edition of Company magazine, describes BIBA as the “sixties fashion and style phenomenon”, and announces the re-launch of BIBA branded clothing.

14. Mr Levy goes on to refer to Exhibit CL5, which he says is an invoice relating to sales/delivery note and invoice relating to sales made by Selfridges; there is no mention of BIBA on either document. He goes on to refer to sales of BIBA and BIBA and device branded footwear made through the Grattan catalogue in the 1999 Autumn/Winter catalogue. Exhibit CL6 is said to be a copy of an invoice showing total sales to Grattan of nearly £12,000 in the period July 1999 to February 2000. The invoice is dated 30 April 1999, raised by Christopher Joseph of Melian Agencies who Mr Levy says had been helping as a distributor, to Grattan plc, and is endorsed “paid 4/6/99”. The invoice mentions goods by the codes BIBA01, BIBA02, etc, but not by name. There are references such as “Cost £24.05 x 170 pairs...” which could indicate that these are footwear. Exhibit CL4 contains two pages marked as being from the Grattan catalogue which, amongst other things, shows BIBA footwear, BIBA being shown with the swirl device and also on its own in the descriptive text, but there is nothing such as corresponding code numbers to tie the invoice to these pages.

15. Mr Levy says that Christopher Joseph assisted with further sales of BIBA footwear through TK Maxx stores in Bristol, Reading, Hatfield, Woking, Croydon, Plymouth, Slough, Cheltenham, Ealing, Bedford and St Albans. Exhibit CL7 includes photographs of the shoes said to have been sold by TK Maxx, the BIBA and swirl device being seen on the upper sole. The exhibit also includes an order form from TK Maxx for goods stated to be the BIBA label, from a supplier named as Brocade, the order form, numbered 0431048 bears the dates 19 July 2004, and the 15 and 30 August 2004 although I am not able to determine their relevance. The order form uses descriptions for goods such as “Purple brooch trim ank” followed by the numerals “37, 38, 39 40” which could well be shoe sizes, with the numbers “2, 4, 4, 2” placed below, which I take to be the quantity ordered. That these goods are items of footwear can be seen from the packing list and commercial invoices dating from September and October 2004. These show Brocade Shoes Limited as the agent, and descriptions of goods such as “40 cartons containing 480 pairs of ladies leather sandals, as follows:”, although not stated as being BIBA branded. The packing

lists/invoices state that they relate to order 431048 (the same as the TK Maxx order), and use the same style code numbers for the goods as those shown on the TK Maxx order. Taken together I consider it to be reasonable to infer that all documentation forming CL7 relates to BIBA branded footwear.

16. Mr Levy says that products namely, clothing, jewellery, cosmetics, handbags and bags, have been sold under the BIBA and BIBA/Device brand since 2000, in the UK, via a mail-order service. Exhibit CL8 consists of a collection of invoices said to have resulted from this trade. These date from 12 May 1999 through to July 2004, and whilst they show the BIBA and Device mark on the heading, and the name BIBA in the contact details on the footer, there is nothing that shows the goods to have been sold as BIBA branded goods. Also, in all but three cases the customer addresses have been blanked out although a number bear the statement “special instructions: sent to the London address noted”. The three that have the addresses included are also in London. Mr Levy goes on to say that the photographs forming Exhibit CL9 show some of the products itemised on the invoices in Exhibit CL8. Whilst these goods are listed on the invoices, and bear the BIBA and BIBA/Device marks, there is nothing, such as product code numbers that would link them to the invoices, or that enables me to place them in time.

17. Mr Levy concludes his Statement by stating that the BIBA brand continues to be used, and has at no time been abandoned.

Applicants’ evidence Rule 31A(1)

18. This consists of a Witness Statement dated 24 August 2005, from Jochen Halfmann, Managing Director of BiBA + Pariscop Daub GmbH, a position he has held since May 1999. Much of Mr Halfmann’s Statement consists of submissions on the evidence filed by Mr Levy. Where relevant facts are given I will summarise them, but otherwise I will note the submissions and take them into account in my determination of this case.

19. Mr Halfmann gives his views on the currency of the BIBA trade mark, describing it as an “antique” brand. He refers to Exhibit JH1, which consists of the book “BIBA: The BIBA Experience” referred to by Mr Levy. Mr Halfmann highlights comments such as “near mythical near history” as supporting his “antique” contentions. But the extract also contains references such as “traces of the BIBA experience have survived”, “women who went there will never forget it...”, “children who grew up in BIBA nappies...have had the story of this extraordinary store passed on to them...” and the “hundreds of young women who were-and are still being-named BIBA bear testimony to its lasting impact”.

20. Mr Halfmann recounts that his company conducted investigations via YELL.Com to find out the addresses of the BIBA shops in Covent Garden and Conduit Street, London, referred to by Mr Levy. Exhibit JH2 consists of screen prints from the YELL.Com website taken on 12 August 2005. Whilst the results do not show an entry for any BIBA clothing shops, there is one for a vintage clothes shop named “Biba Lives Vintage Clothing”.

21. Exhibit JH3 consists of an extract from the BBC London website taken on 12 August 2005, stating that it was last updated on 6 June 2005. The story entitled “Biba 40 Years On” relates the rise and fall of the brand, culminating with the closure of its shops in 1975.

22. Mr Halfmann goes to Mr Levy’s statement regarding the availability of BIBA branded goods via a mail-order service, and to the operation of a concession in Selfridges. Mr Hofmann says that his company search for the mail-order operation failed to find any mention of this on the Internet. The results of the search are shown as Exhibit JH4. Whilst there does not appear to be a specific website for the registered proprietors, this could well be because the search was restricted to the UK. Notwithstanding this, there are mentions of “This new era of Biba saw the introduction of the peripheral merchandise that was to become...An upmarket re-launch of the mail-order catalogue offering...”, several references to “Tips about Biba Blusher on the web... Browse our online catalogue and buy online today”, the date being given as 27 July 2000, and a reference from eBay UK “Bargain Biba catalogue – Great prices on vintage clothing..”. The results of the search for information on the Selfridges concession are shown as Exhibit JH5, and show that a search of the Selfridges website on 23 August 2005 found no use.

23. Mr Halfmann concludes his Statement by introducing Exhibit JH6, which consists of the results of an Internet search of UK web pages based on the search BIBA + clothing. Whilst the results did not bring up a site from which BIBA clothes could be purchased, the results are akin to those mentioned in relation to Exhibit JH4, with 40th Anniversary stories on the BBC and in the Telegraph showing there to be a current interest and awareness in BIBA clothes.

Registered proprietors’ evidence Rule 31(A)(4)(a)

24. This consists of a Witness Statement dated 28 November 2005, from Helen Cawley, an Associate with D Young & Co, and the registered proprietors’ representatives in these proceedings. As Exhibits HJC1 to HJC8, Ms Cawley provides a collection of invoices dating from the period February 2000 to October 2004. Whilst these show the BIBA and swirl device on the header, and the name BIBA in the contact details in the footer, there is nothing that links them to a sale of goods to persons in or from the UK. Exhibit HJC9 consists of a report from FT.com taken on 28 November 2005, which outlines the history of the brand and its originator, Barbara Hulanicki. Ms Cawley highlighted the reference to the introduction of a new line of clothing and cosmetics, and to Ms Hulanicki having reinvented herself as a successful interior designer, but as it also states that she had lost the BIBA name, presumably not using that brand. There is a mention that the Textile Museum is planning a retrospective involving BIBA. Exhibit HJC10 consists of a printout from the website of Biba International Limited, a licensee of Hachel International Foundation. The only reference to dates is a mention of the “21st Century re-launch of BIBA” and various clothing and clothing accessory collections in 2006.

Applicants' evidence in reply Rule 31(A)(5)

25. This consists of a Witness Statement dated 17 March 2006, from Aiden Clarke, a partner of Marks & Clerk, the applicants' representatives in these proceedings. Much of Mr Clarke's Statement consists of submissions on the evidential value of the exhibits provided with Ms Cawley's Witness Statement. Whilst I do not consider it appropriate or necessary to summarise these submissions, I will, of course, take them fully into account in my determination of this case. Mr Clarke does provide evidence at AVC1, which shows the Biba International Limited domain name was registered on 3 May 2005. The exhibit contains the reference:

“Biba is back. One of the most exciting and innovative names in British fashion will be relaunching in 2006. Includes shoes, handbags, clothing, fragrance, cosmetics, jewellery and eyewear.”

26. Mr Clarke notes the absence of any information such as a license agreement.

27. That concludes my summary of the evidence insofar as it is relevant to these proceedings.

DECISION

28. The relevant statutory provision in relation to an application for a revocation of a registered trade mark can be found in Section 46:

“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 case the application is made to the registrar, he may at any stage of the proceedings refer to 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."

29. Under the provisions of Section 100 of the Act, the onus of showing that the mark in question has been used within the relevant period, or that there are proper reasons for non-use, rests with the registered proprietors. 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."

30. The onus placed upon the registered proprietor is to "show" what use has been made of the mark, which suggests that the evidence required by Rule 31(A) must be more than mere assertion that the mark has been used; it must be actual evidence which shows how the trade mark has been used. See *Carte Bleue* [2002] RPC 31.

31. Section 46(1) refers to “genuine use” having been made of the registered trade mark within specific periods of five years. In the case of subsection (b), the period can be any five years, and not just the five years leading up to the filing of the Application. See *La Mer Technology Inc v Laboratoires Goemar SA*’s trade mark case [2004] WL 2945720.

32. These periods must be considered in relation to the proviso contained within Section 46(3), which reads as follows:

“(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 in 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.”

33. The effect of Section 46(3) is not to extend the five-year period by three months. After a period of inactivity the use must commence after the expiry of the five years specified in the Application, but need not immediately follow, and will end with the Application for Revocation. But if the proprietor commences (or makes preparations) to use the mark after the expiry of the specified five year period, but within the three months immediately preceding the Application, the use will be disregarded, that is, unless the registered proprietors had been unaware of the potential Application. See *Philosophy Di Alberta Ferretti* [2003] RPC 15.

34. In paragraph 3 of their Statement of Case, the applicants claim is that there has been no genuine use of the mark for an unspecified period of five years. In paragraph 4 they are more specific in their assertions, alleging non-use during the five years prior to 20 January 2005, the date on which the application for revocation was made.

35. There is no suggestion that if the evidence shows use by the registered proprietors, that this was a result of them becoming aware of a possible revocation action. It therefore seems to me that subject to the proviso contained in Section 46(3), if the registered proprietors have made “eligible” use of the mark in the five years leading up to the date of application, this will be sufficient to defeat all attacks, either by having shown use within the alleged period of non-use, or, if after 21 August 2003, by virtue of the provisions of Section 46(3).

36. The Act refers to “genuine use” having been made of the trade mark but does not set out what constitutes use that is genuine. In Case C-40/01, *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40 at page 725, paragraph 36, the European Court of Justice answered the question in the following terms:

“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 the 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 that have another origin.”

37. The *Ansul* decision stated genuine use 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. Such use must be in relation to goods or services that are already on the market, or about to be marketed and/or for which preparations are underway to secure customers, for example, by means of advertising. The *Bud* Trade Mark case [2002] RPC 38 at paragraphs 41 and 42 gives some useful, albeit limited guidance on advertising.

38. The assessment of whether there has been genuine use must take into account all of the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, and may include giving consideration, amongst other factors, to the nature of the goods or services at issue, the characteristics of the market concerned, and the scale and frequency of use; the use need not always be “quantitatively significant” for it to be deemed genuine.

39. In the *Police* trade mark case [2004] RPC 35, the Appointed Person considered that the *Ansul* judgement did not limit the factors to be taken into account in establishing whether use was genuine only to the three areas specifically mentioned. The judgement had stated that all facts and circumstances relevant to establishing whether there had been real commercial exploitation should be included in the equation, and that the size of a proprietor’s undertaking may be relevant.

40. Further guidance on the scale and frequency of use can be found in the *La Mer Technology Inc* case. This is the decision of a resumed appeal hearing following a reference to the ECJ on various questions relating to the meaning of “genuine use”. In his decision Blackburne J stated:

“31. Whether in any given case the proven use amounts to genuine use (“whether the commercial exploitation of the mark is real” as paragraph 38 of *Ansul* puts it) will depend on all of the facts and circumstances relevant to establishing such a state of affairs, including the characteristics of the market concerned and of the products or services in question, and the frequency or regularity of use of the mark. Even minimal use will be sufficient if, in the market concerned, the proven use is considered sufficient to preserve or create a market share for the goods or services protected by it. Thus, the sale or offering for sale (in, say, a trade magazine) of a single exceedingly costly and highly unusual item carrying the mark in a specialised market, for example a very large and complex piece of earth-moving equipment, may very well be considered by itself to be sufficient in the market for such equipment to preserve or create a market share for items of that kind which carry the mark whereas the sale of a low priced everyday product in a widespread market, for example a single jar of face cream bearing the mark or the exposure for sale of, say, half a dozen such jars for sale on a shop shelf, would almost certainly not be. It would be irrelevant to this conclusion that, in the latter example, the purpose of the proprietor of the mark (or of some third-party acting with the

proprietor's consent) when offering the jar of cream for sale was to create a share in the market for face cream sold in jars bearing the mark.”

41. Mr Justice Blackburne referred back to the decision of Jacob J in the earlier part of the appeal:

“15. Jacob J himself ventured an answer to those questions. At paragraph 29 of his judgment [2002] FSR 51 [29] he said this:

"I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to "genuine" use. There is no lower limit of "negligible". However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely "colourable" or "token", that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further enquire whether that advertisement was really directed at customers here. ...

Nor do I think that the absence of a *de minimis* rule significantly affects the policy behind the legislation. Yes, marks must be used within the relevant period, but there seems no reason to make a trader who has actually made some small, but proper, use of his mark, lose it. Only if his use is in essence a pretence at trade should he do so. And of course, if he has only made limited use of his mark it is likely that the use will be only for a limited part of his specification of services. If he has a wider specification, that can and should be cut back to just those goods for which he has made use ...”

42. The applicants argue that the evidence shows BIBA is a brand from the past. This is undoubtedly true. But statements such as “traces of the BIBA experience have survived” and “hundreds of young women who were – and are still being – named Biba bear testimony to its lasting impact” in the BIBA book exhibited by Mr Halfmann (JH1) indicates that there may be a residual awareness from the earlier trade in BIBA branded goods. However, as I do not know the basis on which these statements were made I put it as no more than “may”. The extract from YELL.Com (JH2) shows there to be a shop promoting itself as trading in BIBA clothing from the past. The fact that the outlet specifically mentions it stocks BIBA clothing says to me that the name appears to be sufficiently well known for the trader to see worth in using it to attract customers. But the extract originates from after the date of application and I have no way of assessing the extent of any impact on consumer awareness.

43. The registered proprietors have filed evidence that they say shows recent and relevant use of the mark. There is only one instance of the mark as registered being shown in use, which can be found in Exhibit CL3. This consists of a photograph of what appears to be a box of matches, but whatever it is, it is clearly is not an item of jewellery. There is an inscription “21/02/200, which I believe is part of a date imprinted on the photograph by the camera recording the date on which the

photograph was taken, but is clearly incomplete. It could be any of the years from 2000 to 2004 and be in the relevant period, or 2005 and therefore outside; I do not know.

44. Setting aside the fact that it does not show use of the mark as registered, much of the rest of the evidence goes only part way in providing the detail necessary to determine whether, when, for what goods the mark has been used, or relates to goods that do not come within the ambit of the specification of the subject registration.

45. A photograph of a handbag bearing the word BIBA on the clasp has a date of 31 March 2005 imprinted upon it, again seemingly by the camera at the time of taking the photograph. Mr Levy says that it was on sale in the UK, but not whether this was before, at the time of, or after the date shown, or where or how many were sold. Extracts from Company magazine and a regional edition of the Daily Post depict a nail polish bearing the name BIBA with an “art-deco” device, and a reference to “Biba” hair mascara (but no representation of the product), respectively. However, as both date from April 1999 they do not show use within the five years prior to the application.

46. An extract taken from a magazine entitled “Keep that edge” depicts a nail varnish, lipstick, face powder compact, cosmetic brush, all bearing the BIBA and art-deco device mark, stating that these are available from Selfridges, but there is nothing by which to date the feature. Exhibit CL5 consists of an invoice dated 11 June 1999, relating to goods originating from the registered proprietors that have been supplied to Selfridges. By taking both pieces of evidence together, and account of the identity of the supplier-purchaser, that the descriptions and prices of three of the four goods listed are the same as those mentioned in the article, I do not think it is unreasonable to infer that the invoice and article relate to the same goods, and at least as far as the cosmetics listed in the invoice are concerned, that they were on sale in 1999 under the BIBA art-deco mark, but again this is too early to constitute use in the five years leading up to the application.

47. Exhibit CL7 includes an order form from TK Maxx showing a number of dates from 19 July 2004 and the 30 August 2004. The copy quality is so poor that beyond saying that the form relates to an order for goods placed and/or fulfilled some time on or between these dates, I am not able to ascertain the stage in the transaction to which each relates. The order refers to the goods as being from the BIBA label, and contains information that suggests it is an order for footwear of some sort, but it does not actually say this. The supplier is named as “Brocade”.

48. The exhibit also includes several packing lists/invoices dating from September and October 2004, stating the goods to which they relate in terms such as “40 cartons containing 480 pairs of ladies leather sandals, as follows:”. Shipping is to an address in the UK, the agent is noted as Brocade Shoes Ltd. Although the packing lists/invoices do not state that the footwear is BIBA branded, they use the same order number, refer to the goods by the same style code numbers and record the same supplier as the TK Maxx order.

49. The remaining part of the exhibit includes several photographs of ladies “strappy” shoes (that could fall within the description sandals) that Mr Levy says are the goods

mentioned in the order and packing lists/invoices. The BIBA and art-deco mark can be seen on the upper sole. Whilst the shoes do not bear any visible marking such as style number by which to link them to the documentation, their colours correspond to the product descriptions in the packing lists/invoices. Although not conclusive, I consider that there is sufficient to lend support to Mr Levy’s claim; the applicants did not challenge the veracity of his statement. To my mind, the sum of the parts of Exhibit CL7 amount to a whole that evidences the placing and fulfilment of an order, from a UK trader, for items of ladies footwear bearing the BIBA and Device mark, in the period July – September 2004, within the five years leading to the application.

50. Exhibit CL8 consists of a number of invoices dating from the period 12 May 1999 to 17 July 2004. In their written submissions the applicants say that the existence of these invoices is not evidence that they have been paid and goods have been sold in the UK, or show that the registered proprietors were “engaged in a regular trade in the sense that a market was being created or preserved in relation to the mark in suit”, submitting that “the whole transaction cries out for an explanation”, both being quotes from the decision in *Philosophy Di Alberta Ferretti*.

51. At face value most of the invoices appear to be flawed as evidence. Each shows the BIBA and Device mark as a header, and the name BIBA as part of the corporate name in the contact details at the foot of the page. But in all but three cases the contact addresses for the customers have been blanked out in copying, which means that it is not possible to determine whether they relate to sales in the UK. However, some have a footer stating “SPECIAL INSTRUCTION: SENT PRODUCTS TO LONDON ADDRESS NOTED”, so even though the actual address is not known, it is possible to say that the customer was located in the UK. Those invoices that have the customer details show addresses in London. The invoices that can be seen to relate to sales to customers in the UK date from 11 February 2001 through to 17 July 2004, within the relevant five year window. They collectively relate to the following product types:

Clothing	Cosmetics	Jewellery	Other
T-shirts	bronzing face powder	gold hoop earrings	handbag
leather jackets	waterproof mascara	gold bangles	bag
long-sleeve top	rose face blush	gold necklace/charm set	
denim crop skirt	nail polish set	gold anklet	
mini skirt	lipstick	silver/gold ring sets	
stretch pants	pencil lipliners		
halter top	eye shadow kits		
turtleneck top	pencil eyeliners		
leather mini skirt	cream face foundation		
cotton tank top	blusher		
denim flow skirt	face powder.		

52. Even though they do not say that the goods were delivered and paid for, these invoices are clear evidence that over a period of years, goods were available for purchase by consumers located within the UK, and that these customers would have been exposed to the BIBA name in some form, composite or otherwise. The position, therefore, is that there is use of an “art-deco” style composite mark (but not identical

to the mark as registered) and also or as part of the name “Biba Corporation of America” within the relevant five year period.

53. Having determined that there is use in relation to goods covered by the registration, I have to decide whether the proviso of Section 46(2) applies and determine whether this has been “...in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered...”. How should I approach this question? In the judgement of the Court of Appeal in *Bud and Budweiser Budbrau Trade Marks* [2003] RPC 25, Sir Martin Nourse put the position as follows:

10 It will have been observed that Mr Salthouse, without discussion, assumed that the average consumer's reaction was of paramount importance. For that he was criticised by the judge, on the ground that what is required is a determination of the elements that make up the distinctive character of the mark, being a matter which is to be viewed through the eyes of the registrar in assessing whether or not the mark should be registered. There was a debate before us as to whether the matter should be viewed through the eyes of the registrar or through the eyes of the average consumer. I agree with the approach of the judge so far as it goes. But it appears that he may not have given adequate weight to the consideration that the registrar, in assessing the distinctiveness of the mark, would necessarily have to view the matter through the eyes of the average consumer. Indeed, Mr Bloch Q.C., for AB, did not deny that the average consumer had a role to play. While emphasising that the registrar is required to carry out an exercise which the average consumer does not carry out, he accepted that, in assessing the distinctive character of a mark, she has to have regard to the way in which it would be perceived by the average consumer.

11 The judge also criticised Mr Salthouse for having sought to ascertain what was the central message of the mark. For myself, I do not think that that was what Mr Salthouse did. Paraphrasing somewhat, I understand him to have said that the distinctive feature of the mark was the words Budweiser Budbräu and that the different fonts and the underlining of the word Budbräu did not detract from, or add anything to, that distinctive feature. On that view of the matter Mr Salthouse was doing precisely what s.46(2) required him to do.

12 Mr Bloch accepted that, in relation to a particular mark, it is possible, as Mr Salthouse put it, for the words to speak louder than the device. However, he said that it does not necessarily follow that the entire distinctive character of the mark lies in the words alone. That too is correct. But there is yet another possibility. A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or, to put it the other way round, the words have a dominance which reduces to insignificance the other recognisable elements. In my judgment, on a careful reading of Mr Salthouse's decision, it was into that category that he put the Budweiser Budbräu mark.”

54. The position, therefore, is that in assessing the distinctiveness of the mark as registered, the Registrar will necessarily have to view the matter through the eyes of

the average consumer, and taking into account the dominance of the elements, must decide whether the differences in the used version of the mark detract from, or add anything to the distinctive character.

55. In the decision in *New Covent Garden Soup Company Ltd v Covent Garden Authority* BL O/312/05, the Hearing Officer considered whether use of a composite mark incorporating the words NEW COVENT GARDEN SOUP CO constituted use of the words alone. The composite mark is as follows:



56. Determining that the average consumer of the relevant goods, in this case soup, would regard the mark as a single, composite trade mark differing in elements to the words alone, he first contrasted the position in this case with that of the *Bud* case:

“24. In the *Bud* case, the application of s46(2) came into issue because certain features of the registered marks had been omitted from the marks used. The omission of a part of a registered mark inevitably gives rise to doubt as to whether the distinctive character of the registered mark has been retained when only some elements of it have been used.”

57. He then went on to pose the question of whether the addition of the other elements altered the distinctive character of the mark in the form in which it is registered:

“25. However, the main area of doubt with regard to the use of the composite mark arises in a rather different context in which the whole of the registered mark has been used a) in form which differs from that in which it is registered...and b) with other elements added to it to form the composite mark.

26. ...It is possible for the addition of elements to alter the distinctive character of a mark. For example, I do not think that the mark JAMES has the same distinctive character as the mark JAMES & JOHNSON. But in this case I believe that the average consumer of soups would regard the words NEW COVENT GARDEN SOUP CO as having an independent distinctive role within the composite mark. These words have the same distinctive character when they are used as a part of the composite mark as they do when used alone. On that view of the matter, the use of the words as part of the composite mark shown above falls squarely within s46(2).”

58. The Hearing Officer found support for his conclusions in Case C-353/03, *Société des Produits Nestlé SA v Mars UK Ltd*, In this the ECJ had been asked to make a preliminary ruling on the meaning of Article 3(3) of the Directive, which is the basis

for the proviso to section 3(1) of the Act. This allows for registration of a trade mark that lacks the necessary (inherent) distinctive character if it has acquired such a character through use. The referring court's question was whether such a character could be gained as a result of the use of a trade mark in conjunction with, or as a part of, another trade mark. The ECJ's answer was that it could. Accepting that this did not necessarily mean it is possible to sustain a trade mark registration through use of that mark as a part of another mark, at paragraph 28 he considered there to be "a certain logic in the proposition that if it is possible for a mark to acquire its own distinctive character as a result of its use as part of another mark, then it should also be possible for it to retain that distinctive character, even though it is always used with the other elements of the composite mark." He considered this to have been the view of the Advocate General Kokott, who in paragraph 24 of her opinion in the *Nestle* case stated:

"Structurally it would surely be wrong to recognise use for the acquisition of distinctive character but not to allow it to suffice in order to prevent loss of trade mark protection. Indeed, it is not precluded that use of a mark as part of another mark may also suffice in the context of Article 10. Under Article 10(2)(a) it also constitutes use if the trade mark is used in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered. Use of a sign as part of a principal mark also comes within that definition."

59. To my mind the combined effect of *Bud* and *Nestle* means that having assessed the distinctiveness of the used mark, I must decide whether any differences in the used form detract from, or add anything to the distinctive character of the mark as registered, both inherent and in the likely perception of the consumer of the goods in question. I must also take account of the contribution that it makes as an element of the composite mark.

60. In the *Bud* case, Sir Martin Nourse accepted that in a composite mark it is possible for "words to speak louder than a device" but that it did not necessarily follow that the entire distinctive character of the mark rested in the words alone. He went on to say that it is also possible for the words to have "a dominance which reduces to insignificance the other recognisable elements." Neither the Hearing Officer in *New Covent Garden Soup Co.*, or the ECJ in *Nestle* made any suggestion that for the use of one mark as part of another to be taken as sufficient to allow the acquisition of a distinctive character, the elements other than that mark must be devoid of distinctive character. I take the view that this is because the question is not one of balancing the distinctiveness of the component parts, but of determining whether an element used within a composite mark is in a form which does not alter the distinctive character of the registered version, and has a prominence so as to have been the significant contributor to what makes the composite mark work as a badge of origin.

61. Whether or not a graphical element in a composite mark is of itself distinctive, if the word element is distinctive and prominent, (although not necessarily dominant), the consumer will come to know the mark by the words to the extent that if they were used independent of any other matter, they will function as a badge of origin. The more distinctive the words, the stronger will be their capacity to function as a trade mark independent of the graphical elements. In effect, it is the words that make the

mark distinctive in the minds of the consumer, and provided the word(s) as used, and the word(s) forming a registered mark do not differ in their distinctive make-up, I would agree with the Hearing Officer that it would seem logical to accept such use as falling within the provisions of Section 46(2).

62. The mark as registered is the word BIBA and a device, both elements being represented in an art-deco style. There is no evidence to assist me, but as far as I am aware BIBA is not an ordinary dictionary word and has no meaning whatsoever for the goods for which it is registered. However, for whatever reason the registered proprietors have entered a disclaimer to the word BIBA. The mark as used is also composed of the word BIBA and a device in an “art-deco” style. Whilst the stylisation of the word is different, it is not significantly so and had I been considering the use of one version to sustain the other in the circumstances of Section 46(2) I would have found in the registered proprietors favour. It is in the figurative element that the main difference exist. Although both are represented in a style evocative of the art-deco era, as can be seen below, they are very different in appearance:



63. Starting from the point that the use of the word is in a form that does not alter its distinctive character from the registered version, there is a logic in taking the use of a word in a composite mark as use of the word registered *solus*, and not so where the registered mark is a composite mark, and the use is of the word element alone or the word with a different device. In the former the use is of the registered mark in its entirety, albeit with another element, whereas the use of a word alone is not use of the whole of a composite mark. I believe the position with respect to the use of a different device, whether on its own or with other elements self-evidently cannot be use of a distinctively similar mark. I therefore come to the conclusion that the registered proprietors’ use does not show use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it is registered, and that the revocation must succeed.

In summary, I find that the application for revocation succeeds, and that with effect from the 20 January 2005, the registration should be revoked

The applicants sought revocation in respect of the registration in its entirety and have been successful. They are therefore entitled to a contribution to their costs. I order the registered proprietors to pay the applicants the sum of £1,250. This 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 7th Day of December 2006

**Mike Foley
For the Registrar
The Comptroller-General**