

O-372-11

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS RELATING TO:

**INTERNATIONAL REGISTRATIONS 1023046 & 1023047
IN THE NAME OF NATUREX AND OPPOSITION THERETO (Nos 72160/1) BY
TONYSON'S TRADE LINKS (OVERSEAS) LTD**

AND

**UK REGISTRATION 2040736 IN THE NAME OF TONYSON'S TRADE LINKS
(OVERSEAS) LTD AND AN APPLICATION FOR REVOCATION (No 83853) BY
NATUREX**

THE BACKGROUND AND THE PLEADINGS

1) Naturex are the holders of International Registrations 1023046 & 1023047 for the trade marks NAT SELECT and NAT PROTECT respectively. Both designated the UK for protection on 1 October 2009. They both claim priority from 17 April 2009 stemming from an application in France. 1023046 was published in the Trade Marks Journal on 4 June 2010, 1023047 on 23 April 2010. The specification of 1023046 reads:

Class 03: Soaps; perfumes; cosmetics; essential oils; odoriferous substances; cosmetics in galenic form and mainly containing plant extracts, not for medical purposes; nutritional additives that may contain plant extracts and/or purified molecules extracted from plants, for beauty or skin, body, facial, hair or nail care, in the form of capsules, tablets, ampules, yeast, powders, bars, creams or beverages, for cosmetic purposes.

Class 05: Pharmaceutical, veterinary and sanitary preparations, all of which may contain plant extracts; dietetic substances adapted for medical use; nutritional additives for medical purposes; mineral food supplements; plant extracts for nutritional additives for medical purposes.

The specification of 1023047 reads:

Class 01: Chemicals as raw materials for cosmetics and the food and pharmaceutical industries, mainly comprising plant extracts; active ingredients used in cosmetic formulation; mineral acids; mineral salts; chemicals mainly comprising plant extracts designed to preserve cosmetics and for the antimicrobial protection thereof.

Class 03: Soaps; perfumes; cosmetics; essential oils; odoriferous substances; cosmetics in galenic form and mainly containing plant extracts, not for medical purposes; nutritional additives that may contain plant extracts and/or purified molecules extracted from plants, for beauty or skin, body, facial, hair or nail care, in the form of capsules, tablets, ampules, yeast, powders, bars, creams or beverages, for cosmetic purposes.

2) Tonyson's Trade Links (Overseas) Ltd ("Tonyson") opposes protection of the International Registrations in the UK. Tonyson is the proprietor of trade mark 2040736 for the mark NAT which was filed on 10 October 1995 and which completed its registration procedure on 21 June 1996. The mark is registered in respect of:

Class 03: Soaps; medicated soaps; hand creams; face creams; toiletries; deodorants; perfumes; lipsticks; hair lotions; face powder; all included in Class 3.

3) Tonyson's grounds of opposition are under sections 5(1)/5(2)(a)/5(2)(b) of the Trade Marks Act 1994 ("the Act"). There was also a ground under section 5(3) but this was struck out by the tribunal due to there being no evidence of a reputation; Tonyson did not object to the striking out of this ground. Tonyson also made reference to a claim under section 56 of the Act (which deals with well-known marks) but this has not been pursued, so, I will not deal with this ground¹.

4) Naturex have applied for the revocation of Tonyson's trade mark on the grounds of non-use. The claim is made under section 46(1)(b) of the Trade Marks Act 1994 ("the Act"). Non-use is alleged in the period 25 August 2005 to 24 August 2010. Naturex seek an effective date of revocation of 25 August 2010.

5) Only Tonyson filed evidence in the consolidated proceedings. A hearing was held before me on 22 August 2011 at which Mr Mooneapillay of Fry Heath Spence represented Naturex; Tonyson was represented by its director, Mr Tony Hamalis.

INITIAL APPROACH OF DECISION

6) Due to Tonyson's earlier mark having completed its registration process more than five years prior to Naturex's trade marks being published in the Trade Marks Journal, the proof of use conditions set out in section 6A of the Act apply. Naturex, when filing its counterstatements, put Tonyson to proof of use. This means that the issue of whether Tonyson has made genuine use of its trade mark relates to both the opposition proceedings and to the claim for revocation. I will, therefore, deal with this aspect of the cases in the first instance.

HAS TONYSON MADE GENUINE USE OF ITS TRADE MARK?

7) In terms of the application for revocation, this is dealt with under the provisions of section 46(1) of the Act, the relevant parts of which read:

"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

¹ In any event, and as will be seen shortly, the evidence filed by Tonyson falls a long way short of establishing that it is the proprietor of a well-known mark.

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)

(d)

(2) For the purpose 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.”

8) In relation to Tonyson’s earlier mark having the capacity to be relied upon in the opposition proceedings, it must meet the use conditions which are set out in section 6A(3) of the Act:

“...The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.”

9) Section 100 is also relevant which reads:

“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.”

10) When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely: the judgments of the Court of Justice of the European Union (“CJEU”) in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). The position² was helpfully summarized by Ms Anna Carboni, sitting as the Appointed Person, in BL O-371-09 *SANT AMBROEUS*:

“42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the “legal learning” that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The 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

² Which also took into account the guidance set out in *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28

the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

11) When considering the evidence filed by Tonyson, I bear in mind that there are three distinct, albeit overlapping, time periods, namely:

- i) In relation to the revocation of Tonyson's trade mark: 25 August 2005 to 24 August 2010;
- ii) In relation to whether Tonyson's earlier mark can be relied upon to oppose International Registration 1023046: 5 June 2005 to 4 June 2010;
- iii) In relation to whether Tonyson's earlier mark can be relied upon to oppose International Registration 1023047: 24 April 2005 to 23 April 2010.

12) In terms of the evidence that Tonyson filed, it should be noted that a case-management conference took place before me on 12 July 2011. I discussed not only the way in which the three sets of proceedings should be handled, but, also, any further evidence the parties wished to file. Mr Hamalis indicated, on behalf of Tonyson, that it did not wish to file any further evidence and that what had been filed thus far (as I will detail below) was all it relied on. This was so despite Naturex clearly challenging the sufficiency of the evidence.

13) In terms of the evidence filed by Tonyson, this comes in the form of a witness statement from Mr Hamalis. Some of his evidence relates to the background to the proceedings which I do not need to detail. In terms of evidence relating to the use made of the mark, Mr Hamalis states that the trade mark was first used in the UK in 1996 up to the present date³. He states that the mark has been used on all of the goods covered by its specification (soaps; medicated soaps; hand creams; face creams; toiletries; deodorants; perfumes; lipsticks; hair lotions; face powder). Later in his witness statement it is added that such use has been in “.. London, Manchester Liverpool etc....”. Of the exhibits that relate to use, the following are provided:

- Exhibit 3: This is an undated letter marked “to whom it may concern” from a company called Carton Care. The letter writer states that “This is to confirm that since 1996 Cartoncare has been producing packaging for soaps and creams for: **Fairtrade International Limited** (Tonyson’s Tradelinks (Overseas) Ltd). It is added that “We have been working with Tony Hamalis during this time and supplied him with many millions of packaging”.
- Exhibit 4: This is a letter dated 19 August 2010 addressed to Tonyson from Robertet (UK) Ltd. The letter writer begins by stating that “..we supply the above fragrance compound at the request of Fairtrade International Ltd to nominated UK contract manufacturers. It is added “We have been supplying this compound since 1996 which is used in a range of creams, lotions and soaps. This compound is specifically allocated to this company for use in their current branded range of toiletry products”. I note that the “above compound fragrance” is not identified.
- Exhibit 5: This is a letter dated 13 August 2010 addressed to Mr Hamalis of Fairtrade International Co. Ltd from Cleanliness Ltd. It has a reference headed **NAT Brand**. The letter writer states that “we have manufactured creams and lotions under the aforementioned Trademark for you since 1996 to the present date.
- Exhibit 6: This is a letter dated 1 September 2010 from SigmaSoap to Tonyson re: **NAT BRAND**. The letter writer states that “..our company

³ The present date, when Mr Hamalis gave his evidence, was 28 October 2010.

manufactures and supplies the above products to your company...". Reference is then made to the regulatory framework for toiletry and cosmetic products".

- Exhibit 7: This is a "to whom it might concern" letter dated 20 August 2010 from a company called Pak's re NAT cosmetics. The letter writer states that "we are the agent for NAT cosmetics that includes soaps, creams, lotion".

14) In terms of the above exhibits, two are headed as "to whom it may/might concern". The others, although addressed to a particular company/person, still appear to have been solicited for the proceedings. In *DUCCIO Trade Mark* BL O343-09, Professor Ruth Annand, sitting as the Appointed Person, observed:

"There are two ways in which "to whom it may concern letters" can be introduced in Registry proceedings. First, the writer of the letter can provide a verifying affidavit, statutory declaration or witness statement to which his or her letter is exhibited. Second, the party seeking to rely on the letter can provide an affidavit, statutory declaration or witness statement to which the third party letter is exhibited. In the first case, the letter is part of the writer's own evidence. In the second case, the letter is hearsay evidence admissible by virtue of section 1 of the 1995 Act."

15) Tribunal Practice Notice 5/2009 refers to the above case and concludes:

6. Hearing Officers will give hearsay evidence of this kind such weight as it deserves (as per section 4 of the Civil Evidence Act 1995), assessing each case on its own merits. Accordingly, hearsay evidence will not be discounted simply because it is hearsay. So, for example, substantial weight may be given to a hearsay statement made in letters or documents created around the time of the issue or event to which it relates. On the other hand, a Hearing Officer may decide to afford less weight to a hearsay statement made in a letter solicited by a party some time after an event, for the purpose of the proceedings, than he or she would have given to the same statement if had been made in a witness statement and accompanied by a statement of truth. Further, if the person making such a hearsay statement had any motive to conceal or misrepresent matters, and the Hearing Officer decides that the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight, he or she may give the statement no weight at all.

7. A party filing a hearsay statement therefore runs the risk that the tribunal may assess its weight at a lower level than that which the party considers it should carry. Accordingly, unless it is impractical to do so, the

best course of action is to file statements made specifically for the purposes of the proceedings in the form of a witness statement.”

16) The exhibits can, therefore be taken into account. In terms of their weight, there is nothing to suggest that the “evidence” was filed in this way to conceal or misrepresent matters. It is more likely that Mr Hamalis, who has not availed himself of professional representation, felt that filing evidence in this form was sufficient. The evidence will be given some weight.

17) In terms of the evidence itself, Mr Hamalis states that the mark has been used from 1996 to date in respect of all of the registered goods. However, he has not provided evidence of any sales of products bearing the mark. He has not provided any exhibits (be it packaging or advertisements) showing what is presented to the public in respect of any of this claimed use. These failures are not cured by any of the exhibits. The exhibits come, in the main, from various people involved in manufacturing goods. Carton Care produce packaging, Robertet supply fragrance compound, Cleanliness Ltd and Sigma Soap produce products. Whilst the test for genuine use is more qualitative than quantitative, the only evidence as to the scale of Tonyson's operation is that Carton Care produces “many millions of packaging”. If many millions of products have been produced and sold then it would have been a simple task for Tonyson to provide evidence of this. Furthermore, none of the exhibits show the mark in use, not even the exhibit from Carton Care who produce packaging. Indeed, Carton Care and Robertet do not even mention the mark at all. Whilst Cleanliness Ltd and Sigma Soap refer to NAT, there is still no evidence before the tribunal as to the mark that it presented to the public. The significance of this is that tribunal must be satisfied that the mark said to have been genuinely used is used either as registered, or in a form differing only in elements which do not alter the distinctive character of the mark (see section 46(2)). Whilst I am sure unintentionally, Tonyson has immunized itself from this requirement. The exhibits, furthermore, do little to contextualise any use in terms of time periods. Three of the letter writers state that they have been undertaking the activities referred to since 1996, only one says that this is “to date”. What went on in the relevant time periods being examined is, therefore, not contextualised. One of the exhibits mentions no time period at all. Context is also lacking when it comes to the goods upon which the mark is claimed to have been used, the letter writers referring to certain goods, but Mr Hamalis referring to all of the goods covered by the registration.

18) The letter from PAK refers to them being an agent for NAT cosmetics. What it means by being an agent is not explained. Mr Hamalis provides no commentary to take matters forward. This letter, therefore, does not improve Tonyson's position. Indeed, the position is worsened by the unexplained relationship between Tonyson and Fairtrade International Ltd (“Fairtrade”). Sigma Soap wrote its letter to Tonyson, Cleanliness Ltd wrote to Fairtrade, Robertet refers to Fairtrade, Carton Care refers to both (Tonyson is written in brackets following Fairtrade). The letter from Pak mentions neither. Genuine use must be

made either by Tonyson, or else be with its consent. If there has been genuine use it is difficult to see who has been using it. If it is not Tonyson, there is no commentary to explain the nature of any consensual relationship. Mr Hamalis simply states that he is a director of both companies. On the basis of such paucity, and even accepting that consent may be inferred in certain circumstances, it is not possible to make such an inference here.

19) Whilst I remind myself that the test the tribunal must apply is one based on the balance of probabilities, I also remind myself of the words of Jacob J in *Laboratoire De La Mer Trade Mark* [2002] FSR 51 where stated:

“9 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.”

20) For the reasons assessed, I come to the view that the evidence supplied by Tonyson falls short of establishing that the mark as registered (or in a form differing only in elements which do not alter its distinctive character) has been genuinely used within the relevant periods. Even if use has been made, it is difficult to see who the user is and, if it were not Tonyson, whether such use is with Tonyson's consent. The consequences of these findings are that:

- i) The revocation action succeeds, so meaning that registration 2040736 is revoked with effect from 25 August 2010.
- ii) The earlier mark has failed to meet the use conditions meaning that it cannot be relied upon to oppose Naturex's marks⁴. The opposition, therefore, fails. I do not need, in view of this, to determine whether there was a likelihood of confusion.

COSTS

21) Naturex is the successful party and is entitled to a contribution towards its costs⁵. I order Tonyson's Trade Links (Overseas) Ltd to pay Naturex the sum of £2100, calculated as follows:

Preparing statements and considering the other side's statements (opposition cases) - £600

⁴ As per section 6A(2) of the Act.

⁵ Costs are normally awarded on the basis of the registrar's published scale in Tribunal Practice Notice 4/2007.

Preparing statement and considering the other side's statement
(revocation case) - £400

Official fee for filing the revocation - £200

Considering Tonyson's evidence - £400

Attending the hearing - £500

22) The above sum should 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 27th day of October 2011

**Oliver Morris
For the Registrar,
The Comptroller-General**