

O-053-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 80209
BY TRIDENT TYRE LIMITED
FOR REVOCATION OF TRADE MARK No. 1289867
TRIDENT
IN CLASS 12
STANDING IN THE NAME OF DUNLOP TYRES LIMITED**

**AND IN THE MATTER OF AN APPEAL
TO THE APPOINTED PERSON
AGAINST THE DECISION OF MR. G. W. SALTHOUSE
DATED 23 APRIL 2004**

DECISION

Introduction

1. This is an appeal against a decision of Mr. George W. Salthouse, the Hearing Officer acting on behalf of the Registrar, dated 23 April 2004, BL O/111/04, in which he partially revoked UK Trade Mark Registration No. 1289867 for non-use pursuant to section 46(1)(b) and (5) of the Trade Marks Act 1994 (“the TMA”).
2. UK Trade Mark No. 1289867 comprising the word TRIDENT was entered on the Register on 4 August 1989 with a filing date of 3 November 1986 in the name of Sumitomo Rubber Industries Limited (“Sumitomo”). The original specification of goods reads:

“Tyres for land vehicles; inner tubes and valves, all for the aforesaid tyres; all included in Class 12”.
3. According to the decision of the Hearing Officer (at para. 2): “On 16 January 2002 the mark was assigned to Dunlop Tyres Ltd” (“Dunlop”).
4. On 15 January 2002, the Registry received an application for the revocation of registration 1289867 on the grounds of non-use on Form TM26(N) made in the name of Trident Tyre Limited (“the Applicant”). The registered proprietor was identified on the form as Sumitomo. The grounds for revocation stated:

“2 Inquiries have been carried out which have revealed that the Trade Mark registered under No 1289867 has not been used in the United Kingdom for an uninterrupted period of five years

up to the date three months prior to the date of this application by any proprietor thereof for the time being upon or in relation to any of the goods covered by the said registration.

3. Accordingly, Trident Tyre Limited hereby request Revocation of Trade Mark Registration No 1289867 in accordance with the provisions of Section 46(1)(b) of the Trade Marks Act 1994.”
5. Despite the period mentioned in paragraph 2 of the Applicant’s grounds, the parties accept that the claimed period of alleged non-use is the five years immediately preceding the date of the application for revocation namely 15 January 1997 to 14 January 2002¹. Section 46(1) of the TMA provides:

“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 ...”
6. Pursuant to what was then Rule 31(1) and is now Rule 31(2) of the Trade Marks Rules 2000, as amended (“TMR”), the Registry sent a copy of the application and the statement to Sumitomo on 21 January 2002. By a letter of even date, the Registry informed the Applicant of the date of sending and set a time for Sumitomo’s response. Realising that a Form TM16 Application to register a change of proprietor had been received on 16 January 2002, the Registry cancelled the letter of 21 January 2002 to Sumitomo. On 30 January 2002, the Registry notified the Applicant that: (i) a Form TM16 to assign the registration had been submitted on 16 January 2002; (ii) the documents had been resent to the new agent; (iii) a new time had been set for delivery of the counterstatement and evidence of use of the mark or reasons for non-use. The Registry sent the Applicant’s agents a further letter on 13 February 2002 stating that “ownership of the above application [sic – Registration No. 1289867] changed hands and the recordal of the assignment took place on 11th February 2002”. Dunlop’s details were given as the “new applicants” i.e. the new proprietor and it was stated that the agents remained the same.
7. Dunlop filed Form TM8 and a counterstatement of grounds, which was received by the Registry on 1 May 2002. The counterstatement of grounds stated (at paras. 3 – 4):

¹ The Hearing Officer misstated the period as 15 January 1997 to 15 January 2002 but this makes no difference to his decision.

- “3. Paragraph 2 of the TTL [the Applicant] Statement is not admitted and TTL is put to strict proof. It is denied that TTL or Withers & Rogers [the Applicant’s agents] carried out proper or reasonable enquiries. Neither TTL nor any representative of it contacted Dunlop or Ipulse [Dunlop’s agents] or the previous proprietor and asked whether the TRIDENT trademark had been used. ...
4. Dunlop has used the trademark TRIDENT in relation to tyres in trade in the UK throughout at least the last 5 years. About 51,000 tyres bearing the trademark TRIDENT have been manufactured and sold in the UK throughout the relevant period. In the year 2001 Dunlop sold over 7,000 tyres bearing the TRIDENT trademark in the UK. TTL were informed of this on 5 February. ...”
8. The letter of 5 February 2002 mentioned in the counterstatement of grounds (put in evidence at Exhibit DJR 1 to the witness statement of David Rickard dated 5 November 2002) in turn refers to a letter of 10 January 2002 from Dunlop’s agents to the Applicant. That letter states (see DJR 1): “[Dunlop] is the proprietor, by assignment from Sumitomo [sic] Rubber Industries Ltd, of UK registration 1289867 for the trademark TRIDENT for inter alia tyres.” The Applicant’s agents responded by letter of 11 January 2002 (also in evidence at DJR 1):

“Our comments on the points raised in your letter of 10 January 2002 are as follows:

(i) your letter states that Dunlop Tyres Ltd. are the proprietors by assignment of U.K. Registration No. 1289867. However, the Trade Marks Register for Registration No. 1289867, a copy of which is attached, shows that Registration No. 1289867 still stands in the name of Sumitomo Rubber Industries, Ltd. Please provide evidence of your clients’ ownership of that Registration;

[...]

... we look forward to receiving details of genuine use of TRIDENT in the United Kingdom by Sumitomo Rubber Industries Ltd., or by your clients with their consent, in relation to the goods in respect of which the trade mark TRIDENT is registered under No. 1289867. ...”

Evidence of genuine use

9. Section 100 of the TMA provides:

“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. The evidence submitted in defence of the application for revocation consisted of a witness statement of Charles Geoffrey Stewart dated 29 April 2002. Mr. Stewart is Dunlop's Contracts and Patents Manager. His statement is based upon his own knowledge and information obtained from the records of Dunlop, which he believes to be true and correct. Mr. Stewart states that in 1992 a tyre design was completed (he does not say by whom) for a tyre with TRIDENT on the sidewall to be manufactured by Dunlop. A tyre to that design was first manufactured and sold in the United Kingdom in 1992 and has continuously been manufactured and sold in the United Kingdom since that date under the TRIDENT mark. Mr. Stewart exhibits a copy of a photograph showing a section of the sidewall of a tyre with TRIDENT marked on the tyre sidewall (CGS 1). The photograph was taken on 23 April 2002, i.e. after the material period, but Mr. Stewart says that the TRIDENT tyres manufactured and sold in the United Kingdom since at least 1997 have included a section of tyre sidewall the same as is shown in the exhibited photograph. Mr. Stewart explains that Dunlop has supplied TRIDENT tyres to Jet Tyres Limited ("Jet"). The tyres are supplied to Jet's distribution outlets according to orders received. He says that the tyres are sold on by Jet and used on vehicles throughout the United Kingdom. TRIDENT tyres have also been supplied in the United Kingdom to a firm called ATS. Mr. Stewart exhibits copies of promotional materials produced and distributed by Jet and ATS (CGS 2) offering TRIDENT tyres. None of the copies in CGS 2 are dated². However, in a letter of 21 February 2002, Dunlop's representatives sent the Applicant's representatives a copy of what appears to be an identical Jet leaflet, which states that the prices listed in the leaflet apply from 1 February 2002 (Exhibit DJR 1 to the witness statement of David Rickard dated 5 November 2002). As the Hearing Officer noted most of the leaflets are directed to Black Cab Taxi Owners. Mr. Stewart gives approximations of numbers of TRIDENT tyres sold by Dunlop in the UK in the period 1997 – 2001. He says that he got these numbers from printouts supplied by Dunlop's Sales Department. The printouts are not exhibited because they contain commercially sensitive information but Mr. Stewart believes that they provide an accurate summary as follows:

1997	11,400
1998	11,500
1999	11,500
2000	9,600
2001	7,000

Mr. Stewart adds that from 1 January 2002 to 19 April 2002, Dunlop sold 1,800 TRIDENT tyres in the United Kingdom. He concludes that from the beginning of 1997 to 19 April 2002 Dunlop has manufactured, sold and supplied in the United Kingdom approximately 51,000 tyres [sic] with TRIDENT on the sidewall.

Evidence in support of the application

² An ATS leaflet does appear to carry a date but it is not discernible.

11. The Applicant's evidence consisted of witness statements of Julian Majzub, Nicholas Martin Wilson and Rex Grogan.
12. Julian Majzub is the Managing Director of the Applicant. In his witness statement of 2 August 2002, he explains how TRIDENT came to be adopted by the Applicant with the intention of using it in connection with tyres for vintage cars. Mr. Majzub does so by reference to an article he authored, which had "just appeared" in Bugatti Club Magazine. The article was published in Vol. 65 No. 2 but there is no date on the copy exhibited at JM 1 to Mr. Majzub's witness statement. I shall return to this article later in my decision. Mr. Majzub states that before adopting the name TRIDENT for his tyres, he undertook an extensive Internet search and found no mention of TRIDENT being used by Dunlop. When he received a letter of objection from Dunlop, he checked Dunlop's website but discovered no entry for TRIDENT. Mr. Majzub says this continues to be the case and exhibits at JM 2 extracts from Dunlop's website. Regarding the promotional materials exhibited by Mr. Stewart at CGS 2, Mr. Majzub comments that taxi tyres are a distinctive category of tyre and are governed by very strict regulations. He exhibits at JM 3 a copy of what he claims to be the current regulations. In fact the exhibited specifications concern only London Taxicabs and do not appear to prescribe any particular type, brand or size of tyre.
13. Nicholas Martin Wilson is a Partner in the firm of Withers & Rogers, the Applicant's trade mark attorneys. The purpose of his witness statement dated 5 August 2002 is to exhibit copies of settlement correspondence between the parties. The Hearing Officer did not find the correspondence of any assistance to his decision.
14. The Hearing Officer was also dismissive of the evidence of Rex Grogan. Mr. Grogan states in his witness statement of 1 August 2002 that he is an International Pneumatic Tyre Consultant specialising in forensic and accident investigations. From 1947 – 1980 he was employed in Dunlop's Technical Department. Mr. Grogan purports to give a history of the development of the taxi tyre by Dunlop. His evidence is relative only to the issue of partial revocation and I shall return to it later in my decision.

Proprietor's further evidence

15. This consisted of the three witness statements of Robert Heywood, Paul Hocken and David John Rickard.
16. Mr. Heywood's witness statement is dated 5 November 2002. Mr. Heywood is the General Manager, Motor Sports Division of Dunlop. He makes his statement from his own knowledge and the records of Dunlop. He adds that where he refers to information from Dunlop's records or from third parties, he has checked the information and believes it to be true. He says that for at least the last 10 years, Dunlop has supplied tyres of sizes that are suitable for use on taxis and classic vehicles but are also used on private vehicles. An example is 175R16. DUNLOP and TRIDENT tyres of that size have been supplied to different companies including Jet and Vintage Tyre Supplies, Beaulieu. He

claims that these tyres have been sold to members of the public for use on classic cars, private vehicles and taxis. They are radial ply tyres and the 175R16 size is useful as a replacement for cross ply tyres previously used on classic cars. Again, he says that in at least the last 5 years TRIDENT tyres are and have been sold for use on classic vehicles, which require tyres of that size not available in other ranges. The remainder of Mr. Heywood's witness statement is devoted to commenting on the Applicant's evidence. The Hearing Officer found the comments of limited assistance and I see no need to describe them further.

17. The witness statement of Paul Hocken dated 5 November 2002 was crucial to the outcome of the case. Mr. Hocken is the Northern Sales Manager of Jet. He says that he makes his statement based on his own knowledge and from the records of his company, which he believes to be true and correct. Mr. Hocken's evidence is brief and I set it out in full:

“2. Jet has purchased from Dunlop Tyres Ltd tyres branded on the tyre sidewall with the trademark TRIDENT since about 1992.

3. Jet operates tyre distribution outlets throughout the UK and has sold the TRIDENT tyres from these outlets for more than 5 years throughout the UK. Jet has 9 outlets branded JET TYRES and in addition sells tyres, including TRIDENT tyres, wholesale to over 500 outlets throughout the UK for sale to the public. The TRIDENT tyres are primarily sold to Black Cab taxis but not those used on licensed London Black cabs. They are also sold to anyone who has a need for tyres of the same size, including classic vehicle owners and other private vehicle owners.

4. I personally have sold tyres bearing the TRIDENT trademark to customers in the UK for use on vintage cars at various times in the last five years. I particularly remember one particular occasion in 1998 when I took 10 tyres to Mr King. I remember this because it was quite a long trip to his place and when I got there he refused to pay by cash or cheque but wanted an account set up. After some discussion, he agreed and I gave the tyres to him. I have spoken with other staff at Jet who have confirmed making “cash” sales of TRIDENT tyres to customers in the UK for use on vintage cars and private cars. I understand that the 175R16-size tyre is particularly suitable for use on cars built in the 1940's to 1950's. I also note that a number of people have purchased and use as private cars vehicles of the Black Cab style.

5. In the year 2000 Jet purchased over 7000 TRIDENT branded tyres from Dunlop Tyres Limited.

6. Since 1997 Jet has purchased more than 52000 tyres from Dunlop Tyres Limited branded with the trademark TRIDENT on the sidewall.”

18. During the hearing below, Dunlop's Counsel drew the Hearing Officer's attention to an "unfortunate typo" in Mr. Hocken's evidence in that paragraph 6 should read "Since 1992 ..." and not "Since 1997 ...". Counsel acknowledged that otherwise there would be a clash with the evidence of Mr. Stewart who states "since the beginning of 1997 to 19 April 2002 Dunlop has manufactured, sold and supplied in the UK approximately 51,000 tyres bearing the trademark TRIDENT on the sidewall". The Hearing Officer accepted the amendment and I do not understand the Applicant to challenge this on appeal.
19. David John Rickard is Dunlop's trade mark attorney. He responds to the witness statement of his counterpart, Mr. Wilson, by exhibiting copies of correspondence between the parties and a file note of a telephone conversation with Mr. Wilson. The Hearing Officer did not consider the information provided by Mr. Rickard to be of any assistance to his decision. I refer to some of the correspondence in my decision, inter alia, because Dunlop's Counsel sought to rely upon it during the appeal proceedings.

Applicant's evidence in reply

20. The Applicant filed three witness statements in reply. The witness statement of James Gray, dated 24 February 2003, concerns only the Applicant's conduct. The Hearing Officer rightly dismissed it as irrelevant to the revocation proceedings in hand.
21. Mr. Majzub filed a further witness statement, dated 4 March 2003. Mr. Majzub exhibits at JM 4 a copy Jet advertisement (undated), which has the JETYRES logo at the top, TAXI at an angle and in a box underneath and underneath again the phrase "TYRES ARE OUR BUSINESS", "All leading brands ...". Mr. Majzub also exhibits what he claims to be a copy of Vintage Tyre Supplies Price List (although there is no indication to that effect on the copy), which shows a listing under "WIRED-ON CAR TYRES 16"" for "175R16 Dunlop SP Taxi". I notice that several other brands of 16" tyre are mentioned, for example, Puma WW, Avon Tourist, Dunlop Trackgrip. Mr. Majzub contends that although one could fit a 175R16 radial tyre to a 1940's car that would constitute the fitment of incorrect equipment. Mr. Majzub then deals with his own conduct. Finally he draws attention to the fact that the leaflets supplied by Dunlop show the 175R16 tyre listed as TRIDENT TAXI NEW. He also exhibits at JM 7 a photograph showing TRIDENT in large letters on a tyre sidewall with the words "PROVINCIAL TAXI" in much smaller letters underneath. Mr. Majzub provides a copy extract from what he says is the Federation Internationale de l'Automobile "Invitation to Tender for Supplying Tyres" (again no parentage is mentioned on the copy document and it is undated). Mr. Majzub says that within the historic car world the FIA is the main body in Europe under which the majority of car rallies and race meetings are run. The specification states that no part of the casing may include rayon. He points out that by the admission of Mr. Heywood, the TRIDENT tyre contains rayon. Anyone with those tyres fitted to their classic car would therefore be excluded from a FIA race.

22. Mr. Grogan also provides a second witness statement dated 27 February 2002. Mr. Grogan maintains his previous position that the 175R16 is a taxi tyre. At RG1 he exhibits a copy of a DIMENSIONAL DATA SHEET, which lists the 175-R16 as “SP4 Taxi”, and also a leaflet entitled “DUNLOP CAR & VAN RANGE” where 175-16 (and 5.57-16) tyres are listed under the heading “DUNLOP TAXI TYRES”. Mr. Grogan refers to an extract from the ETRTO Standards Manual of 1998, which he says sets out all tyre sizes (exhibited at RJG2). He continues:

“The 175R16 is absent from the list. It is my belief that the only source of taxi tyre regulation is the Public Carriage Office which is administered by the Lord Mayor’s Office. The omission of 175R16 from the ETRTO Standards Manual means that it does not come within the scope of the organisation which sets the tyre standards for Europe ... the 175R16 ... is, therefore, not a standard tyre.”

The Hearing Officer’s decision

23. As to the law on whether the proprietor had satisfied the onus in section 100 of showing genuine use of TRIDENT for the registered goods in accordance with section 46(1)(b) of the TMA, the Hearing Officer addressed himself in relation to three authorities: the view of Jacob J. on substantiality of use in *LABORATOIRE DE LA MER Trade Marks* [2002] FSR 802 at paragraph 29; the judgment of the Court of Justice of the European Communities (“ECJ”) in Case C-40/01 *Ansul* [2003] ECR I-2439 on the meaning of “genuine use” in Articles 10 and 12 of Council Directive 89/104/EEC; and the comments of Wilberforce J. relating to single acts of user in *NODOZ Trade Mark* [1962] RPC 1 at page 7. No challenge to the Hearing Officer’s exposition of the relevant law was made on appeal. However, I must confess myself troubled by the fact that the Hearing Officer addressed himself by reference to paragraphs 40 – 42 of the ECJ’s judgment in *Ansul* instead of paragraphs 35 – 39 where the ECJ rules on the interpretation of “genuine use”. Paragraphs 40 – 42 of *Ansul* concern use on the after-sales market, which was not claimed in the present case.
24. The Hearing Officer considered that:

“33) The relevant facts before me are as follows:

- Mr. Stewart states that in the relevant period 51,000 TRIDENT tyres were sold in the UK.
- A photograph of a tyre showing the TRIDENT mark is provided. Although the photograph was taken in April 2002, Mr. Stewart states that the tyres manufactured since 1992 have had the mark incorporated in the tyre wall in the same manner.
- An independent witness states that his company has purchased more than 52,000 TRIDENT tyres since 1992. With over 7,000 such tyres being purchased in 2000.”

25. The Hearing Officer concluded:

“34) The registered proprietor chose not to file any corroborative evidence such as invoices other than the statement by the independent witness. However, to my mind this statement is sufficient to show that tyres with trade mark TRIDENT have been sold in the UK in the relevant period.”

26. The Hearing Officer then considered the Applicant’s alternative argument that the specification of Trade Mark No. 1289867 should be restricted to taxi tyres. Here the Hearing Officer cited well known passages from the judgments of Neuberger J. in *Premier Brands UK Ltd v. Typhoon Europe Ltd* [2000] FSR 767 at page 808, Jacob J. in *MINERVA Trade Mark* [2000] FSR 734 at page 738 and Aldous L.J. in *Thomson Holidays Ltd v. Norwegian Cruise Liners Ltd* [2003] RPC 586 at page 597.

27. His decision on the partial revocation aspect of the case was as follows:

“39) It is clear from these cases that there is no need for excessive detail in the description of goods/services and that a reasonable degree of generality can be tolerated. In the instant case the proprietor has shown use of the brand on tyres which it states are used on taxis, vintage/classic cars and on private cars. The applicant has not shown that the tyres can only be used on taxis. I therefore reject their request to restrict the specification in the manner suggested. However, the proprietor has not shown use of the mark in suit on “inner tubes and valves” and so the revocation action is successful with regard to these items. The specification will therefore be reduced to read:

“Tyres for land vehicles in Class 12”.”

28. As to Dunlop’s claim for costs above the scale on the contention that the Applicant’s case was unarguable following the details provided with Dunlop’s attorney’s letter of 5th February 2002, the Hearing Officer said:

“40) ... to my mind the evidence provided by the proprietor was not convincing until it filed a statement from an independent witness. Even then in its pre-amended form it posed questions as the number of tyres said to have been purchased was greater than the number stated to have been produced. ...

41) Although the applicant was only marginally successful and would normally have faced a costs award against it, I take into account that fact that the proprietor’s evidence was not fully resolved until the hearing. Once Mr. Brandreth [Dunlop’s Counsel] provided the correction to the date, the questions posed by the apparent conflict in

the proprietor's evidence were resolved and then it could be seen that the proprietor had indeed, shown use of the mark. To my mind the proprietor could and should have provided unequivocal evidence of use, such as invoices in its evidence in chief. For these reasons I therefore decline to award costs in this case. ...”

The appeal

29. On 19 May 2004, the Applicant filed notice of appeal to an Appointed Person under section 76 of the TMA. The first ground of appeal, in summary, pointed to the Hearing Officer's comments on the nature of the registered proprietor's evidence and contended that the Hearing Officer was wrong to have found that the burden in section 100 of proving genuine use in accordance with section 46(1)(b) of the TMA had been discharged (paragraph 11 of the statement of grounds). Secondly, the Applicant claimed that the Hearing Officer applied the wrong test in deciding the issue of partial revocation and that the specification of Trade Mark No. 1289867 should have been restricted to “taxi tyres”. There was no cross-appeal.
30. At the hearing of the appeal before me, the Applicant was represented by Mr. Richard Davis of Counsel. Mr. Benet Brandreth of Counsel represented Dunlop. By mistake, Mr. Davis' skeleton argument was sent to another Appointed Person and I did not get sight of it until the actual hearing. At that point it became clear that Mr. Davis additionally claimed that the Hearing Officer failed to address himself on the criteria for assessing the weight of hearsay evidence set out in section 4(2) of the Civil Evidence Act 1995.

Standard of review

31. Both counsel accepted that the proper approach to an appeal from the Registry is as explained by Robert Walker L.J. in *REEF Trade Mark* [2003] RPC 101 at page 109:

“In this case the hearing officer had to make what he himself referred to as a multi-factorial comparison, evaluating similarity of marks, similarity of goods and other factors in order to reach conclusions about the likelihood of confusion and the outcome of a notional passing off claim. It is not suggested that he was not experienced in this field, and there is nothing in the Civil Procedure Rules to diminish the degree of respect which has traditionally been shown to a hearing officer's specialised experience. (It is interesting to compare the observations made by Lord Radcliffe in *Edwards v. Bairstow* [1956] AC 14 at pp. 38-39, about the general commissioners, a tribunal with a specialised function but often little specialised training.) On the other hand the hearing officer did not hear any oral evidence. In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.”

32. As to what constitutes a sufficient basis for interference with the Hearing Officer's decision, Lord Woolf M.R. in *Phonographic Performance Ltd v. AEI Rediffusion Music Ltd* [1999] 2 All ER 299 at page 314 approved the following summary of Stuart-Smith L.J. in *Roache v. News Group Newspapers Ltd* [1998] EMLR 161 at page 172 in these terms:

“Before the court can interfere it must be shown that the judge has either erred in principle in his approach, or has left out of account, or taken into account, some feature that he should or should not, have considered, or that his decision is wholly wrong because the court is forced to the conclusion that he has not balanced the various factors fairly in the scale.”

33. Moreover, it is clear that the Hearing Officer must give adequate reasons for his decision. As the Court of Appeal explained in *English v. Emery Reimbold & Strick Ltd* [2002] 3 All ER 385 at pages 393 – 4:

“[19] It follows that, if the appellate process is to work satisfactorily, the judgment must enable the appellate court to understand why the judge reached his decision. This does not mean that every factor which weighed with the judge in his appraisal of the evidence has to be identified and explained. But the issues the resolution of which were vital to the judge's conclusion should be identified and the manner in which he resolved them explained. ...

[...]

[21] ... The essential requirement is that the terms of the judgment should enable the parties and any appellate tribunal readily to analyse the reasoning that was essential to the judge's decision.”

Use by the proprietor or with his consent

34. After the hearing on 11 October 2004, I reserved my judgment in the appeal. When reviewing the Hearing Officer's decision in the light of the parties' arguments, I identified the following area of concern. According to section 46(1)(b) of the TMA, the registration of a trade mark may be revoked if genuine use of the mark in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it was registered has been suspended for an uninterrupted period of five years and there are no proper reasons for non-use. The relevant five year period in the present case was 15 January 1997 – 14 January 2002. During that five-year period the registered proprietor of United Kingdom Trade Mark No. 1289867 was Sumitomo, the original applicant. The Hearing Officer's decision merely stated: “On 16 January 2002 the mark was assigned to Dunlop Tyres Limited”. It seemed to me that there was nothing in the Hearing Officer's decision, or in the counterstatement of grounds or evidence adduced by Dunlop, which indicated how the acts of user relied on by Dunlop could properly be classified as use by the proprietor or with his consent.

35. In a Note dated 18 October 2004, I invited the parties to provide written submissions on the above limited to the evidence on file, which in due course both parties did. Dunlop argued:
- (a) This was a new point, which I was not permitted to raise on appeal (*Jones v. MBNA International Bank*, CAT 30 June 2000). I deal with Dunlop's first argument below.
 - (b) Section 46(1)(b) refers to use by "the proprietor". Dunlop is the proprietor and has provided evidence of its use of TRIDENT in the relevant period. Dunlop did not pursue this line of argument, which in any event I believe is unsustainable. In order to constitute genuine use of a trade mark as interpreted by the ECJ in *Ansul* namely, use of the mark in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which the mark is registered, in order to create or preserve an outlet for those goods or services, qualifying use must be by the proprietor for the time being of the mark or by a third party with that proprietor's consent.
 - (c) The Applicant did not question whether Dunlop's use was with Sumitomo's consent. In effect, the point was conceded.
 - (d) Until 1999 Dunlop was a wholly owned subsidiary of Sumitomo and since that date has been jointly owned by Sumitomo. It is apparent from the article written by Mr. Majzub exhibited to his first witness statement at JM 1 that the Applicant knew this. Furthermore the share holdings in Dunlop were a matter of public record. The article at JM 1 is, as I have already mentioned, undated. The passage relied on by Dunlop reads:

"It turned out that the name *Trident* was registered, not to Dunlop but to Sumitomo in Japan, who had sold on Dunlop to Goodyear but kept the name ...".

I fail to see how that passage assists Dunlop in satisfying the onus in section 100 of proving genuine use during the relevant period by the proprietor or with his consent for the goods in question. Moreover, a further exchange of submissions between the parties (see below) revealed that Dunlop was not a wholly owned subsidiary of Sumitomo at the time mentioned.
36. By way of response to my Note of 18 October 2004, both parties relied to opposite effect on the decision of the Court of First Instance of the European Communities ("CFI") in Case T-203/02, *The Sunrider Corp. v. OHIM (VITAFRUIT)*, 8 July 2004. The CFI decision in *VITAFRUIT*, which is being appealed to the ECJ, concerns, inter alia, what can or cannot be implied from the use of a mark made by a third party. I shall return to that issue later in my decision.
37. On 29 October 2004, I sent a Further Note to the parties. Dunlop's response to my earlier note had contained statements that went beyond the evidence on

file and appeared to involve departures from Dunlop's pleadings as originally filed, namely (at paragraph 12(c) of Dunlop's response received by the Treasury Solicitor on 25 October 2004):

“Until 1999 Dunlop was a wholly owned subsidiary of Sumitomo and since that date has been jointly owned by Sumitomo and Goodyear ...”.

Before such departures could be taken into account, it would be necessary for Dunlop to regularise its position, insofar as it deemed appropriate, by way of amendment to its pleadings and the introduction of further evidence. No such applications had been made and any such applications would, of course, necessitate a re-opening of the appeal and the appointment of a further hearing. I indicated that I would postpone writing my decision for at least fourteen days to allow any such applications to be made.

38. Dunlop responded on 12 November 2004. For the first time, Dunlop sought to rely on the Form TM 16 Application to register a change of proprietor, received by the Registry on 16 January 2002. In particular, Dunlop relied on the statement in box 5 of the Form: “Date new proprietor took over ownership ... 31 August 1999”. Dunlop stated, “if the query is – as is assumed – whether Dunlop's use was use as proprietor during the relevant period it is submitted that its use since August 31, 1999 clearly qualifies”. Dunlop also sought to make a “conditional application” to amend its pleadings and to serve further evidence. The proposed amendment and further evidence were attached. The latter comprised a witness statement of Robin Whitehurst, Company secretary of Dunlop with three exhibits.
39. On 9 December 2004, I informed the parties in writing through the Offices of the Treasury Solicitor that I believed it appropriate to take into account in writing my decision the said Form TM 16 since this was received by hand at the Registry on 16 January 2002 and would have been available to the Hearing Officer. Further, I intended to proceed on that basis unless I received a request from either party by 17 December 2004 notifying me of their wish to be heard on the matter of the Form TM 16 or any other issue raised in the parties' submissions to my Note and Further Note. The Applicant's representatives wrote on 16 December 2004 informing me that subject to the observations made in their letter, the Applicant was content for me to proceed in the manner I had indicated on 9 December. However, the response from Dunlop's attorneys of 13 December 2004 made clear that a hearing would be necessary. First, the Appointed Person was asked otherwise to confirm her acceptance that Dunlop was the owner of UK registration 1289867 during the relevant five-year period, namely from 31 August 1999 and that genuine use of the trade mark was made in connection with the goods “by the proprietor or with its consent” during the relevant five-year period. In my view, that request purported to pre-empt my decision in the appeal. Secondly, Dunlop expressed their intention to claim indemnity costs if the Appointed Person found in Dunlop's favour in relation to “this issue” (although it is not entirely clear from the letter what issue is meant). Attached to Dunlop's response was a draft joint letter, which Dunlop's attorneys had asked the Applicant's

representatives by letter dated 9 November 2004 to sign on behalf of the Applicant. The proposed joint letter reads in so far as relevant:

“It was known to both parties that Dunlop Tyres Limited was until 1999 a wholly owned subsidiary of Sumitomo Rubber Industries Limited and since that date has been jointly owned by Sumitomo and Goodyear.

No point was taken on the issue raised in the Notes [my Note of 18 October and Further Note of 29 October] because, to the extent that it might be considered relevant, it was conceded that such use of the TRIDENT trademark (registration 1289867) in the UK in connection with tyres throughout the relevant under consideration in Opposition [sic] 80209 as was proved by Dunlop was at all times use with the consent and license of Sumitomo.

It is therefore the joint request of both parties that Professor Annand proceed on the basis that the facts stated in the first sentence of paragraph 12(c) of Dunlop’s Response to the Note of Professor Annand dated 18 October 2004 is accepted as true and proved [the said first sentence reads: “Until 1999 Dunlop was a wholly owned subsidiary of Sumitomo and since that date has been jointly owned by Sumitomo and Goodyear”]. Further, that it is proved that Dunlop Tyres Limited had at all times the consent and license of Sumitomo to use the TRIDENT trademark.”

Unsurprisingly, the Applicant’s representatives wrote to Dunlop’s representatives on 12 November 2004 saying that they were unable to provide the letter requested.

40. A further hearing was appointed for 19 January 2005. As before, Mr. Brandreth represented Dunlop and Mr. Davis, the Applicant. In the event, Dunlop did not proceed with the conditional applications to amend its pleadings and to introduce further evidence. However, Dunlop did reassert its claim for the costs of the hearing above the normal scale.

A new point

41. Mr. Brandreth argues that the area for concern identified in my note of 18 October 2004 is a new point, which the appellate tribunal is not entitled to bring forward. Mr. Brandreth relies on the following passage from the decision of the Court of Appeal in *Jones v. MBNA International Bank* (CAT June 30, 2000), which is quoted in the White Book at paragraph 52.8.2 in connection with CPR 52.8 – “An appeal notice may not be amended without the permission of the appeal court”. May L.J. said at paragraph 52:

“Civil trials are conducted on the basis that the court decides the factual and legal issues which the parties bring before the court. Normally each party should bring before the court the whole relevant case that he wishes to advance. He may choose to confine his claim or

defence to some only of the theoretical ways in which the case might be put. If he does so, the court will decide the issues which are raised and normally will not decide issues which are not raised. Normally a party cannot raise in subsequent proceedings claims or issues which could and should have been raised in the first proceedings. Equally, a party cannot, in my judgment, normally seek to appeal a trial judge's decision on the basis that a claim, which could have been brought before the trial judge, but was not, would have succeeded if it had been so brought. The justice of this as a general principle is, in my view, obvious. It is not merely a matter of efficiency, expediency and cost, but of substantial justice. Parties to litigation are entitled to know where they stand. The parties are entitled, and the court requires, to know what the issues are. Upon this depends a variety of decisions, including, by the parties, what evidence to call, how much effort and money it is appropriate to invest in the case, and generally how to conduct the case; and, by the court, what case management and administrative decisions and directions to make and give, and the substantive decisions in the case itself. Litigation should be resolved once and for all, and it is not, generally speaking, just if a party who successfully contested a case advanced on one basis should be expected to face on appeal, not a challenge to the original decision, but a new case advanced on a different basis. There may be exceptional cases in which the court would not apply the general principle which I have expressed but in my view this is not such a case."

In *Jones*, the claimant sued his former employer, MBNA International Bank Ltd, for breach of an implied term of confidence and trust in his employment contract in that the Bank acted in bad faith in seeking to replace the claimant with another manager. Claimant's counsel specifically accepted before the Recorder that bad faith was a necessary element of the claim for breach of implied term. On appeal, the claimant sought to amend his notice of appeal effectively claiming breach of the implied term through the Bank's unreasonable behaviour in investigating an allegedly false expenses claim and eventually dismissing the claimant. The Court of Appeal refused the claimant's amendment.

42. The purpose of an appeal under section 76 of the TMA is to obtain a review of the legality of a Hearing Officer's decision. Clearly that review must take place in the legal and factual context of the dispute as it was presented before the Hearing Officer. The role of the appellate tribunal is to determine if the Hearing Officer was wrong. That must involve determining whether, taking into account the facts and evidence relied upon by the parties, the Hearing Officer correctly applied the relevant law. The present case involves an application for revocation of Registered Trade Mark No. 1289867 TRIDENT in Class 12 on grounds of non-use under section 46(1)(b) of the TMA. The alleged five-year period of non-use is 15 January 1997 to 14 January 2002. On appeal, the Applicant contends, inter alia, that the Hearing Officer erred in finding that the registered proprietor had satisfied the onus imposed by section 100 of proving genuine use of TRIDENT for the registered goods in accordance with section 46(1)(b) of the TMA. In my judgment, I am entitled

to rule on a matter of law necessary to the correct application of section 46(1)(b), viz. whether genuine use was by the proprietor or with his consent, in the light of the facts, evidence and arguments adduced by the parties notwithstanding: (i) the Hearing Officer appears to have missed the issue at first instance; and (ii) the Applicant did not specifically raise the issue either at the hearing below or on appeal – provided, of course, that the parties have been given an opportunity to be heard. Counsel have directed me to, and I am aware of, no authority to the effect that I must ignore errors of principle necessary to the correct application of the law in question unless those errors have been specifically brought to my attention by the appellant.

What may be inferred from Dunlop’s use?

43. As I mentioned earlier in my decision, both parties sought to rely on the judgment of the CFI in the *VITAFRUIT* case. *VITAFRUIT* concerned an opposition to a Community trade mark application where the opponent registered proprietor was called upon to prove use of the earlier trade mark pursuant to Articles 42(2) and (3) and 15(1) of Council Regulation (EC) 40/94. The opponent submitted evidence of use by a third company, although the name of the former also appeared in the name of the latter (Juan Espadafor Caba/Industrias Espadafor SA). The CFI held:

“24. Where an opposing party maintains that the use of an earlier trade mark by a third party constitutes genuine use for the purposes of Article 43(2) and (3) of Regulation No. 40/94, he claims, by implication, that he consented to that use.

25. As to the truth of what that implies, it is evident that, if the use of the earlier trade mark, as shown by the invoices produced to OHIM, was without the proprietor’s consent and consequently in breach of the proprietor’s trade-mark right, it would have been in Industrias Espadafor SA’s interests, in the normal course of events, not to disclose evidence of such use to the proprietor of the trade mark in question. Consequently, it seems unlikely that the proprietor of a trade mark would be in a position to submit proof that the mark had been used against his wishes.

26. There was all the more reason for OHIM to rely on that presumption given that the applicant did not dispute that the earlier mark had been put to use by Industrias Espadafor SA with the opposing party’s consent. ...

[...]

28. Those factors formed a sufficiently firm basis to allow the Board of Appeal to conclude that the earlier trade mark had been used with its proprietor’s consent.”

44. These findings by the CFI in *VITAFRUIT* are the subject of an appeal to the ECJ. But, in any event, the facts of *VITAFRUIT* differ significantly from the case in hand. The evidence of use in *VITAFRUIT*, albeit by a third party, was submitted by the proprietor of the mark throughout the relevant time. Further there was a commonality in the names of the proprietor, an individual, and the third party, a company. In the present case, the proprietor of TRIDENT for (at least) the beginning part of the five-year period was Sumitomo but use for the whole five-year period was submitted by and on the part of Dunlop. In my view, there was nothing in the materials before the Hearing Officer from which he could have inferred that use throughout the five-year period was by the proprietor or with his consent and so the Applicant's conduct in failing to query the evidence in that regard is irrelevant.
45. What could the Hearing Officer have inferred from the materials before him? The Form TM 16 received by the Registry on 16 January 2002 states that the ownership of TRIDENT for the registered goods passed on 31 August 1999. The Form TM 16 purports to be signed by the (same) representative on behalf of the registered proprietor (Sumitomo) and on behalf of the new proprietor (Dunlop). In accordance with Rule 41(2)(a) of the TMR, that would have been sufficient to record the transaction without the need for documentary evidence in support. Hence, in the absence of specific challenge by the Applicant, I believe that the Hearing Officer: (a) was entitled to assume that Dunlop became the proprietor of TRIDENT as from 31 August 1999; and (b) should have dealt with the evidence of use submitted by Dunlop accordingly. I do not believe, as asserted by Mr. Brandreth on behalf of Dunlop, that the Hearing Officer could further have presumed from the Form TM 16 that the use relied on by Dunlop in the period 15 January 1977 to 31 August 1999 was use by Dunlop with Sumitomo's consent. As Mr. Davis observed, the earlier use could have been unlicensed/infringing use resulting in the purchase of the mark from Sumitomo as part of a settlement package.
46. The outcome of the above deliberations is that I believe the Hearing Officer did fall into error by failing to consider whether use *throughout* the five-year period was use by the proprietor or with his consent. In my view, it is clear that the Hearing Officer did not differentiate between the evidence relating to the periods 15 January 1997 to 31 August 1999 on the one hand, and 1 September 1999 to 14 January 2002 on the other hand, when he found that Dunlop had succeeded in proving genuine use for tyres for land vehicles during those times. In particular, there was no evidence from which it could be inferred that Dunlop's use in period 15 January 1997 to 31 August 1999 was use with the consent of the then proprietor of the mark, Sumitomo. It follows that I must either remit the case to the Registry for reconsideration of the evidence or undertake that task myself. I believe the latter way forward best serves the overriding objective of dealing with the case justly.

Has Dunlop shown genuine use in the five-year period?

47. Clearly, now the only relevant time is 31 August 1999 – 14 January 2002 when Dunlop became the proprietor of the mark. I believe this makes little difference to Mr. Hocken's evidence. The amendment made by Mr. Brandreth

to the last paragraph of Mr. Hocken's witness statement – "Since 1997 [sic, 1992] Jet has purchased more than 52000 tyres from Dunlop Tyres Limited branded with the trademark TRIDENT on the sidewall." – had already robbed that paragraph of any unequivocal significance to the five-year period in hand. However, Mr. Hocken's recollection of a visit to Mr. King is no longer relevant since it took place around 1998, before Dunlop became the owner of the mark.

48. Mr. Davis referred me to three authorities on the standard of proof of use to be expected under sections 46(1)(b) and 100 of the TMA. First, he drew my attention to the observations of Laddie J. with regard to Registry evidence in *DIXY FRIED CHICKEN Trade Mark* [2003] EWHC 2902 (Ch) concerning an application for a declaration of invalidity based on section 5(4)(a) of the TMA:

"5. As is well known, the Registry adopts a fairly relaxed attitude to the service of evidence. Whether it is right to do so is not in issue before me. However, acquaintance with these standards could not prepare one for the evidence in this case. It is a shambles. ...

[...]

7. In other words, mere assertion is not enough. Before one can invalidate a registration and thereby deprive a trader of his exclusive rights, one must produce relevant credible evidence of sufficient weight. ..."

Mr. Brandreth responded that these words were uttered in the context of an allegation of forgery, a factor that is not present in this case. Be that as it may, the text indicates that Laddie J. intended his observations of general application.

49. Second, Mr. Davis pointed to observations of the Technical Board of Appeal of the European Patent Office in Case T 0472/92 concerning the standard of proving prior public use to invalidate a patent for lack of novelty. The Board of Appeal confirms that the standard is balance of probability and continues (at 3.1):

"Generally speaking, in cases not involving the issue of prior public use, both parties are able to obtain and to adduce the evidence upon which their respective case rests. By contrast, in the majority of prior public use cases practically all the evidence in support of an alleged prior use lies within the power and knowledge of the opponent, so the patentee seldom has any ready, or indeed access to it all. All he can, in practice, do is to challenge that evidence by pointing out any inconsistencies contained in it or to draw attention to any gaps in the chain of commercial transactions that need to be established by the opponent in order to succeed on this ground.

In consequence, an opponent must prove his case up to the hilt, for little if any evidence will be available to the patentee to establish the contradictory proposition that no prior public use has taken place.”

Mr. Davis says that there are obvious parallels with the case in hand since evidence of use of a trade mark is entirely within the proprietor’s power and knowledge.

50. Third, Mr. Davis took me in detail through the decision of Mr. Matthew Clarke QC sitting as the Appointed Person in *FLORIS Trade Mark* [2001] RPC 19. Mr. Davis argues that *FLORIS* is a comparable case. In *FLORIS* the issue was whether genuine use had been shown for towels (textiles), face cloths. Only one copy invoice within the period was adduced, which emanated from the proprietor’s toiletries shop in Jermyn Street, London and included among a number of items, two face cloths at £3.95 each and two towels at £6.95 each. There was also some promotional material containing fabric items marked FLORIS that might have been face cloths or towels but they were not listed for sale. A director of the proprietor, Mr. Marsh, stated in a declaration:

“ The proprietor sells approximately 2,000 items of its current range of textile goods at an approximate value of £6,500. Distribution of these goods is mainly limited to mail order and retail sales through the Jermyn Street shop. ...”

Mr. Clarke said:

“In my judgment the applicants for revocation were well founded in highlighting the paucity of evidence produced by the registered proprietors in this case. While the hearing officer was correct, in law, in saying that one has to look at the totality of the evidence produced, it has to be borne in mind that the burden of proof remains with the registered proprietor and, in this case, in my view, having regard to the evidence proffered by them, even taken in its entirety, it never came near to discharging the onus of proving genuine use in a commercial sense in the relevant period. I think that the hearing officer lost sight of the careful guidance given by Wilberforce J. in the *NODOZ* case cited above. The hearing officer, in my judgment, was too generous in his treatment of the sparse evidence put before him in this case. That is, perhaps, best illustrated where in his decision at page 8, he refers to the statement made by Mr. Marsh in his statutory declaration that: “The proprietor sells approximately 2,000 items of its current range of textile goods at an approximate value of £6,500” and then goes on to say: “There is no clear statement that the textile goods referred to were in fact towels and face cloths. It is not without hesitation, therefore, that I infer that this was the case.” In my view, the hearing officer should have considered that the registered proprietors had failed to establish genuine use of the mark in relation to “towels (textile) and face cloths” during the relevant period for the purposes of section 46 of the 1994 Act.”

51. Mr. Davis also took me through the criteria for estimating the weight (if any) to be given to hearsay evidence set out in section 4(2) of the Civil Evidence Act 1995 and criticised the Hearing Officer for not referring to such criteria expressly. At times, Mr. Davis sought to contrast what he called “primary evidence”, such as original invoices. The decision below indicates that the Hearing Officer did appreciate the limitations of Dunlop’s evidence. Not every factor that weighed with the Hearing Officer in his appraisal of the evidence needs to be identified and explained (*English v. Emery Reimbold & Strick Ltd*, see paragraph 33 above).
52. Turning to the evidence itself, Mr. Davis makes the following comments on the three items of relevance set out by the Hearing Officer at paragraph 33 of his decision, namely:
- (i) “Mr. Stewart states that in the relevant period 51,000 TRIDENT tyres were sold in the UK.” Whilst accepting that these figures are claimed to be substantiated by Mr. Stewart checking “printouts”, Mr. Davis says the nature and accuracy of the printouts is unexplained [Mr. Stewart states his belief that the printouts provide an accurate summary of Dunlop’s tyre sales.] Further, the fact that the printouts contain commercially sensitive information is no excuse for not exhibiting them since arrangements could have been made with the Registry to protect their confidentiality. Finally it is unclear what Mr. Stewart means by TRIDENT tyres. There is no evidence of how these were promoted and sold. I note that earlier in his statement Mr. Stewart states that he has access to his company’s records and gives an account of the design and manufacturing history of a tyre with the mark TRIDENT on the sidewall. He also exhibits marketing materials used by companies to whom Dunlop supplies tyres, which although undated do show tyres being referred to as “New Trident by Dunlop”, “TRIDENT TAXI NEW” or “TRIDENT TYRE”.
 - (ii) “A photograph of a tyre showing the TRIDENT mark is provided. Although the photograph was taken in April 2002, Mr. Stewart states that the tyres manufactured since 1992 have had the mark incorporated in the tyre wall in the same manner.” Mr. Davis queries how Mr. Stewart knows the latter and points out that there is no substantiation for his statement. I should add that Mr. Stewart’s before mentioned statement was never clearly linked to the five-year period in hand (15 January 1997 – 14 January 2002) and certainly cannot be said unequivocally to relate to period on or after 31 August 1999 when it is possible to infer from the unchallenged Form TM 16 that Dunlop became the owner of the TRIDENT mark.
 - (iii) “An independent witness states that his company has purchased more than 52,000 tyres since 1992. With over 7,000 such tyres being purchased in 2000”. The “independent witness” referred to here is Mr. Hocken. I have already commented on his first sentence in the quoted extract at paragraph 46 above. Mr. Davis queries first, the basis for his

second sentence. Mr. Brandreth responds that at paragraph 1, Mr. Hocken says that he makes his witness statement “based on my own knowledge & from the records of my company, which I believe to be true and correct”. Mr. Davis’ second and third points respectively are: (a) Mr. Hocken does not say how long he has been with Jet or how as Northern Sales Manager he knows anything about countrywide purchasing of tyres; and (b) it cannot be assumed that Jet is independent of Dunlop - Mr. Hocken never says so. Mr. Brandreth rightly says that Mr. Hocken’s evidence was not challenged below. There was no application to cross-examine Mr. Hocken before the Hearing Officer and no such application has been made on appeal.

Finally, the Applicant argues that there is no evidence that tyres were sold on the market.

53. Both sides accept that the leading authority on what constitutes “genuine use” for the purposes of Articles 10 and 12 of the Directive and consequently section 46(1)(a) and (b) of the TMA is *Ansul*. In that case, the ECJ said (at paragraphs 35 – 39):

“35. Next, as *Ansul* argued, the eighth recital in the preamble to the Directive states that trade marks ‘must actually be used, or, if not used, be subject to revocation’. ‘Genuine use’ therefore means actual use of the mark. That approach is confirmed, *inter alia*, by the Dutch version of the Directive, which uses in the eighth recital the words ‘werkelijk wordt gebruikt’, and by other language versions such as the Spanish (‘uso efectivo’), Italian (‘uso effettivo’) and English (‘genuine use’).

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 origin of goods or services to the consumer or the 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 for 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 services concerned on the corresponding market.”
54. In Case C-259/02, *La Mer Technology Inc. v. Laboratoires Goemar SA*, Order 27 January 2004, the ECJ added that use of a mark by a single client that imports the products for which the mark is registered 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 of the mark (paragraph 24).
55. I agree with the Hearing Officer that the evidence of Mr. Hocken is crucial to the outcome of this case. It provides corroboration for the statements of Mr. Stewart and Mr. Heywood of Dunlop that the company had made use of TRIDENT in relation to tyres during the five-year period in question and, in particular, between 31 August 1999 and 14 January 2002, when it was appropriate to infer that Dunlop were the owners of the TRIDENT mark. Mr. Stewart says that in the years 2000 and 2001, respectively 9,600 and 7,000 TRIDENT tyres were sold in the UK, *inter alia*, to Jet. In turn, Mr. Hocken states that in 2000 Jet purchased over 7000 TRIDENT branded tyres from Dunlop. There is no indication in the papers that Dunlop and Jet are linked. Indeed, the different company names, addresses and positions occupied in the tyre supply line point to the opposite conclusion. Jet is not alleged to be Dunlop’s agent. Messrs. Stewart, Heywood and Hocken speak in terms of sales and purchases. I do not believe that the claimed use can be classified as internal. In my judgment, the use has been shown to serve a real commercial purpose and to be warranted in the tyre industry to create or maintain a share in the market. Mr. Davis makes the point that there is no evidence of sales to end-users. My understanding of the ECJ’s judgment in *Ansul* is that the consumer can be anywhere in the supply chain (provided use is not purely internal) and need not necessarily be the end-user. Otherwise, manufacturers who do not supply products direct to the public would always be reliant on

their retailers to supply evidence of use, which would be impractical. In any event, I note that Mr. Hocken states that Jet sells TRIDENT tyres from its distribution outlets throughout the UK and has done so for more than five years (from 5 November 2002). It seems highly unlikely that a company in the business of selling tyres would buy 7000 tyres in 2000 and not distribute them on the market. I believe a proper inference from the evidence is that a not insubstantial number of TRIDENT tyres were sold by Jet to wholesalers or direct to end-users in the period 31 August 1999 to 14 January 2002. In my judgment genuine use has been established.

Partial revocation

56. The Applicant argues in the alternative that the specification of Registered Trade Mark No. 1289867 should be restricted under section 46(1)(b) and (5) of the TMA to “taxi tyres”.
57. The law on partial revocation for non-use is as explained by the Court of Appeal in *Thomson Holidays Ltd v. Norwegian Cruise Lines Ltd*. [2003] RPC 586. Referring to the decision of Pumfrey J. in *Decon Laboratories Ltd v. Fred Baker Scientific Ltd* [2001] RPC 293, Aldous L.J. in *Thomson* said (at page 597:

“Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?”

Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s. 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

58. Regarding partial revocation the Hearing Officer found (at paragraph 39):

“In the instant case the proprietor has shown use of the brand on tyres which it states are used on taxis, vintage/classic cars and on private cars. The applicant has not shown that the tyres can only be used on

taxis. I therefore reject their request to restrict the specification in the manner suggested.”

59. The Applicant complains that the Hearing Officer used the wrong test and that it was not up to the Applicant to show that the tyres could only be used for taxis. In my view, the Applicant’s criticism is entirely justified. The task is to decide how the reasonably well-informed and reasonably observant and circumspect consumer would describe the use that the tribunal has found made of the TRIDENT mark.
60. The Applicant relies upon the promotional material exhibited to the witness statement of Mr. Stewart at CGS2. As I have already mentioned, none of these materials is dated. The Jet leaflet is headed “TYRE PRICES” and lists the “175 x 16 New Trident by Dunlop”. Three ATS leaflets are headed “BLACK CAB TAXI OWNERS, TYRE AND BATTERY PRICE LIST” and each leaflet lists “175 – 16 TRIDENT TAXI NEW”. The final leaflet is headed “CALLING ALL TAXIS, Mr. Tyre Ltd, Black Cab Taxi, Tyres and Battery Prices” and offers “175-16 Trident Taxi New”. The Applicant also relies on the evidence of Rex Grogan who describes himself as an International Pneumatic Tyre Consultant. In his first witness statement, Mr. Grogan says he bases his belief that TRIDENT has only been used in relation to taxi tyres on the promotional materials just described. He adds that the sales figures given by Mr. Heywood indicate a small output, which would tend to confirm the tyres’ restricted application. He says that tyres for use on traditional black cab taxis have to meet rigid specifications but not what these are. Mr. Majzub of the applicant repeats the latter in his first witness statement and exhibits at JM3 “TRANSPORT FOR LONDON PUBLIC CARRAIGE OFFICE, TYRE REQUIREMENTS FOR LONDON TAXICABS”. The requirements (at paragraph 2) state that the tyres must “bear your brand name and the word ‘TAXI’”. JM3 is dated 2002. Mr. Grogan’s second witness statement says “Everyone knows that 175R16 is a size of tyre used specifically on taxis” but Mr. Grogan does not explain the basis of his statement nor whom he means by “everyone”. He exhibits further Dunlop materials (RJG1 – DIMENSIONAL DATA and DUNLOP CAR AND VAN RANGE brochure) but in fact these materials do not mention tyres bearing the TRIDENT mark. Mr. Majzub in his second witness statement exhibits a copy photograph (undated) showing a tyre sidewall with TRIDENT marked in large letters and “PROVINCIAL TAXI” in much smaller letters underneath.
61. On Dunlop’s side, Mr. Heywood says that TRIDENT tyres have been sold to members of the public for use on classic cars, private vehicles and taxis but much of his evidence is hearsay to which I attach little weight. Mr Hocken says that TRIDENT tyres are primarily sold to Black Cab taxis but not those used on licensed London cabs. He adds: “I personally have sold tyres bearing the TRIDENT trade mark to customers in the UK for use on vintage cars at various times in the last five years.”
62. I believe that there is a further factor that I must take into account in determining the partial revocation case and that is the need for certain

registrations. The ECJ has stressed the need for legal certainty and sound administration on several occasions, for example, in Case C-273/00, *Sieckmann* [2002] ECR I-11737, paragraphs 37 and 46 – 55 in relation to representations, Case C-363/99, *Koninklijke KPN Nederland NV*, 12 February 2004, paragraphs 114 – 115, regarding limitations and most recently in the Opinion of A.G. Léger in Case C-418/02, *Praktiker Bau- und Heimwerkermärkte AG*, 13 January 2005, paragraphs 62 – 67, concerning specifications of goods and services. The parties accept that there are two types of Black Cab taxis – London and provincial. Further, I believe that I can take judicial notice of the well-known truth that taxis comprise saloon cars, estate cars, MPVs (also known as people vehicles) and traditional Black Cabs. In my view, a specification of “taxi tyres”, even if justified on the evidence (on which I express no view), would not meet the dual requirements of legal certainty and sound administration. Accordingly, I agree with the Hearing Officer that the specification should read: “Tyres for land vehicles in Class 12” there having been no appeal against the Hearing Officer’s decision to remove “inner tubes and valves, all for the aforesaid tyres” from the original list of goods.

Costs

63. Dunlop says that it is entitled to an award of costs for the hearing below. Mr. Davis counters that Dunlop did not appeal the decision of the Hearing Officer to make no award of costs. Mr. Davis is right. This issue is not before me for decision.
64. Dunlop has been largely successful on appeal and should receive a contribution towards its costs. However, I see no reason to depart from the normal scale. There was, of course, a second appeal hearing at which Dunlop decided not to pursue its conditional application to amend its pleadings and adduce new evidence. Nevertheless, the Applicant was obliged to prepare to defend the application. I believe Dunlop’s costs should be reduced to reflect this.

Conclusion

65. In the result, I direct that:
 - (1) The specification of Registered Trade Mark 1289867 is reduced to read “Tyres for land vehicles in Class 12”.
 - (2) The Applicant pays Dunlop the sum of £750.00 towards the costs of the appeal within seven days.

Mr. Richard Davis of Counsel, instructed by Withers & Rogers, appeared on behalf of Trident Tyre Limited.

Mr. Benet Brandreth of Counsel, instructed by Ipulse, appeared on behalf of Dunlop Tyres Limited.