

O-056-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 82318
BY WYCOMBE WINE COMPANY LIMITED
FOR REVOCATION OF TRADE MARK No. 1488222
STANDING IN THE NAME OF
CM VINTNERS LIMITED**

BACKGROUND

1) The following trade mark is registered in the name of C M Vintners Ltd

Mark	Number	Registered Date	Class	Specification
CHATEAU ROCHELLE	1488222	12.02.93	33	Wines, spirits, sparkling perry; all included in Class 33.

2) By an application dated 9 November 2005, Wycombe Wine Company Ltd applied for the revocation of the registration under the provision of Sections 46(1)(a) & (b) claiming there has been no use of the trade mark in suit in the five years prior to the filing of the applications for revocation, nor in the five years following registration.

3) On 6 March 2005 the registered proprietor filed a counterstatement admitting non-use of the mark as registered but claiming use on “ROCHELLE”.

4) Both sides filed evidence. Both sides ask for an award of costs. The matter came to be heard on 23 January 2007 when the registered proprietor was represented by Mr Jennings of Messrs W P Thompson & Co. and the applicant was represented by Ms Maddox of Messrs Chancery Trade Marks.

REGISTERED PROPRIETOR’S EVIDENCE

5) The registered proprietor filed a witness statement, dated 2 March 2006 by Robert Miller the Commercial Trading Manager of the registered proprietor company. He admits that his company has not made use of the trade mark as registered but instead has used the trade mark ROCHELLE in relation to wine which has been sold during the relevant periods. At exhibit A he provides a specimen label showing use of the mark “ROCHELLE” and also copy invoices showing sales of the wine under this label. The label shows a typical heraldic eagle with wings splayed above the word ROCHELLE and then in smaller print “POIRE MOUSSEUX SUPERIEUR”. The label is for a sparkling Perry. Also provided are three invoices dated 14 June 2002, 17 July 2002 and 19 August 2002. All are addressed to the same company, Denbur Foods Ltd in Nottinghamshire and each invoice is for £6090 in relation to “Rochelle medium sweet”.

6) Mr Miller contends that the word “Chateau” in relation to wines is in common use and hence is generic and that therefore the distinguishing feature of trade mark 1488222 is the word ROCHELLE, which he states has been used on wine.

APPLICANT’S EVIDENCE

7) The applicant has filed an affidavit, dated 1 September 2006, by Anthony Kenneth Harwood a Director and owner of the applicant company. He states that he has been involved in the drinks industry for thirty years. Mr Harwood states that;

“Different types of alcoholic beverages attract particular types of trade marks so that for instance for vodkas you will find that manufacturers will use trade marks with a Russian connotation whilst for Scotch whisky, the names will have

a Scottish connotation. With regard to fine wines, from France, there is a tradition for wines to be sold under a “CHATEAU” name because it confers status on the product. It was the “Chateau” estates in France which established the reputation for fine wines, especially in the Bordeaux region. “CHATEAU” names are not normally used for alcoholic drinks other than wines.”

8) Mr Harwood points out that the registered proprietor has shown use of the mark ROCHELLE on a sparkling Perry which is made from pears rather than grapes. He states that “Chateau Rochelle” would only be appropriate for a fine wine. He also points out that Perry is largely a British product. He states that the addition of the word “Chateau” makes a significant difference to the mark. He states that he has been unable to find any information on the use of CHATEAU ROCHELLE or even ROCHELLE on the internet during the last five years.

9) That concludes my review of the evidence. I now turn to the decision.

DECISION

10) The revocation actions are based upon Section 46 of the Trade marks Act 1994, the relevant parts of which read as follows:

“46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c)
- (d)

(2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made.

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the

commencement or resumption began before the proprietor became aware that the application might be made.”

11) The applicant alleges that the marks have not been used in the five years following registration and also in the five years prior to the date of the application for revocation. The periods in question are, therefore, for Section 46(1)(a) 13 February 1993 – 12 February 1998 and for Section 46(1)(b) 9 November 2000 – 8 November 2005.

12) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act make it clear that the onus of showing use rests with him. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

13) I take into account the judgement in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-42:

“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 *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations 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.

40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

41. That applies, *inter alia*, where the proprietor of the trade mark under which such goods were put on the market sells parts which are integral to the make-up or structure of the goods previously sold, and for which he makes actual use of the same mark under the conditions described in paras [35] to [39] of this judgement. Since the parts are integral to those goods and are sold under the same mark, genuine use of the mark for those parts must be considered to relate to the goods previously sold and to serve to preserve the proprietor's rights in respect of those goods.

42. The same may be true where the trade mark proprietor makes actual use of the mark, under the same conditions, for goods and services, which, though not integral to the make-up or structure of the goods previously sold, are directly related to those goods and intended to meet the needs of customers of those goods. That may apply to after-sales services, such as the sale of accessories or related parts, or the supply of maintenance and repair services.”

14) In the instant case the registered proprietor has provided three invoices covering the period June to August 2002 inclusive. The three invoices are all in relation to the sale of sparkling Perry and the total sales amounted to just over £18,000. The registered proprietor accepts that its attempt to launch its sparkling Perry under the ROCHELLE label was not successful, but it contends that the sales shown were genuine sales and the use made fully meets the standards set out above. The registered proprietor also contends that it has not abandoned the mark but as a small firm it has to utilise its resources carefully.

15) I agree that the sales made are very small when taking into account the size of the market for alcoholic drinks. However, the fact that the sales were made years before the revocation action was filed suggests that the sales constituted a genuine attempt by the registered proprietor to launch a product under the mark ROCHELLE. The fact that the launch failed cannot be held against the registered proprietor. To my mind, the use shown, albeit small, amounts to genuine use of the mark ROCHELLE on sparkling Perry. The registered proprietor has not shown use or intention to use the

mark on any other product which is included in its specification. Therefore, use has been shown of the mark ROCHELLE in the Section 46(1)(b) period but no use has been provided for the Section 46(1)(a) period.

16) I must now turn to consider whether use of the mark as shown in the exhibit can be considered use of the registered mark. In considering this issue I look to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 24. In particular, I refer to the comments of Lord Walker at paragraphs 43-45 where he stated:

“40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal:

“...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.”

(This language is word for word the same as the English language version of Art.10.2(a) of the Directive).

41 The word “elements” can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) “elements” must have a weaker sense (of “features” or even, as Mr Bloch came close to submitting, “details”).

42 The deputy judge touched on this and some related points in paras [18-22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark’s distinctive character was altered (not substantially altered).

43... The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

‘Bare ruin’d choirs, where late the sweet birds sang’

is effective whether or not the reader is familiar with Empson’s commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of ‘whose eyes? - registrar or ordinary consumer?’ is a direct conflict. It is for the registrar, through the hearing officer’s specialised experience and judgement, to analyse the ‘visual, aural and conceptual’ qualities of a mark and make a ‘global appreciation’ of its likely impact on the average consumer, who:

‘Normally perceives a mark as a whole and does not proceed to analyse its various details.’

The quotations are from para [26] of the judgement of the Court of Justice in Case C-342/97 *Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance.”

17) I also refer to the comments of Sir Martin Nourse, in the same *Bud* case where, at paragraph 12, he said:

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

18) At the hearing both parties agreed that the average consumer for sparkling Perry, or indeed any alcoholic drink, would consist of all adults over the age of eighteen who were consumers of alcohol.

19) The registered proprietor contends that use of the word “Rochelle” should be deemed as use of the mark “Chateau Rochelle”. They state that “Clearly, the word ‘Chateau’ cannot be monopolised and therefore the only other distinguishing feature of the registration in suit is the word ‘ROCHELLE’”. Whereas, the applicant contends:

“There are then some words which are commonly used in the trade but which are nevertheless not wholly non-distinctive and when combined with other words add distinctiveness to a mark as a whole. The word CHATEAU would fall into this latter category. It is of course used widely for wine products but it has the capacity to transform the connotation of whatever follows. The word ROCHELLE on its own might be a place name or the name of the Managing Director’s daughter, but if the word CHATEAU is placed before it immediately creates a completely different meaning and conveys a different bundle of messages to the consumer. CHATEAU ROCHELLE hangs together creating an integral whole. If CHATEAU is taken away it leaves a different mark.”

20) I agree that the word CHATEAU is widely used within the drinks industry and of itself is not distinctive. However, I agree that it is capable of changing the perception

of other words. As the applicant contended ROCHELLE on its own could be a region, a city, a town or hamlet. Equally, it could be a forename or surname or an entirely fanciful creation with no meaning whatsoever. However, all this changes when the word CHATEAU is placed before it. The addition of this non-distinctive element to a word, ROCHELLE, which lacks meaning to the average consumer turns it into a mark which has a very distinct meaning. Most consumers upon seeing CHATEAU ROCHELLE would immediately envisage a large house or manor surrounded by vineyards. They would also assume that the property is or was owned by the Rochelle family.

21) I also take into account the very obvious visual and phonetic differences between ROCHELLE and CHATEAU ROCHELLE. To my mind, use of the word ROCHELLE absent the word CHATEAU significantly alters the distinctive character or the registered trade mark which takes the mark beyond the differing forms allowed under Section 46(2). Consequently, it is my opinion that the registered proprietor has not shown any use of the registered trade mark and the revocation action under both Sections 46(1)(a) & (b) succeed. Trade mark 1488222 is therefore revoked with effect of 12 February 1998.

22) As the applicants have been successful they are entitled to a contribution towards their costs. I order the registered proprietor to pay the applicants the sum of £2,000. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of February 2007

**George W Salthouse
For the Registrar,
the Comptroller-General**