

O-069-09

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

BETWEEN IVO CUTELARIAS LDa (IVO)

AND

ROUSSELON FRERES ET CIE (RF)

UNDER NUMBERS 82692-4 AND 94478

CONSISTING OF:

**1) AN OPPOSITION BY RF TO IVO'S APPLICATION TO
REGISTER 'P. SABATIER' AS A TRADE MARK IN CLASS 8**

AND

**2) VARIOUS APPLICATIONS BY IVO
TO CANCEL THE REGISTRATION OF RF'S EARLIER
TRADE MARK 'SABATIER'**

Summary of the Cases

1. These proceedings are about:

- a) Application No.2379778 made on 7 December 2004 by a Portuguese company called Ivo Cutelarias Lda (IVO) to register the trade mark P.SABATIER for 'cutlery, knives, forks and spoons; cleavers, sharpening steels, spatulas, slicers and parers' in Class 8.
- b) Opposition No. 94478 to that application under sections 5(2)(b) and 5(3) of the Act by a French company called Rousselon Freres et cie (RF) based on the earlier trade mark SABATIER, which is registered in RF's name in the UK under No. 940831 for 'kitchen knives, cook's kitchen knives and butcher's knives; forks for cooking, carving and roasting; and sharpening steels'.
- c) Three applications made by IVO on 25 October 2006 for registration No. 940831 to be:
 - i) Declared invalid because, at the time of its registration, it was devoid of any distinctive character, and/or a sign that may have served in trade to designate characteristics of the registered goods, and/or a sign that had become customary in the current language or in the *bona fide* and established practices of the trade, that it had not acquired a distinctive character through use and it was therefore excluded from registration under section 3(1)(b),(c) and/or (d) of the Act.
 - ii) Revoked under section 46(1)(c) of the Act because as a consequence of the acts or inactivity of RF it has become the common name in the trade for some or all the goods for which it is registered (the first revocation application).
 - iii) Revoked under section 46(1)(a) and/or (b) of the Act because there has been no genuine use of the trade mark since it was registered, or because such use was suspended in the 5 year periods ending on 17 July 2006 or 25 October 2006 (the second revocation application).

2. As the earlier SABATIER mark had been registered for more than five years at the date of publication of IVO's application, RF's opposition includes the statement of use of the earlier mark as required by Rule 13 of the applicable rules (the Trade Mark Rules 2000).

3. In the case of the first revocation application, IVO asks the Registrar to exercise his discretion under section 46(6)(b) of the Act and revoke the registration of the SABATIER trade mark from the date of registration, or the first later date on which it appears to the Registrar that the conditions for revocation existed. In the case of the second revocation application, IVO asks for the registration to be revoked from the expiry of the five year period following the completion of the registration process, or

the first later date on which it appears to the Registrar that the conditions for revocation existed. The application form, which has been amended four times, actually mentions two specific later dates (17 and 25 July 2006) and I heard (and rejected) an application for a fifth amendment to add another alternative date, but for the reasons given below nothing turns on this.

4. All the actions are defended. In the case of the opposition, IVO challenges RF's statement of use of the earlier trade mark under section 6A of the Act and puts it to proof that there was genuine use of the mark in the five year period ending on the date of the publication of the P.SABATIER trade mark.

5. Both sides seek an award of costs.

6. The various applications were subsequently consolidated. I will take account of all of the evidence before me in relation to each of the actions.

7. In order to better understand what follows it is necessary to appreciate that there have been relatively recent proceedings between RF and other users of Sabatier marks. One such action related to applications brought by RF to invalidate the trade marks JUDGE SABATIER and STELLAR SABATIER, which had been registered in the name of Horwood Homes Limited (Horwood). Horwood was at the time selling goods in the UK made for it by IVO. The grounds for invalidating Horwood's registrations were based on an allegation of a likelihood of confusion between on the one hand, the JUDGE SABATIER and STELLAR SABATIER marks, and on the other hand, various earlier marks in RF's name that consisted of, or included, the name SABATIER. The applications were rejected by the Registrar but succeeded on appeal before Mr Justice Warren. The judgment of the court is reported at [2008] RPC 30. Part of Horwood's case in those invalidation proceedings was that the name SABATIER had little or no distinctive character because it was a common name in the trade. Although the judge had no formal application before him to revoke the earlier marks, he rejected that claim on the basis of the evidence before him and expressed the view that a formal application for revocation of the mark SABATIER would fail on the same evidence (there is additional evidence in these proceedings).

8. Like IVO, Horwood had in fact filed applications to revoke RF's registration of SABATIER, but these proceedings had not been concluded at the time of the hearing of the appeal by the High Court. Following the outcome of the appeal, the Registrar set out a timetable for the conclusion of IVO and Horwood's various applications to cancel the registration of RF's SABATIER mark, which were scheduled to be heard together. According to this timetable, the matters could be heard by the last week in November 2008, but in any case would have to be heard no later than in the week commencing 15 December.

9. Horwood subsequently settled with RF and withdrew its applications. IVO and RF subsequently jointly proposed that the hearing of these proceedings should take place on 18 and 19 December. At that hearing, RF was represented by Mr Mark Vanhegan of Counsel, instructed by Saunders and Dollymore, and IVO was represented by Mr Simon Malynicz of Counsel, instructed by Wildbore & Gibbons.

The Scale of the Evidence

10. IVO's formal evidence consists of three witness statements: two by Sara Jane Leno and one by Stephen Kinsey, both of whom are trade mark attorneys with Wildbore and Gibbons, IVO's UK agent. However, a large part of Mr Kinsey's evidence and most of Ms Leno's evidence consists of evidence adopted from the proceedings between RF and Horwood. In total, IVO relies on 17 statements from 13 witnesses.

11. RF relies upon 30 statements from 17 witnesses. A schedule of all the various witness statements is set out in Annex A. It should be noted that some of the statements were submitted in the form of exhibits to other people's witness statements. I have taken account of all the evidence. If a particular witness is not mentioned in the following account of the issues it is either because it has not been necessary to attach weight to their evidence and/or the matter(s) about which they gave evidence is no longer in dispute.

12. On 17 November 2008, IVO asked to be allowed to cross examine the following of RF's witnesses:

- i) Pascale Sol-Bruchon, who is the President and General Manager of RF;
- ii) Dr Adam Kilgarriff, who is an expert in the field on lexicography;
- iii) Karen Auker, Gary Gordon, David Phillips, Nicky Foster, Alastair Fisher, Alison Thorne and Stephen Lloyd, who are all in businesses that trade in kitchenware/homeware.

13. The Registrar agreed to this request on 28 November and set a timetable for cross examination.

14. On 25 November 2008, RF asked to be allowed to cross examine the following witnesses on certain specified issues:

- i) John Symonds, Rachael Garratt and Felicity Cox, who all work for Mathys and Squire, Horwood's trade mark attorneys;
- ii) Paul Turner and Neil Rosati, who are Horwood's Managing and Marketing Directors, respectively.

15. With one minor exception, the Registrar also agreed to this request and set a timetable for the cross examination.

16. In the event, none of the witnesses that RF had asked to be allowed to cross examine attended the hearing. Messrs Kilgarriff, Fisher, Lloyd and Gordon attended the hearing and were cross examined on the evidence that they had given on behalf of RF. Madam Sol-Bruchon was unable to attend the hearing because she was on a business trip to India (she offered to attend for cross examination on an alternative date, but this did not prove to be practical), and Nicky Foster, Alison Thorne, David

Phillips and Karen Aucker were also unavailable. All of these witnesses cited their need to tend to their businesses in the run up to Christmas as the reason for their non-availability.

17. The failure of witnesses to attend for cross examination naturally raised the question of the weight (if any) that could be accorded to their written evidence. Fortunately, Counsel were agreed that the proper course in this situation was to treat the evidence of the witnesses who had failed to appear for cross examination as hearsay evidence. It was also common ground that Civil Evidence Act 1995 (CEA 1995) applied to hearsay evidence before the Registrar. Consequently, the relevant considerations were those set out in paragraphs 16 and 17 of Mr Vanhegan's skeleton argument, which is re-produced below.

16. As a result, pursuant to section 4(2) of the CEA 1995, the following considerations are relevant when assessing what weight if any is to be given to hearsay evidence before the Registrar:

- a. whether it would have been reasonable and practicable for the party by whom the evidence was adduced to have produced the maker of the original statement as a witness;
- b. whether the original statement was made contemporaneously with the occurrence or existence of the matters stated;
- c. whether the evidence involves multiple hearsay;
- d. whether any person involved had any motive to conceal or misrepresent matters;
- e. whether the original statement was an edited account, or was made in collaboration with another or for a particular purpose;
- f. whether the circumstances in which the evidence is adduced as hearsay are such as to suggest an attempt to prevent proper evaluation of its weight.

17. In this context it is appreciated that the Registry's practice is that if, having been ordered to attend for cross-examination, a person does not attend then it will be for the Hearing Officer to decide what weight, if any, he can give to that person's untested written evidence. If there is a conflict of evidence and differing accounts of events then a failure to attend may also give rise to greater weight being placed on an alternative account given by the other side, (see paragraph 7.11 of the Registry Work Manual – applicable to the present proceedings, (paragraph 7.12 of the current Registry Work Manual).

18. In connection with the point made in 16(a) of the skeleton above, Mr Vanhegan noted that whereas RF had provided documents showing that attempts had been made to provide its witnesses for cross examination, IVO had produced none. I therefore invited IVO to provide the necessary documents. IVO did so. These revealed that not only had Mathys and Squire (Horwood's agent) indicated that its three employee witnesses were unavailable (two of them having left the firm), but that as far as it was concerned, none of Horwood's witnesses had consented to their written evidence being put forward in support of IVO's case. Consequently, on the

second day of the hearing, Mr Vanhegan questioned the admissibility of IVO's 'adopted' evidence. In this connection, my attention was drawn to Rule 32.12 of the Civil Procedure Rules (CPR) which is as follows:

“Rule 32.12 Use of witness statements for other purposes

32.12

Use of witness statements for other purposes

(1) Except as provided by this rule, a witness statement may be used only for the purpose of the proceedings in which it is served.

(2) Paragraph (1) does not apply if and to the extent that—

(a) the witness gives consent in writing to some other use of it;

(b) the court gives permission for some other use; or

(c) the witness statement has been put in evidence at a hearing held in public.”

19. I refused to exclude IVO's 'adopted' evidence for the following reasons. Firstly, I am not bound to follow the CPR: see *St Trudo Trade Mark* [1995] RPC 370. Secondly, as there is clearly a public interest in the determination of the continuing validity of RF's SABATIER trade mark, I would, if necessary, have given IVO permission to rely on the hearsay evidence of Horwood's witnesses. In any event, much (but not all) of Horwood's evidence was heard in public in the earlier proceedings between Horwood and RF and therefore falls outside the scope of Rule 32.12 by virtue of paragraph (2)(c).

20. Having identified whose evidence the parties rely on and how I should approach the substantial volume of hearsay evidence in these proceedings, I turn to the facts. I shall do this by setting out, in summary form, the factual background, which is not in serious dispute, and then turn in more detail to the three factual issues which are at the heart of the matter, namely RF's use of SABATIER, the use of SABATIER by others in the relevant trade, and the public's perception of the meaning of the word SABATIER, both at the time of registration and at the dates of the applications before me.

21. I will reflect the results of the cross examination of witnesses at the appropriate points in the following analysis. In so doing, I bear in mind that despite the volume of evidence and the anticipated need for substantial cross examination, by the conclusion of the hearing surprisingly few primary facts were still in dispute.

The Factual Background

22. The SABATIER mark has its origins in Thiers in France at the beginning of the 19th century when a Phillipe Sabatier began to manufacture knives. The knives acquired a reputation for quality and were sought after by chefs and others in the butchery trade. Subsequent generations of the Sabatier family continued this trade. Until 1964 it was impossible to protect family names *per se* as trade marks in France. However, a family name could be protected if accompanied by another word or picture. Accordingly, it became customary for different branches of the Sabatier family to use and register versions of the SABATIER name accompanied by some

other letter(s), word(s) or pictures. Phillipe Sabatier used the mark K SABATIER. The business he started continues to this day and is now owned and operated by the firm Sabatier Aine et Perrier.

23. In 1979 the registered proprietors of French trade marks including the word SABATIER, who were the descendants of, or successors in title to, the various branches of the Sabatier family, formed an association called (in English) "The Association of Proprietors of Cutlery Trade Marks incorporating the word Sabatier" (the association). The association comprised ten producers who at that time owned French trade marks with the word SABATIER "constituting or forming part of a manufacturing or trade mark in the field of cutlery". The association was committed to preserving the distinctive character of the name Sabatier and to taking legal action against non-members of the association found using the Sabatier name.

24. One of the members of the association was a Maxime Girard who subsequently in 1991 assigned her marks to Coutel'Innov Srl, which in turn assigned the marks to RF. These marks included the word SABATIER solus, the subject of these proceedings, and the following marks:

SABATIER with the word and/or picture of a lion
SABATIER with the words and/or picture of two lions
VERTIABLE SABATIER with MG logo
PROFESSIONAL SABATIER
SABATIER LECASOAR
SABATIER with griffin logo
SABATIER INTERNATIONAL with words and/or picture of two lions.

25. These marks designate different product or quality ranges, or are used for products sold through particular channels. For example, 2 Lions Sabatier International is used for cheaper knives manufactured in Asia.

RF's Use of SABATIER

26. There is no dispute that RF has sold significant volumes of goods bearing the above marks in the UK. In 2002 exports to the UK exceeded 1.16m euros. The figure for 2004 was 718k euros. For 2005, the figure was 962k euros. These figures represent trade prices. The retail turnover would have been about twice the amounts shown.

27. The sales appear to have been primarily of knives, but also included forks and sharpening steels. The most widely used marks appear to have been the Lion Sabatier marks. The word SABATIER was also used with other sign(s). For example, the Lion Sabatier range includes the word and/or picture of a lion on the blade(s) of the products. The word SABATIER is sometimes used in a subordinate role to the word LION. However, there is also evidence, including that of Mr Gary Gordon of Kitchen Kapers (who have been selling RF's products in the UK since 1979 and is now RF's UK distributor), that up until 2006 the Lion Sabatier knives, forks and sharpening steels had the name SABATIER alone embossed within an oval border on the handle of each product. Although Mr Gordon was cross examined, there was no challenge to this aspect of his evidence.

28. Mr Stephen Lloyd is the General Manager of Paul Swolf Limited, which has imported RF's products for 25 years. His evidence is that, with RF's consent, his firm markets a range of knives, forks and sharpening steels in the UK under the mark PROFESSIONAL SABATIER. Mr Lloyd was also cross examined, but there was no challenge to his evidence that between 2002 and 2006, his company sold between £5k and £10k of these products per annum under the above mark to UK wholesalers for onward sale to the restaurant trade (hence the use of "Professional").

29. RF's products have also been available to the general public in the UK for many years through well known retailers, such as John Lewis.

30. There is documentary evidence that some UK retailers have promoted RF's products in their own publications under the word SABATIER alone. For example, a retailer called Lockhart marketed 'Sabatier' knives in its 2003 and 2005 brochures. A company called Divertimenti offered 'Sabatier' knives on its web site in 2005, and a promotional brochure it issued around the same time marketed 'Sabatier, Sydney' knife sets and blocks (see witness statement of Sol-Bruchon, 7 November 2005, exhibits 6 & 8). An advertisement in the Daily Telegraph in 2004 marketed 2 Lions Sabatier knives under the words 'Sabatier Knife Set' (see witness statement of Sol-Bruchon 12 September 2008, exhibit PSB62). Madam Sol-Bruchon says that all of these uses were with RF's consent. In deciding how much weight to give to that evidence I must take account of the fact that Madam Sol-Bruchon did not attend the hearing for cross examination as requested and her evidence is therefore untested. I do not doubt that these are all instances of RF's products appearing under the word 'Sabatier' alone. However, I am unconvinced that these uses represent anything more than use in advertising for RF's Lion Sabatier products, where 'Sabatier' was being used by UK retailers as a shorthand for the Lion Sabatier products that they were marketing.

31. Two of RF's witnesses (Karen Aucker and Alison Thorne) gave evidence that although they are aware of third party uses of names including Sabatier for cutlery, they believed that RF is the only company entitled to use SABATIER alone. It is not clear why they believed this, and as they also failed to attend the hearing for cross examination, I am not inclined to attach any weight to their evidence on this point.

Use of SABATIER by Others

32. There is a mass of evidence as to the use of SABATIER in the UK in relation to cutlery by parties other than RF. With two exceptions (to which I return below), all of these uses are of SABATIER in combination with some other name or sign. I have already noted that Sabatier Aine et Perrier uses the trade mark K SABATIER. Some other examples of SABATIER marks that have been used in the UK are:

- i) Adimas SA used the trade mark SABATIER DIAMANT;
- ii) Richardson Sheffield Limited used the marks R SABATIER and V SABATIER FRANCE;

- iii) Therias et L'Econome SA used the trade marks MEXEUR & CIE SABATIER and L'UNIQUE SABATIER 1ERE QUALITIE;
- iv) Deglon used the mark SABATIER DEG;
- v) Thiers Issard used the mark SABATIER with the device of four stars and/or an elephant;
- vi) Amefa used the mark SABATIER TROMPETTE.

33. The above entities are (or where at the time of the use) members of the association mentioned above. Some of them also made knives that were marketed in the UK under retailers' marks. For example, Thiers Issard made a knife for the retailer Habitat which carried its SABATIER and 4 stars mark on the blade but was marketed under the name SABATIER FOR HABITAT.

34. There is no dispute that other members of the association have made significant use of marks including the word SABATIER in the UK prior to the dates of the revocation applications. Consistent with this, Mr Lloyd accepted during cross examination that he was aware of the use of the mark V SABATIER in relation to knives, and that this was not RF's mark. Mr Gordon was also aware of use of SABATIER marks in the UK by other members of the association. Mr Alastair Fisher has worked in his family's business, now known as Taylor's Eye Witness Limited, for over 30 years. His firm markets RF's knives in the UK under the mark VERTIBLE SABATIER. Mr Fisher is also a past President of the British Home Enhancement Trade Association and therefore has a good knowledge of the relevant market. In answer to questions during cross examination he stated that he was aware of the use by members of the association of K SABATIER, V SABATIER, SABATIER MEXEUR, ELEPHANT SABATIER, SABATIER DEG, SABATIER PERRIER and SABATIER DIAMANT. He was also aware of the use by Horwood of other SABATIER marks.

35. A great deal of research evidence was filed, initially by Horwood, and then by RF, directed at establishing the full range of undertakings that have used the SABATIER name in the UK. Fortunately, it is not necessary to go into this evidence in great detail because by the conclusion of the hearing the parties were largely agreed that the evidence of Mr Rupert Andrew Knights, who is a trade mark attorney employed by Saunders and Dolleymore (RF's agents) represented an accurate summary of the evidence on this point. Mr Knights analysed the evidence of all the relevant witnesses and concluded that, apart from Horwood's use and the three uses described in the following paragraph, all the uses of SABATIER marks in the UK in recent times were attributable to RF and the following eight other members of the association:

1. Sabatier Aine & Perrier
2. Adiamas S.A.
3. Richardson Sheffield Limited
4. Therias et L'Econome S.A.
5. Deglon
6. Thiers Issard

7. Amefa
8. Andre Verrier

36. Mr Knights was unable to identify the maker of three of the SABATIER knives shown in the evidence. These are Prestige Sabatier, Boots Sabatier and Sabatier Corolla. However, Madame Sol-Bruchon states in her reply evidence (witness statement of Sol-Bruchon, 12 September 2008) that according to her researches, the Prestige Sabatier knife is an old knife that was probably made by Maxime Girard, RF's predecessor in business. Phillippa Eke, who is a trade mark attorney employed by Saunders and Dolleymore, gives evidence (in her witness statement dated 12 September 2008) that she owns a knife that was bought at least 9 years before and which bears the logo of Boots the retailer and the mark SABATIER DIAMOND. She notes that SABATIER DIAMANT is a mark of Adiamas S.A., an association member, and concludes that in the 1990s Boots were probably selling SABATIER knives made in France by Adiamas. From Ms Eke's enquiries, it appears that Boots no longer sell SABATIER knives. On the balance of probability, I find that the Prestige and Boots SABATIER knives were made by RF and Adiamas S.A., respectively, as these witnesses suggest. Despite extensive researches, no one has been able to identify the party responsible for the SABATIER COROLLA knife, but as this appears to have been an old and isolated instance of use of SABATIER in the UK, nothing really turns on it.

37. There is evidence that two other members of the association have used the name SABATIER alone in relation to cutlery sold in the UK. In particular, a Mr Richard Greenshields, who is another employee of Mathys and Squire, in a witness statement dated 22 January 2008, provides pictures of some knives given to him by a partner in the firm, Mrs Margaret Arnott, in 2005 which show that both Sabatier Aine and Perrier and Sabatier Mexeur & Cie market knives that carry composite SABATIER marks on the blades, but the word SABATIER alone on the handles.

38. RF accepts that there has been some use of the word SABATIER alone by these undertakings, but points out that there is no evidence as to the extent or length of such use.

Use of SABATIER by Horwood

39. According to the evidence of Neil Rosati, its Marketing Director, Horwood has been selling knives marked with SABATIER in the UK since about 1992. The products have been sold under the signs Stellar Sabatier, Stellar P Sabatier, Judge Sabatier and Judge P Sabatier.

40. According to Mr Turner, Horwood's Managing Director, the decision to sell a "Sabatier style of knife, by which [he] means a knife with a black handle and three rivets with a bird's beak pommel" was made because it was thought that this would lead to an increase in UK sales. The products were originally sold under the sign STELLAR SABATIER and a device of 4 stars, but this changed in 1993 following a complaint from the owner of the French SABATIER & 4 stars trade mark. In 1995, IVO took a licence from the owner of the French trade mark P. SABATIER and started to supply Horwood with knives carrying both that sign and Horwood's trade mark STELLAR. At that time the knives were forged in France but finished in

Portugal. Later the knives were forged and finished in Portugal. The use of the sign JUDGE P. SABATIER began in 1995. JUDGE was another of Horwood's existing marks and was used for lower quality products (compared to STELLAR). In 2000, Horwood started selling knives under the signs JUDGE SABATIER and STELLAR SABATIER (i.e. without the "P.").

41. According to Mr Rosati, at some time after 1995 Horwood decided to use the Sabatier name on knives which did "not look like the traditional Sabatier-style knife". This was because "the Sabatier name was being used for other designs of knives by other companies and because [Horwood's] STELLAR P. SABATIER/STELLAR SABATIER and JUDGE P. SABATIER/JUDGE SABATIER KNIVES had become so well established as [Horwood's] brands that [Horwood] could do with them as [Horwood] liked". This was despite the fact that according to Mr Rosati there had been "no advertising to the general public for any Sabatier knives [Horwood] have sold", only limited trade advertising as each range of knives was launched.

42. This limited level of promotion appears to have been sufficient for Horwood to make substantial sales of knives and knife blocks in the UK under these marks. For example, in the year 2000 Horwood achieved sales of £1.3m. Sales under these marks peaked in 2004 at over £2m before falling back to around £1.75m in 2005.

43. Mr Gordon accepted during cross examination that his company had stocked Horwood's STELLAR P. SABATIER knives up until 2005. He said that he had mistakenly believed that these knives were made by a member of the association.

Public Perception of the Name SABATIER

44. The date of registration of RF's SABATIER trade mark is 8 April 1969. In *K Sabatier* [1993] RPC 97, the Registrar rectified the registration of K SABATIER, which had been obtained in 1981 by a company called Philbar & Co Limited. The case report indicates that Philbar had been appointed as the UK distributor of Sabatier Aine & Perrier in 1955 and had gone on to register the trade mark in its own name. At most, the case suggests that there may have been some use of K SABATIER in the UK between 1955 and 1993. I approach this with caution because the evidence in that case is not before me and, in any event, there is no indication of the extent of any such use.

45. Margaret Arnott second witness statement dated 11 March 2008 exhibited an expert report from a Gerard Pacella. M. Pacella is a French journalist who appears to specialise in knives and knife making. According to M. Pacella, between 1945 and 1950 there were around 50 separate undertakings in France making knives bearing the name Sabatier with various distinguishing insignia. The number had dwindled to 13 by 2006.

46. Mr Malynicz relies on M. Pacella's evidence to show that SABATIER was known in the UK as a non-proprietary term even at the time when it was first registered. In particular, he relies upon paragraph 38 of M. Pacella's report, which states:

"...it is a well known fact that French cuisine has always been highly appreciated throughout the world. Accordingly, when chefs....butchers and

other talented professionals moved away to practice their art outside of their homeland, they naturally took with them their armoury of famous knives, which were immediately coveted and hence bought by other professionals in the country concerned. So it was that the name Sabatier became both synonymous with the chef's knife and an ambassador for France. For many years many manufacturers of Sabatier knives have exported their knives to other countries, including the United Kingdom."

47. Mr Malynicz submitted that English chefs etc. training in France, and French chefs working in the UK, would have been aware of the non-proprietary nature of the Sabatier name in France and would have brought this understanding to the UK and shared it with others. To support this point, my attention was drawn to a copy of an article published in the Observer Food Monthly in 2002 in which it is recorded that Rick Stein, a well known chef, recalled buying Sabatier knives on his return to the UK when he was aged 22. The article sheds no light on Mr Stein's perception of the meaning of the word Sabatier and according to the article, he was returning from travels to Australia, New Zealand, America and Mexico rather than France.

48. Mr Vanhegan pointed out that M. Pacella's has not provided a witness statement and is therefore not even a witness. Further, in her 5th witness statement, Madame Sol-Bruchon challenged the authenticity of the report and whether it was even written by M. Pacella. However, as he has not made a witness statement, RF could not seek to cross examine him. Mr Vanhegan submitted that in these circumstances, I should not attach any weight to M. Pacella's report.

49. In fact much of the report attributed to M. Pacella is consistent with Madame Sol-Bruchon's own evidence. For example, it is not disputed that there are numerous makers of Sabatier knives in France and that, at least in recent years, a number of them export knives to the UK. Nor is it seriously disputed that these undertakings generally individualise their products by the use of additional indicia. However, it would, in my view, be dangerous to attach any weight to the implication in the report about knowledge of the history of the Sabatier marks in the UK, not least because M. Pacella does not claim to have any direct knowledge of the UK market and in fact expressly directs himself to the position in France.

50. I see nothing in the article about Rick Stein that assists me in establishing what the relevant trade in the UK, or the general UK public, thought of the word Sabatier in 1969.

51. I conclude that there is no evidence that it was understood as a generic or descriptive word for knives in the UK in 1969.

52. Mr Malynicz invited me to attach weight to another 'expert' report prepared by a Roger Hamby on 6 June 2007, this time for IVO's Trade Mark Attorneys, Wildbore and Gibbons. Mr Hamby is the Director of Research at the Cutlery & Allied Trades Research Association. Again, Mr Hamby has not filed a witness statement and, like M. Pacella, isn't formally a witness. Instead his report is introduced as an exhibit to the witness statement of Mr Kinsey of Wildbore and Gibbons. It is accepted that Mr Hamby's evidence is hearsay. Most of it is not contentious. His report consists mainly of information taken from the French website of one of the association

members, Sabatier Diamant, which describes the origins of the Sabatier name in France and that because of its complicated history, the “brand” Sabatier alone is not distinctive of one undertaking. Mr Hamby goes on to offer opinions about the design of the Sabatier knife changing over the years and that many Sabatier brands are available in the USA. He concludes:

“This appears to me, that taking into account the wide variety of uses of the name Sabatier within the UK and Europe, that the name has become so widely used and its meaning so distorted in terms of its traditional values, that it is difficult for consumers to have any clear comprehension of the name(s) or understand if it confers any particular design or quality attributes. This is borne out by many conversations with visitors to CATRA, who have no real comprehension of the term Sabatier and more often than not have a completely false understanding of the meaning of the name.”

53. In deciding what weight to attach to this opinion I bear in mind that it is hearsay and that RF has not had the opportunity to cross examine Mr Hamby about it. Having said that, I do not believe that there is necessarily any tension between Mr Hamby’s opinion and the conclusions I draw below as a result of my assessment of the other evidence in the case.

54. Mr Kinsey also provides (as exhibit SK4 to his statement) a copy of an entry from an on-line dictionary called “The Free Dictionary by Farlex”. It records the history of the Sabatier “name (or brand)” in similar terms to the entry on Sabatier Diamant’s French web site. Mr Vanhegan cautioned me against relying on it because it is a US website and therefore not necessarily reflective of the position in the UK. I bear that warning in mind.

55. This is a convenient point to turn to the evidence of the fourth witness who was cross examined at the hearing: Dr Adam Kilgarriff. Dr Kilgarriff has 16 years experience in the field of dictionary preparation and he acts as a consultant to Oxford University Press on topics relating to dictionaries. He was instructed on behalf of RF to prepare a report on the profile of the word ‘sabatier’. To do this he looked in English dictionaries and found no entries for this word. He also looked at three corpus of English words which are used by Dictionary makers: the British National Corpus (BNC), the Oxford English Corpus (OEC) and the UK Web as Corpus (UKWaC). The first corpus was about 16 years old when Dr Kilgarriff used it and contained 100 million words. The other two are more up to date and both contain around two billion English words.

56. In a nutshell, Dr Kilgarriff found 10 instances of use of ‘sabatier’ in BNC, 91 in OEC and 116 in UKWaC. After excluding what he considered to be irrelevant references, he found 7 in BNC, 7 in OEC and 23 in UKWaC in the field on knives. He points out that ‘sabatier’ is therefore a relatively obscure word in the English language, of roughly the same order of currency as words like ‘sapete’, ‘saveloy’, ‘sapless’ and ‘sacramentalist’. Further, he notes that the instance of capitalisation of ‘sabatier’ amongst the 37 instances of use he thought were relevant (all bar 2 or 95%) was consistent with its status as a brand name rather than as a generic word.

57. Mr Malynicz asked Dr Kilgarriff, inter alia, about the instances of use of Sabatier in the corpora, which he had exhibited as AK 5 to the witness statement covering his report. In particular, Mr Malynicz put it to Dr Kilgarriff that the following example of use of 'sabatier' from the seven hits in the BNC corpus was consistent with the word being generic.

"...blades are best as they're hard wearing and stain resistant but, when choosing, check that the blade is made from a single piece of steel. A word of warning: don't be fooled by the name '**Sabatier**'. Although it once guaranteed good quality, now no one company holds an exclusive licence over the use of the name and the quality of the knives really does vary from brand to brand."

58. Dr Kilgarriff's answer was that he was an expert in how words are used and not whether they are trade marks. In my view, this instance of use does suggest that 'sabatier' is no longer itself a 'brand', but to be fair, all the other 36 uses that Dr Kilgarriff thought pointed to 'sabatier' being used a trade mark did, in my view, do just that.

59. Dr Kilgarriff accepted that the corpora on which he had relied did not present a perfect or complete picture of the use of 'sabatier' in the UK. His written evidence included an analysis of eight examples of use of the word 'sabatier' which had been put forward by Horwood as evidence that it is generic. The instances are conveniently set out in exhibit AK7 to Dr Kilgarriff's witness statement. They are:

- 1) An article from Good Housekeeping dated November 2004 which contains an inset note stating:

"Did You Know? It's a common misconception that Sabatier is a top quality knife manufacturer, but in fact it's neither a brand name nor an indication of quality. It's just a generic name showing that the knife comes from Thiers in France."

- 2) An article in the Mail on Sunday dated 14 January 2007 reviewed a number of brands of kitchen knives including Sabatier, but the review of this knife noted that:

"There are a number of manufacturers who make Sabatiers."

- 3/4) A 'Sales Training Guide' produced in 2003 and re-printed in 2005 by Richardson Sheffield (an association member at the time) stated that:

"What is a Sabatier knife? Sabatier is widely assumed to be a brand name. But it's just a generic term for a particular pattern of high quality kitchen knife. Half a dozen different suppliers list 'Sabatier' knives."

- 5) An article in Housewares Magazine in April 2000 noted that:

“The traditionally styled three riveted handle, which most people refer to as ‘sabatier’ whether it is genuine or not, is a consistently good line.”

- 6) An article in a supplement to the Guardian in November 2004 included the following sentence:

“While we’re on knife myths, Sabatier isn’t a knife manufacturer but a generic name revealing nothing more than that the knife comes from the French town of Thiers.”

- 7) An article in the Independent in June 2000 reviewed a Sabatier knife and noted:

“Sabatier is the name given to a method of manufacture rather than an individual company. It still carries its old Cordon Bleu reputation of being a suitable knife for serious cooks.”

- 8) An article in the Financial Times in 1984 about a company called Westall Richardson contained the following:

“[Prestige] also has more faith than Westall in the sales future of very up-market Sabatier-style knives which it, but not Westall markets.”

60. Dr Kilgarriff rejected the significance of these entries, primarily on the grounds that they were selected to prove a point and not representative of the use of the word ‘sabatier’ in the UK. However, he also rejected each of these as examples of ‘sabatier’ in use as a generic term for a number of other reasons, including that:

- a) the use of Sabatier with a capital “S”, or as a pre-modifier of “knife”, or in the context of manufacturers of knives, is consistent with Sabatier’s status as a trade mark,
- b) examples 1 and 6 refer to knife makers rather than knives *per se* and are therefore irrelevant.

61. Mr Malynicz challenged these aspects of Dr Kilgarriff’s evidence during cross examination. I found Dr Kilgarriff to be a frank and open witness who did his best to bring his expertise in linguistics to the aid of this tribunal. I accept his evidence that the 36 instances of trade mark use of Sabatier in the corpora he used are statistically more significant than the 8 instances identified by Horwood, not just because they are numerically greater, but also because they were the result of a process of random selection, whereas Horwood’s evidence was undoubtedly chosen selectively. Nevertheless, I reject his analysis of the nature of the usage shown in the evidence originally filed by Horwood. In my view, 6 of the 8 instances of use in that evidence do show that Sabatier was being used in a generic sense. I accept that examples 5 and 8 above are neutral, in the sense that those uses may convey a trade mark or a generic meaning.

62. During cross examination, Mr Gordon of Kitchen Kapers was also asked about the public's understanding of the word 'sabatier'. The relevant exchanges with Mr Malynicz went like this:

- Q. Now to the average UK consumer the word Sabatier cannot mean any single knife manufacturer, can it?
- A. There is confusion but it is, yes, definitely.
- Q. You agree with that?
- A. There is a presumption on the public that it is one brand from one area.
- Q. You mean by brand and area that multiple companies within that area?
- A. The public generally do not know that. They have to have that explained to them basically.
- Q. The mere fact the word Sabatier was sitting on the handle of these knives, either in embossed form or in sticker form, does not change how you refer to these knives, does it?
- A. No, the oval signage on the knife is recognised by people who are more aware, be they retailers, distributors or consumers, that it is a real Sabatier. It again goes back to Elizabeth David and other writers of the time stating that the way to find the proper correct Sabatier, it has the oval black and gold marking on the handle.
- Q. But you call them in your promotional literature and indeed in your witness statement Lion Sabatier?
- A. Yes.
- Q. You do not call them real Sabatier, do you?
- A. We do refer to that quite regularly.
- Q. What you mean by that is that Lion Sabatier is the real Sabatier?
- A. Yes, correct.

63. Mr Lloyd of Paul Swolf Limited was also cross examined on this point. The relevant exchanges with Mr Malynicz went like this.

- Q. So if a customer went into your shop in the last couple of years and said, "I want a Sabatier", you would have to say to them, "Which one?"; correct?
- A. No, we would show them the Lion Sabatier. We have several ranges by Rousselon, so if we said "Which one?", it was which range from Lion Sabatier's ranges we were showing them.
- Q. But you said earlier that there is a lot of confusion in the marketplace.
- A. There is. Even I have been confused, hence the comment down there. There has been confusion as to where things are sourced from and how they are made.
- Q. You have to explain the historical position about Thiers and all the cousins?
- A. Yes, exactly.

64. Mr Fisher of Taylor's Eye Witness was also asked questions about the trade and the public's perception of the Sabatier name. As he does not sell to the general public, he could not shed much light on their perception. However, he accepted that if a member of the public went into a cook shop and asked for a 'Sabatier', the retailer would probably offer whichever Sabatier product they had on their shelves. Mr Fisher was also asked about a statement in his written evidence to the effect that (after the relevant dates in these proceedings) his company had secured a contract to supply SABATIER knives to Tesco. The knives are sourced from RF and carry only the mark SABATIER. The relevant exchanges between Mr Fisher and Mr Malynicz went like this:

- Q. What I am trying to put to you is had you been selling another Guild member's Sabatiers that would have done the job just as well providing the price was right?
- A. It is not just the price.
- Q. And the quality and the other issues?
- A. Yes, that is probably right.
- Q. It was not that they wanted specifically Rousselon's Sabatier?
- A. No.
- Q. Indeed, they were not supplied the two existing ranges of Rousselon Sabatier that you were trading in at that time?
- A. That is correct; we did a special for them.

65. The overall picture which emerges from the evidence is of those "in the know" making occasional efforts to explain to ordinary consumers and end users of kitchen and butchers knives, which includes both 'professional' users and ordinary members of the general public, that there are a number of undertakings responsible for products marked with SABATIER. However, the number of such public statements in evidence is relatively small, and there is no indication of the statements diminishing over time as the message is grasped by the relevant UK public. That is consistent with the findings of Dr Kilgarriff's research into the use of the word Sabatier in the corpora he studied. It also fits with the evidence of Mr Gordon, that the public still regard Sabatier as the 'brand' of one undertaking and require education of the true position.

66. In my view, this conclusion is also consistent with the evidence of Mr Fisher, that as late as 2007 Tesco wanted to market a quality Sabatier product, but were not wedded to any particular producer (assuming that they were aware that there was more than one). That degree of indifference about the particular source of the products would make sense if Sabatier was understood by the relevant public as being the trade mark of one undertaking, but not otherwise. Mr Vanhegan offered an alternative explanation; that the Tesco contract was an example of RF being prepared to rely upon the word Sabatier alone to distinguish its products from those or other undertakings, including others using Sabatier in combination with other distinguishing indicia. I reject that. I think it far more likely that the branding for this product was simply a reflection of Tesco's desire to market a quality knife under a brand which they expected their customers to recognize and value – SABATIER. I see no evidence that the average UK consumer has mastered the subtle distinctions

in branding used by the various French Sabatier makers. This is no doubt partly because the association members made no apparent effort to educate the UK consumer about the significance of their variations to the SABATIER name.

67. I accept that at the date of the applications for revocation, a significant proportion of those in the UK involved in the trade in homeware products were probably aware that Sabatier cutlery products came from a range of different undertakings. However, the relevant section of the general public, comprising ordinary consumers and end users of kitchen and butchers knives, were largely ignorant about the different users of Sabatier, and a substantial majority of relevant consumers were of the belief that SABATIER was a 'brand' for high quality goods, for which one undertaking was responsible. I believe that this represents the understanding of the word Sabatier by the relevant average UK consumer.

The Invalidation Application

68. The relevant parts of section 47 are as follows:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) –

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court -

(4) -

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

69. As noted above, IVO claims that registration of the mark SABATIER was invalid from the outset in 1969 because the mark offends section 3(1) of the Act, which is as follows:

“Grounds for refusal of registration

3. - (1) The following shall not be registered -

(a) signs which do not satisfy the requirements of section 1(1),

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

70. The applicable case law under section 3(1) is not in dispute. I shall therefore start with that. The correct approach can be discerned from paragraphs 23-27 of the judgment of the European Court of Justice (ECJ) in *SAT.1 v OHIM* [2005] ETMR 20, which is re-produced below.

“23 First, the essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see, in particular, Case 102/77 Hoffmann-La Roche [1978] E.C.R. 1139, [7], and Case C-299/99 Philips [2002] E.C.R. I-5475, [30]). Article 7(1)(b) of the regulation is thus intended to preclude registration of trade marks which are devoid of distinctive character which alone renders them capable of fulfilling that essential function.

24 Secondly, in order to determine whether a sign presents a characteristic such as to render it registrable as a trade mark, it is appropriate to take the viewpoint of the relevant public. Where the goods or services with which the registration application is concerned are intended for all consumers, the relevant public must be deemed to be composed of the average consumer, reasonably well-informed and reasonably observant and circumspect (see Case C-342/97 Lloyd Schuhfabrik Meyer [1999] E.C.R. I-3819 , [26], and Case C-104/01 Libertel [2003] E.C.R. I-3793 , [46]).

25 Thirdly, it is important to observe that each of the grounds for refusal to register listed in Art.7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] E.C.R. I-0000 , [45] and [46]).

26 As regards the registration as trade marks of colours per se, not spatially delimited, the Court has already ruled, in Libertel , [60], that the public interest underlying Art.3(1)(b) of the First Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks ([1989] O.J. L40/1), a provision which is identical to Art.7(1)(b) of the regulation, is aimed at the need not to restrict unduly the availability of colours for the other operators who offer for sale goods or services of the same type as those in respect of which registration is sought.

27 Furthermore, in view of the extent of the protection afforded to a trade mark by the regulation, the public interest underlying Art.7(1)(b) of the regulation is, manifestly, indissociable from the essential function of a trade mark, as observed in [23] above.”

71. Accordingly, article 7(1)(b) of the Community Trade Mark Regulation is aimed at excluding marks which cannot fulfil their essential function of distinguishing the trade

source of goods and services and must be interpreted and applied with this objective in mind.

72. The purpose of Article 3(1)(c) of the Trade Mark Directive is conveniently set out in paragraphs 73-75 of the judgment of the ECJ in joined cases C-53/01-55/01, *Linde* [2003] RPC 45, which are re-produced below.

“73. According to the Court's case-law, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75. The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand.”

73. The scope and purpose of article 3(1)(d) of the Directive was considered by the ECJ in *Merz & Krell & Co.* [2002] ETMR 21. For the purposes of this case it is sufficient to record the court's answer to the second of the two questions asked of it, which was as follows.

“Article 3(1)(d) must... be interpreted as meaning that it subjects refusal to register a trade mark to the sole condition that the signs or indications of which the trade mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services.

74. The *SAT.1* judgment addressed the meaning of article 7(1)(b) of the Community Trade Mark Regulation. This is identical in substance to article 3(1)(b) of Directive EEC/104/89. Sections 3(1)(b),(c) and (d) of the Act give effect to articles 3(1)(b),(c) and (d) of this Directive. Directive 104/89 has now been replaced by Directive EC/95/2008, but the relevant provisions remain the same. The ECJ's guidance on article 7(1)(b) of the Community Trade Mark Regulation, and articles 3(1)(c) and (d) of the 1989 Directive, is therefore equally applicable to the interpretation of the corresponding provisions of national law.

75. There are a few later judgments which add to the legal principles set out above. Firstly, a sign does not have to be in use as a descriptor at the date of the trade mark application in order for it be excluded from registration under section 3(1)(c): it is sufficient that it could be used for that purpose. Secondly, it does not matter if there are other ways of designating the relevant characteristics of the goods or services: see the ECJ's judgment in *Doublemint* [2004] RPC 18, which is authority for both these propositions. Thirdly, in deciding whether a word from another language is excluded from registration under section 3(1)(b) and (c) of the Act it is necessary to retain the perspective of relevant consumers and traders in the UK. This is apparent from the ECJ's conclusion in *Matratzan Concord*, Case C-421/04, [2006] ETMR 48, which was that:

“...the answer to the question referred is that Art.3(1)(b) and (c) of the Directive does not preclude the registration in a Member State, as a national trade mark, of a term borrowed from the language of another Member State in which it is devoid of distinctive character or descriptive of the goods or services in respect of which registration is sought, unless the relevant parties in the Member State in which registration is sought are capable of identifying the meaning of the term.”

76. The ECJ identified the “relevant parties” (at paragraph 24 of the judgment in Case C-421/04) as being:

“... that is to say [those] in trade and or amongst average consumers of the said goods or services”

77. Applying the ECJ's case law to the facts of this case, as I have found them to be, it is clear that the grounds for invalidation must fail. There is not a shred of evidence that the word Sabatier had “become customary in the current language or in the bona fide and established practices of the trade” in the UK by the date of the registration in 1969 so as to designate the goods for which the mark SABATIER was registered. Consequently, I reject that ground for invalidation.

78. Mr Malynicz placed particular emphasis on the need to take account of the public interest underlying section 3(1)(c) In *Windsurfing Chiemsee* [1995] ETMR the ECJ provided guidance on the registrability of geographical names as trade marks, the relevant section of which is as follows:

“Article 3(1)(c) of Directive 89/104 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that:

- . it does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods;
- . where there is currently no association in the mind of the relevant class of persons between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods;
- . in making that assessment, particular consideration should be given to the degree of

familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned.”

79. In the light of this guidance it seems to me that section 3(1)(c) of the Act is not offended simply because it can be shown that third parties might have had a reason to use a prospective trade mark at the time that it was put forward for registration. Rather it is necessary to consider whether the relevant trade and public had sufficient understanding of the meaning and significance of the word or sign so as to understand its potential for use as a descriptor. On the basis of my findings of fact above, I do not believe that it has been shown that, in 1969, either a significant section of the relevant UK trade, or the relevant average UK consumer, had sufficient familiarity and understanding of the word Sabatier so as to mean that there was the potential for descriptive use of that word in the UK in relation to cutlery. Rather the word would have appeared to the relevant parties in the UK to be a word, possibly a French word, with no obvious meaning. The section 3(1)(c) ground must therefore be rejected for this reason alone.

80. As the ground for invalidation under section 3(1)(b) of the Act also turns on whether there was anything to prevent traders and consumers in the UK accepting SABATIER as a trade mark in 1969, it follows from what I have already said that this ground must also fail.

81. In the light of these findings there is no need to examine RF’s alternative defence, that even if the mark lacked distinctiveness at the date of registration it had acquired a distinctive character by the date of the application for invalidation as a result of the use made of it.

The Application to Revoke the SABATIER Trade Mark because it has become a Common Name for Cutlery

82. Section 46(1)(c) is as follows.

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

(a) -

(b) -

(c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) –

83. The provision is based on article 12(2)(a) of the Directive 104/89 and must be interpreted accordingly. The leading authority on this provision of the Directive is Case C-371/02. *Bjornekulla Fruktindustrier AB v Procordia Food AB*, which is reported at [2004] RPC 45. It is, in my view, important to note that the essential question in that case was whether the trade mark had become a common name for the goods at issue was to be judged through the eyes of end consumers, or of those in the trade, or both. The relevant part of the ECJ’s judgment is set out below.

“20 The essential function of the trade mark is to guarantee the identity of the origin of the marked goods or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or service from others which have another origin (see, inter alia, Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28, and Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 22). For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the EC Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have been produced under the control of a single undertaking which is responsible for their quality (*Canon*, paragraph 28).

21 That essential function of trade marks has been incorporated by the Community legislature into Article 2 of the Directive, which provides that signs which are capable of being represented graphically may only constitute a trade mark if they are capable of distinguishing the goods or services of one undertaking from those of other undertakings (*Merz & Krell*, paragraph 23).

22 That condition is given effect to in, inter alia, Articles 3 and 12 of the Directive. While Article 3 specifies the circumstances in which a trade mark is incapable, *ab initio*, of fulfilling its function as an indication of origin, Article 12(2)(a) addresses the situation where the trade mark is no longer capable of fulfilling that function.

23 If the function of the trade mark as an indication of origin is of primary importance to the consumer or end user, it is also relevant to intermediaries who deal with the product commercially. As with consumers or end users, it will tend to influence their conduct in the market.

24 In general, the perception of consumers or end users will play a decisive role. The whole aim of the commercialisation process is the purchase of the product by those persons and the role of the intermediary consists as much in detecting and anticipating the demand for that product as in increasing or directing it.

25 Accordingly, the relevant classes of persons comprise principally consumers and end users. However, depending on the features of the product market concerned, the influence of intermediaries on decisions to purchase, and thus their perception of the trade mark, must also be taken into consideration.

26 The answer to the question referred must therefore be that Article 12(2)(a) of the Directive should be interpreted as meaning that in cases where intermediaries participate in the distribution to the consumer or the end user of a product which is the subject of a registered trade mark, the relevant classes of persons whose views fall to be taken into account in determining whether that trade mark has become the common name in the trade for the product in question comprise all consumers and end users and, depending on the features of the market concerned, all those in the trade who deal with that product commercially.”

84. It is clear from this judgment that the perception of the mark by consumers or end users is generally of decisive importance to the assessment of whether the mark has become a common name for the registered goods.

85. The leading UK authority on the domestic version of article 12(2)(a) – section 46(1)(c) - is *Hormel Foods Corporation v Antilles Investments NV*. The judgment of Mr Richard Arnold QC (as he then was), sitting as a deputy judge of the High Court, is reported at [2005] ETMR 54. I am content to rely upon the relevant part of Mr Vanhegan’s summary of the judge’s findings, which is re-produced below.

- a) There are two factual issues to be determined: i) whether the Mark has become the common name in the trade for the goods in respect of which it is registered; and ii) if so, was this due to acts or inactivity of the registered proprietor (para. 163)
- b) The test is qualitative rather than quantitative (para. 166)
- c) That it is not necessary for the Mark to have become the single common name for the goods, it is sufficient for the purposes of s.46(1)(c) that it has become a common name in the trade, taking account of the relevant users as set out in *Björnekulla*. If this has happened, the Mark will have ceased to fulfil its essential function (para. 167)
- d) Whilst it is not necessary for the proprietor's acts or inactivity to be the sole cause of the Mark becoming a common name, it must be shown that the acts or inactivity were a cause (para. 171)
- e) There is a higher burden on a proprietor who registers a highly descriptive mark to take steps to prevent it becoming a common name than on one who registers an inherently distinctive mark (para. 172)
- f) It is not enough to establish a mark as being a common name in the trade that there is some descriptive use of the Mark (para. 173)

86. IVO's claim that Sabatier has become a common name in the trade for cutlery was poorly particularised in the grounds for revocation and the factual basis for the claim has vacillated during the course of the proceedings. Some of the evidence upon which IVO relies appears to suggest that Sabatier is a common name because it is descriptive of a particular design of knife and/or knives from Thiers in France. However, neither of these specific claims is made out in the evidence. In this connection, I recall that the evidence Mr Rosati of Horwood (on which IVO relies) is that the name was originally associated with knives with a black handle and three rivets with a bird's beak pommel. However, Horwood also used the name for knives of other descriptions because "others" (and on the evidence this almost certainly mean association members) were doing the same. Further, Horwood's various Sabatier knives, which were marketed on a substantial scale, carried no claim to be made in Thiers, France, and in recent years were in fact made in Portugal (by IVO). Further still, RF's cheaper Sabatier knives were made in the Asia. I conclude that there is insufficient evidence to establish that by the date of the application for revocation, the relevant parties in the UK expected knives marketed under the name Sabatier to conform to a particular design or to originate in Thiers, France.

87. In my judgment, the evidence shows that the Sabatier name was being used, both by Horwood and by RF, and by the other association members, as trade marks or, more usually, as part of various trade marks. Indeed Mr Rosati's evidence for Horwood was that its composite STELLAR SABATIER and JUDGE SABATIER names had become established as "brands" belonging to Horwood.

88. Mr Malynicz's primary case at the hearing was that the word Sabatier had become a common name in the trade in cutlery as a result of the general (i.e. not specifically descriptive) use of that name in the UK by a significant number of economically unrelated undertakings. According to this view of the matter, once the name came to be used by unrelated undertakings for the same class of products, it became incapable of fulfilling its essential function and therefore became liable to revocation. It is tempting, but in my view wrong, to regard *Bjornekulla* as authority for the proposition that any factual situation which appears to be inconsistent with the essential function of a trade mark – to distinguish the goods of one undertaking from those of others, without any possibility of confusion - presents grounds for revocation. As Mr Arnold stated in the *Spambuster* case, the condition for revocation under section 46(1)(c) of the Act presupposes that a trade mark has lost its distinctive character *because it has become a common name in the trade*, and the question of whether the mark has become a common name cannot therefore be bypassed in favour of a general re-assessment of the mark's capability to perform its essential function.

89. The parties were agreed that a common name was simply "a name by which something is known". However, there was disagreement as to whether uses of a name *as a trade mark* are capable of resulting in a name becoming common in the trade. In my view, such use is capable of producing that result. For example, a name for a pharmaceutical may start off as a trade mark for a product. The product may be protected by a patent and all commercial use of the trade mark may therefore be a consequence of the use of a trade mark of one undertaking. Nevertheless, such use can, and has in the past, resulted in the name being adopted by the public and by trade intermediaries as the common name for the product, by which I mean a name which designates the product and not only who is responsible for it. This is why pharmaceutical companies ensure that all new drugs are launched with a trade mark and an alternative generic name. That approach prevents the trade mark also becoming the generic name by default.

90. Mr Vanhegan submitted that for a name to become "common in the trade" it must be a name which is potentially available to anyone in the trade. The evidence shows that, except for the use by Horwood, which RF regards as illegitimate, the use of Sabatier in UK trade is almost entirely attributable to uses of Sabatier marks by members of the association. According to Mr Vanhegan this means that the use of the name cannot properly be characterised as common in the trade; the name is only common to association members. I reject that submission. As I explained above, in certain circumstances even uses of a mark that are exclusively associated with the products of one undertaking can result in that mark becoming a common name in the trade for the product.

91. The essential question is therefore whether the significant concurrent use of Sabatier in the UK in the trade marks of at least ten (including Horwood) economically distinct undertakings has caused the relevant parties to regard Sabatier as a common name in the trade for cutlery, with the result that the mark has lost its capacity to distinguish according to trade source. In answering that question I bear in mind that the test is qualitative rather than quantitative. I also think it relevant that the Act includes provisions (see, for example, section 48 covering acquiescence), which expressly contemplate situations in which two or more parties

make concurrent use of the same or similar trade marks. I do not therefore think that the mere fact of concurrent users of marks including the word Sabatier means that RF's SABATIER mark has become a "common name in the trade". I have already found that despite the concurrent use in the UK by a number of economically unrelated undertakings of marks including, or consisting of, the word Sabatier, the average UK consumer still regarded Sabatier as a trade mark and not as a common name for cutlery. Indeed the continuing distinctive character of the SABATIER mark to consumers is the reason that retailers like Mr Lloyd sometimes have to explain to confused consumers that there is more than one maker of Sabatier products. As the views of consumers and end users are generally of decisive importance, I attach more weight to this than to the perception of the Sabatier "brand" by those in trade circles, which I accept is more mixed.

92. For these reasons, I therefore reject the ground for invalidation under section 46(1)(c).

93. In case I am found to be wrong about this I will briefly consider whether if, contrary to my primary findings, Sabatier had become a common name for cutlery by the date of the application for revocation, this is the result of acts or omissions by RF.

94. Mr Malynicz relied on both acts and omissions. RF's omission was the delay in bringing infringement proceedings against Horwood. I reject this. RF first threatened to sue Horwood for infringement in 2003. It is obvious that RF could have brought infringement proceedings against Horwood sooner than it did. But given the lengthy opposition proceedings against Horwood and IVO's trade mark applications I do not think that RF can be accused of failing to defend its mark from Horwood or IVO.

95. According to Mr Malynicz, the act for which RF is responsible is the use of its mark in such a way as to educate the public that it is not to be relied upon, by itself, as a distinguishing mark. In part this refers to RF's general practice of using the SABATIER mark as part of, or in conjunction with, other signs, such as LION SABATIER. In principle, a proprietor cannot be criticised for using a trade mark in conjunction with, or as part of, another mark. A trade mark may even acquire the distinctive character it originally lacked as a result of such use: see *Societe des Produits Nestle S.A. v Mars UK Ltd* [2005] ETMR 96. I do not therefore think that there is any merit in the criticism of RF's use of SABATIER as part of, or in conjunction with, other marks. However, RF's decision to tolerate the use of a range of Sabatier marks in the UK by other association members, whether or not they had concurrent rights in this territory, created the potential for the SABATIER mark to become a common name for the product in the UK. Consequently, if I had found that the mark had become a common name for cutlery, I would have been prepared to accept that this was partly as a result of the omissions of RF with regard to the use of Sabatier marks in the UK by other members of the association.

The Application to revoke the SABATIER trade mark for non-use

96. The relevant parts of Section 46 of the 1994 Act provide as follows:

“(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 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;...

(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 is registered, and use in the United Kingdom includes affixing the trade mark to goods or 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 expiry of the five year period and before the application for revocation is made:....

(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 registration;

(b) if the registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that date.”

97. These provisions implement Articles 10(1), 12 and 13 of Directive 89/104. They correspond to Articles 15(1) and 50(1)(a),(2) of Council Regulation 40/94/EC of 20 December 1993 on the Community trade mark (CTMR).

98. Section 100 of the 1994 Act 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 it.”

99. The leading authorities are *Ansul BV v Ajax Brandbeveiliging BV* [2003] RPC 40, *La Mer Technology Inc. v Laboratoire Goemar SA* [2004] FSR 38, *Sunrider v OHIM, Case C-416/04 P* and *Il Ponte Finanziaria SpA v OHIM* [2008] ETMR 13, all ECJ. The following legal principles can be derived from these cases.

- i) ‘Genuine use’ means actual use of the mark in relation to goods or services which are already marketed, or about to be marketed, for the purpose of creating or preserving a market for those goods/services (*Ansul*, paragraph 36);
- ii) Such use must be by the trade mark proprietor or by a third party with authority to use the trade mark (*La Mer*, paragraph 37);

- iii) Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user (*Ansul*, paragraph 36):
- iv) Use must therefore be external and not merely internal to the trade mark proprietor's business (*Ansul*, paragraph 37);
- v) Genuine use does not include token [but external] use for the sole purpose of preserving the rights conferred by the registration (*Ansul*, paragraph 36 and *Il Ponte*, paragraph 72);
- vi) Even use that is not quantitatively significant may be sufficient to establish genuine use (*La Mer*, paragraph 21);
- vii) Accordingly, use of the mark by a single importer may constitute genuine use if it appears that the import operation has a genuine commercial justification for the proprietor of the mark (*La Mer*, paragraph 24);
- viii) It is not possible a priori, and in the abstract, to determine a quantitative threshold below which use may be regarded as de minimis (*La Mer*, paragraph 25);
- ix) Rather the assessment as to whether use is genuine must have regard to 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 trade mark (*Ansul*, paragraph 38)
- x) The question of whether use of a trade mark is sufficient to maintain or create a market share for the goods or services must be assessed on a case by case basis against all relevant facts and circumstances, including the nature of the goods and services, the characteristics of the market concerned and the scale and frequency of use of the mark (*La Mer*, paragraph 22, *Sunrider*, paragraph 71 and *Il Ponte*, paragraph 73).

100. There is no dispute that RF has used the mark SABATIER alone within an oval on the handle of a substantial number of cutlery items marketed within the 5 year period leading up to the application for revocation on 25 October 2006. I have already found that the various uses of SABATIER by RF and others were as trade marks for their products. This includes RF's use of SABATIER alone on the handles of its products. It is not suggested that simply placing the mark within an oval border disqualifies the use from qualifying as use of the registered trade mark.

101. Further, on the evidence of Mr Stephen Lloyd, I find that the use with RF's consent of PROFESSIONAL SABATIER by Paul Swolf Limited also represents use of the mark SABATIER in the UK within the same five year period. In my view, this represents use of the mark SABATIER in combination with the descriptive term 'Professional'. The use of the word 'Professional' was purely descriptive because, in

context, it served to designate the kind of product: the kind of cutlery suitable for use by professional restaurant users. On that view of the matter, the use of PROFESSIONAL SABATIER represents use of the mark as registered. However, even if that is wrong and this should properly be regarded as use of the composite mark PROFESSIONAL SABATIER, for the reason given above, I find that this would have been perceived by the relevant consumer as use of the SABATIER mark in a form which does not affect its distinctive character, and therefore qualifies as use of the registered mark by virtue of section 46(2) of the Act.

102. The real issue between the parties under this heading is whether the requirement in the case law of the ECJ for the use to be “consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user”, requires a factual enquiry into whether the use of SABATIER alone was distinctive of RF’s goods. On behalf of IVO, Mr Malynicz says that it does. Mr Vanhegan for RF says that it is sufficient that RF’s use of the word SABATIER was consistent with the mark’s function as a trade mark. The difference between these two approaches is that the approach advocated by Mr Vanhegan involves an assessment of whether the mark was used in accordance with its function of distinguishing RF’s goods, whereas the approach advanced by Mr Malynicz also requires an assessment of whether RF’s use of Sabatier on handles etc. succeeded in fact in distinguishing RF’s goods from those of other traders.

103. In support of his submissions, Mr Vanhegan drew my attention to a judgment of the Court of First Instance of the European Communities (CFI) in Case T-29/04, *Castellblanch v OHIM* in which the court stated:

31 In the present case the applicant submits that it is evident from the proof of use and of repute produced by the intervener that the latter used the earlier mark in a form different to the one under which it was registered. The earlier mark is used for bottles which have on their main and neck labels, in addition to the word ‘cristal’, the denomination ‘Louis Roederer’ several times, as well as a symbol that includes the letters ‘l’ and ‘r’ and some complementary figurative elements which appear several times. According to the applicant, the combination of the word ‘cristal’ with the denomination ‘Louis Roederer’, the letters ‘lr’ and the accompanying figurative elements substantially alters the identity of the earlier mark, especially when account is taken of the strong distinctive character of the words ‘Louis Roederer’, and does not constitute genuine use of the earlier mark CRISTAL. Therefore, the opposition filed by the intervener and, consequently, the contested decision are wholly unfounded.

32 The Court of First Instance points out, first, following the example of OHIM, that the applicant does not contest the place, time or extent of use of the earlier mark but only the nature of that use.

33 In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company, as is the case particularly in the context of the automobile and wine industries.

34 That approach must be followed. The situation is not that the intervener’s mark is used under a form different to the one under which it was registered, but that

several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice.

104. Mr Vanhegan says that RF is in the same position. The use of other composite marks consisting of the word SABATIER in combination with the word LION, or a picture of a lion, on the blade of its products and on their packaging, does not prevent the use of the word SABATIER alone on the handles of its products from being genuine use of that mark alone. Provided that the use of SABATIER on the handles is in the nature of trade mark use (as opposed to descriptive or decorative use) the use qualifies as genuine.

105. Mr Malynicz says that this is too simplistic. If the use of the mark relied upon did not discharge the essential function of a trade mark, the use does not qualify as genuine use and the registration must be revoked for non-use.

106. As I have already noted, the Directive, the Act and the CTMR contain a number of provisions which envisage that the same or similar marks may be owned and used by different undertakings. For example, section 11(3) of the Act provides a defence for antecedent use of unregistered marks. And despite the unitary nature of the Community trade mark (CTM), Article 106 of the CTMR states that the use of a registered CTM may be prevented in those territories where there are earlier conflicting national trade marks. Further, section 23(3) of the Act provides for joint proprietors of a registered mark who, subject to any agreement to the contrary, have the right to use the mark independently of one another.

107. It is not therefore unknown for the same trade mark to be owned and used by different undertakings in the same field. In the UK, the best known example is probably the Budweiser trade marks, which most consumers know are used by two unrelated undertakings. The registration and concurrent use of the word 'Mail' by different undertakings for newspapers is another well known example: see *Associated Newspapers v Express Newspapers* [2003] FSR 51. It would therefore be very surprising if the mere fact of concurrent use meant that the users were not making genuine use of their marks for the purposes of registration. The approach suggested by Mr Malynicz is also difficult to reconcile with the purpose of section 46(1)(a) and (b), which is clearly explained in the 9th recital to the underlying Directive in these terms.

“(9) In order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation.”

I see nothing in this which supports the proposition that the non-use provisions are intended to provide a means of testing the distinctiveness of the proprietor's trade mark. On the contrary, the purpose of the provision is limited to the removal of trade marks that are not in use.

108. I therefore reject Mr Malynicz's submission that the enquiry under section 46(1)(a) and (b) requires an assessment as to whether the use of the subject trade mark succeeded in distinguishing the goods or services of the proprietor, despite concurrent [trade mark] uses by others. In my judgment, it is sufficient if the nature of RF's use of the SABATIER mark on the handles of knives, forks and sharpening steels, and in the composite term PROFESSIONAL SABATIER, is consistent with the mark's function of distinguishing goods in trade according to a trade source.

109. This brings me to the question of whether RF's use meets that description. I have already found that RF's use of SABATIER was not generic or descriptive but in the nature of trade mark use. I have also carefully considered whether the use shown by RF of SABATIER is not genuine because it is actually consistent with the function of distinguishing the goods of *association members* from those of other undertakings. In other words, that the mark was used as a collective trade mark identifying membership of the association rather than in accordance with its essential trade mark function of distinguishing RF's goods. However, I do not think that the evidence support that conclusion for these reasons. Firstly, there is nothing to suggest that RF has ever promoted its mark as serving this purpose. Secondly, there is no evidence that the existence of the association is apparent to relevant parties in the UK. Thirdly, at all material times in these proceedings, the association existed solely to protect the distinctiveness of the Sabatier name (presumably from any further dilution). There were no common quality standards or anything else that was relevant from a consumer's viewpoint. Consequently, using SABATIER to indicate membership of the association would have served no commercial purpose so far as traders in, or consumers of, cutlery were concerned.

110. I therefore accept that the use of the SABATIER marks on which RF's relies was trade mark use consistent with the marks' function of distinguishing its cutlery and thereby maintaining a market for those products. It follows that I reject the application for revocation of the SABATIER trade mark on the grounds of non-use in the five year period ended on 25 October 2006. In the light of the provisions of section 46(3) of the Act there is no need to consider the position for any earlier period.

The Opposition by RF to IVO's Application to Register P.Sabatier as a Trade Mark in Class 8

111. RF opposes IVO's application for registration under sections 5(2)(b) and 5(3) of the Act. However, very sensibly, RF only pursued the first mentioned ground at the hearing. Section 5(2) (b) of the Act is as follows:

- “(2) A trade mark shall not be registered if because –
- (a) -
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

112. It is common ground that, if valid, RF's UK registration of SABATIER is an earlier trade mark. As I indicated earlier, IVO challenges RF's statement of use of the earlier trade mark. This is potentially relevant to the outcome of the ground of opposition under Section 5(2) because the relevant part of section 6A(1) of the Act states that:

“(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) 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.

(4) For these purposes -

(a) 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

(b) 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. ”

113. It is apparent from this that the use conditions effectively mirror the conditions for revoking a trade mark in section 46(1)(a) and (b), which I have already considered and rejected. There is one difference. In *Riviera Trade Mark* [2003] RPC 883, I held that the relevant date for assessing the relevance of a subsequently revoked conflicting earlier trade mark was the date of the application for registration of the later mark. Since then the Trade Marks Act has been amended by the addition of section 6A, which expressly identifies the relevant date for assessing the use of the earlier trade mark as the date of publication of the later mark. In this case that was 21 April 2006.

114. The relevant 5 year period under section 6A therefore covers an earlier period than the period I considered in connection with the second revocation application, which ended on 25 October 2006. It is therefore necessary to consider whether the change to the relevant 5 year period means that IVO's challenge to RF's statement of use can succeed despite the failure of the second application for revocation. In my view, the change to the period makes no difference. The nature of RF' use of the SABATIER mark was the same in the earlier five year period as it was in later period. Indeed the nature of RF' use of SABATIER appears to have been consistent in all the material periods in these proceedings. It should therefore be apparent from my earlier findings in relation to the revocation application why I also reject the allegation of non-use (or no genuine use) in relation to the earlier 5 year period ending on 21 April 2006. This is also why nothing turns on my rejection of IVO's application to add a third alternative date to its second application for revocation, as mentioned in paragraph 3 above.

115. I conclude that RF's earlier trade mark satisfies the use conditions and can be taken into account for the purposes of the opposition.

116. In my consideration of whether there is a likelihood of confusion between the earlier mark and IVO's mark, I take into account of the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Matratzen Concord v OHIM C-3/03* [2004] ECR I-3657, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; *Shaker di L. Laudato & C. Sas v OHIM*
- (f) nevertheless, the overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components; *Matratzen Concord v OHIM*,
- (g) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,
- (h) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (i) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that

has been made of it; *Sabel BV v Puma AG*,

(j) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(k) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(l) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(m) if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of the Marks

117. It is self evident that SABATIER is very similar to P.SABATIER from a visual and aural perspective. This is because the word SABATIER is plainly the dominant and most distinctive feature of the mark P.SABATIER. The average consumer would probably realise that Sabatier is a French word. The marks therefore share some slight conceptual connection, admittedly at a very high level of generality. Whether consumers would recognise that Sabatier is a French surname is more doubtful. There is no evidence that it is a common French name, although it seems to have been quite popular in Thiers in the 19th century. The presentation of IVO's mark invites consumers to accept Sabatier as a surname. Accordingly, for consumers who come across and form impressions of both marks, the mark SABATIER may also be thought of as a French surname. However, consumers don't generally think very deeply about the meaning of trade marks, so I do not intend to attach much weight to this conceptual similarity. I am content to proceed on the basis that there is little obvious conceptual similarity between the marks, but equally no relevant dissimilarity that might help to reduce the impact of the visual and aural similarities between the respective marks.

Comparison of Goods

118. IVO's application covers "knives", "forks" and "sharpening steels", which I find to encompass the "kitchen knives, cook's kitchen knives and butcher's knives", "forks for cooking, carving and roasting" and "sharpening steels" in the list of goods for which the earlier trade mark is protected. In the absence of any restriction to the list of goods applied for, these products must be regarded as identical. IVO's application also covers "cutlery" at large, which for the same reason I find to be identical to the goods covered by the earlier mark.

119. IVO's application also includes "cleavers", which are virtually identical to "cook's kitchen knives and butcher's knives" in RF's list of goods. IVO's application also covers "spatulas, slicers and parers". Slicers and parers appear to serve a very similar purpose to kitchen and butcher's knives. They are so similar that I do not believe that any further analysis is required in order to explain why they are closely similar products. A spatula is a utensil used for lifting, spreading or stirring foods. It is similar in nature to a carving fork, which can also be used for lifting items whilst cooking or serving. Both are used and bought by, inter alia, cooks. They are not really in competition with one another but both might be purchased as part of a set of kitchen utensils. I find that these are also closely similar products.

Distinctiveness of the Earlier Mark

120. I understand that RF's mark may have been registered partly on the basis of acquired distinctiveness. If that is so it is almost certainly the result of it being a French surname. The Trade Marks Act 1938 presented certain legal obstacles to the registration of surnames (even foreign surnames) as trade marks. None of this matters now. I base my assessment on the perception of the UK consumer. Taking that approach I find that the earlier trade mark has an inherent high level of distinctiveness for cutlery.

Likelihood of Confusion

121. Following the reasoning of Warren J. in the earlier proceedings between RF and Horwood, Mr Vanhegan relied upon paragraph 36 of the *Medion* case cited above, in which the ECJ found that:

"It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark."

122. Although I understand why Mr Vanhegan relied on this authority, I do not think that one has to resort (by analogy) to the exceptional situation described in the *Medion* case as authority for the proposition that the use by unrelated undertakings of marks as similar as SABATIER and P. SABATIER, in relation to identical or closely similar goods in Class 8, is likely to result in confusion on the part of the relevant average consumer. Although the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, there is a likelihood of confusion as a result of the marks being directly mistaken for one another through imperfect recollection. This is because both marks are liable to be remembered as SABATIER marks. Further, even those consumers who register that IVO's mark is P.SABATIER are likely to be misled into believing that the use of the dominant and distinctive element of that mark - SABATIER – is use by the same undertaking of a variation of the P.SABATIER mark (or vice versa).

123. I recognise that, in principle, it is possible for such similar marks to co-exist in the marketplace without a likelihood of confusion. For example, the evidence might have shown that the relevant parties in the UK have become accustomed to distinguishing between the various SABATIER marks on the basis of additional

distinguishing indicia, or when the name is used alone. However, in my view, the evidence shows no such thing. On the contrary, the balance of the evidence shows that the use of various SABATIER marks by different undertakings is confusing the average UK consumer, who absent education, generally believes that SABATIER is the trade mark of one undertaking.

124. The potential for confusion can easily be illustrated by comparing Mr Gordon's evidence, that the public are confused into thinking that SABATIER is a single brand, and Mr Fisher's evidence - that retailers offer whichever SABATIER product they have on their shelves. Further, Mr Lloyd's evidence was that even he had been confused in the past. I do not, therefore, believe that the history of concurrent uses of SABATIER marks in the UK assists IVO with its application. IVO may well feel that in view of the existing state of affairs in the market it should also be permitted to exploit the Sabatier name by registering and using its own version of the mark. However, if that is likely to cause confusion then absent any defence the law does not permit it.

125. I conclude that the concurrent use of RF and IVO's marks is likely to cause confusion on the part of the public and the opposition under section 5(2)(b) of the Act succeeds accordingly.

Conclusion

126. The applications to invalidate and revoke RF's SABATIER trade mark are rejected.

127. IVO's application for registration of P.SABATIER in Class 8 is refused.

Costs

128. The parties asked to be allowed to see my decision before making submissions on costs. I will allow 21 days from the date shown below for this purpose. I direct that any submissions made to the Registrar should be copied to the other party. Any request for an award of costs above the usual scale should be justified and supported by relevant bills of costs. This should not be taken as an encouragement (or discouragement) to the making of such an application; it is simply recognition of possibility of such a claim being made.

129. The parties will have a further 14 days, starting from the date receipt of any submissions from the other party, to file any comments they may have in response. I will then issue a supplementary decision covering costs.

130. The date shown below is the date of my decision for the purposes of any appeal against any of my findings on the substantive matters.

Dated this 10th Day of March 2009

**Allan James
For the Registrar**

ANNEX A

Evidence filed by Rousselon Freres et Cie

Witness Statement by Philippa Dianne Eke dated 12 March 2007 and exhibits PDE1-PDE24.

PDE1 consists of a declaration by Pascale Sol-Bruchon dated 07 November 2005

PDE5 consists of a Witness Statement by Stephen Lloyd dated 28 October 2005

PDE6 consists of a Witness Statement by Alastair Fisher dated 25 October 2005

PDE7 consists of a Witness Statement by Kate Carrick dated 02 November 2005

PDE8 consists of a Witness Statement by Michael Schneideman dated 31 October 2005

Exhibit PDE9 consists of a Witness Statement by Alison Thorne dated 09 November 2005

Exhibit PDE10 consists of a Witness Statement by Phillipa Dianne Eke dated 09 November 2005

Exhibit PDE11 consists of a Witness Statement by Pascale Sol-Bruchon dated 12 June 2006.

Exhibit PDE12 consists of an Affidavit by Vivina Cabrita Ivo Peralta Rafael dated 06 February 2006.

Witness Statement by Philippa Dianne Eke dated 10 May 2007 and exhibits PDE1-PDE10

Witness Statement by Philippa Dianne Eke dated 07 September 2007 and exhibits PDE25-PDE28

Exhibit PDE26 consists of a Witness Statement by Philippa Dianne Eke dated 15 June 2006

Exhibit PDE27 consists of a Witness Statement of Guillaume Therias dated 15 June 2006

Witness Statement by Philippa Dianne Eke dated 12 September 2008 and exhibits PDE71-PDE76

Witness Statement by Pascale Sol-Bruchon dated 30 April 2007 and exhibit PSB1

Witness Statement by Pascale Sol-Bruchon dated 28 April 2008 and exhibits PSB1-PSB14

Witness Statement by Pascale Sol-Bruchon dated 12 September 2008 and exhibits PSB51-PSB66

Exhibit PSB64 consists of a Statutory Declaration by Maurice Girard dated 23 January 1970

Witness Statement by Dr Adam Kilgarriff dated 13 August 2008 and exhibits exhibit AK1-AK8

Witness Statement by Karen Auker dated 09 September 2008 and exhibits KA1-KA8

Witness Statement by Gary Gordon dated 03 September 2008 and exhibits GG1-GG4

Witness Statement by David Phillips dated 09 September 2008 and exhibits DP1-DP3

Witness Statement by Nicky Foster dated 09 September 2008 and exhibits NF1-NF2

Witness Statement by Alastair Fisher dated 10 September 2008 and exhibits AF1-AF9

Witness Statement by Alison Thorne dated 12 September 2008 and exhibits AT1-AT4

Witness Statement by Stephen Lloyd dated 27 February 2007 and exhibit SL1 and SL2

Witness Statement by Stephen Lloyd dated 09 September 2008 and exhibit SL3

Witness Statement by Guy Marie Antoine Fruchard dated 12 September 2008 and exhibits GMAF1-GMAF7

Witness Statement by Rupert Andrew Knights dated 12 September 2008 and exhibit RAK1-RAK9

Evidence filed by Ivo Cutelarias Lda.

Witness Statement by Sarah Jane Leno dated 29 April 2008 and exhibit SJL1

Exhibit SJL1 consists of evidence filed by Horwood Homewares Limited in related proceedings these being:

Witness Statement by Neil Michael James Rosati dated 23 January 2008 and exhibits NMJR1-NMJR11

Exhibit NMJR11 consists of a Witness Statement by Neil Michael James Rosati dated 28 April 2006

Witness Statement by John Francis Symonds dated 23 January 2008 and exhibits JS1-JS3

Witness Statement by Jennifer Rebecca Dyal dated 22 January 2008 and exhibits JRD1-JRD3

Witness Statement by Richard Matthew Greenshields dated 22 January 2008 and exhibit RMG1

Witness Statement by Rachel Louise Frances Garratt dated 21 January 2008 and exhibits RLFG1-RLFG2

Witness Statement by Felicity Anne Cox dated 23 January 2008 and exhibits FAC1 to FAC3

Witness Statement by Rose-Marie Embleton-Smith dated 23 January 2008 and exhibits RMES1 – RMES36

Witness Statement by Margaret Jane Arnott dated 14 February 2008 and exhibits MJA1 – MJA20

Exhibit MJA2 contains a Witness Statement of Mark Tocher dated 08 June 2000 and Philip Hart dated 09 June 2000.

Exhibit MJA9 consists of a Witness Statement by Paul William Turner dated 21 April 2006

Witness Statement by Margaret Jane Arnott dated 11 March 2008 and exhibits MJA21 – MJA22

Exhibit MJA21 consists of an expert report by Gerard Pacella dated 28 January 2008

Exhibit MJA22 consists of an English translation of expert report by Gerard Pacella dated 28 January 2008

Witness Statement by Sarah Jane Leno dated 15 July 2008 and exhibits SL2 – SL3

Witness Statement by Stephen Kinsey dated 08 June 2007 and exhibits SK1-SK7

Exhibit SK1 contains

a Witness Statement by Margaret Jane Arnott dated 21 April 2006.