

O-101-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION No. 1516333  
IN THE NAME OF TRADELINK (LONDON) LIMITED**

**AND**

**IN THE MATTER OF AN APPLICATION FOR REVOCATION  
THERE TO UNDER No. 80806 BY EAST END FOODS PLC**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF Trade Mark Registration  
No. 1516333 in the name of Tradelink (London) Limited**

**and**

**IN THE MATTER OF an Application for Revocation  
thereto under No. 80806 by East End Foods Plc**

**BACKGROUND**

1. On 26 April 2002, East End Foods Plc applied to revoke registration No. 1516333 standing in the name of Tradelink (London) Limited. The registration is in respect of the following trade mark:



and is registered for the following specification of goods:

Saffron, spices, tea, papads, papadoms; all included in Class 30.

2. The application for revocation is made under Section 46(1)(b) and is expressed as follows:

AYthat, in the five years preceding 28 January 2002, the trade mark has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which it is registered, and there are no proper reasons for non-use.

The applicants submit that no use whatsoever of the Trade Mark has been made in this five year period, but also submit, in the alternative, that no genuine use of the trade mark has been made in relation to papads or papadoms, and there are no proper reasons for non-use.

Under the provisions of Sections 46(1)(b) and 46(5) of the Trade Marks Act 1994, the applicants request that the registration be revoked in its entirety, or, where some use is shown by the proprietor, that the registration be revoked in part.@

3. On 12 August 2002, the registered proprietors filed a counterstatement in which they responded to the allegations of non-use. In essence, the registered proprietors deny the various grounds of revocation. The relevant statements from the counterstatement are as follows:

Alt is argued that use and such use being genuine, has been made since registration of our trade mark RUBY BRAND R as we have been trading for an uninterrupted period since registration in saffron and tea.

Further, in answer to the applicants= allegation of non-use in their paragraph 2.E I put forward the following proper reasons for non-use in respect of papadoms;

Our company previously traded in papadoms in 1994 under the brand name VENUS. Due to having a vast quantity of stock available, purchased under the brand name VENUS, until 1996 we had no need to purchase further stocks.

In 1997 we decided to develop our RUBY BRAND R mark further by introducing a new variety of rice papadoms in various flavours. It was at this time that the applicants initiated their non-productive and deliberately vexatious invalidity action. This caused us to halt production of our new brand of papadoms under our mark RUBY BRAND R for an uninterrupted period of two years and two months.

Further, in 1999/2000 our business was, with great regret, hit by an illness of a family and company member who passed away at the age of 49 years. This again prevented us from the development of our brand RUBY BRAND R papadoms and any further product development.

Finally in the middle of 2001 our project recommenced to develop RUBY BRAND R papadoms as in accordance with Section 46(3) Trade Marks Act 1994 and we have now successfully launched our brand of papadoms on the open market.®

4. On 10 February 2004, I issued my decision in respect of the above proceedings, finding the application for revocation to have succeeded, and under the provisions of Section 46(1), that the registration should be revoked in its entirety. This decision was subject to appeal, which was subsequently made to the Appointed Person. In his decision, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, determined that there had been a procedural irregularity of material significance in relation to the determination of the proceedings. Mr Hobbs QC stated:

My intention is that the matter should be restored for directions and at that point it will be appropriate for the registered proprietor to apply to the Registrar for leave to adduce further evidence. I recognise that there is a need to know what the samples that were misguidedly withdrawn from the Registry might have demonstrated and confirmed in terms of their packaging and presentation. It does not necessarily follow that any evidence which is allowed in should extend to broader issues concerning the commercialisation of the relevant mark during the relevant period. However, I do not intend to pre-empt the Registrar's decision on any application that may be made for the filing of further evidence. The upshot of this morning's proceedings is that the appeal will be allowed and the revocation application will be remitted to the Registry for further processing in accordance with directions to be given by the Registrar hereafter.®

5. On 11 March 2004, Wildbore & Gibbons, on behalf of the registered proprietors, sought leave to file further evidence. By an official letter dated 14 September 2004, the evidence, summarised below, was admitted.

6. Neither side took up the offer of an oral hearing although both provided written submissions in lieu of a hearing. Therefore, after a careful study of the papers and evidence I go on to give my decision.

#### **Registered proprietors= further evidence**

7. This consists of a Witness Statement dated 10 March 2004, by Rajesh Doshi, a Director of Tradelink (London) Limited. Mr Doshi introduces exhibits RD4 which consists of a 5 gram container of saffron and a bag for Kenyan tea. The container bears the mark in the composite form in which it is registered, and a seal stating that the contents were packaged in the year 2000 and have an expiry date of 2003. The bag for packaging tea has a label showing a **Best before**® date of the end of April 2004, which is some considerable time after the end of the five-year period. Mr Doshi refers to exhibit RD5, which consists of a selection of invoices from 1996 onwards. Whilst these refer to RUBY and RUBY

BRAND in relation to tea and saffron, they do not show that these goods were sold under the mark as registered.

8. That concludes my review of the evidence insofar as it is relevant to these proceedings.

## **DECISION**

9. The statutory provisions of Section 46 under which this application has been made are as follows:

**A46.**-(1)The registration of a trade mark may be revoked on any of the following Grounds-

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

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

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

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

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

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

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

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

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

10. Section 100 is also relevant. It reads:

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

11. The applicant's attack has two strands, namely, that there has been no eligible use of the mark in respect of any of the goods for which it is registered, or, in the alternative, if there has been use it does not cover papadoms. The registered proprietor's defence is likewise on two fronts, stating that there has been use of the mark in respect of saffron and tea, and that there are proper reasons for non-use in respect of papadoms.

12. The first question is whether the newly admitted evidence establishes that there has been use of the mark as registered, or taking on board the provisions of subsection 2 of Section 46, A...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.@"

13. Exhibit RD5 shows use of the words RUBY and RUBY BRAND within the relevant period in relation to saffron and tea, but this is in the form of these words alone. In my decision of 10 February 2004, I determined that based on the guidance set down in *R v Bud and Budweiser Budbräu Trade Marks* [2002] RPC 38 and the *Elle* trade mark case [1997] FSR 529, such use does not constitute A...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.@ That position remains the same.

14. Exhibit RD4 consists of a container of saffron and packaging for tea. The container for the saffron bears a seal that indicates the product was packaged in the year 2000, and has an expiry date of 2003. I am satisfied that this exhibit substantiates that the mark, as registered, was in use in relation to saffron during the relevant five year period, a fact that is supported by the invoices contained in exhibit RD5.

15. The packaging for the tea bears a mark which although not exactly the design as registered, in my view does not differ in its distinctive character. However, unlike the saffron, this packaging only bears a Abest before@date, showing this to be some two years after the end of the relevant period. I do not know what the shelf life of the product is; it may or may not have been packaged within the relevant five years, I do not know. The invoices at exhibit RD5 show that the registered proprietors were trading in tea under the RUBY name within the relevant period, but not the form in which it was used. Mr Doshi says that the packaging is the same as that used in previous years, and whilst I do not doubt his word, this of itself is not evidence of fact. Collectively the evidence suggests that the registered proprietors were trading in tea under a mark that would constitute relevant use, but this is not enough.

16. In my earlier decision I gave full consideration to the question of whether there are any Aproper reasons for non-use@of the mark, and see no reason to revisit this issue.

17. Taking into account the reasons given above, and the relevant comments in my earlier decision, I find that the registered proprietors have established that there has been use of the mark in relation to saffron, but not in respect of any other goods. Consequently, the application for revocation under section 46(1) succeeds in respect of all goods other than saffron, and the registration will be revoked accordingly with effect from 26 April 2002.

18. The application for revocation having been successful, the applicant is entitled to an award of costs. I order the registered proprietor to pay to the applicant the sum of , 250. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18th day of April 2005**

**Mike Foley  
for the Registrar  
the Comptroller-General**