

O-105-05

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 81219
BY DESHOULIERES SOCIETE ANONYME
FOR REVOCATION OF TRADE MARK No 1135461
APILCO OVEN TO TABLE PORCELAIN
STANDING IN THE NAME OF
EDWARD HOCKLEY HOLDINGS LIMITED

BACKGROUND

1) Trade mark No 1135461 is registered with effect from 17.06.80, having been placed on the register in November 1982, in the name of Edward Hockley Holdings Limited of 100 East Road, London, N1 6AA. The mark is registered in respect of the following goods in Class 21: "Oven-to-tableware articles included in Class 21 made of decorated and of glazed porcelain, and being the produce of France." The mark is as follows:



It is a condition of registration that the blank spaces in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-trade mark character. Registration of this Trade Mark shall give no right to the exclusive use of the words "Oven to Table Porcelain".

2) By an application dated 18 March 2003, Deshoulieres Societe Anonyme of Le Plenty, 86300 Chauvigny, France applied for the revocation of the registration under the provisions of Section 46(1)(a) & (b). The grounds stated that there has been no use of the trade mark in suit since registration was granted, or in the alternative that there has been no use in the five years preceding the application for revocation and the revocation should date from 30 November 1996.

3) On 23 June 2003 the registered proprietor filed a counterstatement denying the above grounds.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 23 February 2005 when the applicant for revocation was represented by Mr George of Messrs R.G.C. Jenkins & Co. The registered proprietor was not represented at the hearing nor did they provide written submissions.

REGISTERED PROPRIETOR'S EVIDENCE

5) The registered proprietor filed a statutory declaration, dated 20 June 2003, by David Robert Holmes the Managing Director of the registered proprietor company. Mr Holmes states that the proprietor, and with their consent F Trauffler Limited, a member of the proprietor's group of companies, have used the mark in suit in the UK since 17 June 1980. He states that his company are distributors and suppliers of

ranges of ceramics, glassware and housewares to both independent and multiple retailers, hotels, restaurants and catering distributors. He states that they supply articles such as plates cups and saucers, soufflés, casseroles, roasting pans and various platters all suitable for use from oven to table. At exhibit DRH1 he provides a sample bundle of copies of invoices which show the sale of such goods, with each invoice having the mark in suit upon it, albeit with the addition of the words “Domestic and Catering Porcelain”. The nine invoices are addressed to towns and cities throughout the UK. The amount of each invoice is very low, the highest being for £170.38 including VAT, and the dates cover the period 23 May 2000- 28 February 2001. Each invoice was issued by Trauffler and the invoices state that “TRAUFFLER is a division of Edward Hockley Holdings Ltd”.

6) At exhibit DRH2 he provides a bundle of trade price lists and pricelist coversheets showing how the mark has been used. All were issued by F. Trauffler Ltd. These are dated 1981-1994. They show the mark in suit together with the words “Domestic and Catering Porcelain” between 1 January 1986 – 1992. Prior to this date (1981-1985) a slightly different version was used, which showed the name of “F. Trauffler Ltd” above the name “Apilco” the firms address, telephone and telex number and the words “Fireproof Porcelain Hand Cut Lead Crystal and Plain Glassware”.

7) Mr Holmes provides turnover figures under the mark in suit in the UK as follows:

Year	Turnover £
1980/81	295,871
1981/82	445,475
1982/83	490,910
1983/84	627,349
1984/85	773,209
1985/86	1,035,178
1986/87	1,231,140
1987/88	1,545,197
1988/89	1,977,679
1989/90	2,009,487
1990/91	2,011,718
1991/92	2,071,269
1992/93	1,893,882
1993/94	2,584,998
1994/95	2,153,705
1995/96	2,003,301
1996/97	1,636,375
1997/98	1,793,660
1998/99	1,629,491
1999/20	1,186,934
2000/01	1,130,693
2001/02	733,259
2002/03	570,276

8) At exhibit DRH3 he provides a bundle of UK trade fair catalogues which he states shows “where and when the proprietors exhibited goods under the trade mark in the

UK". The pages copies are mixed up but purport to show that the registered proprietor attended trade fairs in Birmingham in February and September of 1996, 1997 & 1998, as well as other UK fairs in 1990 and 1994. Each entry shows the company offering Apilco goods, but not the mark in suit.

9) Lastly, Mr Holmes claims that "Not less than £20,000 has been spent annually on advertising and marketing the proprietor's goods under the trade mark in the United Kingdom". He states that the advertisements appeared in magazines and trade papers and at exhibit DRH4 he provides examples of copies of such advertisements. Very few are dated. However, those that are, and which show the mark in suit, albeit with the words "Domestic and Catering Porcelain" inserted as opposed to merely mentioning Apilco, carry the following dates: August 1983, January 1989 & July 1989.

APPLICANT'S EVIDENCE

10) The applicant for revocation filed two witness statements. The first, dated 30 September 2003, is by Gilles Fuste the Production Manager of Deshoulieres, the applicant company. He states that the applicant company supplies porcelain products to the registered proprietor company. These goods, since 1992 have had a logo on them with the words "Porcelaine Apilco France" on three lines in an oval. He states that the mark in suit "APILCO OVEN TO TABLE PORCELAIN" has not been used by his company for at least ten years and he claims that the UK distributor "TRAUFFLERS (owned by Edward Hockley Holdings) agreed to only use the new logo APILCO, and to abandon use of the previous one".

11) The second witness statement by Yves Deshoulieres the Chairman and Managing Director of the applicant company is not dated, but was received by the Registry in October 2003. He states that his company granted an exclusive UK distributorship to Trauffer, a company which he describes as "now controlled by or otherwise associated with Edward Hockley Holdings Limited". As part of this agreement the distributor was only able to sell Apilco products. He states that in 1992 the original trade mark of his company was replaced by a new logo version. The mark in suit is identical to the original trade mark. Mr Deshoulieres therefore claims that the registered proprietor cannot have been selling Class 21 goods with the mark in suit on them as for the last ten years all such products emanating from his company had the new logo, and did not carry the mark in suit. He also alleges that the registered proprietor did not have his company's permission to register the mark in suit.

12) He comments that much of the evidence is quite old and that the invoices cannot refer to goods sold with the mark in suit on them (see above) and states that it is the first time that he has seen such invoice stationery.

REGISTERED PROPRIETOR'S EVIDENCE IN REPLY

13) The registered proprietor filed a witness statement by Mr Holmes, dated 13 January 2004. He states that his company and its predecessors have been the owners in the UK of the trade mark APILCO and its derivatives in a registered and unregistered sense for "the best part of a century, and the applicant has never owned the rights to the mark APILCO or its derivatives in the UK". He does not deny that

the applicant changed the mark on their goods, but states that his company has used the mark in suit in addition to the new logo mark.

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

DECISION

15) The relevant part of Section 46 reads as follows:

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

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

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

16) The applicant alleges that the mark has not been put to use in the UK within five years of its registration or in the alternative it has not been used in the five years prior to the date of the application for revocation. Under Section 46(1)(a) the applicant seeks a revocation date of “late 1988”. Under section 46(1)(b) it seeks revocation from the earlier of either 30 November 1996 or 18 March 2003.

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

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

18) In considering this matter I look to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* [2002] ETMR 34. This was an appeal against a decision by the Registrar. In that case the question of whether a very limited amount of use in this country can be regarded as sufficient to be “genuine”

was considered. It was decided to refer the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter. He said:

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

19) I also take into account the judgement in Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* where the European Court of Justice, on 11 March 2003, stated at paragraphs 35-39:

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

36. ‘Genuine use’ must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of origin of goods or services to the consumer or the end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that ‘genuine use’ of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *viv-a-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’etre*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations for by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in

particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or services at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or services concerned on the corresponding market.”

20) On the question of onus of proof I note the comments from the *NODOZ* case [1962] RPC 1, in which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established,

21) The relevant facts before me are as follows:

- Trade price lists for the period 1981-1985 inclusive were provided. These were issued by F. Trauffler Ltd and show the mark in suit with the name, address, telephone and telex number of this company and the words “Fireproof Porcelain Hand Cut Lead Crystal and Plain Glassware”.
- Trade price lists for the period 1 January 1986 – 1992 issued by F. Trauffler Ltd all carry the mark in suit with the words “Domestic and Catering Porcelain” inserted in the bottom part of the mark.
- Turnover figures said to be for the mark in suit in the UK were provided covering the period 1980 – 2003 inclusive.
- Advertisements dated August 1983, January 1989 and July 1989 which show the mark in suit with the words “Domestic and Catering Porcelain” inserted have been provided.
- Whilst the company attended a number of trade fairs in the UK between 1990-1998 there is no evidence provided showing that the mark in suit was used.
- A sample bundle of invoices for the period 23 May 2000 – 28 February 2001 issued by Trauffler has been provided. Each invoice has the mark in suit with the additional words “Domestic and Catering Porcelain” inserted.

22) In the evidence the applicant for revocation contended that the goods sold under the mark in suit by the registered proprietor and associated companies were produced by the applicant, something which the registered proprietor has not contested. The applicant states that the trade mark applied by it to the products it produces changed in approximately 1993 and so the registered proprietor could not have been using the mark in suit after this date. It was also claimed that the registered proprietor's associated company, Trauffler, had agreed to cease use of the "old" trade mark once the "new" mark had been launched. However, no evidence of such an agreement was provided. The change of the applicant's mark is admitted by the registered proprietor but it claims that whilst the mark on the goods changed it continued to use the mark in suit in addition.

23) However, at the hearing the applicant's representative sought to challenge much of the evidence. It was contended that none of the use shown related to "Oven-to-table porcelain" or indeed any porcelain made in France. The turnover figures were questioned as to whether they related to the sales of oven-to-table porcelain produced in France under the Apilco mark or to other parts of the registered proprietor's business. The invoices in particular were questioned in so far as they were issued by Trauffler which was shown to be a division of Edward Hockley Holdings Ltd. The invoices were issued after the date of delivery, they carried no specific references to "oven-to-table porcelain" and that the mark used had additional words included and was not the mark as registered. Similarly, the other evidence also showed additional wording to the mark as registered and it was claimed that many of the goods were not oven-to-table porcelain but "tableware".

24) Whilst the applicant is fully entitled to comment on the evidence submitted these comments cannot be given the same weight as the evidence filed. If the applicant wished to challenge whether the items shown on the invoices were oven-to-table porcelain produced in France then it should have either raised such issues in the evidence or sought to cross-examine the witness.

25) The registered proprietor has provided three distinct bundles of evidence to corroborate its claims that the mark in suit has been used on the goods covered by the specification in the UK within the three periods in question. All show use of the mark by F.Trauffler Ltd which is a member of the proprietor's group of companies, and which has according to the evidence of Mr Holmes, used the mark with the registered proprietor's consent. The three bundles I refer to are the advertisements dated August 1983, January 1989 and July 1989; the trade price lists for the period 1 January 1986 – 1992 and the sample bundle of invoices for the period 23 May 2000 – 28 February 2001. All the usage shown in this evidence is of the mark in suit with the words "Domestic and Catering Porcelain" inserted.

26) I must now consider whether the use of the mark with these additional words constitutes use of the mark in suit. I look to the judgement of the Court of Appeal in *BUD / BUDWEISER BUDBRAU* [2003] RPC 24. In particular, to the comments of Lord Walker at paragraphs 43-45 where he stated:

"43. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences

have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

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

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

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

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

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

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

27) For ease of reference I reproduce below the mark in suit and also the conditions that apply.



It is a condition of registration that the blank spaces in the Mark shall, when the Mark is in use, be occupied only by matter of a wholly descriptive and non-trade mark character. Registration of this Trade Mark shall give no right to the exclusive use of the words "Oven to Table Porcelain".

28) The mark as used by the registered proprietor has the additional words “Domestic and Catering Porcelain” inserted into the lower portion of the shield. I would regard

such words as falling within the definition of “wholly descriptive and non-trade mark character”. Therefore, to my mind the use shown by the registered proprietor although it has additional matter to that shown in the registered mark has to be considered as use of the mark as registered as it is within the limitations imposed at the time of registration. Consequently, the mark shown to be used is not in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered.

29) I must now consider the use shown in relation to the three periods which are to be considered. The periods are Nov-1983- Nov 88; 30 November 1990-29 November 1996 and 18 March 1998-17 March 2003. I must consider whether the use shown is in relation to the goods stated in the specification of the mark which is as follows:

“Oven-to-tableware articles included in Class 21 made of decorated and of glazed porcelain, and being the produce of France.”

30) The applicant has stated that all goods produced until approximately 1993 had the mark in suit applied to them prior to leaving the applicant’s premises. The evidence for the period Nov 1983 – November 1988 consists of trade price lists, advertisements and turnover figures. These all refer to use of the mark which itself refers to “Apilco oven to table porcelain”. To my mind the registered proprietor has shown genuine use of the mark in suit upon goods covered by the registration during the period in question.

31) Turning to the period 30 November 1990-29 November 1996. The evidence provided are the trade price lists for the period 1 January 1986 – 1992 and the turnover figures which for this period average approximately £2 million per annum. The registered proprietor has stated that these figures relate to use of the mark in suit within the UK. As the applicant was supplying the goods which were being sold under this mark had there been a substantial difference between the amount they supplied and the turnover figures one would have expected the applicant to have commented upon this in their evidence. I also note that during this period by their own admission the applicant was applying the mark in suit to the products. To my mind the registered proprietor has shown genuine use of the mark in suit upon the goods covered by the registration during the period in question.

32) Lastly, I turn to the period 18 March 1998-17 March 2003. The evidence provided are the sample bundle of invoices and the turnover figures which for this period average approximately £1.1 million per annum. The registered proprietor has stated that these figures relate to use of the mark in suit within the UK. As the applicant was supplying the goods which were being sold under this mark had there been a substantial difference between the amount they supplied and the turnover figures one would have expected the applicant to have commented upon this in their evidence. The invoices have been criticised at the hearing for not specifically referring to oven to table porcelain made in France. The invoices refer to items such as plates and bowls all of which could be covered in this category. Again, the applicant supplies products to the registered proprietor and the descriptions used are such that one would have thought that the manufacturer would have recognised very quickly if the descriptions did not relate to products manufactured and supplied by them. To my mind, the registered proprietor has overcome the onus which is placed upon him and

shown use of the mark in suit upon goods covered by the registration during the period in question.

33) The application for revocation fails. I order the applicant for revocation to pay the registered proprietor the sum of £1000. 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 19th day of April 2005

George W Salthouse
For the Registrar
The Comptroller-General