

O-111-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 80209
BY TRIDENT TYRE LIMITED
FOR REVOCATION OF TRADE MARK No 1289867
TRIDENT
IN CLASS 12
STANDING IN THE NAME OF
DUNLOP TYRES LIMITED

BACKGROUND

- 1) The trade mark TRIDENT is registered under number 1289867 in respect of the following goods in Class 12: Tyres for land vehicles; inner tubes and valves, all for the aforesaid tyres; all included in Class 12@.
- 2) The application for registration was made on 3 November 1986 by Sumitomo Rubber Industries Limited and the mark was placed on the register on 4 August 1989. On 16 January 2002 the mark was assigned to Dunlop Tyres Limited.
- 3) By an application dated 15 January 2002, Trident Tyre Limited of Manor House Farm, Little Wolford, Shipston on Stour, Warwickshire, CV36 5LZ applied for the revocation of the registration under the provisions of Section 46(1)(b). The ground states that the mark in suit has not been used in the UK in the five years prior to the date of the application for revocation.
- 4) On 30 April 2002 the registered proprietor filed a counterstatement denying all the grounds and also stated that they had been given no notification of the revocation action and had themselves been seeking to prevent the applicant from importing tyres carrying their trade mark.
- 5) Both sides seek an award of costs. Both sides filed evidence.
- 6) At the hearing, on 4 February 2004, the registered proprietor was represented by Mr Brandreth of Counsel instructed by Messrs IPulse. The applicant for revocation was represented by Mr Chettle of Messrs Withers & Rogers.

REGISTERED PROPRIETOR'S EVIDENCE.

- 7) The registered proprietor filed a witness statement, dated 29 April 2002, by Charles Geoffrey Stewart the Contracts & Patents Manager of Dunlop Tyres Ltd. He states that he has access to the company records of Dunlop including design drawings and records.
- 8) Mr Stewart states that in 1992 a design for a tyre was completed which would include the trademark TRIDENT on the sidewall. This tyre was first manufactured in 1992 and has been sold in the UK continuously since this date. At exhibit CGS1 he provides a photograph, taken in April

2002, of a portion of the sidewall of the tyre which shows the mark in suit. It is stated that the tyres manufactured and sold in the UK since 1992 have had the mark incorporated in the sidewall in the same manner. Mr Stewart states that, inter alia, his company has sold tyres to Jet tyres Limited and ATS. He states that the number of tyres sold in the UK in recent years is as follows:

Year	Number of Tyres
1997	11,400
1998	11,500
1999	11,500
2000	9,600
2001	7,000
TOTAL	51,000

9) At exhibit CGS2 Mr Stewart provides copies of promotional materials produced and distributed by Jet Tyres Limited and ATS in marketing TRIDENT tyres in the UK. None are dated and most are aimed at the taxi market. Amongst the various makes offered to taxi owners are the ATrident Taxi@. One list simply refers to the ANew Trident by Dunlop@.

APPLICANT-S EVIDENCE

10) The applicant filed three witness statements. The first, dated 5 August 2002, is by Nicholas Martin Wilson the applicant-s Trade Mark Attorney. He files letters referring to the legal proceedings threatened by the proprietor and referred to in the counterstatement. However, these are not, in my view, of any relevance to these proceedings and therefore not of assistance in my decision.

11) The second witness statement, dated 2 August 2002, is by Julian Majzub the Managing Director of Trident Tyre Limited (TTL). He states that in 2001 he adopted the name Trident for tyres for classic cars which would comply with modern legislation. He subsequently began trading under the name until he received an objection from Dunlop. He states that he had carried out internet searches, and found no mention of TRIDENT being used by Dunlop.

12) Mr Majzub states that following receipt of the letter from Dunlop he specifically searched their website but could not find any use of the mark in suit. He provides copies of the Dunlop website at exhibit JM2. He also states that taxi tyres are Aa distinctive category of tyre available from specialist dealers and are governed by very strict regulations@.

13) The applicant-s third witness statement, dated 1 August 2002, is by Rex Grogan. Mr Grogan

states that he is an International Pneumatic Tyre Consultant specialising in forensic and accident investigations. He provides details of the requirements of taxi tyres and their development. He also provides his opinion on the confusability of various marks. Again, none of this is of assistance to me in my decision.

REGISTERED PROPRIETOR'S EVIDENCE IN REPLY

14) The proprietor filed three witness statements in response. The first, dated 5 November 2002, is by Robert Heywood, the General Manager, Motor Sports Division of Dunlop Tyres Ltd. He states that for at least the last ten years TRIDENT branded tyres have been supplied to various companies for use on taxis and classic cars. They have been manufactured in a single size 175R16. He also states that one of the companies purchasing these tyres, Vintage Tyre Supplies is acquiring TRIDENT tyres manufactured by Dunlop. He states that tyres, whether for taxis or private cars tend to be sold from the same outlets.

15) Mr Heywood states that his company sells TRIDENT tyres of a size which is particularly suitable for taxis. The same tyres are also sold for use on vintage cars and private cars. Mr Heywood also comments on a number of aspects of the applicant's evidence. However, I do not find these comments of assistance in determining the case.

16) The second witness statement, dated 5 November 2002, is by Paul Hocken the Northern Sales Manager of Jet Tyres Limited. He states that his company has sold tyres with the mark TRIDENT since 1992. He states that his company has nine outlets and also sells to over 500 other tyre outlets throughout the UK. He states that in the year 2000 his company purchased from Dunlop over 7,000 tyres branded TRIDENT, and has since 1997 purchased more than 52,000 such tyres.

17) The third statement, dated 5 November 2002, is by David John Rickard the proprietor's Trade Mark Attorney. He provides copies of correspondence; e-mails with his clients and contemporaneous notes. However, I do not regard the information provided of any assistance in my decision.

APPLICANT'S EVIDENCE IN REPLY

18) The applicant filed three witness statements. The first dated, 4 March 2003, is by Mr Majzub who provided an earlier statement. He contends that the proprietor makes only one size of tyre, 175R16, which he maintains is only suitable for taxis. He states that classic cars use imperial sizes. At exhibit JM7 he provides a photograph of a Trident tyre manufactured by Dunlop which shows the word TRIDENT in large letters with beneath, in very small print, the words Provincial taxi. Mr Mazjub also claims that the advertisements provided by the proprietor show the tyres being marketed as TRIDENT TAXI NEW.

19) At exhibit JM8 Mr Mazjub provides a copy of the Federation Internationale de l'Automobile (FIA) Invitation to Tender for Supplying Tyres. He states that the FIA organise the majority of car rallies and race meetings for classic cars and that most classic car owners aspire to take part in these events. The document states that the tyres cannot contain Rayon, and the proprietors' tyres do contain, by their own admission, this substance. Therefore, anyone using these tyres would not be able to participate in FIA organised events. He therefore disputes whether the proprietors' tyres have been sold to owners of vintage or classic cars.

20) The second statement, dated 27 February 2003, is by Mr Grogan who provided an earlier statement. He repeats his contention that the proprietor has used the mark only on tyres for taxis. He claims that the size of tyre, 175R16, is specific to taxis. At exhibit RJG1 he provides a copy of a Dunlop dimensional data sheet and a sales leaflet, both of which identify this size of tyre as suitable for taxis. Other sections in the leaflet are for Avans, Acars and Acars & vans. There also appear to be Asportier and Aoff-road tyres.

21) At exhibit RJG2 he provides a copy of an extract from the ETRTO Standards Manual of 1998 which lists all standard tyre sizes. There is no mention of a size 175R16. Mr Grogan states:

It is my belief that the only source of taxi tyre regulation is the Public Carriage Office which is administered by the Lord Mayor's Office. The omission of 175R16 from the ETRTO Standards Manual means that it does not come within the scope of that organisation which sets the tyre standards for Europe and the ETRTO overrides the BSI.

22) Also at exhibit RJG2 is a copy of an extract from the BSI Tyre Data sheets for radial ply tyres. The size 175R16 is not listed as a standard tyre.

23) The applicant also filed a statement, dated 24 February 2003, by James Gray. However, nothing in this statement is of assistance in reaching my decision.

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

DECISION

25) At the hearing Counsel for the registered proprietor stated that there was a typing error in one of the witness statements filed on his client's behalf. In the witness statement of Paul Hocken, dated 5 November 2002, Mr Hocken stated at paragraph 6:

Since 1997 Jet has purchased more than 52,000 tyres from Dunlop Tyres Limited branded with the trademark TRIDENT on the sidewall.

26) Mr Brandreth stated that the reference to 1997 was incorrect, it should have read 1992. The applicant did not comment on this amendment. In my view it does not prejudice the applicant.

Therefore, I accept the amendment and will use the amended date in my decision.

27) The ground of revocation is based on Section 46(1)(b) which reads:

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

(a)....

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

28) The application for revocation was filed on 15 January 2002. Therefore the period in question is 15 January 1997 - 15 January 2002.

29) 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:

A100. 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.@

30) 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 Agenuine@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:

A29. 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 Agenuine@use. There is no lower limit of Anegligible@. 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 Acolourable@or Atoken@, 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*.@

31) 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 40 - 42:

A40. Use of the mark may also in certain circumstances be genuine for goods in respect of which it is registered that were sold at one time but are no longer available.

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

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

32) 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,®

33) The relevant facts before me are as follows:

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

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

35) The applicant sought to have the specification restricted to taxi tyres as they contended that all the tyres produced and sold were of a certain size (175R16) which is specific to taxis. The registered specification is for Tyres for land vehicles; inner tubes and valves, all for the aforesaid tyres; all included in Class 12.

36) In *Premier Brands UK Limited v Typhoon Europe Limited* (Typhoon) [2000] FSR 767 Mr Justice Neuberger stated:

Mr Arnold raised the question as to how Section 46(5) is to be applied once one concludes, as I have done in relation to the >276 Mark, that it has been used in respect of some of the items for which it is registered, but not in respect of others. It appears to me that one simply looks at the list of items on the register and asks oneself, in relation to each item, whether or not the mark has been used in relation to or in connection with that item during the past five years. If the answer is in the affirmative, then the mark can remain registered in respect of that item; if the answer is in the negative then, subject to any question of discretion, the registration is revoked in respect of that item. One does not dig deeper and, as it were, narrow a particular category of item to reflect the extent of the goods to which the mark has been used. Thus if the only domestic ... container in connection with which the mark had been used was a red tea caddy, it seems to me that the registration should remain in respect of domestic containers: it should not be cut down to, for instance containers for food, containers for tea, tea caddies or red tea cadies.

37) I also look to the comments of Jacob J in the case of *Pomaco Ltd v Reed Consumer Books Ltd* [2000] FSR 734 where he said:

Neuberger J's attention was not drawn to the decision of Laddie J in *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850. Laddie J was concerned with a very wide specification of goods: computer programs. In rejecting an application for summary judgement, he took the view that the wide specification could be cut down by a non use attack. In other words, that computer programs could be limited to computer programs of a particular part.

I have no doubt that what Laddie J assumed was right and in this respect I differ from Neuberger J. The problem is that some of the language for specifications of goods is apt to be extremely wide. Indeed, printed matter in this case is extremely wide. I think it is inevitable that at times one would have to dig deeper. Even taking the specification considered by Neuberger J for a domestic container, one can think of quite different sorts of domestic container: a hat box, a snuff box, a jewellery box, a plastic thing you put in the fridge. Wide words can cover what are commercially quite different sorts of articles. So if one were to show use for just one of that sort, it would be commercially nonsense to maintain the registration for all goods caused by the wide words.

That is not to say the court will cut the registration right down to things like red tea

caddies. But if non use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the specification.@

38) In a more recent case, Aldous LJ in *Thompson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32 stated:

¶In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.@

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

¶Tyres for land vehicles in Class 12.@

40) The revocation has only been marginally successful. The registered proprietor sought costs above the scale as it was contended that the action was unarguable following details provided by the proprietor's Trade Mark Agent in February 2002. It was also suggested that the evidence filed was such that the revocation action should have been dropped or at least amended to refer only to the ground relating to the reduction of the specification. Mr Brandreth suggested that the revocation action had been maintained as a Atactical chip in the bargaining scenario@. I do not accept these contentions, to my mind the evidence provided by the proprietor was not convincing until it filed a statement from the independent witness. Even then in its pre-amended form it posed questions as the number of tyres said to have been purchased was greater than the number stated to have been produced. It was only at the hearing that this issue was resolved, which then left a clear statement of use of the mark in suit.

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

the apparent conflict in the proprietor's evidence were resolved and then it could be seen that the proprietor had indeed, shown use of its mark. To my mind the proprietor could and should have provided unequivocal evidence of use, such as invoices in its evidence in chief. For these reasons I therefore decline to award costs in this case. The applicant has twenty-eight days from the date below to appeal against this decision.

Dated this 23rd day of April 2004

George W Salthouse
For the Registrar
the Comptroller-General