

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATIONS
NOS. 1106682 AND 1106683 IN THE NAME
OF MILLET SA**

AND

**IN THE MATTER OF CONSOLIDATED APPLICATIONS
FOR REVOCATION AND DECLARATIONS OF INVALIDITY
(NOS. 8609 AND 8608) BY MILLETS LEISURE LIMITED**

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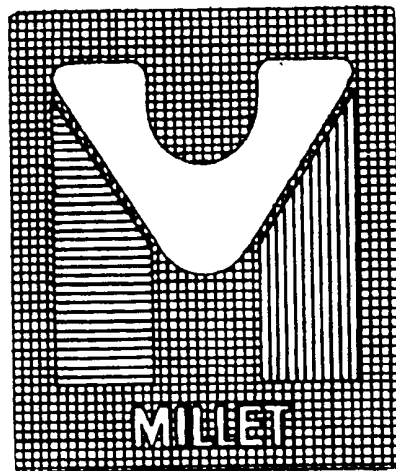
DECISION

Trade marks No. 1106682 and 1106683 are registered respectively for the following specifications of goods:

Class 18 - Articles of luggage

Class 25 - Articles of outer clothing, articles of sports clothing; gaiters and leggings, all being articles of clothing.

The mark as advertised in each case is as follows:



The registration details indicate that “the trade mark is limited to the colours black, white, blue and red as shown in the representation on the form of application”.

For ease of reference in what follows I also reproduce below the mark in its colour form:-



The registrations stand in the name of Millet S.A.

By applications dated 10 August 1995 Millets Leisure Ltd applied for revocation of, or declarations of invalidity in respect of, these registrations.

The grounds in each case are:

- (i) under Section 47(2) in that the applicants have an earlier right in relation to which the conditions set out in Section 5(4) apply (in particular they refer to the law of passing off)
- (ii) under Section 46 in that “within a period of 3 months prior to the filing of this application there has been a consecutive period of five years during which the proprietors of the registration had not used the trade mark”. Furthermore it is said that there has been no use of a similar mark or use with the consent of the proprietor and no proper reason for non-use.

The registered proprietors filed counterstatements denying the above grounds. I note that they interpret the Section 46 ground as being in relation to an alleged non-use period of five years up to three months before 9 August 1995. They put the applicants to proof in relation to their claim to an earlier right and use of the trade mark MILLETS. Both sides ask for an award of costs in their favour. The cases were consolidated and both sides filed evidence.

The matter came to be heard on 29 April 1999 when the applicants were represented by Mr J Groom of Trade Mark Owners Association Ltd, Trade Mark Attorneys and the registered proprietors were represented by Mr R Sullivan of Counsel, instructed by Swindell & Pearson, Trade Mark Attorneys.

Applicants' Evidence

5 The applicants filed two statutory declarations. The first dated 13 September 1996 comes from Stephen A Keith a Director of Probe International, a private investigation company. He says that he was asked by the applicants' trade mark agents to conduct enquiries aimed at ascertaining whether the mark M MILLET (logo) of Societe Nouvelle Millet was in use in this country. Enquiries with Companies House and British Telecom failed to reveal any company of that name. Further enquiries established that the address of a company called Millet S.A. was the same as Societe Nouvelle Millet. He records his findings as follows:

10 "I contacted Millet S.A. by telephone and found that the company specialises in Alpine outdoor clothing such as mountaineering clothing and ski clothes. I found that the company also sells rucksacks.

15 I established that Millet S.A. does use the trade Mark M MILLET (LOGO) in the course of its business.

20 I ascertained that Millet S.A. is French owned and operated but most of the sales made by the company are in countries other than France. Given that Ian Wilkes had asked me to establish whether M MILLET (LOGO) was in use in the UK specifically, I made suitable enquiries along these lines. I was told that no use was presently being made, but that "in the past month" a UK based company had been appointed with a view to making future sales in the UK. I was told that the UK company in question was 105 Degree Meridian Limited (hereinafter referred to as "105 Degree")."

The remainder of his declaration deals with contacts made with 105 Degree and is not directly relevant to the issues before me.

30 The second declaration, dated 29 January 1997, is by Mark O'Keefe, the Company Secretary of Millets Leisure Ltd. His declaration is in essence a history of the Millets business which originated in about 1894. For reasons which will become apparent I do not propose to record the content of his declaration in detail.

Registered Proprietors' Evidence

40 Three affidavits have been filed by Phillipe Joffard the President of Millet S.A. under Rules 31(3), 13(5) and 13(7). Mr Joffard has been associated with the company since 6 February 1995, has access to the records of the company and is familiar with the English language. In his first affidavit dated 5 March 1996, he confirms that Millet S.A. are the successors in title to Societe Nouvelle Millet and that the mark at issue has been used continuously in this country since around 1960 and up to three months before 9 August 1995. He exhibits (PJ) copies of invoices showing use of the mark.

45 The purpose of his second affidavit, dated 24 June 1997, is to exhibit

PJ2 - copies of catalogues distributed in the UK showing goods offered for sale under the mark or with a mark which it is said differs in elements which do not alter the distinctive character of the mark in the form in which it was registered

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PJ3 - sample labels used on goods sold in this country by the company or its predecessor in title until 1992. After 1992 the mark is said to have been used with the word MILLET arranged vertically at the side of the M device. For ease of reference and illustration exhibit PJ3 is reproduced at Annex A and the variant form of the mark used after 1992 is shown at Annex B.

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The third declaration dated 16 December 1997 confirms or clarifies two points. Firstly that the references to SN Millet on the invoices at PJ1 and the brochures at PJ2 are references to Societe Nouvelle Millet, the letters SN being an abbreviation of Societe Nouvelle. Secondly it is said that Societe Nouvelle Millet used the marks shown in PJ3 in the United Kingdom in respect of goods covered by the above registrations from 1990 until 1992.

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Mr Groom, for the applicants, helpfully indicated in advance of the hearing that he was not intending to pursue the ground based on Section 47(2). I need, therefore, say no more about this particular ground.

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The registered proprietors made a late request to file two further pieces of evidence, these being another affidavit by Mr Joffard and a statutory declaration by George Gordon Davison. The question of the admittance of this evidence was dealt with as a preliminary point. After hearing submissions from both sides I decided to admit Mr Joffard's affidavit (save for paragraphs 4 and 5 which relate to the ground which has been dropped from the proceedings). His evidence clarifies the matter of the transfer of the business of S.N. Millet to Millet S.A. and provides a copy of the assignment certificate relating to the registrations at issue. It also provides supplementary invoice etc. evidence for the relevant period. Although this evidence was filed late in the proceedings I do not think admitting it results in any significant prejudice to the applicants and it is relevant to the issues before me. I decided not to admit Mr Davison's declaration. This introduces new material without any proper explanation as to why it could not have been brought forward at an earlier date. It provides information and a view on the issue of the distinctive character of the mark (for Section 46(2) purposes) by reference to what Mr Davison claimed to have known about other marks in the UK. In my view the latter point stood little chance of assisting me to come to a view on the Section 46(2) issue and, if it were to be considered, would have necessitated allowing the applicants to respond with evidence of their own.

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Section 46 of the Act reads as follows:

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

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- (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;

- 5 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- 10 (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;
- 15 (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.

20 (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.

25 (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:

30 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.

35 (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
- 40 (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

45 (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-

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- (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 of this Act is also relevant and 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”.

15 It is common ground between the parties that the relevant period for the purposes of these proceedings is the five years from 9 May 1990 to 9 May 1995. Although the registered proprietors have not attempted to quantify their overall level of trade in this country during this period it is not disputed that a trade has taken place and I confirm that that is also my view of the matter having regard to

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- S the existence of a distributor (Camping Gaz) up to 1994
 - S the existence of brochures referring to the above distributor and containing English language text
 - 25 S a large volume of copy invoices, a substantial proportion of which fall within the period

30 It is also accepted that the trade that has taken place is genuine in the sense, I think, that it is not token activity simply to preserve the registrations. The essence of the applicants’ case is that none of the marks used is the same as the mark as registered and, for the purposes of Section 46(2), is not “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”.

35 Before considering the submissions and evidence in relation to this point I should comment briefly on Mr Groom’s point that the registered proprietors, in their counterstatement, had claimed to have used the mark as registered. In other words they had not clearly indicated that they intended to rely (in whole or in part) on use of a mark within the meaning of Section 46(2). I note that Section 46(2) commences with the words “For the purposes of Section 40 46(1)”. It is perhaps arguable, therefore, whether a formal claim needs to be made. It might well have been in the registered proprietors’ interest to put the matter beyond doubt by expressly making the claim. As matters stand they have denied the applicants’ stated ground which includes the claim “nor had there been use of any trade mark similar thereto” but made no positive counter claim of their own. Whatever the demerits of this approach, Section 46(2)

appears to be in the nature of a defining provision that determines what can constitute use of a trade mark. As such it can be said to operate automatically without the need for a registered proprietor to expressly plead reliance on the provision. I, therefore, proceed on the basis that the registered proprietors' position under Section 46(2) is part of the case to be considered.

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I have attached at Annex A a copy of Exhibit PJ3 to Mr Joffard's second affidavit showing samples of labels used on goods sold in this country until 1992. In fact even that selection does not tell the full story. Other variations on the theme can be found in the evidence filed. For instance the invoices in Exhibit PJ show use of the M device with the words S.N.

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MILLET. It is debatable whether in the context S.N. MILLET would be seen as the company name (SN being Société Nouvelle) or part of a composite mark. On balance (and despite a more prominent typeface than the accompanying address) I doubt that it would be seen as part of the mark.

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I was referred to a number of reported cases in terms of the approach I should adopt. Mr Groom, for the applicants referred me to Neutrogena Corporation and Anr v Golden Ltd and Anr, 1996 RPC 473 and in particular the following passage from Jacob J.

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"I think there is a significant difference between Neutralia and Nutralia. First I think that some may pronounce them differently (with "Nut-" as in "hazel-"). But much more significantly, the visual impression is different, which matters a lot because the products are bought mainly by self-service. And the message conveyed is different too. "Nutr-" conveys the notion of "nutrition". So the notion of feeding the skin or the hair is conveyed by Nutralia which is not so in the case of Neutralia. Moreover the reference to neutrality is lost. These are important differences. "Not substantially affecting its identity" means what it says, both in this section and in other sections of the Act (e.g. section 35). An alteration which affects the way a mark is or may be pronounced, or its visual impact or the idea conveyed by the mark cannot satisfy the test. I am confirmed in my opinion by the fact that the plaintiffs have made it clear they would be content if the Neutralia were changed to Nutralia but Garnier are unwilling to make the change. Why, if the change would have no substantial effect? The question only admits of one answer - the change is seen as significant."

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Neutrogena v Golden was a trade mark infringement and passing off case and the above remarks must be read in that context as well as the fact that the proceedings were under the preceding law, the Trade Marks Act 1938 (the circumstances were that the defendants had a registration of NUTRALIA and the question arose as to whether use of NEUTRALIA was equivalent to use of the registered NUTRALIA for the purposes of a defence under Section 4(4) of the 1938 Act). The wording of Section 46(2) is based on Article 10(2) of the Directive (89/104/EEC) so comparison with the old law and particularly different sorts of actions under that law must be approached with caution notwithstanding some underlying similarities of approach. Of rather more direct relevance is the following passage relied on by Mr Groom from ELLE Trade Marks, 1997 FSR 529 where the proprietors had registrations of "elle" in lower case letters in the middle of a circle with a cross off the circle bottom right (the scientific symbol for the female gender). Mr Justice Lloyd said:-

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“..... one comes back to the question whether, by omitting the device and by converting the four letters of the word from lower to upper case, something has been done which alters the distinctive character of the mark from the registered form. In my judgment it has. It seems to me that the device is at least as much what makes the mark distinctive as the word. The use of the word alone and in capitals does alter the distinctive character of the mark, in my judgment, in a significant and substantial way. Therefore, although I do not proceed by analogy with section 41, I agree with the decision of Mr Knight on this point and without having to consider the position as regards disclaimer.”

Mr Sullivan, for the registered proprietor, referred me to re CLUB and CLUB SODA an unreported Registry decision (SRIS No. 0-230-98) and Levi Strauss & Co v Shah and Another, 1985 RPC 371. The latter, like Neutrogena v Golden was under the preceding law and involved an infringement action and counter claim for rectification. The proprietor successfully defended their tab device registration notwithstanding that the tab was used in connection with the word LEVI'S. Again, therefore, the circumstances were different and in some respects the reverse of the position in the proceedings before me in as much as one of the issues I have to consider is whether use of the M device on its own (without the word MILLET) brings the proprietors within Section 46(2). I do not, therefore, draw much assistance from the Levi's case.

I regard the evidence as establishing

S some use of each of the marks shown in Annex A up to 1992 on or in relation to the goods at issue

S use of the mark at Annex B after 1992 in relation to a similar range of goods

S use of the forms of the mark at (i) and (ii) of Annex A, which are self evidently closest to the mark as registered, appear to be quite limited but can be seen on page 15 of the 1992 brochure and page 7 of the 1993 brochure

S after 1992 the M device with the word MILLET running vertically to the right hand side is the dominant mark used and features on the front cover of the 1993 and 1994 brochures as well as on the goods depicted in those brochures

S the invoices at Exhibit PJ show use of the M device with the company name

S the invoices at Exhibit PJ7 also show use of the Annex B mark along with catalogue pages to show the link between the catalogue number and the invoices.

Turning to the marks themselves I take the view that versions (iv) and (v) of the sample labels at Annex A are so obviously different to the mark as registered that they cannot fail to alter the distinctive character. They are overwhelmingly word marks with the M device subsumed within them, significantly reduced in impact and not picked out in its three colour form. Version (iii), the M device on its own, consists of one of the elements of the mark as

registered (arguably the strongest element) but I do not think it can be said to qualify for the purposes of Section 46(2). Moreover it would be difficult to reconcile acceptance of this mark for Section 46(2) purposes as being consistent with the ELLE decision which also involved a 'missing' element. The test is not whether the single most distinctive element is present but whether the distinctive character of the mark in the form registered has been altered. Omitting the word MILLET can hardly be said to leave the distinctive character unaltered.

Versions (i) and (ii), albeit that the word MILLET is slightly larger than the registered form, unquestionably qualify for the purposes of Section 46(2). However, as noted above the use of this form is relatively thin. There are some parallels with the ELLE case where it was said that offers for sale through foreign editions of a magazine would not fail to qualify for the purposes of Section 46 by reason of the fact that there was no evidence of actual sales during the relevant period. It might, therefore, be said that on the narrow basis of the few illustrations of goods bearing these versions of the mark in the 1992 and 1993 brochures that the registered proprietors should succeed. However no circulation figures have been given for the brochures and it is difficult to establish a link with the invoice evidence. Mr Sullivan referred me to ZIPPO Trade Mark, 1999 RPC 173 where it was said, having regard also to BON MATIN, 1989 RPC 537, "..... where, as in this case, it is established that a mark has been used, and the genuineness of such use is not in question, detailed consideration of the substantiality of that use serves no purpose." Even so bearing in mind the onus under Section 100 the registered proprietors can at best be considered to have established a weak defence based on this particular usage. Certainly their case is not so convincingly made that I do not need to consider the aspect of their claim based on the version of the mark used after 1992 (the Annex B mark). There is rather stronger evidence that this mark has been used. Not only does it appear on the front cover of the brochures (as a house mark as it were) but it is also used more consistently on individual goods items. Allied to this the invoices at PJ7 also show this mark (I infer from the photocopied invoices that the originals were in colour). I note also in passing that the invoices from 1994 relate to a period when Camping Gaz was no longer the recognised UK distributor and a replacement had yet to be appointed. This confirms that a UK trade was still taking place.

The registered proprietors are thus in a much stronger position if I accept that this version of the mark qualifies for Section 46(2) purposes. The principal elements of the mark as registered are the stylisation of the M device, the colours in which it is presented and the word MILLET. Clearly all these elements are in the Annex B mark. It is nevertheless possible to envisage circumstances where other factors come into play which might be said to alter the distinctive character of the mark as registered - use of an unusual script for instance or the way elements of a mark are configured. Does the different orientation of the word MILLET have that effect here?

I take the view that simply rotating the word MILLET through ninety degrees and placing it to the right of the M device does not alter the distinctive character of the mark. It is by no means unusual in advertising to alter the orientation of words. Just conceivably such a change or a combination of such changes might have an effect on the character of a weak mark but I do not think that can be said to be the case here. I, therefore, find that registered proprietors have used their mark within the meaning of Section 46(2).

5 Although the specifications set out at the start of this decision employ broad terms the applicants' attack is not so far as I can see focussed on any particular items. Having regard to the evidence filed I consider the specifications to be a reasonable reflection of the range of goods offered for sale. It is true that the Class 18 goods are primarily rucksacks but other types of bags and luggage are available. For instance page 26 of the 1994 brochure shows a range of holdalls and suitcases bearing the mark.

10 As the registered proprietors have successfully defended their registrations they are entitled to a contribution towards their costs.

15 Taking all the circumstances of the case and the submissions on costs into account I order the applicants to pay the registered proprietors the sum of £870 in respect of these consolidated proceedings.

Dated this 19 day of May 1999

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25 **M REYNOLDS**
For the Registrar
The Comptroller General



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