

TRADE MARKS ACT 1938 (AS AMENDED)

**IN THE MATTER OF APPLICATION No 1372540
BY REVLON SUISSE SA
TO REGISTER A TRADE MARK IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No 30883
BY REVILLON**

TRADE MARKS ACT 1938 (AS AMENDED)
IN THE MATTER OF Application No 1372540
by Revlon Suisse SA
to Register a Trade Mark in Class 25

and

IN THE MATTER OF Opposition thereto under No 30883
by Revillon

BACKGROUND

1. On 1 February 1989 Revlon (Suisse) S.A. of Adliswil, Switzerland, applied to register the trade mark REVLON. After examination the application No. 1372540 proceeded to advertisement for a specification of goods which reads as follows:-

Articles of clothing, belts, scarves, shawls; all for women or girls; all included in Class 25.

2. On 24 February 1992 Revillon of Croissy-Beubourg, France, filed notice of opposition. The grounds of opposition were, in summary, as follows:-

- (i) under the provisions of Section 12 of the Act because the applicants' trade mark (and goods), so nearly resemble the REVILLON trade marks (and goods) the subject of the opponents registrations. These are shown at Annex A
- (ii) under the provisions of Section 11 because, as a result of the use by the opponents of their REVILLON trade marks, any use by the applicants of their trade mark in respect of the goods covered by the specification of the application for registration is liable to cause deception and confusion
- (iii) under Section 17 of the Act because the applicants cannot be regarded as proprietors of the trade mark REVLON in view of their presumed knowledge of the opponents' trade mark
- (iv) the opponents also ask for the exercise of the Registrar's discretion in their favour.

3. The applicants filed a counterstatement in which they admitted that the opponents are the proprietors of the trade marks set out in the Annex but denied the opponents' allegations. Both sides sought an award of costs in their favour and both sides filed evidence.

4. Negotiations between the parties ran in parallel with the filing of evidence and extensions of time for filing evidence and to facilitate a settlement were granted. Indeed a Hearing on the substantive issues was due to be held on 9 February 2001 but representatives from both sides,

Ms Fiona Clark of Counsel, instructed by Grant Spencer Caisley & Porteous, on behalf of the applicants, and Mr Michael Edenborough, instructed by Mewburn Ellis on behalf of the opponents persuaded me to stay proceedings for a period of one year in order that negotiations with the aim of reaching an amicable settlement could be completed. No settlement was reached and the matter came to be heard on 5 February 2002. At that Hearing the applicants were represented by Ms Fiona Clark, the opponents were neither present nor represented but I had a skeleton argument prepared by Mr Edenborough in connection with the earlier hearing.

5. By the time the matter came to be decided, the Trade Marks Act 1938 (as amended) had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly all references in the later parts of this decision are references to the provisions of the old law.

DECISION

6. By the time this matter came to be heard there had been a substantial change in the circumstances of the opponents. This stems from the fact that the four trade mark registrations upon which the grounds of opposition based upon Section 12 of the Act are based have now been removed from the Register. In a Witness Statement dated 8 February 2002, Claire Christine Hutchinson, a Trade Mark Attorney acting on behalf of the applicants for registration stated as follows:-

- "3. Revillon relied upon four United Kingdom trade mark registrations in support of its opposition under Section 12 of the Trade Marks Act 1938. Those registrations were United Kingdom trade mark registration numbers 1311073, 1296426, 547644 and 547643. At some point following the opposition registration numbers 547643 and 547644 were merged the surviving registration being registration number 547644.
4. On 8 February 2001 we filed applications to revoke each of the registrations mentioned in paragraph 3. The Registrar issued Decisions revoking all three registrations on 10 July 2001. Copies of each of those decisions appear at Exhibit CCH 1 to my statement. No appeals were filed with regard to the applications to revoke the registrations and we were notified on 5 September 2001 that the decisions had been implemented. Exhibited hereto marked CCH 2 are extracts from the Trade Mark Registry website records reflecting that each of the three registrations has been revoked."

7. At the Hearing on 5 February, Ms Clark drew to my attention POLYMAT trade mark [1968] RPC 124 in which Mr G W Tookey Esq, acting as the Secretary of States' Tribunal

Held, (1) that although by section 19(1) of the Act a mark was deemed registered as of the date of application for registration, nevertheless both the practice of the Registry and authority condoned the acceptance of marks for registration where an objection to

registration under section 12 was removed between the date of application and the date of actually entering the mark on the register.

8. Applying that decision to the facts of this case it means that the objection to this application for registration based upon Section 12 of the Act is now removed because although these earlier registrations were effective at the date of application they are no longer a barrier now that the registration of this application has come to be finally determined. The objection therefore under Section 12 (1) of the Act is dismissed.

9. As far as the objection based upon Section 11 is concerned there was some indication from the evidence of the opponents that their trade mark was in use in the United Kingdom at the date of application in this case. However, I am not satisfied that the amount of use was in anyway significant and it is not wholly clear from the opponents' evidence on what goods the trade marks in question had been used. In relation to Section 11 the law is settled and has been succinctly formulated by Evershed J in *Smith Hayden & Co Limited's application* (1946) 63 RPC 97 at 101 (as modified by Lord Upjohn in *Bali* [1969] RPC 472 at 496 . Adapted to the case here the test reads

"Having regard to the use of the trade mark REVILLON, is the Court satisfied that the mark applied for, REVLON, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

10. Given my comments above about the lack of focus to the evidence, I do not consider that use by the applicants of their trade mark is likely to cause deception and confusion amongst a substantial number of persons. And as the opponents did not defend their registrations against the application for revocation on the grounds of non-use by the applicants, I can only assume that whatever use they may have made in the past of these trade marks, there has been no such use in the last five years thus there is no residual reputation upon which the opponents rely. In all of the circumstances, my finding is that the ground of opposition based on Section 11 is not made out and that ground of opposition too is dismissed.

11. There was no evidence submitted as far as I could see in support of the ground of opposition based upon Section 17 and there is no need, or justification, for the exercise of the Registrar's discretion on behalf of the opponents in this matter.

12. The opposition to this application for registration is dismissed. The applicants are therefore entitled to an award of costs in their favour. I order the opponents to pay to the applicants the sum of £600. This sum is 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 26 day of March 2002

M KNIGHT
For the Registrar
the Comptroller-General

ANNEX A

<u>Number</u>	<u>Mark</u>	<u>Class</u>	<u>Specification</u>
1311073	REVILLON	14	Goods made of precious metals or coated therewith; jewellery; horological and chronometric instruments; all included in Class 14.
1296426	REVILLON	09	Optical apparatus and instruments; spectacles, sunglasses and spectacle frames; cases for spectacles and for sunglasses; parts and fittings for all the aforesaid goods; all included in Class 9.
547644	REVILLON	18	Furs, not made up.
		25	Fur coats, furs made up for wear and fur muffs; and coats, capes, cloaks and gloves (being articles of clothing) all trimmed or lined with fur.
547643	REVILLON	18	Furs, not made up.