

O-191-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF**

**APPLICATION No. 81513**

**IN THE NAME OF YORK TRAILERS LTD**

**FOR REVOCATION OF**

**TRADE MARK REGISTRATION No. 2024099A**

**IN THE NAME OF DENNISON TRAILERS LTD**

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**DECISION**

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1. The following trade mark was registered under number 2024099A with effect from 16 June 1995 for use in relation to *'Motor vehicle trailers and semi-trailers; parts and fittings for the aforesaid goods'* in Class 12:



The procedure for registration was completed on 14 November 1997.

2. The registration was initially owned by Utility International Ltd, a company associated with Wordsworth Holdings Plc. Dennison Trailers Ltd (**‘the Respondent’**) acquired the trade mark and associated goodwill from the liquidators of Utility International Ltd in November 2002. The transfer of the trade mark to the Respondent was recorded in the register of trade marks in December 2003.

3. On 11 November 2003, York Trailers Ltd (**‘the Applicant’**) applied for revocation of the registration of the trade mark under sections 46(1)(a) and (b) of the Trade Marks Act 1994. These sub-paragraphs provide for revocation of the registration of a trade mark if:

- (a) 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) such use has been suspended for an uninterrupted period of five year and there are no proper reasons for non-use.

4. In accordance with section 46(6) of the Act, 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 the court is satisfied that the grounds for revocation existed at an earlier date, that date.

The date of the application for revocation is taken to be the relevant date for revocation in the absence of a clearly formulated request for revocation from an earlier date Omega SA v. Omega Engineering Inc [2003] FSR 49, p.893 (Jacob J).

5. In the present case, it was pleaded on behalf of the Applicant that:

In the event that the Registrar holds that the registration is liable to be revoked under the provisions of Section 46(1)(a) of the Act, the Applicant asserts that the rights of the proprietor should be deemed to have ceased to exist as from 15 November 2002 (the day following the expiry of the 5 year period as determined by Section 46(1)(a) of the Act) as provided for under the provisions of Section 46(6)(b) of the Act.

However, the request for revocation under section 46(1)(a) was subsequently abandoned.

6. No date earlier than the date of the application for revocation was specified in relation to the request for revocation under section 46(1)(b). On the basis of the pleadings as they currently stand, the Applicant must be taken to have requested revocation under section 46(1)(b) with effect from the date of the application for revocation (11 November 2003) in accordance with the approach adopted by Jacob J. in Omega.

7. In defence of the registration, the Respondent pleaded that the trade mark had been used (including use in a form differing in elements which did not alter the distinctive character of the mark in the form in which it was registered) across the full width of the specification of goods for which it was registered. The use in

question was alleged to have been use by or with the consent of the proprietor of the trade mark during the period of 5 years envisaged by the request for revocation under section 46(1)(b).

8. The burden of substantiating these propositions was upon the Respondent in accordance with section 100 of the Act. Section 100 specifies that:

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.

9. Consistently with that approach to the burden of proof, an application for revocation under section 46(1)(a) or (b) may be treated as unopposed under rule 31(3) of the Trade Marks Rules 2000 if the proprietor of the registration does not, within the period of 3 months from the date on which the application for revocation was sent to him by the Registry, *'file a counter statement, in conjunction with notice of the same on Form TM8 and either: (a) two copies of evidence of use made of the mark; or (b) reasons for non-use of the mark'* as required by rule 31(2).

10. The purpose of rule 31(3) is to allow the Registrar to make an order for revocation if it does not appear from information provided in the manner prescribed by rule 31(2) that the proprietor has a viable defence to the pleaded allegation(s) of non-use. If it appears from the information provided that the proprietor does have a viable defence, the application for revocation should be determined on its merits at the conclusion of the adversarial procedure envisaged by rules 31(4) to 31(10):

- (4) Within three months of the date upon which a copy of the Form TM8 and counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.
- (5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.
- (6) If the applicant files evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such further evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.
- (7) Within three months of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence; and shall send a copy thereof to the proprietor.
- (8) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.
- (9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

- (10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

11. In the context of rule 31 as a whole, it is clear that allegations of non-use cannot be treated as unopposed under rule 31(3) if they have been opposed in the manner prescribed by rule 31(2) and thereby met with a defence which, although it might be contestable, cannot be regarded as unviable. It is implicit in rules 31(4) to 31(10) that contestability is consistent with acceptability under rule 31(2). The precondition for exercise of the discretionary power conferred by rule 31(3) is non-compliance with the requirements of rule 31(2), nothing more and nothing less.

12. In the present case the Applicant called on the Registrar to treat the application for revocation under section 46(1)(b) as unopposed under rule 31(3) on the ground that the Respondent had filed a '*counter-statement in conjunction with notice of the same on Form TM8*' with evidence that was too insubstantial to constitute '*evidence of use made of the mark*' for the purposes of rule 31(2). A hearing was appointed to consider whether the Respondent was in default under rule 31(2) and, if so, what the sanction should be. The hearing took place on 21 July 2004 before Ms. Ann Corbett acting on behalf of the Registrar.

13. In a written decision issued on 29 October 2004 the Hearing Officer reviewed the evidence filed on behalf of the Respondent and found it to be deficient:

Taking the evidence in its entirety and having subjected it to individual attention, I am unable to agree with [Counsel's] submission that I can infer from the evidence that the mark had been used within the relevant period. Neither does the evidence clearly indicate that a proper defence is and can be mounted to the allegation that the trade mark has not been used.

She went on to decide that no good reason had been shown for allowing the proceedings to continue in the exercise of the discretion available to the Registrar under rule 31(3). In conclusion she held that:

The evidence required to satisfy the requirement of rule 31(2) should be sufficient to demonstrate that a defence of the trade mark can be mounted. I determined that no such evidence has been filed in this case. Given that there were no proper reasons for non-use claimed and having found that there was no justification for the exercise of discretion under rule 31(3) the consequences are clear. I determined that the opposition to the application for revocation would be treated as withdrawn.

14. The Respondent appealed to an Appointed Person under section 76 of the Act contending, in substance, that the Hearing Officer was mistaken in thinking that no acceptable '*evidence of use made of the mark*' had been filed under rule 31(2) and was also mistaken in thinking that there were no good reasons for allowing the revocation proceedings to continue in the exercise of the discretion conferred by rule 31(3).

15. At this point it is necessary to refer to the evidence tendered by the Respondent under rule 31(2). This consisted of a witness statement of James

Dennison with 12 exhibits dated 17 February 2004 and a witness statement of Terry Brayshaw with 1 exhibit also dated 17 February 2004.

16. Mr. Dennison is the Managing Director of the Respondent. He gave evidence in the following terms:

1. I presently hold the position of Managing Director of Dennison Trailers Limited of Caton Road, Lancaster, LA1 3PE, a position I have held since February 1998. Dennison Trailers Limited (hereinafter referred to as “my company”) is a leading manufacturer of commercial vehicle semi-trailers and my Company operates across the whole of the United Kingdom. I make this declaration from the facts and matters within my knowledge or from the records of my company to which I have full access.

There is now produced and shown to me marked Exhibit JD1, a copy of the audited accounts of Dennison Trailers Limited for the year ending December 2001.

2. My company purchased UK Trade Mark Registration No. 2024099A for the YORK and Leaf Logo from Liquidators of Utility International Limited on 14th November 2002, including all associated goodwill and common law rights associated with the business connected under the trade mark forming the subject of the said Registration.

There is now produced and shown to me marked Exhibit JD2, a copy of the Deed of Assignment dated 14th November 2002 assigning the UK Registration No. 2024099A into the name of my Company.

Registration No. 2024099A was subsequently recorded in the name of my Company at the Trade Marks Registry on 23rd December 2003.

There is now produced and shown to me marked Exhibit JD3, a copy of the Official Assignment Certificate recording Dennison Trailers Limited as the registered proprietors of Registration No. 2024099A.

I understand that the previous owners of Registration No. 2024099A, Utility International Limited were created as a joint venture between Utility Trailer Manufacturing Company of the United States of America and Wordsworth Holdings plc in November 1997 and started trading in early 1998. I understand that Utility International Limited traded under the trade mark forming the subject of Registration No. 2024099A (hereinafter referred to as "The Trade Mark"), amongst other brands, and manufactured and sold trailers and associated parts and fittings under the said trade mark. I understand from Stephen Bennett, who was the Managing Director of Utility International Limited from 1998, that Utility International Limited used the trade mark in relation to trailers throughout 1998 into 1999 and even beyond. I understand from Stephen Bennett that the Trade Mark was used on the Vehicle Identification Numbers, which appeared on the trailers much later than 1999. I understand from Stephen Bennett that a large order was made to Blue Circle Cement of trailers carrying the Trade Mark in 1999.

There is now produced and produced and shown to me marked Exhibit JD4 copies of the audited accounts of Utility International Limited for the years 1998 to 2001, with a copy of a statement of affairs associated to the Winding Up of Utility International Limited in 2002.

There is now produced and shown to me marked Exhibit JD5 copies of correspondence between Stephen Bennett and Mr. John Bright at Blue Circle Industries PLC dating from late 1998 into 1999 which prove that a number of trailers carrying the trade mark costing £14,800 per trailer were sold to Blue Circle Industries in

the early months of 1999. The engineering drawings which were supplied to Blue Circle Industries PLC clearly carry the Trade Mark and the Trade Mark can clearly be seen in the drawings of the trailers to be reproduced on the back of the trailers.

There is also produced and shown to me marked Exhibit JD6 copies of Pre-Order Engineering Request Forms carrying the Trade Mark dating from February 1999 which relate to the Blue Circle order referred to above. I understand D Prescott who is referred to on the Engineering Request Form was the Engineering Manager at Utility International Limited at the time of the Blue Circle order.

There is also produced and shown to me marked Exhibit JD7 an Internal Mail envelope carrying the Trade Mark and a Purchase Requisition Sheet which refers to "York Trailer" and dates from 16th December 1998, which was being used by Utility International Limited at the time and clearly shows the trade mark was being used on Utility International Limited administrative literature at the time.

3. I think it is also important to be aware of what use was made of the trade mark before 1998 and Utility International Limited's acquisition of the trade mark. As I have referred to above Utility International Limited was created as a joint venture between Utility Trailer Manufacturing Company of the United States of America and Wordsworth Holdings plc in November 1997. The previous owners of Registration No. 2024099A were Wordsworth Holdings Limited who originally registered the mark in June 1995. Utility International Limited operated from the same site as Wordsworth Holdings Limited in North Allerton and simply took the business on from Wordsworth Holdings Limited. Therefore, as a result what use the trade mark which went on before 1998 has a bearing the use after the date as Utility International Limited simply continued on with

such use as proved above through 1998, 1999 and beyond.

There is now produced and shown to me marked Exhibit JD8 audited accounts for Wordsworth Holdings plc for the years 1995 through to 1999.

There is now produced and shown to me marked Exhibit JD9 an article dating from 15th April 1998 which refers to “York Trailers” and the change of by Utility International Limited.

There is also produced and shown to me marked Exhibit JD10 a copy of a news bulletin on “Look North” on BBC1 dated 12th January 1998 which shows a clip of the factory which produced York branded trailers on which the Trade Mark can clearly be seen.

There is also produced and shown to me marked Exhibit JF11, a video relating to the five year warranty relating to trailers carrying the trade mark and is typical of the way in which the trade mark has been used since its first introduction.

4. I also know that various companies still provide parts for trailers branded under the trade mark and have done so continuously to my knowledge since 1998 with our consent and the consent of previous owners of the trade mark. An example of this is Stanway Commercials Limited who supply parts for and carry out associated repair and maintenance services for trailers branded under the York and Leaf Device.

There is now produced and shown to me marked Exhibit JD12 copies of extracts from websites of various traders in the UK which sell parts for York trailers.

17. It appears from this witness statement that the trade mark in issue was not alleged to have been used by the Respondent at any relevant time. The defence to

the application for revocation appears to have depended on use by or with the consent of the Respondent's predecessor in title.

18. Within Exhibit JD4 is a Statement of Affairs filed at the Companies Registry by Mr. Christopher Farrington of Messrs. Deloitte & Touche as liquidator of Utility International Ltd. The Statement was filed under rule 4.34 of the Insolvency Rules 1986. It summarised the position with regard to the business, assets and liabilities of Utility International Ltd as at 2 July 2002 and it was verified by an affirmation of Mr. Niall Wordsworth who is identifiable from other documents in the same Exhibit as a director of the company down to the date of the resolution for it to be wound up. In paragraphs 1 to 4 of the Notes forming part of the Statement of Affairs it is recorded that:

1. The Company has operated with a positive cash balance almost consistently since its incorporation. A dormant banking facility was formally cancelled in November 2001.
2. Debtors represent amounts due for sales of trailers and parts prior to July 2002 (£333k) and monies loaned to the joint venture, Stanway Commercials Ltd (£82k). To be prudent a general provision of £40k has been made against sales ledger balances to arrive at the estimated to realise figure.
3. In accordance with a court order obtained pursuant to section 166(2) of the Insolvency Act 1986 the Company, acting by its Liquidator, identified certain items of work in progress which were sufficiently advanced in terms of their manufacture to warrant completion into finished trailers and augment the stock of trailers held at appointment. The estimated to realise figure shown in the statement of affairs represents the amounts the directors consider

could be realised for all completed trailers. The estimate to realise figure **excludes** amounts realisable for the following;

Assembled components and part built trailers not completed. It is considered such disclosure could prejudice the outcome of any subsequent sale.

Stocks of raw materials. Such stocks have been subject to a number reservation of title claims and until these claims have been resolved it cannot be ascertained what quantity of raw materials may be available for disposal.

4. The Liquidator has indicated that plant and machinery together with office furniture and remaining stocks may be disposed of by way of a tender sale. As the estimated realisable could be commercially sensitive with regard to any forthcoming tender sale no estimate has been given for the purpose of drawing up the statement of affairs.

19. Mr. Brayshaw is the Managing Director of Stanway Commercials Ltd. He gave evidence in the following terms:

1. I presently hold the position of Managing Director of Stanway Commercials Limited of Yafforth Road, North Allerton, North Yorkshire, DL7 8UE, a position I have held since January 2002. I held the position of Sales Director of Stanway Commercials Limited (hereinafter referred to as "the Company") from 1st April 2000. I make this declaration from the facts and matters within my knowledge or from the records of the Company to which I have full access.
2. I understand that Utility International Limited was created as a joint venture between Utility Trailer Manufacturing Limited of the United States of America and Wordsworth Holdings

plc in November 1997. Utility International Limited traded under the YORK and Leaf device, amongst other brands, and manufactured and sold trailers and associated parts and fittings under the said brand. Fifty percent of the Company was owned by Utility International Limited from 1998 until the receivership of Utility International Limited in late 2002. The Company provided repair and maintenance services to Utility International Limited and third parties, in particular the repair and maintenance of trailers branded under the YORK and Leaf device until the receivership of Utility International Limited. Such services were also provided to third parties who had purchased trailers carrying the YORK and Leaf device, in the form of a maintenance package provided in association with Utility International Limited. The Company also supplied parts to trailers manufactured and distributed by Utility International Limited under the YORK and Leaf mark to third parties and in fact continue to do so to this day. The YORK and Leaf Device still appears on the side of the Company's factory and while we were part owned by Utility International Limited appeared prominently on business cards and administrative and promotional literature. The Company would have repaired and serviced hundreds of trailers carrying the YORK and Leaf device while we [were] part owned by Utility International Limited up until late 2002 and still service such trailers today. Also we would have provided thousands of parts which would have been supplied to fit trailers to which the YORK and Leaf Device would have been applied. The sale of such parts would have been under the YORK and Leaf Device.

There is now produced and shown to me marked Exhibit TB1, a copy of the trade mark which I refer to as the YORK and Leaf device.

3. I know from my association with Utility International Limited and the goods and services we sold in association with Utility International Limited that trailers carrying the

YORK and Leaf device were sold in 1999 and 2000 if not later. All trailers carry identification which show when they were manufactured and given that we still supply parts for and repair trailers which carry the YORK and Leaf device, I know that trailers are being serviced now by the Company which carry the YORK and Leaf device and were manufactured in 1999 and 2000. In fact we have 20 trailers on their way from a client called W.H. Malcolm which require servicing in a few weeks time and I understand these trailers were manufactured in 2000 and carry the YORK and Leaf device.

4. I can categorically state, without any doubt, that trailers, trailer parts and associated repair and maintenance services were sold under the YORK and Leaf device by Utility International Limited or the Company up until November 2002. As explained above, the Company still supplies parts, which fit trailers carrying the YORK and Leaf device and we still service trailers, which carry the YORK and Leaf device and were manufactured in 1999 and 2000. The YORK and Leaf device still appears on the side of the Company's factory.

The YORK and Leaf device identified at Exhibit TB1 is the trade mark shown in paragraph 1 above.

20. The above extracts from the evidence are sufficient, in my view, to show that the Respondent did indeed file '*evidence of use made of the mark*' within the period prescribed by rule 31(2). To suggest otherwise is to adopt an unduly restrictive view of what can constitute '*evidence*' and '*evidence of use made of the mark*' for the purposes of that rule. Evidence in narrative form is well within the scope of rule 55 and not intended, so far as I can discern, to be excluded from consideration under rule 31(2). It is a separate question whether the probative value of the evidence

presented was sufficient to show that the Respondent had a viable defence to the pleaded allegations of non-use. That is the question to which I now turn.

21. At the request of the Applicant, the Hearing Officer assessed the probative value of the evidence filed under rule 31(2). It appears that she mistrusted the averments of use and looked for exhibits that were demonstrative of use rather than corroborative of the trading activities that were said to be pertinent to the averments. Thus, she observed (with emphasis added by me):

29. Mr. Dennison refers in his witness statement to a Stephen Bennett who, he says was MD of Utility International Ltd from 1998. He states he understands from Mr. Bennett that the mark was used throughout 1998 and 1999 and beyond in relation to trailers but I find it somewhat unsatisfactory that he gives no indication of how he gained this understanding. No evidence has been filed by Mr. Bennett himself.

30. Mr. Dennison also states he understands from Mr. Bennett that a large order of trailers was made to Blue Circle Cement in 1999. Again he gives no indication of how he gained this understanding but does exhibit copies of correspondence which, he says, prove these sales. These copies form Exhibit JD5.

31. JD5 comprises copies of two letters from Stephen Bennett to a John Bright at Blue Circle Industries plc together with three technical drawings. There is nothing in or on either letter to indicate that the trailers to which the quotation applies are being offered under anything other than the Utility name. Indeed, there is, I believe, some force in Mr. Wyand's argument that the words used in the letters differentiates Utility International Ltd from "York". Certainly there is no indication that the trailers being quoted were being offered under, or would, if an order followed, be sold under, the mark in suit.

32. The three "technical" drawings filed as part of the exhibit do not appear to relate to either of the copy

letters and each of them have dates which pre-date the relevant period.

33. Exhibits JD1, JD4 and JD8 are copies of audited company accounts which make no reference to the trade mark in suit nor to any sales made under the mark. Exhibits JD2 and JD3 are copies of documents relating to the assignment. They contain nothing relating to any use of the mark in suit. Exhibit JD7 is merely a copy of an internal envelope of no probative value in relation to use of the mark on the goods of the registration.

34. Exhibit JD11 is what appears to be some sort of promotional video but I am given no indication of when it was made or if and when it was released. Exhibit JD12 are printouts from a variety of websites said to be offering trailer parts for sale. The printouts are all taken from the internet well after the end of the relevant period.

35. Exhibit JD9 is a copy of an article taken from the Internet. Whilst the copy shows it to have been downloaded on 15 December 2003, the article itself states it was first published 15 April 1998. The article refers to Utility International Ltd's take-over of a factory and its plans to take on extra staff. JD10 is a video of a local BBC news broadcast of 12 January 1998. It refers to Utility International Ltd's investment in a factory.

36. Exhibits JD9 and 10 both date from before the relevant period (some 7 and 10 months respectively). Mr. Fernando acknowledged that this material predates the relevant date but argued that it should be taken into account as corroborating other evidence of use within the relevant period. He also submitted that it could be legitimately inferred from this material that use carried on into the relevant period.

...

39. I cannot infer from this material that goods were sold under the mark 7 months and more later. Despite Mr. Fernando's submission that factories and large scale production are not ephemeral, 7 months is a long time in industry. The reports refer to investment by an

incoming company and its future plans but these plans may or may not have come into fruition. Even if they did and the company did start or continue production, it is not unheard of for manufacturing companies to encounter difficulties and cease production over a matter of weeks if not a shorter period. In any event, even if I were to infer that the company's factory still remained open and goods were being manufactured I could not infer under which trade marks any resulting use might have been made. It is clear from Exhibit JD2 that Utility International Ltd owned various trade marks and Mr. Brayshaw's witness statement claims that it traded under the "York and Leaf device, amongst other brands".

40. The remaining exhibit is JD6. The first two pages are headed "Pre-order engineering request". I have no evidence before me of what a pre-order engineering request might be but note that each of the papers have an identified customer and sales representative. The forms appear to be a request for something to be done or made available preparatory to an order but I have no evidence which explains this. What the forms do show is a model type, "ZT 2 FPT" and "ZT 3 FCS". I note that "ZT" is referred to in exhibit JD2 as one of the trade marks assigned by Utility International Ltd. The third page of this exhibit is an untitled form of some sort which shows the customer as being Blue Circle. The form is almost completely devoid of any completed detail, does not bear any reference to the trade mark and is, in any event, undated.

41. Mr. Brayshaw's evidence is brief. He explains the relationship between his company and Utility International Ltd although Mr Wyand pointed out the detail is somewhat at odds with information contained in exhibits attached to Mr. Dennison's evidence. Mr. Brayshaw says his company provided repair and maintenance services for trailers branded under, as he puts it, the "York and Leaf device" and supplied parts for trailers manufactured and distributed by Utility International Ltd under the York and Leaf mark, but this does not mean that any parts were supplied under the trade mark in suit.

42. Mr. Brayshaw does go on to say that this company still services such trailers and would have provided thousands of parts to fit trailers to which the York and Leaf device would have been applied and that the sale of such parts would have been under the York and Leaf device. He does not provide any supporting evidence for these assertions but in any event does not specifically address the position during the relevant period.”

22. In these paragraphs the evidence was subjected to sceptical analysis. I am left with the impression that the Hearing Officer approached the question of compliance with the requirements of rule 31(2) on the basis: (1) that there was an assumption of non-use which had to be rebutted by evidence in which use of the mark was not only described, but documented in material linked to the relevant period; and (2) that in the absence of such evidence the assumption would remain unrebutted and the Respondent could accordingly be denied the right to defend the application for revocation under rule 31(3).

23. Even if (which I question) that would be the right approach to adopt for the purpose of determining whether a contested application for revocation on the ground of non-use should succeed under section 46 of the Act, I do not accept that it is the right approach to adopt for the purpose of determining whether an application for revocation on the ground of non-use has been adequately defended under rule 31(2). The information provided by the Respondent in the prescribed manner comprised: (1) witness statements deposing to use of the relevant trade mark during the relevant period in relation to trailers and parts and fittings for trailers; and (2) documentary materials indicating that the erstwhile proprietor of the relevant

registration was engaged in manufacturing and supplying the relevant goods down to July 2002. The averments in the witness statements were supported by statements of truth and could not simply be ignored. Taken as a whole, the body of information provided under rule 31(2) was sufficient to disclose a viable defence to the pleaded allegations of non-use. It was therefore sufficient to satisfy the requirements of rule 31(2) and none the less so because the defence thereby disclosed could be regarded as contestable in one or more of the respects mentioned by the Hearing Officer in her assessment. In that state of affairs it was not open to the Hearing Officer to use rule 31(3) either as a basis for sanctioning the Respondent for default under rule 31(2) or as a basis for proceeding to a final determination of the application for revocation without following the adversarial procedure envisaged by rules 31(4) to 31(10).

24. I do not agree with the suggestion that the approach adopted by the Hearing Officer in the present case conformed to the approach adopted by the Hearing Officer in CARTE BLEUE Trade Marks [2002] RPC 31 p.599. In the latter case Mr. M. Knight acting for the Registrar accepted the evidence filed by the proprietor under rule 31(2) at face value. He went on to hold that it failed to show '*that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used*' (paragraph 31) because it failed on the face of it to provide any '*evidence of use made of the mark*' in the United Kingdom during the relevant period (paragraphs 12 to 18, 35, 37 and 40 to 43).

25. He explained his approach to the nature of the evidence required by rule 31(2) in the following terms (paragraph 29):

In my view, taking the Act and the Rules together, they seem to me to envisage that when challenged there is an onus upon the registered proprietor at the outset to provide some evidence that the trade mark the subject of the application for revocation was in use during the relevant period. In that connection, in particular I note that the word “show” is used in section 100 which suggests in revocation proceedings evidence must be more than mere assertion that the trade mark in question has been used, but must be actual evidence which shows how the trade mark is used.

In paragraphs 32 and 33 he commented that:

... the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc., all of which show use of the trade mark in question, together with some indication of the sales of goods, or the provision of services during the relevant period. Clearly this cannot be an exhaustive list and is merely an example of the material which might be sent in.

I do not understand him to have decided that information in narrative form cannot provide ‘*evidence of use made of the mark*’ for the purposes of rule 31(2) or that evidence must be subjected to sceptical analysis when deciding whether it meets the requirements of that particular rule. In both respects the Hearing Officer in the present case appears to me to have gone further than envisaged by the decision of the Hearing Officer in the CARTE BLEUE case. I do not think that rule 31(3) enabled her to do so.

26. In the circumstances it is unnecessary for me to consider the scope, availability or effect of the discretionary power to allow the revocation proceedings to continue under rule 31(3).

27. For the reasons I have given, the appeal will be allowed and the Hearing Officer's decision will be set aside. I direct the Applicant to pay the Respondent £850 as a contribution towards its costs of the successful appeal, with payment to be made by no later than 15 July 2005. In arriving at that sum, I have reduced what would otherwise have been the amount of the award by £200 so as to give the Applicant a countervailing credit for its costs of and occasioned by the unsuccessful attempt on the part of the Respondent to adduce further evidence on appeal. In order to protect the Respondent's position with regard to the costs of the interim procedure which culminated in the Hearing Officer's decision of 29 October 2004, I further direct that the Respondent is to be at liberty to apply to the Registrar for an award of costs in respect of that particular aspect of the Registry proceedings at the conclusion of the application for revocation before the Registrar.

Geoffrey Hobbs Q.C.

1 July 2005

Roger Wyand Q.C. instructed by Messrs Baron & Warren appeared as Counsel for the Applicant.

Giles Fernando instructed by Messrs Pinsent Masons appeared as Counsel for the Respondent.

The Registrar was not represented.