

O-223-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION Nos. 81557 AND 81590
BY MINIMAX GMBH & CO KG
FOR REVOCATION OF REGISTRATION Nos. 432900 AND 2111368
STANDING IN THE NAME OF CHUBB FIRE LIMITED**

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**IN THE MATTER OF Application Nos. 81557 and 81590
by Minimax GmbH & Co KG
for Revocation of registration Nos. 432900 and 2111368
standing in the name of Chubb Fire Limited**

BACKGROUND

1. Trade Mark No. 432900 is registered in respect of:

Class 01:

Fire extinguishing compounds, fire proofing solutions, prepared sand for fire extinguishing.

Class 09:

Fire escapes.

Class 17:

Tubular hose.

Class 21:

Ladders and pails, all made of wood.

Class 22:

Tarpaulins, cover sheets in the nature of tarpaulins and jute or hemp rope.

The mark in question is:



and stands in the name of Chubb Fire Limited (Chubb).

2. Trade Mark No. 2111368, MINIMAX, is registered in respect of:

Class 01:

Fire extinguishing and fire retarding compositions; chemical substances for generating and stabilising foam; absorbents for spilled liquids.

Class 09:

Fire extinguishers and recharging apparatus therefor; fire-fighting and fire-preventing apparatus, appliances, vehicles and systems; fire hose nozzles and valves; fire buckets and blankets; fire escapes; fire, flame, smoke, gas, temperature, intrusion and theft detecting and indicating apparatus, instruments and systems; alarms and alarm systems; alarm bells and sirens; apparatus, appliances and clothing for protection against accident, injury, fire or contamination; breathing apparatus and respirators; protective helmets, goggles and masks; weighing apparatus and instruments; pressure gauges; flow meters; Fire-extinguishers and fire extinguishing apparatus being machines. electric batteries and cables; luminous and reflective signs; and parts and fittings for all the aforesaid goods.

Class 17:

Hoses; hose fittings; hose couplings and connectors; washers and seals.

Class 37:

Installation, maintenance, repair and refurbishment of fire extinguishers, fire-fighting and fire-preventing apparatus, appliances, vehicles and systems; of fire, flame, smoke, gas, temperature, intrusion and theft detecting and indicating apparatus, instruments and systems; of alarms and alarm systems; of apparatus, appliances and clothing for protection against accident, injury, fire or contamination.

It too stands in the name of Chubb Fire Limited (Chubb).

3. On 17 December 2003 Minimax GmbH & Co KG (Minimax) applied for registration No. 432900 to be revoked under the provisions of Section 46(1)(b) on the basis of non-use by the proprietor for a continuous period of at least five years.

4. On 26 January 2004 Minimax applied for registration No. 2111368 to be revoked under the provisions of Section 46(1)(b) on the basis of non-use by the proprietor for a continuous period of at least five years.

5. Chubb filed counterstatements denying the non-use claim and confirming that:

“... the trade mark MINIMAX is used in the United Kingdom in connection with the servicing, maintenance, refilling and refurbishing of MINIMAX fire extinguishers and also in relation to the servicing of MINIMAX hose reels. The services provided also utilise fire extinguishing compounds as claimed under Class 1 of Registration No. 432900 and MINIMAX extinguishers were still manufactured in early 1999. Whilst the actual product is available for exhibition in these proceedings, the Respondent is attempting to locate further evidence which will substantiate it's [sic] date.”

A statement in broadly similar terms was filed in relation to No. 2111368.

6. Chubb goes on to say that during the period June 1999 to June 2000 it took genuine steps towards the development and launch of a new fire extinguisher product under the brand

MINIMAX. The launch was prevented by structural changes in the Chubb Group. The counterstatements go on to say that:

“We believe that the changes in ownership and structural re-organisations have effected [sic] the focus and priorities of the Respondent’s business and constitute proper reasons for non-use of the trade mark MINIMAX in relation to fire extinguishers and other fire-fighting apparatus if indeed this should be established.”

7. I should also record Chubb’s further comments in relation to the mark used in the case of No. 432900:

“In more recent years the mark MINIMAX has also been used in ordinary typeface as opposed to the stylised form of Registration No. 432900. The essential feature of the registered mark is clearly MINIMAX and we believe that use of the mark in an ordinary letter form does not alter the distinctive character of the mark as registered.”

8. Both sides ask for an award of costs in their favour.

9. Both sides have filed evidence. The cases came to be heard on 19 July 2005 when Chubb was represented by Mr S Malynicz of Counsel instructed by Marks & Clerk and Minimax by Ms D McFarland of Counsel instructed by Potts Kerr & Co.

Consolidation

10. At a late stage in the proceedings (shortly before the hearing in fact) the parties agreed to the consolidation of the two revocation actions. Accordingly, Counsel for each side made a single set of submissions.

EVIDENCE

11. The evidence in each of the cases was filed separately (ie. pre-consolidation) but is in large measure the same. The summary that follows has been taken from the evidence submitted in relation to No. 432900 by Anthea Bowdler. Evidence in No. 2111368 has been filed by Suzanne Donovan on behalf of the registered proprietor rather than Ms Bowdler. Where Ms Donovan’s evidence differs from that of Ms Bowdler in any material respect I will identify it in my decision.

Registered proprietor’s evidence

12. Ms Bowdler is Chubb’s Commercial Manager. She had been employed by Chubb for a period of 7 years at the time of her statement (which is dated 4 May 2004).

13. The first part of Ms Bowdler’s statement sets out some of the history of the MINIMAX mark whose use in the UK dates back to 1903. Some historical material is exhibited at AB1.

14. In terms of the more recent past Ms Bowdler gives the following information:

“4. At the present time my company through its divisions and service centres continues to service MINIMAX hose reels and also receives MINIMAX extinguishers for refilling and refurbishment from the trade. Our service centre at Stakehill Industrial Park, Middleton, Manchester, advises that they receive around 20 CO₂ extinguisher for refills/refurbishment a year and around 6-10 old powder extinguishers. Of the later MINIMAX extinguishers which were launched in

1992 and are of a stored pressure nature, my company currently refills and refurbishes between 75-100 per annum. This refilling and refurbishment involves the provision of fire extinguishing compounds under the MINIMAX mark.

5. Around June 1999 and up until June 2000, my company made genuine and good preparations for the launch of a new MINIMAX product, a project which was headed by John Dus a design and development engineer with Chubb Fire Limited. Exhibit AB3 to this statement is a copy of the development file kept by Mr Dus and clearly shows the negotiations and research carried out into the development of a new extinguisher comprising extinguishing compounds, to be marketed under the MINIMAX brand. As part of this preparation, the corresponding design of the portable fire extinguisher was registered in the United Kingdom under 2083482 and a copy of the details of this registration are attached marked Exhibit AB4.
6. The preparations towards the launch of the new MINIMAX product were interrupted in November 2000 by the demerger of the Chubb Group including Chubb Fire Limited from Williams Plc, which organisation acquired Chubb in 1997. Clearly, structural and ownership changes and the run up to them placed a different focus and emphasis on the business and my company's brand and product development programmes were put on hold. Since then, the Chubb Group has undergone the sale of its lock and safe manufacturing businesses in 2002 and subsequently, the sale of the remaining Chubb business to United Technologies Corporation in the United States. This sale was concluded in July 2003. Clearly, the changes to which my company have been subject over the last 3-4 years have had an impact on the business and certainly upon research and development and new product launches. I can confirm however that my company is now committed to new business developments and is currently working upon a new domestic extinguisher which will be launched in the UK under the MINIMAX brand."

15. Ms Bowdler goes on to comment on the reputation accruing to and remaining with the MINIMAX mark and the consequences if Minimax were to use and register the mark (the applicant for revocation apparently wishes to register the mark MINIMAX in Classes 1 and 9).

Applicant for revocation's evidence

16. Ulrich Stahl, the head of Minimax's legal department has filed a witness statement. He confirms that he has a good knowledge of English.

17. The first part of his statement is largely a critique of Ms Bowdler's evidence. I take note of his submissions but do not propose to record them at this point.

18. He also exhibits copies of two investigation reports commissioned by Minimax into use of the mark MINIMAX. The first of these was produced on 28 February 1996 and so is well outside the relevant five year period for this case. The second was commissioned in May 2003 from Kingsley & Talboys. The executive summary dated 22 July 2003 and the search results are exhibited at US2. Mr Stahl says that this shows there has been no genuine use of the mark MINIMAX.

19. That completes my review of the evidence.

DECISION

The Law

20. Section 46 reads:

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

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

(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.

(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:

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.

(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
- (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.

(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 -

- (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.”

21. Section 100 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.”

Guiding principles

22. During the course of the hearing I was referred to a number of judgments and decisions of the European Court of Justice, the Court of First Instance, the UK Courts and Registry Hearing Officers. Whilst I take note of these and will draw on them where necessary in my decision, the starting point has to be the ECJ’s judgment in *Ansul BV and Ajax Brandbeveiliging BV (Minimax)* [2003] RPC 40. I will record the relevant paragraphs in full:

- 36 “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.
- 37 It follows that “genuine use” of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability *vis-à-vis* third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as envisaged in Art.10(3) of the Directive, by a third party with authority to use the mark.
- 38 Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.
- 39 Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the

mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.

- 40 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 paras [35] to [39] of this judgment. 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.”

23. I understand that the parties to the actions before me are related to the parties in the *Ansul* case and, as can be seen, the marks and goods/services involved are essentially the same. The *Ansul* judgement is, therefore, of particular relevance to the issues before me.

Relevant dates

24. These actions have been brought under Section 46(1)(b). As no earlier period of five years non-use has been claimed the relevant periods run in each case up to the date of the respective applications. In the case of No. 81557 that period is 17 December 1998 to 16 December 2003 and, in the case of No. 81590, the period 26 January 1999 to 25 January 2004. Although the dates are not quite in parallel as it were, Counsel on both sides accepted that nothing turns on the point. There is no crucial piece of evidence that falls within the short intervening period which might make a difference to the outcome of the later filed action.

Use in relation to the core products (fire extinguishers)

25. The main submissions at the hearing related to the registered proprietor's activities in refilling and refurbishing fire extinguishers and servicing hose reels. Allied to this activity there is said to be a continuing trade in the provision of fire extinguishing compounds. These after sales activities are said to be the product of a past trade in the core products of fire extinguishers and hose reels.

26. The conical MINIMAX fire extinguisher has a long history which goes back to the very early years of the last century (Exhibit AB1). Ms Bowdler describes the more recent history as follows:

“In 1981, Chubb Fire Security Limited launched a new range of Chubb Fire extinguishers and there was a period of time during which the mark MINIMAX may not have been used directly in relation to fire extinguishers and other fire fighting appliances. However, during this period the servicing, refurbishment and refilling of existing extinguishers and hose reels continued and in 1992 the Pyrene Company introduced a new range of pressure model extinguishers under the MINIMAX brand. Whilst I have been unable, as yet, to

locate any supporting documentation, we have retained a sample of the modern MINIMAX extinguisher which we believe was manufactured in early 1999. The extinguisher can be exhibited in these proceedings if appropriate and can certainly be produced at a Hearing. A copy photograph of the extinguisher bearing the production dates of 1997, 1998 and 1999 is exhibited to this statement marked Exhibit AB2.”

27. No further evidence has ever been supplied in support of the trade since 1981 and it appears to be conceded that there was a period (in itself unspecified) during which the mark was not in use. As Ms McFarland pointed out, Ms Bowdler’s evidence (and likewise Ms Donovan’s) is cautious in the terms in which it is expressed referring to a belief (“we believe”) that a new range of MINIMAX extinguishers was manufactured in early 1999. There is no corroborative information as to the volume of sales, geographical extent of sales, the means by which the goods reached the market, invoices or other concrete indicators of trade. The photograph of a fire extinguisher (Exhibit AB2) is the only evidence that might assist the registered proprietor’s case and even that is not produced in Ms Donovan’s otherwise comparable evidence. I find it difficult to believe that the registered proprietor could not have produced supporting material if it existed. A single photograph without other evidence to substantiate the fact that the goods were put on the market during the relevant period is in itself insufficient to defend the registration.

Preparations for the launch of a new MINIMAX product

28. In dealing with genuine use paragraph 37 of *Ansul* indicates that:

“Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns.”

29. I have recorded in paragraph 14 above Ms Bowdler’s evidence as to the registered proprietor’s plans to launch a new MINIMAX product in the period June 1999 to June 2000. In principle such preparations may constitute or contribute to genuine use of the mark.

30. I note in particular that the passage from *Ansul* is cast in terms of “... preparations to secure customers”. That is consistent with the earlier reference in the same paragraph to genuine use entailing use of the mark “on the market” and “not just internal use by the undertaking concerned”. Considered in those terms this part of the registered proprietor’s case falls well short of establishing a viable defence. The material relied upon consists almost exclusively of internal documentation (designs, drawings, costings, specifications etc). To the extent that there is any evidence that the project was discussed outside of Chubb the contacts appear to have been with potential manufacturers or suppliers of parts, tooling etc. There is no suggestion in this material that potential customers were ever approached or made aware of the existence of the planned new product. I might just add that the papers at AB3 are also somewhat inconsistent in the name by which the project was known. Some refer to MINIMAX, some to MINI MAX, others make no mention of a name at all. The registered proprietor’s case based on preparations for use seems to me to be without merit.

Use in relation to refilling/refurbishment of fire extinguishers etc

31. This is a key part of the registered proprietor’s defence. For convenience I will repeat the paragraph of Ms Bowdler’s evidence that deals with the matter:

“4. At the present time my company through its divisions and service centres continues to service MINIMAX hose reels and also receives MINIMAX

extinguishers for refilling and refurbishment from the trade. Our service centre at Stakehill Industrial Park, Middleton, Manchester, advises that they receive around 20 CO₂ extinguisher for refills/refurbishment a year and around 6-10 old powder extinguishers. Of the later MINIMAX extinguishers which were launched in 1992 and are of a stored pressure nature, my company currently refills and refurbishes between 75-100 per annum. This refilling and refurbishment involves the provision of fire extinguishing compounds under the MINIMAX mark.”

32. Ms Donovan’s statement is word for word the same with the notable exception that it does not contain the final sentence about the mark itself. The reason for the omission has not been explained.

33. Paragraphs 40 to 42 of *Ansul* deal precisely with the circumstances pertaining here and make it clear that use may be genuine as a result of the sale of parts integral to the goods or the sale of accessories/parts or the supply of maintenance and repair services even though the original goods are no longer available. The outcome here must, of course, be determined on the basis of the facts before me.

34. In principle, therefore, I accept the starting point for Mr Malynicz’s submissions. He also took the view that the applicant has not denied the factual scenario set out in Ms Bowdler’s paragraph 4 above. Nor has cross-examination been requested.

35. The first point to be made about Ms Bowdler’s statement is that it is hearsay. The information does not appear to have been within her own knowledge and it is not clear whether she herself received the advice from the service centre or whether more distant hearsay is involved. Evidence is not to be disregarded simply because it is hearsay but it is for the tribunal to decide what weight to accord it.

36. I note that the source of the information is not identified so it is not possible to judge the level of authority/knowledge that the source brought to bear in responding to the enquiry or what questions were asked. What is of rather more concern is the fact that no corroborative material has been supplied to confirm the precise nature of the trade outlined in the evidence and in particular whether customers were accustomed to order, or the supplier provide, the goods and services under the mark MINIMAX. The mere fact that MINIMAX fire extinguishers were being refilled/refurbished is not proof that the refilling/refurbishment was under or by reference to the MINIMAX mark.

37. The point can be illustrated by way of example. To continue the one I used at the hearing, if a Ford car is taken into a Ford garage/service centre for servicing then that service is likely to be under the Ford brand. But, if the same Ford car is taken to a third party for servicing then the service will most likely have been supplied under the third party brand. It will be a question of fact in each case as to what the position will be.

38. It might be thought a reasonable inference in the cases before me that because the fire extinguishers were being sent to in-house service centres that it follows that the service would be provided under the product brand name. I do not accept that this is necessarily the case. Ms Bowdler says “... My company through its divisions and service centres continues to service MINIMAX hose reels and also receives MINIMAX extinguishers for refilling and refurbishment”. The reference to my company etc is to Chubb Fire Limited. Given that MINIMAX was no longer being actively used in relation to new products in the relevant period (and even the photograph at AB2 is of a Chubb Minimax extinguisher) it is possible (I might even say probable) that the services in question were being supplied under the Chubb name.

39. The matter was quite capable of being resolved by evidence directed to how customers ordered the services or how those services were branded (e.g. on invoices) when supplied to the customers. As matters stand the question remains unanswered save for the statement by Ms Bowdler that “This refilling and refurbishment involves the provision of fire extinguishing compounds under the MINIMAX mark”. Again the point has not been substantiated by any exhibits either of the actual compounds or photographs thereof. There is the further point that, even taking this statement at face value, it tells me nothing about whether the brand name was placed before consumers. On the face of it, if a fire extinguisher is sent to a service centre for refill, the customer is unlikely to know or enquire as to the branding of the compound used for the refill. Again, supporting evidence or exhibits might have established a different position. As matters stand I am unable to accept that the registered proprietor has established that it has supplied after sales services under the mark or that it has substantiated the claim that fire-extinguishing compounds have been supplied under the mark MINIMAX.

The mark used

40. There is one final point arising from the claim made in paragraph 4 of Ms Bowdler’s evidence that is not made in paragraph 4 of Ms Donovan’s evidence. Ms Bowdler gives evidence in relation to registration No. 432900 which is the older and stylised version of the MINIMAX mark. Her evidence refers in the body of her statement to MINIMAX (in plain form) rather than the stylised version. I am not clear whether she is distinguishing between the two marks or assuming that use of one is use of the other. And what am I to make of the fact that Ms Donovan does not make a comparable statement?

41. These questions remain unanswered. The point is not entirely academic. Ms McFarland’s primary case was that the registered proprietor had failed to show genuine use of the mark but that, in any case, such references as there are in the evidence to MINIMAX would not be use falling within Section 46(2) sufficient to defend No. 432900.

42. The leading authority on the applicable principles when considering use in a form not altering the distinctive character of a mark is *Bud and Budweiser Budbräu Trade Marks* [2003] RPC 25 – see, in particular, Lord Walker’s judgment. In the light of my findings on the registered proprietor’s claims it is not necessary to consider this matter in detail but given the presentational features of the 432900 mark (and notwithstanding that it is still clearly a MINIMAX mark) I do not consider that use of the same word in plain block capitals can be taken as falling within Section 46(2). The features of styling, notably the linking of the limbs of the M and X, the arching of the intermediate letters and the black bar background, seem to me to be the result of a conscious effort to give the mark a presentational identity that is distinct from the plain word MINIMAX.

Conclusions on genuine use

43. Before drawing together the threads of this aspect of the case I should put on record three points that were put to me during the course of Mr Malynicz's submissions.

44. Firstly, he reminded me that there was nothing in the UK domestic law equivalent to the specific evidential provisions which are to be found in Rule 22 of Regulation No. 2868/95 governing the Community Trade Mark. Thus, the absence of one or more of the 'checklist' of items put forward in that Rule should not be fatal to his client's case. I accept that there is no comparable provision in UK law and that, accordingly, I must consider the evidence on its merits and am not bound by any such checklist approach.

45. Secondly, he advocated a global approach to consideration of the registered proprietor's position taking into account particularly the interdependency principle referred to in the following passage from the judgment of the Court of First instance in Case T-203/02 *The Sunrider Corp v OHIM*:

“42 To examine, in a particular case, whether an earlier trade mark has been put to genuine use, an overall assessment must be carried out, which takes into account all the relevant factors of the particular case. That assessment entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. In addition, the turnover and the volume of sales of the product under the earlier trade mark cannot be assessed in absolute terms but must be looked at in relation to other relevant factors, such as the volume of business, product or marketing capacity or the degree of diversification of the undertaking using the trade mark and the characteristics of the products or services on the relevant market. As a result, the Court has stated that use of the earlier mark need not always be quantitatively significant in order to be deemed genuine (*Ansul*, paragraph 39).”

46. I do not regard the above to be inconsistent with the repeated statements in *Ansul* and *La Mer Technology Inc v Laboratoires Goemar SA* [2004] FSR 38¹ to the extent that it is saying that all relevant facts and circumstances are to be taken into account including the relationship and interplay between individual facts and circumstances.

47. Finally, he submitted that the use of the MINIMAX mark over many years prior to the relevant period should also inform the tribunal's assessment of the evidence within the actual period being scrutinised. In support of that proposition he relied on the following passage from the Order of the ECJ in *La Mer Technology Inc*:

“31 Nevertheless, the Directive does not expressly preclude in assessing the genuineness of use during the relevant period, account being taken, where appropriate, of any circumstances subsequent to that filing [of the application for revocation]. Such circumstances may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time.”

¹ I should put on record that Mr Malynicz advised that an appeal against Mr Justice Blackburne's judgment in the *La Mer* case (on return from the ECJ reference) was heard on 13-14 July 2005 and that the Court of Appeal had heard submissions as to the meaning and effect of the ECJ's judgment and order in *Ansul* and *La Mer* respectively. He suggested I might wish to delay my decision in this case and invite written submissions on the Court of Appeal's judgment when available. In my view, it is not necessary for me to do so in the circumstances of this case.

48. As Mr Malynicz acknowledged the above passage deals with events subsequent to the filing date of the revocation action but submitted that the principle could be extended to events occurring before the start of the relevant five year period.

49. I am not aware of any authority that deals with the relevance of use prior to the relevant period but I see no reason why the principle established in *La Mer Technology Inc* should not extend this far. The issue is whether the use shown within the relevant period is genuine. If, say, smallscale use within the relevant timeframe reflected the continuation of trade from what was previously a much larger business, I see no reason why that earlier activity should not be a relevant factor in considering the genuineness of smallscale use within the relevant period subject to the circumstances satisfying the other requirements of *Ansul*.

50. In the circumstances of the cases before me I assume the registered proprietor anticipates that the net effect of these considerations would be to minimise the deficiencies in its evidence and bring into play whatever overhang of reputation the MINIMAX mark can claim as a result of use prior to the relevant period.

51. In the event I have come to the clear view that taking all the circumstances of these cases into account the registered proprietor's case falls well short of establishing genuine use.

52. Whilst it is true that the MINIMAX mark has a long history, Ms Bowdler's account of events since the early 1980s is sketchy and largely unsupported in terms of information on the size of the business and documentary evidence in support of the trade. It was for this reason that the registered proprietor had to fall back on the claims in relation to an after-sales trade. But the latter is itself wholly unsupported by any material evidencing the trade in question. It also raises a number of unanswered questions as to the mark(s) under which that trade took place. The other leg to the registered proprietor's case is the preparation for the launch of a new MINIMAX product. But that was restricted to internal usage. I am not satisfied that consumers were made aware that it was planned to launch a new product under the mark.

Proper reason for non-use

53. The registered proprietor's case rests on the circumstances described in paragraph 6 of Ms Bowdler's evidence, that is to say the changes in ownership and structural re-organisation that took place in relation to the Chubb Group. Ms Bowdler expresses the belief (the matter is put no higher than that) that this affected the focus and priorities of Chubb's business.

54. It is fair to say that Mr Malynicz did not make proper reasons for non-use the main plank of the registered proprietor's defence. Equally the claim has not been given up.

55. There is as yet no guidance from the ECJ on what may constitute proper reasons for non-use. The issue has been dealt with in *Magic Ball Trade Mark* [2000] RPC 439 where Park J. said:

“As regards the new Act, there has been no discussion yet in the High Court or above of the words “proper reasons”. There is one earlier decision of a hearing officer in *INVERMONT Trade Mark* [1997] R.P.C. 125. The officer, in a passage cited and relied on by his colleague who decided the present case, said this:

“... bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirement

to use a trade mark or lose it, I think the word proper, in the context of section 46 means; apt, acceptable, reasonable, justifiable in all the circumstances.

I do not think that the term “proper” was intended to cover normal situations or routine difficulties. I think it much more likely that it is intended to cover abnormal situations in the industry or the market, or even perhaps some temporary but serious disruption affecting the registered proprietor’s business. Normal delays occasioned by some unavoidable regulatory requirement, such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman’s own control and I think he should plan accordingly.”

.....

I have no disagreement with anything which the hearing officer said in the *INVERMONT* case. I would only add the comment that, while the adjectives which he puts forward – “apt, acceptable, reasonable, justifiable in all the circumstances” – seem to me to be well chosen, it must not be forgotten that the statutory word which falls to be applied is “proper”, not any of the near-synonyms which the hearing officer suggested.”

56. Ms McFarland also reminded me that in *Philosophy Inc v Ferretti Studio SRL*, [2003] RPC 15, reference was made to the following part of Article 19 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS):

“1. If use is required to maintain a registration, the registration may be cancelled only after an uninterrupted period of at least three years of non-use, unless valid reasons based on the existence of obstacles to such use are shown by the trademark owner. Circumstances arising independently of the will of the owner of the trademark which constitute an obstacle to the use of the trademark, such as import restrictions on or other government requirements for goods or services protected by the trademark, shall be recognised as valid reasons for non-use.”

57. I also accept her submission that, for a proprietor to have a defence, there must be a clear connection between the circumstance that is said to constitute the obstacle and the non-use. In other words, but for the existence of the obstacle, the proprietor would have put his mark into use.

58. The circumstances that are said to result in proper reasons for non-use here are the corporate changes and restructuring that took place within the Chubb Group. Ms Bowdler claims that this had an impact on research and development and new product launches. In particular she says that “the preparations towards the launch of the new MINIMAX product were interrupted in November 2000 by the de-merger of the Chubb Group including Chubb Fire Limited from Williams Plc...”.

59. The fact that there was a de-merger is not, to the best of my knowledge, disputed by the applicant for revocation. Corporate changes which take place in the context of an existing business are apt to create some uncertainty as to the future direction of the underlying businesses. Equally, it may be said that normal business functions and trading activity do not stop simply because of changes in corporate circumstances. The twin issues for consideration are whether the corporate changes in this case have been shown to impact on use of the MINIMAX marks and, if so, whether this constitutes a proper reason for non-use within the terms of the guiding principles set out above.

60. Ms Bowdler’s claims are general in nature. She does not point to any particular document or directive issued by or within the Chubb Group which expressly placed an embargo on new

product development or launches. Nor, on the face of it, does it seem entirely plausible that the effects of corporate restructuring would impinge on an operational matter such as the development and launch of a product of this nature.

61. I also find Ms Bowdler's claim that the preparations for launch of the new MINIMAX product was interrupted in November 2000 by the de-merger to be inconsistent with the claim in paragraph 5 of her statement that the preparations for launch of a new product took place between June 1999 and June 2000. On that basis the preparations had either been completed prior to the de-merger or it had been decided by that point in time not to proceed with the planned new product. I am far from convinced, therefore, that the corporate changes were the direct cause of the non-use rather than simply being a surrounding circumstance. I might just add that a decision to stop or put new product launches on hold seems to me to be precisely the sort of thing that is internal and within the business man's own control and would not normally be expected to constitute proper reasons for non-use.

62. There is a further overriding point arising from Ms Bowdler's statement. Her comments are framed primarily in terms of the effect of the corporate changes on new product development and launches. There is no suggestion that these changes prevented use of the mark on existing goods or services. In fact it would be surprising if this were the case. I, therefore, dismiss the registered proprietor's claim that there were proper reasons for non-use.

Conclusions

63. The registrations thus fall to be revoked in relation to all the goods and services for which they are registered.

64. In accordance with Section 46(6), revocation will take effect from the filing date of the applications. In the case of registration No. 432900 that date is 17 December 2003. In the case of No. 2111368 the date is 26 January 2004.

65. In the circumstances I do not need to deal with a submission advanced by Mr Malynicz that, in the event that the registered proprietor was able to mount a partial defence in relation to certain goods or services within the respective specifications that fall outside the core business of fire extinguishers, there can be no question of partial revocation since this had not been pleaded. In support of this he relied on *Omega SA v Omega Engineering Inc* [2003] FSR 49. In that case it was held that, if a party wanted revocation to take effect from a date earlier than the date of the application for revocation, the point should be clearly pleaded.

66. I will merely say that I think it is unlikely that the *Omega* case supports the proposition that Mr Malynicz is contending for. There is clearly a need for precision in relation to the date from which revocation is sought as this will determine the period to be addressed in the registered proprietor's evidence. However, even accepting his submission that a proprietor should not be taken by surprise by an applicant who wishes to dig deep within a specification as he put it, I do not think this is a case where the proprietor did not know the nature of the challenge it faced. However, I do not need to formally resolve the point raised by Mr Malynicz's submission.

Costs

67. The applicant for revocation has been successful and is entitled to a contribution towards its costs. Taking account of the fact that the evidence in this case is largely duplicative and I received a single set of submissions at the hearing I order the registered proprietor to pay the applicant for revocation the sum of £2500 in respect of the consolidated proceedings. 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 3rd day of August 2005

**M REYNOLDS
For the Registrar
the Comptroller-General**