

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 11914  
BY MARS U.K. LIMITED

FOR REVOCATION OF TRADE MARK No 804672  
**LOVE LETTERS**  
STANDING IN THE NAME OF  
SWEETMASTERS LIMITED

## **DECISION**

- 1) The trade mark LOVE LETTERS is registered under number 804672 in Class 30 of the register in respect of “Non-medicated confectionery”.
- 2) The application for registration was made on 19 April 1960 and the mark was placed on the register on 23 March 1961. Following two assignments the registration stands in the name of Sweetmasters Limited of P.O. Box 13, Blackpool, Lancs, FY3 9XQ.
- 3) By an application dated 8 September 2000, Mars U.K. Limited of 3D Dundee Road, Slough, Berkshire, SL1 4LG applied for the revocation of the registration under the provisions of Section 46(1)(a) & (b). The grounds stated that there has been no use of the trade mark in suit, since it was entered onto the Register by the proprietor (or with his consent) in relation to the goods covered by the registration.
- 4) In the alternative they contend that there has been no use of the mark in suit in relation to the goods covered by the registration for an uninterrupted period of five years prior to the date of the application. Further, they state that there are no proper reasons for such non-use.
- 5) On 3 March 2000 the registered proprietor filed a counterstatement denying all the grounds, and also pointing out that the applicant had not contacted them prior to filing the application.
- 6) Both sides seek an award of costs. Both sides filed evidence.
- 7) At the hearing, on 21 March 2002, the registered proprietor was represented by Mr Marsh of Messrs Wilson Gunn M’Caw. The applicant for revocation was represented by Mr Jennings of Messrs Clifford Chance.

## **REGISTERED PROPRIETOR’S EVIDENCE.**

- 8) The registered proprietor filed a declaration, dated 21 December 2000, by David William Van Faraday a Director of Sweetmasters Limited (the registered proprietor).
- 9) Mr Van Faraday stated that the mark was assigned to his company from Swizzels Matlow

Limited on 5 October 1999. His company purchased the Registration following an approach from one of their customers, in Spring 1999, regarding the production of chocolate confectionery. The customer, Petty Wood & Co Ltd, run a mail order business. Once the mark in suit had been purchased an agreement was made with Petty Wood & Co to produce confectionery for their Spring 2001 range. At exhibit 1 is an example of the packaging agreed with the client. This shows the mark prominently on a box of chocolate letters, allowing the purchaser to create their own message.

10) At exhibit 2 is a copy of the brochure said to have been produced in June 2000 by Petty Wood & Co Ltd which shows the product. Mr Van Faraday claims that the brochure was circulated from June 2000. The proprietor claims to have been manufacturing and supplying pre ordered products for the “past 4-5 months”. At exhibit 3 is an example of a purchase order dated 8 December 2000 for £1749.60 worth of “Love Letters” in the nature of “samples”. The order has a delivery date shown of 18 December.

#### APPLICANT’S EVIDENCE

11) The applicant filed a declaration, dated 30 July 2001, by Evie Kyriakides the marketing property manager of Mars U.K. Limited.

12) Ms Kyriakides claims that the proprietor’s evidence is not detailed enough to substantiate the claim that the mark was used prior to the relevant date of 8 September 2000. The brochure produced at exhibit 2 of the proprietor’s evidence is undated. At exhibit EK1 she provides a copy of a report by an investigation agency, TraceMarq International Limited.

13) The report states that enquiries were made of Petty Wood. It is stated that the Customer Service Department confirmed that the Spring 2001 catalogue was issued after Christmas 2000. They also state that the Spring 2002 catalogue will be released after Christmas 2001. Ms Kyriakides states that she is familiar with the confectionery business and she would not expect a Spring catalogue to be released prior to the Christmas of the year before.

14) Ms Kyriakides then comments on the proprietor’s evidence. She states that the specimen purchase order, dated exactly three months after the relevant date, is clearly marked “QC samples to be sent to Gordon Smith prior to delivery and are subject to QC approval”. She states that from her experience quality control samples are usually only sent before a product is accepted by a retailer. She claims that this suggests that there were no prior sales of “Love Letters” as the quality control shipment would be the first delivery for inspection. She claims that as the shipment is “subject to QC approval” then if the goods do not meet the standard required then they can be rejected. There is no evidence as to whether the goods met the quality standard and were accepted.

15) Ms Kyriakides also comments that “it is difficult to believe that the Spring 2001 catalogue was available in June 2000”. On the basis of all this she states that the use of the mark was too

insignificant and was after the relevant date.

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

## DECISION

17) The grounds of revocation are based on Section 46(1)(a) and (b) which read:

*“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;”*

18) The applicant alleges that the mark has not been used in the five years prior to the date of the application for revocation. The registered proprietor claimed that the applicant did not notify him of their intention to launch a revocation action, and sought the assistance of Section 46(3) which reads:

*“46.- (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.”*

19) It appears to me that an application for revocation under Section 46(1)(b) of the Act can be filed specifying any five year period following the completion of the registration procedure ending at or before the date of application. If the application identifies an earlier five year period and use of the mark has commenced or resumed, one must consider when this occurred and when preparations for this use began. It follows that if an application for revocation is filed specifying a period of non-use ending on the day prior to the application no use of the mark could have resumed or commenced after the end of the five year period and the qualification raised at 46(3) does not apply.

20) In this case the application for revocation was received on 8 September 2000 and, in the absence of any statement from the applicant as to any earlier period, the relevant period is to be considered as being the five years prior to that date, 8.9.95 - 8.9.2000. As the registered proprietors claim to have been using the mark during the period the question of commencement or resumption of use referred to in Section 46(3) is not applicable.

21) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. It reads:

*“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.”*

22) My attention was drawn to the comments of Jacob J. in the case of *Laboratories Goemar SA v La Mer Technology Inc.* CH 2001 App 010568 & 010569, dated 19 December 2001. This was an appeal against a decision by the Registry. In that case the question of whether a very limited amount of use definitely in this country can be regarded as sufficient to be “genuine”. It was decided to refer to the matter to the European Court of Justice. However, the learned judge also gave his opinion on the matter.

“29. Now my own answer. I take the view that provided there is nothing artificial about a transaction under a mark, then it will amount to “genuine” use. There is no lower limit of “negligible”. However, the smaller the amount of use, the more carefully must it be proved, and the more important will it be for the trade mark owner to demonstrate that the use was not merely “colourable” or “token”, that is to say done with the ulterior motive of validating the registration. Where the use is not actually on the goods or the packaging (for instance it is in advertisement) then one must further inquire whether that advertisement was really directed at customers here. For then the place of use is also called into question, as in *Euromarket*.”

23) On the question of onus of proof I also take into account the comments from the NODOZ case {1962} RPC 1. In which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“ The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, .....”

24) It was asserted that the proprietor purchased the mark in suit following an approach from a

client, Petty Wood & Co. It is also claimed that following the acquisition of the mark that an agreement was made with this client to produce confectionery under the mark in suit. However, no corroborative evidence of any of the dealings with this client has been provided. The proprietor has filed an example of the packaging it claims to have agreed with Petty Wood & Co and also a copy of a brochure showing, amongst other confectionery items, the packaging with the mark in suit upon it. The packaging is not dated, nor has the proprietor filed any evidence of when or by whom it was designed or produced. It is claimed that the brochure was in circulation from June 2000, even though it relates to Easter products for the year 2001. Again no corroborative evidence regarding the circulation has been provided.

25) The applicant has questioned the claim regarding the circulation of the brochure. The applicant's marketing manager has stated that in her experience catalogues for Easter products would not be issued until December of the year before. The applicant has also filed an investigator's report which claims to have contacted the proprietor's client, Petty Wood & Co., and been informed that the brochure in question was issued in late December 2000. The registered proprietor did not file evidence countering these claims or even repudiating them.

26) The proprietor also claims to have been manufacturing and supplying pre-ordered products since approximately August 2000. However, the only corroborative evidence supplied was a purchase order dated 8 December 2000.

27) Given the very specific nature of the revocation action, the proprietor had no reason not to file clear, unambiguous evidence of use of the mark in relation to the goods under attack. Although I believe that the registered proprietor intended to use, and indeed has used, the mark in suit the use was after the relevant date. They have offered no evidence of proper reasons for non-use within the relevant period. Therefore, I have reluctantly come to the view that the registered proprietor has failed to discharge the onus that is placed on them by Section 100 of the Act.

28) The application for revocation succeeds. I order the registered proprietor to pay the applicant the sum of £1700. This sum 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 10 day of June 2002

George W Salthouse  
For the Registrar  
The Comptroller General