

O-291-04

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 469923
IN THE NAME OF J. CHOMETTE & SON LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81689
THERE TO BY SAS NOUVELLE PILLIVUYT**

IN THE MATTER OF trade mark registration No. 469923
in the name of J. Chomette & Son Limited

AND

IN THE MATTER OF an application for a Declaration of Invalidity
No. 81689 thereto by Sas Nouvelle Pillivuyt

BACKGROUND

1. The trade mark “PILIVITE” was the subject of an application for registration filed on 19 May 1926 and has been registered since 18 August 1926 under number 469923 and stands in the name of J. Chomette & Son Limited (subsequently referred to as Chomette). It is registered in respect of:

Class 21:
Fireproof china culinary utensils.

2. On 30 March 2004, Sas Nouvelle Pillivuyt (subsequently referred to as Pillivuyt) filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are under sections 47(1), 47(2), 3(6), 5(4)(a), 32(3) and 60(3)(a) of the Act.

3. In the statement of case the applicant, Pillivuyt, asserts that they are the successor in title to Pillivuyt SA and have been manufacturing porcelain dinnerware and bakeware in a factory at Mehun Sur Yèvre since 1818; the trade mark “PILLIVUYT” being widely known for the goods of Pillivuyt sold throughout the world through a network of distributors. That the registered proprietor, Chomette, have acted as Pillivuyt’s distributor in the UK since 1890 when the first formal agreement between the parties was signed; that the early agreements did not deal specifically with intellectual property issues but the parties have always understood that the trade marks were the property of Pillivuyt; this was clarified in correspondence between the parties in October 2001. Pillivuyt became aware of this registration when it was raised as a citation against their own application, No. 2334421; have successfully opposed an attempt by Chomette to register the trade mark “PILLIVUYT”, application No. 2279394; state that they employ distributors in a number of countries, none of whom have registered the trade mark “PILLIVUYT”; and that all such trade mark applications are made in the name of the applicant for invalidation. They argue that Chomette knew they could not register “PILLIVUYT” and therefore registered “PILIVITE” as they considered it to be an English language version of the trade mark. They state that no use of the mark was found during an Internet search carried out in October 2002, however they believe that the mark has been brought into use recently. Pillivuyt assert that the registration was applied for in bad faith as they are the proprietor of the trade mark and have been at all material times; that Chomette had no

bona fide intention to use the trade mark as registered at the date of application; that Pilivuyt are the proprietor of the mark in several convention countries and that Chomette is the agent of Pilivuyt; that Pilivuyt is the owner of the goodwill in the trade mark, an earlier right which gives them the right to take action against the registration for passing off.

4. On 8 April 2004 a copy of the application for invalidation and the statement of case were sent to the address for J. Chomette & Son Limited recorded on the register. The documents were sent by recorded delivery but returned by Royal Mail undelivered. The forms were then resent by normal mail to the same address. The registered proprietor did not file a counter-statement within the three months specified by Rule 31(2) of the Trade Mark Rules 2000. Such circumstances are covered by Rule 31(3) which states:

“.....the registrar may treat his opposition to the application as having been deemed withdrawn.”

No reasons have been advanced as to why revocation should not take place, likewise no reasons have been given as to why I should exercise discretion in favour of the Registered Proprietor and I therefore decline to do so. The consequences of failure to defend the registration were set out in the letter dated 8 April 2004, namely that the application for declaration of invalidity could be granted in whole or in part.

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to make the case that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

8. With this in mind, on 11 June 2004, the Registrar wrote to the applicant's representative inviting them to file any evidence or make any submission which he felt would support his client's application to, at the least, establish a prima facie case. They were also invited to state whether they wished to be heard or would accept a decision from the papers filed.

9. The period set for the filing of evidence was extended at the request of the applicant's representative, such that the final deadline for filing of evidence was 23 August 2004.

10. On 4 August 2004 the applicant for invalidity provided a witness statement, with exhibits, to support the case the applicant alleged against the proprietor of the trade mark.

11. The evidence and exhibits submitted consist of a statutory declaration by Christian Houel, President of Sas Nouvelle Pillivuyt, dated 27 July 2004, and nine exhibits. The witness statement first relates that Pillivuyt are the manufacturer of porcelain dinnerware and bakeware to which the trade mark "PILLIVUYT" is applied; these goods being manufactured firstly at Foëcy from 1818 and subsequently, and up to date, at Mehun Sur Yèvre from 1853. That the trade mark is applied to the base of their products, to labels applied to packaging and in letter heads. It goes on to state that the original UK distributors agreement was between Pillivuyt and Chomette in 1890; that although intellectual property rights were not mentioned in the early agreements it was clear from the wording, and understood by the parties, that the trade marks and rights were the property of Pillivuyt; the latest agreement was signed on 20 August 1999. It also states that in the promotional literature produced by Chomette there is a statement that they are ". . . sole UK importers of Pillivuyt Porcelain . . ." and the "PILLIVUYT" trade mark is shown in the same literature. Also it states that at no time has permission been given for Chomette to register any trade mark in its own right and no other distributor has done so. In considering the trade mark in suit, "PILIVITE", it is suggested that this is an English language version of the trade mark "PILLIVUYT", and the two marks are sometimes used interchangeably; also that Pillivuyt first became aware of the registration in suit when it was raised as a citation during the examination of their own application, No. 2269308. The declaration goes on to state that the trade mark has been used in the UK in relation to these goods for over 100 years and they believe they have acquired a substantial goodwill and reputation in the mark; it lists turnover in goods sold over the previous ten years (in Euros) as 1993 - €1,100,000, 1994 - €1,380,000, 1995 - €1,500,000, 1996 - €1,540,000, 1997 - €1,680,000, 1998 - €1,740,000, 1999 - €1,740,000, 2000 - €1,970,000, 2001 - €1,840,000, 2002 - €1,940,000, 2003 - €2,170,000; and lists the goods as being sold through the distributor, Chomette, to catering wholesalers, hotels (including the Savoy), restaurants, department stores (including Harrods and John Lewis) and to retailers such as Divertimenti; promotion of the goods sold under the mark was the responsibility of the distributor who attended trade shows and exhibitions and issued press releases to the trade press.

- Exhibit 1 – a catalogue of products, printed in French, English and German, undated but declared in the declaration as the current catalogue.

- Exhibit 2 – a photocopy showing the trade mark applied to the base of a small dish, a photocopy of three labels applied to packaging, the text being in French, English and German, all undated, a copy of a letter from Pillivuyt to the registered proprietor showing the trade mark in the letterhead, in English and dated 19 January 1995.
- Exhibit 3 – a copy of the revised distributors agreement signed 20 August 1999 between Pillivuyt and Chomette, in the form of Chomette Limited. This states that J. Chomette & Son Limited is a wholly owned subsidiary of Chomette Limited and that Chomette has distributed products manufactured by Pillivuyt since 1890 under agreements dated 13 January 1890, 1 January 1965, 5 January 1968 and 28 November 1984. There are no specific clauses relating to intellectual property.
- Exhibit 4 – photocopies of two pages from a promotional brochure produced by Chomette, refers to Pillivuyt products and shows the Pillivuyt trade mark, undated but has the reference “No.7” on the front page.
- Exhibit 5 – a printed list of 54 countries and territories being Pillivuyt’s major overseas markets, in French, dated 21 October 2003; a print from a commercial trade mark database (Dennemeyer et Cie) showing 22 trade mark registrations, at WIPO, Australia, Austria, the Benelux, Canada, the Czech Republic, Denmark, France, Germany, Italy, Japan, Morocco, New Zealand, Norway, Portugal, Spain, Sweden, Switzerland, Taiwan and the United States of America, also 2 trade mark applications, Turkey and the UK, all in the name of Pillivuyt.
- Exhibit 6 – a photocopy of the cover of “Gift Buyer” magazine, dated September 1991, with a photograph of a display of tableware in conjunction with the trade mark “PILLIVUYT” and also the statement “TATOU A Pilivite Porcelain Design for the Trendsetter”; a second photocopy, hand marked as being from “Gift Buyer” of February 1991, with the same photograph of tableware, the “PILLIVUYT” trade mark and a statement “Tatou de Pillivuyt The French largest culinary china manufacturer at its utmost refinement”.
- Exhibit 7 – a copy of the examination report for application No. 2269308, dated 22 May 2001, raising the registration No. 469923 as a citation.
- Exhibit 8 – photocopies of correspondence between Pillivuyt and Chomette, the first being an order for goods placed 13 January 1995, the second being a copy of a fax dated 14 February 1995 from Chomette to Pillivuyt raising issues about non-delivery of items, and the third being a copy of a fax dated 19 June 1995 from Chomette to Pillivuyt confirming shipment dates.
- Exhibit 9 – six photocopies of promotional literature; three are listed as being from the “Housewares” show, dated as May 1992, February 1993 and May 1993, showing the products and the name or trade mark “PILLIVUYT”; one is from an unnamed and undated catalogue with a photograph which has a hand written

indication that it relates to Pillivuyt products; one is from an unnamed and undated catalogue with two photographs showing the products and the text being a potted history and promotion of Pillivuyt; the last is a copy of a poster promoting Pillivuyt, in French and apparently dated 1 May 1899.

12. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

DECISION

13. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 3(6), 5(4)(a), 32(3) and 60(3)(a). The relevant parts of the Act are as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

(a) , or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“3 (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

“5. - (1)

(2)

(3)

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

“32. - (1)

(2)

(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.”

“60. - (1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2)

(3) If the application (not being so opposed) is granted, the proprietor may-

(a) apply for a declaration of the invalidity of the registration, or

(b)”

In the context of this action, the following parts of section 55 of the Act should be noted:

“55. - (1) In this Act-

(a) “the Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time,

(aa), and

(b) a “Convention country” means a country, other than the United Kingdom, which is a party to that Convention.”

14. With regard to the ground of action based on section 3(6) of the Act, that the application for registration was made in bad faith; recent case law has indicated that bad faith is a serious allegation. In *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J stated at page 379:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

15. In the statutory declaration Pillivuyt argue that the trade mark in suit, “PILIVITE”, is an English language version of their trade mark “PILLIVUYT”. They argue that the relative pronunciations would be ‘pilly-vyte’ for the “PILIVITE” trade mark and for the “PILLIVUYT” trade mark either ‘pilly-vweet’, if the person was conversant with the French language, or ‘pilly-vyte’, if they are less familiar with the French language. This view of the Anglicisation of the trade mark “PILLIVUYT” is supported by exhibit 6, where the two trade marks are used together and with “PILIVITE” used as a clear alternative for “PILLIVUYT”. It therefore appears that the trade mark was registered by Pillivuyt’s distributor and used as a colourable alternative to the trade mark under which the goods were supposed to be sold.

16. The facts set out in the statutory declaration, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case of bad faith has been made out in that, at the date of the application, J. Chomette & Son Limited were not entitled to claim proprietorship of the trade mark the subject of the application for invalidation. In the absence of defence by the registered proprietor, the application for a declaration of invalidity made under sections 47(1) and 3(6) of the Act succeeds.

17. As the applicant has been successful I do not need to go on to consider the grounds based on sections 5(4)(a), 32(3) or 60(3)(a) of the Act.

18. As to costs, the applicant, Sas Nouvelle Pillivuyt, has been successful, and I order J. Chomette & Son Limited to pay them £600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of September 2004

**Graham Attfield
For the Registrar
the Comptroller-General**