

O-298-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO  
AN APPLICATION UNDER NO. 82103 FOR REVOCATION ON THE  
GROUNDS OF NON-USE BY E & J GALLO WINERY OF REGISTERED  
TRADE MARK NO. 2207602 IN THE NAME OF J.E.A. TAYLOR**

## TRADE MARKS ACT 1994

### IN THE MATTER OF an interlocutory hearing in relation to an application under No. 82103 for revocation on the grounds of non-use by E & J Gallo Winery of registered trade mark No. 2207602 in the name of J.E.A. Taylor

#### Background

1. On 4 April 2005, R G C Jenkins & Co, on behalf of E & J Gallo Winery (“the applicant”) applied under the provisions of Section 46 of the Act for revocation of trade mark registration No. 2207602 for the mark FRUITEEZER.

2. In line with registry practice, the application was examined and a copy was sent to J.E.A.Taylor (“the registered proprietor”) under cover of a letter dated 8 April 2005. The letter included the following:

“If you wish to continue with your registration, you should complete the enclosed Form TM8 and counterstatement and return it within **3 months** from the date of this letter. You must also include within this period two copies of evidence of use or reasons for non-use of the mark; This is in accordance with Rule 31(3) of the Trade Marks Rules 2000 (as amended).

The Form TM8 and counterstatement and evidence of use (or reasons for non-use) should be received on or before **8 July 2005.**”

3. On 6 July 2005, William A Shepherd & Son Ltd submitted a Form TM33 notifying the registry of its appointment as representative of the registered proprietor. Also enclosed were a Form TM8 together with a Witness Statement and exhibits in support of the registration.

4. The registry considered the documentation and wrote to the registered proprietor. The letter dated 26 July 2005 stated:

“I acknowledge receipt of the Form TM8 and evidence of use consisting of a witness statement by Gary William Anthony Johnson and exhibits GWAJ1-GWAJ3 filed on 6 July 2005.

Unfortunately, the registrar has noted that the registered proprietor has not filed a counterstatement in accordance with Rule 31(3) of the Trade Mark Rules 2000, as amended.

As no counterstatement has been filed within the time period set, Rule 31(3) applies. Rule 31(3) states that: “...otherwise the registrar may treat him as not opposing the application.

The Trade Marks Registry is minded to deem the opposition to the application as withdrawn as no defence has been filed within the prescribed period. However, in accordance with Rule 54(1) either party has the right to be heard or file written submissions on the matter.”

5. William A Shepherd responded by way of a letter dated 2 August 2005 essentially arguing against the registrar’s preliminary view. It indicated that it wished to be heard if the preliminary view was maintained.

6. A hearing was arranged and took place before me via videoconference on 8 September 2005.

### **The Hearing**

7. The issue before me was the registrar’s preliminary view to deem the opposition to the application as withdrawn as no defence was filed within the prescribed period. At the hearing, the applicant was represented by Dr James, the registered proprietor by Mr Johnston. Following the hearing I issued a letter giving my decision which was to overturn the preliminary view and admit the documentation filed as being a proper defence against the application.

8. My letter, dated 8 September stated:

“Although the Form TM8 filed is not the current published form, the registrar has issued no directions indicating that the previous version is no longer valid. A Form TM8 had been filed within the prescribed period, along with a witness statement which not only contained evidence of use but also set out the extent of the defence and thus could serve as a counterstatement. I find that a defence had been filed within the prescribed period which contained all the required information.”

### **Submissions**

9. Mr Johnston apologised for filing an “erroneous” form but said that this was not sufficient to throw the case out. He argued that revocation proceedings involved an attack against a right which already existed (as opposed to opposition proceedings which involved an attack against an application to secure rights) and as such registered rights were somewhat sacrosanct. Mr Johnston submitted that the registrar had a discretion under both rule 31(3) and rule 57 which should be exercised in the registered proprietor’s favour allowing him to defend against the attack.

10. Mr Johnston gave some background to these proceedings and explained that the application had been launched without prior notice and was unexpected. Following receipt of the application from the registry, the registered proprietor contacted William A Shepherd and later appointed them as their professional representative. A meeting was held on 6 June 2005 at which it was agreed that the proceedings would be defended. A letter was issued to the applicant on 8 June 2005 giving details of use of the mark and seeking to dispense with the proceedings. The letter also made it clear that the proceedings would be vigorously defended if not withdrawn. A further letter

was issued on 22 June 2005 providing further evidence of use. Mr Johnston submitted copies of these letters with his skeleton argument.

11. Mr Johnston stated that as the application was not withdrawn, the registered proprietor filed a Form TM8 and evidence of use on 6 July 2005. The actions taken by the registered proprietor showed a clear intention to defend and, although the then latest published version of the form TM8 had not been used, all the information required by that version was present in the material filed.

12. Mr Johnston submitted that unlike evidence of use, there was no prescribed format a counter-statement should take. The evidence of use filed did comply with requirements and included a complete denial of the grounds of revocation. The combined effect of this was that the evidence could serve as a counter-statement.

13. Mr Johnston said that the material filed showed there to be an arguable, substantive case. There is a need to avoid a multiplicity of proceedings and rejecting the defence would lead to the registered proprietor opposing the applicant's own application for registration.

14. For his part, Dr James submitted that the issue was not just one of using an erroneous form but also the lack of a counter-statement. The rules should, he said, be followed especially by professional representatives. Dr James pointed out that the current rules make the filing of a Form TM8 mandatory as was the need for a counter-statement to be included. He argued that the registered proprietor had not filed a counter-statement and, by using an old style form had not, in any event, signed the appropriate declarations.

15. Dr James referred me to the Appointed Person's decision in *Unifers SPA v KML Invest AB* (O-084-04) where the applicant had filed a counter-statement but failed to file a Form TM8. He submitted that whilst the failure to file a form is a big thing, the failure to file a counter-statement is even bigger. Dr James submitted that a party should not have to assume a denial from comments incorporated in the evidence but that reliance should be placed on a proper counter-statement.

16. Dr James accepted that there is a discretion available under rule 31(3) but submitted that following the decision in *Lowden* [2005] RPC 18 such discretion was very limited. The period for filing the defence was not extensible and discretion should only be exercised where there were factual errors on the form itself. Missing the relevant dates because of administrative errors were not sufficient grounds for exercising the discretion and there was no remedy for failing to file a proper defence in time. Neither was there any grounds for exercising any discretion under the provisions of rule 57.

17. Dr James submitted that as the registrar has no power to allow an extension of time for the filing of a counter-statement, no defence has been filed and therefore the registration should now be revoked. Alternatively, and Dr James indicated that he did not argue this with any great vigour, the application should be allowed to proceed with the registered proprietor merely acting as an observer.

18. In reply, Mr Johnston submitted that a counter-statement had been filed albeit not in the usual format but within the evidence. Rejecting Dr James's arguments in respect of the *Uniters* and *Lowden* cases, Mr Johnston said that the circumstances in the current case were very different as the documentation had been filed within the period allowed, it included a form TM8 and the evidence filed in defence was compelling.

19. Mr Johnston said that it would be inequitable and against the rules of natural justice to reject the defence where there was a procedural irregularity by the registered proprietor or his agent. He submitted that the Act and rules were not inconsistent with the Civil Procedure Rules and that the evidence filed should be admitted.

## **The Law**

20. Applications for revocation of a registered trade mark are provided for under Section 46 of the Act. This states:

“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.”

Also relevant is rule 31 which states:

- “**31**(1). An application to the registrar for revocation of a trade mark under section 46, on the grounds set out in section 46(1)(a) or (b), shall be made on Form TM26(N) and be accompanied by a statement of the grounds on which the application is made.
- (2) The registrar shall send a copy of Form TM26(N) and the statement of the grounds on which the application is made to the proprietor.
  - (3) The proprietor shall, within three months of the date on which he was sent a copy of Form TM26(N) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, and be accompanied by-
    - a. two copies of evidence of use of the mark; or
    - b. reasons for non-use of the mark,

otherwise the registrar may treat him as not opposing the application.

- (4) The evidence of use of the mark shall-
  - (a) cover the period of non-use alleged by the applicant on Form TM26(N), or
  - (b) where the proprietor intends to rely on section 46(3), show that use of the mark commenced or resumed after the end of that period but before the application for revocation was made.
- (5) The reasons for non-use of the mark shall cover the period of non-use alleged by the applicant on Form TM26(N).
- (6) The registrar shall send a copy of Form TM8 and any evidence of use, or reasons for non-use, filed by the proprietor to the applicant and the date upon which this is sent shall, for the purposes of rule 31A, be the “initiation date”.

21. The use of forms is provided for under section 66 of the Act. This reads:

“**66.** –(1) The registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the registrar with respect to their use, shall be published in the prescribed manner.”

22. The combined effect of section 66 and rule 31 is that a registered proprietor is required to file a Form TM8 with a counter-statement and, if applicable evidence of use, if it wishes to defend against an attack on its registration.

23. As with all forms published by the registrar, the TM8 is regularly reviewed and updated. At the time the Form TM8 in these proceedings was filed, the then current published form was one bearing the title “Form TM8. Notice of defence and counterstatement”. It also had the notation (REV JUL04) indicative of the fact that it was revised in July 2004. Despite having been filed in July 2005, the Form TM8 submitted in these proceedings was not the version introduced following revision a year earlier. What was filed was a form bearing the title “Form TM8. Form for counterstatement” and bearing the notation (REV/2). There is no indication of when this version of the form was published or introduced though clearly it was some time before July 2004.

24. There are a number of differences between the two forms. Aside from the differing layout of the forms, the later version contains requests for information not present on the older version. Firstly, the filer is requested to provide information regarding statements of use and proof of use. Form TM8 is a multifunctional form, used to file a defence in both pre registration (opposition) and post registration (revocation, invalidation and rectification) proceedings. Because of this, not all requests for information are required to be completed in every instance. The information requested in these spaces would not be completed in respect of an

application for revocation based on the grounds of non-use. Its absence from the form as filed is therefore not relevant in the circumstances of these proceedings.

25. A second substantive difference is that the later form provides an additional space for the completion of the counter-statement itself. There is no equivalent space provided on the earlier version. A further difference is that whilst both versions of the form contain a declaration to be signed by the filer the wording of each is not the same. I will return later to the difference in wording of the declarations.

26. What is clear from the wording of the earlier version of the form, is that although the form itself does not provide a space for a counter-statement, one should accompany the form. Subject to this being done, I do not believe there to be any material difference between the information sought by the two versions of the form in proceedings of the type covered by the present case.

27. There is no evidence before me that, upon publication of the later version, any notice was given that any earlier versions of the Form TM8 were no longer valid. As I indicated earlier, forms are regularly reviewed and updated by the Trade Marks Registry. Despite the updating, old style forms may still be accepted if the information provided on them is in line with that required by the later versions. I am supported in this by guidance recently published by the Trade Marks Registry in its regular newsletter MARK-IT! Issue 12 of the publication, dated August 2005, advised readers of the launch of new trade mark forms. The article stated:

“On the 1<sup>st</sup> September 2005 we will launch new-style Trade Mark forms. There is no need to destroy your existing stocks as you will still be able to use them after the launch date. New-style forms can be obtained from the usual sources.”

28. I also bear in mind the provisions of rule 3 which states:

“**3.** (1) Any forms required by the registrar to be used for the purpose of registration of a trade mark or any other proceedings before her under the Act pursuant to section 66 and any directions with respect to their use shall be published and any amendment or modification of a form or of the directions with respect to its use shall be published.

(2) A requirement under this rule to use a form as published is satisfied by the use either of a replica of that form or of a form which is acceptable to the registrar and contains the information required by the form as published and complies with any directions as to the use of such a form.”

29. The Form TM8 filed in these proceedings was a form published in accordance with rule 3(1). Whilst the form has since been revised and the revised form published, I am not aware of any notice having been published to indicate that the earlier version is no longer valid. Even if I am wrong in this then, subject to the filing of a counter-statement, all the information required by the later version of the Form TM8 was provided on the earlier version as filed and the form as filed would comply with the requirements of rule 3(2).

30. For both versions of the form, a counter-statement is required. As I indicated in paragraph 25 above, the later version of the Form TM8 provides a space for completion of the counter-statement. The space does not contain any questions to be answered or request any specific information but is instead a blank space within which the filer may write whatever he wishes in support of his case. The earlier version of the form requires a separate, but accompanying, counter-statement. It is a matter for the filer to determine how best to present his counter-statement and therefore, there is no specific format that such a statement should follow.

31. Rule 31(2) requires the filing of a Form TM8 “which shall include a counter-statement”. This suggests that the counter-statement be included within the body of the form. The later version of the form provides a space for this to be done. But the space within the form is often completed not with a counter-statement but with the words “see separate sheet”, a fact recognised by the fact that the form has a box for filers to indicate how many separate sheets are attached to the form. I do not therefore consider that the counter-statement must be written on the form itself despite the specific wording of rule 31(2).

32. The Trade Marks Registry takes a purposive approach to the acceptance of counter-statements. The purpose of the counter-statement is to set out the extent of the filer’s defence and thus enable the parties to establish the issues which are in contention. Whilst it is not uncommon for counter-statements to be filed separately, whether under cover of the earlier or later version of the Form TM8, and to bear a heading “Counterstatement”, this is not a requirement. The Registry looks to its content and has accepted these documents in many different formats, e.g. in a covering letter or other accompanying document.

33. In this case, the registered proprietor filed a form which did not contain a space for completion of the counter-statement. Neither did it file a document specifically headed counter-statement. What it did file was a witness statement of Gary William Anthony Johnston, the registered proprietor’s trade mark attorney, and dated 5 July 2005. The witness statement contains the following information:

“(2) The current revocation proceedings are filed on two basis namely that the Mark has not been used for a period of five years following the date of completion of the registration procedure and that there has been no use of the Mark in the period 4 April 2000 to 4 April 2005. This is patently incorrect. Trade Mark No. **2207602** was filed on 3 September 1999 and the month following that the registered proprietor engaged the services of **RED PEPPER ADVERTISING & MARKETING** of 56 West Cliff, Preston, Lancashire, PR1 8HU to design a Logo for the **FRUITEEZER** brand and other supporting promotional materials. Exhibit “**GWAJ 1**” contains copies of invoices by **RED PEPPER ADVERTISING & MARKETING** to **J.E.A TAYLOR LIMITED** evidencing the same. Exhibit “**GWAJ 2** is a photocopy of a 568 millilitre bottle of the **FRUITEEZER** product from which you will note that the Brand **FRUITEEZER** is displayed prominently on the label and it should also be noted that the expiry date for that particular product was 17 December 2004.

(3) Exhibit “**GWAJ 3**” contains information on products sold in the relevant period –I understand this to be taken from the Registered Proprietor’s computer record. It clearly shows the quantity of **FRUITEEZER** products sold in the relevant period. Exhibit “**GWAJ 4**” contains copy invoices showing sales of the product in the relevant period.

(4) As can be gleaned from the above and the Exhibits the Registered Proprietor immediately upon filing an application for registration of this Mark engaged an advertising agency to create an appropriate Logo and other promotional materials to launch this particular product and indeed the product has been sold within the relevant period. In the circumstances therefore the Registered Proprietor has used the Mark within the relevant periods and as such therefore this revocation action should be defeated. On behalf of the Registered Proprietor I hereby request that registration No. 2207602 be maintained in its entirety and that an Award of Costs be issued in its favor (sic) in these proceedings. (*my underlining*).

I confirm that the content of this statement are true to the best of my knowledge and belief.”

34. It is plainly desirable that users of the Trade Mark Registry have regard to the latest published forms. It is also plainly desirable that any counter-statement filed separately to the Form TM8 be clearly and unambiguously an identifiable document in its own right. But although desirable, I bear in mind that no guidance has been issued as to what form such a document should take. I also bear in mind that the Trade Marks Registry frequently admits material intended to be evidence but which contains little more than comment and submission. The evidence in this case, which is relatively brief, submits evidence of use but also contains a complete and unambiguous rebuttal of the allegations made in the application for revocation. Whilst I accept Dr James’s submission that an applicant should not have to “assume a denial” in this case there is no need to “assume”; the denial, as indicated by my underlining in the excerpt in paragraph 33, is explicit.

35. Revocation of a registration is a serious matter. A defence, in the form of a Form TM8 and evidence was filed within the period allowed. Taking all the circumstances into account, adopting a purposive approach and bearing in mind the overriding objective and the need for proportionality, I determined that a counter-statement, albeit within the evidence, had also been filed.

36. As I indicated earlier, Dr James argued that in filing the material it did, the registered proprietor had not signed the appropriate declarations. I have already found that the earlier version of the Form TM8 was acceptable and this being the case the specific wording of the declaration on the form is also acceptable. For completeness, however, I would confirm that in my opinion the wording of the declaration appearing on the earlier version of the form, when considered in conjunction with the wording of the declaration in the witness statement, (which I have determined can in these proceedings stand as a counter-statement), imposes equal if not greater responsibility on the person signing these declarations, (who in this case was one and the same person), as that appearing on the later version of the form.

37. I made no order as to costs.

**Dated this 8th day of November 2005**

**ANN CORBETT  
For the Registrar  
The Comptroller-General**