

O-323-07

TRADE MARKS ACT 1994

**IN THE MATTER OF CONSOLIDATED APPLICATIONS
BY FLINT GROUP GERMANY GMBH UNDER Nos. 82136 AND 82137 FOR
REVOCATION OF REGISTRATIONS Nos. 1429033 AND 1429034
STANDING IN THE NAME OF GLOBOCOIM B.V.**

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for Revocation of Registrations Nos. 1429033 and 1429034
standing in the name of Globocoim B.V.**

BACKGROUND

1. Trade mark No. 1429033, NOVACOTE is registered in Class 1 of the international classification system for a specification of goods that reads:

Class 01:

Chemicals for use in industry; synthetic resins; adhesives for use in industry; formulations comprising priming substances and coating materials, all for use in the packaging industry; binders and resinous or plastic based material, all for use as intermediates in the paints industry; all included in Class 1.

2. The same mark is also registered under No. 1429034 in Class 2 of the international classification system for a specification of goods that reads:

Class 02:

Coatings and coating compositions; sealants; paints, varnishes and lacquers; primers; all included in Class 2.

3. Both registrations stand in the name of Globocoim B.V.

4. On 28 April 2005 BASF Drucksysteme GmbH, now Flint Group Germany GmbH, applied for revocation of these registrations under Section 46(1)(a) and (b) of the Act. The amended statements of grounds that are before me allege non-use following the date of completion of the registration formalities and seek revocation as of 16 October 1997 under the provisions of Sections 46(1)(a) and 46(6)(b).

5. In the alternative, revocation is sought under Section 46(1)(b) on the basis of non-use since at least as early as 10 May 1995 with an effective revocation date of 10 May 2000. In the further alternative non-use is alleged during the five years immediately preceding the applications.

6. If the proprietor claims there are proper reasons for non-use, it is put to strict proof of the existence and propriety of such reasons.

7. The relief sought is either the complete revocation of the registrations or an appropriate restriction of the specifications to reflect the goods on which genuine use has been shown.

8. The registered proprietor filed counterstatements denying the above claims and asking that the applications be refused in their entireties or to such an extent as is

deemed appropriate if it is considered that the trade mark has not been used on all the goods of the registrations.

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

10. The two cases were consolidated. Both sides filed evidence. The matter came to be heard on 16 October 2007 when the registered proprietor was represented by Ms H Whelbourn of J E Evans-Jackson & Co and the applicant for revocation by Mr R Manaton of Bromhead Johnson.

Registered proprietor’s evidence under Rule 31(3)

11. Terence Sadler of Coim UK Limited (Coim) has filed a witness statement. Coim is a UK subsidiary of Globocoim B.V. and Mr Sadler is Coim’s General Manager. He has been employed by Coim since 1 August 2001 and has held his current position since 13 March 2003. He says that the facts set out in his statement have been obtained by, or for, him from the files and records of Coim and its parent company.

12. He says that the mark NOVACOTE has been used in genuine commercial trade by Globocoim B.V. over a period of many years since at least as early as 1997. More specifically it has been used in the UK in the period of five years prior to the date of the filing of the revocation actions, “namely prior to 20 January 2005”. I interject to say that the applications were filed on 28 April 2005 so the reason for this choice of date is not clear but it is probably based on a misinterpretation of the provisions of Section 46(3). The use has been in connection with adhesives and coatings. Sample invoices and other documentation showing sales of goods under the mark between the dates of 16 February 1999 and 18 January 2005 are exhibited at CS1. There are four documents as follows:

Document type	Date	Customer	Description	Value
Packing list	Order 6/8/2001 Despatch 9/8/2001	Novacote Flexipack Sant Etienne du Rouvray (Rouen)	HS-61-185 22kg	- (Weight only given)
Invoice	18/1/2005	BASF Printing Systems Ltd	NC-2147/3 200kg	£1292.50
Invoice	3/6/2004	KPE Coaters Ltd	NC-2231) 24kg) NC-0044) 20kg)	£804.88
Invoice	16/2/1999	Kent Laminators	NC-2985) 22.7kg Adhesive) NC 2986) 2.6kg Adhesive)	£1513.95

Registered proprietor’s evidence under Rule 31A(3)

13. Terry Cooke, the Product Manager of Coim Limited Trading, a UK subsidiary of Globocoim B.V. has filed a witness statement. The facts contained in the statement were obtained by, or for, him from the files and records of his company and the registered proprietor. He exhibits at TC1 the following documentation:

Document type	Date	Customer	Description	Value
Purchase order	1/3/2006	Fisher Scientific UK Ltd	Laboratory equipment and mat	£34.09
Order confirmation	27/4/2006	Penspell Ltd	Laripur 9025	Redacted
Packing list	27/4/2006	Penspell Ltd	Laripur 9025	Weight only given (100kg)
Invoice	27/4/2006	Clean Card Systems	NC-253-A) 25kg) NC-3355) 0.31kg)	Redacted

14. Additionally Exhibit TC1 contains:

- a sheet of A6 address labels with Novacote logo
- a picture of the logo etched into the glass in the meeting room at the Loughborough offices
- a large label used on 200 litre drum packs to give product and safety data
- a 2003/4 promotional desk pad
- a blank technical data sheet template
- a blank letterhead
- a picture of the Novacote sign on the company's warehouse
- A Novacote promotional pen.

15. I note that wherever the Novacote mark appears on the documentation and other materials exhibited by Mr Sadler and Mr Cooke it is in the following form:



16. A number of the items also highlight the word COIM which is itself accompanied by a strong device mark. The word COIM is also stamped across the full width of the purchase orders, invoices and packing list exhibited to Mr Cooke's exhibit.

17. There is also a witness statement from Helene Whelbourn, a Registered Trade Mark Attorney employed by J.E. Evans-Jackson & Co. The purpose of her evidence is to set out the chain of title whereby Globocoim B.V. came into ownership of the mark and to deal with an apparent discrepancy that has occurred in the Registry's records. The issue had potential relevancy in determining whether the mark had been used by the successive proprietors or with their consent. The Registry's records have now been amended to reflect the correct historical information. Ms Whelbourn's

evidence remains on record but the issues it deals with have ceased to be in dispute. The pleadings have been amended to reflect this state of affairs.

Applicant for revocation's evidence under Rules 31(A)(1) and (5)

18. Ross Timothy Manaton has filed two witness statements. He is the applicant's Registered Trade Mark Attorney. He exhibits printouts from the Registry's records showing historical details of the two registrations. Again, the issue underlying the filing of this piece of evidence has been resolved. The remainder of his evidence consists of submissions on the registered proprietor's evidence. I have read this material and take it into account in my decision but do not propose to summarise it at this point.

19. That completes my review of the evidence.

The Law

20. Section 46 reads as follows:

“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 purpose 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. The onus is on the proprietor to show use when a challenge arises (Section 100).

22. The two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Marks* [2006] F.S.R. 5. From these cases I derive the following main points:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account and in particular whether the use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services concerned (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective trading circumstances of each case and not the proprietor's commercial intentions, purpose or motivation in relation to the sales of goods (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

Relevant five year periods

23. On the basis of the pleaded case there are three relevant five year periods. Prior to the hearing the Registry wrote to the parties (official letter of 12 September 2007) drawing their attention to Tribunal Practice Notice 1/2007 regarding the calculation of dates. As a result of this, and with the agreement of the parties, the requested date of revocation under Section 46(1)(a) has been amended (the statements of grounds have been annotated to reflect the change). There has been no request to file additional evidence as a result of the minor change. For convenience I set out the relevant five year periods and the earliest revocation dates as follows:

- (i) Under Section 46(1)(a) the relevant period is 17 October 1992 to 16 October 1997. The earliest revocation date is 17 October 1997.
- (ii) Under Section 46(1)(b) (the first alternative in paragraphs 3 of the statements of grounds) the relevant period is 10 May 1995 to 9 May 2000. The earliest revocation date is 10 May 2000.
- (iii) Under Section 46(1)(b) (the second alternative in paragraphs 4 of the statements of grounds) the relevant period is 28 April 2000 to 27 April 2005. The earliest revocation date is 28 April 2005.

24. I should just add that Mr Sadler's evidence (at paragraph 2) refers to a five year period prior to 20 January 2005. That date is based in part, I think, on a misinterpretation of Section 46(3) (see *Philosophy di Alberta Ferretti* [2003] RPC 15 at paragraphs 7 and 18) together with an unexplained gap between the dating of the Forms TM26(N) requesting revocation and the date on which those forms were formally logged as having been received by the Office. In the event nothing turns on this and, as I have said, it is accepted that the relevant dates are as set out above.

DECISION

25. Firstly, it is admitted that the evidence does not establish use during the first of the periods identified above, that is to say the Section 46(1)(a) period. However, the registered proprietor will have a defence if it can show commencement or resumption of use in the later periods. Ms Whelbourn conceded that the use was thin if the pieces of evidence and accompanying exhibits were considered singly but submitted that I must have regard to the totality of the evidence. She also noted that Mr Sadler had made a clear statement of use in connection with adhesives and coatings.

26. Mr Manaton reminded me of the standard of proof by reference to the following passage from *Kabushiki Kaisha Fernandes v OHIM*, Case T-39/01 [2003] ETMR 98:

“Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and efficient use of the trade mark on the market concerned” (paragraph 47).

and Jacob J's (now LJ) remarks in *Laboratoire De La Mer Trade Marks* [2002] FSR 51 to the effect that:

“Those concerned with proof of use should read their proposed evidence with a critical eye – to ensure that use is actually proved – and for the goods or services of the mark in question. All the “t”s should be crossed and all the “i”s dotted” (paragraph 9).

27. I will deal with Mr Manaton's specific criticisms as part of my own analysis of the evidence provided in support of the registered proprietor's case.

28. By way of introduction I should say that Ms Whelbourn referred me to exhibit TC1 and the list of goods that are said to form part of the 'Production Programme'. It is relied on as giving an indication of the breadth of the proprietor's activities. The document referred to is an information folder. It has been used as a repository for the documents listed in Ms Cooke's witness statement. I am very doubtful whether the folder itself can properly be said to form part of the evidence. Mr Cooke himself does not appear to suggest that this should be taken to be the case. However, Mr Manaton did not suggest that I should reject it on that account. The 'Production Programme' lists the following in four languages:

Laminating Adhesives for Flexible Packaging Materials
Graphic Arts Laminating Adhesives
Primers

TPU-Modifiers for Printing Inks
Heat Seal Coatings
Epoxy Lacquers
Varnishes for Film, Foil, Paper and Board

29. Against that broad statement (undated) of the proprietor's product range I turn firstly to Mr Sadler's evidence. The four items exhibited in support of the generality of his claim are described in paragraph 12 above. Each of the items has the NOVACOTE FLEXPACK composite mark (see paragraph 15 above) along with, in two cases, the sign COIM (highlighted as part of a company name) and a further device mark. I am asked to infer that the letters NC contained in the product descriptions stands for NOVACOTE. That may be the case though I have not been shown actual product packaging, catalogues or other reference material that would serve as a cross-check on the claim. As a result I am also unable in three of the four cases to say what goods were involved. It follows that the only item that can be identified as being of potential relevance is the invoice of 16 February 1999 to Kent Laminators. This sales invoice for £1513.95 identifies the goods as adhesives. There is no suggestion that it is other than a normal arms length trade with a third party in the UK. There are, however, a number of difficulties which can be summarised as being:

- (i) there is no indication on the invoices as to the nature of the adhesives. Adhesives can be found in a number of Classes of the international classification system. Thus, adhesives for industrial purposes are in Class 1, adhesives for cosmetic purposes are in Class 3, adhesives for medical and dental purposes are in Class 5 adhesives for domestic and office use in Class 16 etc. The registered proprietor's specification covers "adhesives for use in industry", in Class 1. It is not clear what adhesives are covered by the Kent Laminators invoice. I note in this respect that the 'Production Programme' listing records that the company offers 'Laminating adhesives for flexible packaging materials' and 'graphic arts laminating adhesives'. These goods may be more appropriate to Class 16 rather than Class 1. I do not need to decide that point definitively. It is enough to say that, on the basis of the limited information available to me, I simply cannot say with confidence which Class the adhesives that are the subject of the invoice are in. It may be said that the quantities (22.7kg and 2.5kg respectively) of this product are suggestive of large volume and, therefore, possibly industrial use but it could simply be that they are high volume Class 16 adhesives that are being sold to an intermediary for repackaging. The name of the recipient, Kent Laminators, is if anything supportive of the view that the goods are more likely to have been adhesives in Class 16.
- (ii) the proprietor of the mark at the date of the transaction (16 February 1999) was Stahl International B.V. The information at the top of the invoice is Novacote Flexpack, Division of Stahl GB Limited. There is also a reference at the bottom left hand corner of the invoice to Stahl GB Ltd and further small print indicating that this company is part of Zeneca Specialities. Zeneca Limited was, as I understand it, the

previous proprietor (up to 6 April 1998). The relationship between Stahl GB Limited and Stahl International B.V. is not declared. They share the same name. Some association would seem likely and with it the further likelihood that the mark was being used with the consent of the proprietor of record at that time. But again it requires a number of assumptions to be made contrary to the approach advocated by the Courts.

- (iii) the mark that features on the invoice is the NOVACOTE FLEXPACK composite mark along with the identifier NC under the product description heading. It is in my view somewhat doubtful whether this state of affairs is sufficient to satisfy the requirement to show use of the mark NOVACOTE or that mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (per Section 46(2)) though I should say that the point was not pursued at the hearing.

30. In summary Mr Sadler's general claim that the mark has been used in connection with adhesives and coatings is in itself insufficiently particularised. As indicated, adhesives may be in a number of Classes (the examples given above do not represent an exhaustive list). Coatings can also be found in a number of Classes. The proprietor's own specifications include "formulations comprising coating materials, all for use in the packaging industry" (Class 1) and "coatings and coating compositions" (Class 2). There are also coatings in other Classes. A bare claim to use on adhesives and coatings does not, therefore, provide the tribunal with the necessary degree of specificity to determine whether the claim relates to goods that are in either, both or neither of the classes of the registrations under attack. Furthermore, as noted above, only 1 of the three items exhibited to Mr Sadler's evidence identifies goods at all.

31. I now turn to Mr Cooke's evidence as described in paragraphs 13 and 14 above. There are four items (invoices etc) evidencing actual trade. All are clearly well after the filing date of the applications for revocation (for the most part by about a year). Whilst a proprietor can only rely on trade within the relevant period(s) to establish use, evidence of activity outside that period(s) may serve to shed light on the genuineness of what has been done within the period(s) (see to that effect *Laboratoire De La Mer Trade Marks* in the High Court, [2002] F.S.R. 51 at paragraph 35). To that limited extent it is not appropriate to entirely discount or disregard such trade. The difficulty here is that I have been unable to satisfy myself as to qualifying trade under the mark in relation to the goods within any of the relevant period that might be further validated, as it were, by these four later documents.

32. Quite apart from the date problem one is left to guess at the goods save for purchase order No PO2157 which relates to 'laboratory equipment and mat'. These are clearly not relevant goods. There are other problems notably the difficulty of establishing which if any of the various trade marks on display (COIM, device mark, NOVACOTE FLEXPACK composite mark) would have been used on or in relation to the goods. There is also a further unexplained reference under 'description' to Laripur which may be a further mark.

33. The remaining items in this exhibit are, with one exception, undated. The exception is a 2003/4 desk planner but this, like the other exhibits, does not establish a trade in relevant goods under the mark NOVACOTE. I also note that Mr Cooke, unlike Mr Sadler, makes no specific claim as to the goods to which his evidence relates and the exhibits fail to shed any further light on the matter.

34. There is one final point I need to address. The specification of the registrations cover a wider range of goods than simply 'adhesives and coatings'. Ms Whelbourn in her submissions sought to defend a broader range of goods on the basis of the 'Production Programme' listing. In my view this fails on the basis of the defence as pleaded. The counterstatement refers to and relies on Mr Sadler's evidence as establishing the parameters of the registered proprietor's defence. Mr Sadler in turn only claims use in relation to adhesives and coatings. It would appear, therefore, that it would have required an amendment to the counterstatement if a more broadly based case was to be contended for. However, this is largely an academic point as there is no evidence of use that can be clearly linked to the items referred to in the Production Programme listing. Any such broader claim must fail both on the pleadings and the evidence.

35. It follows that, even accepting Ms Whelbourn's submissions that I must consider the totality of the evidence rather than simply individual items, I am still unable to satisfy myself that there has been genuine use of the mark on the goods within any of the relevant periods.

36. The applicant has requested, and is entitled to, revocation from the earliest possible date, that is to say after the close of the five year period following the date of completion of the registration procedure (the 46(1)(a) period). Under the provisions of Section 46(6)(b) the rights of the proprietor in respect of both registrations shall be deemed to have ceased from 17 October 1997.

37. The applicant for revocation is entitled to a contribution towards its costs. The applicant had, of necessity, to file separate Forms TM26(N) to launch these proceedings. Thereafter, consolidation took place at an early stage and the evidence has been common to both cases. Taking these factors into account I order the registered proprietor to pay the applicant the sum of **£1500** 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 1st day of November 2007

M REYNOLDS
For the Registrar
the Comptroller-General