

O-352-03

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2260569
IN THE NAME OF FASIL KAMAL**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81237
THERE TO BY KLAASEN & CO NV**

IN THE MATTER OF trade mark registration No. 2260569
in the name of Fasil Kamal

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 81237 thereto by Klaasen & Co NV

BACKGROUND

1. The trade mark “PLUVERA” has been registered since 28 July 2001 under number 2260569 and stands in the name of Fasil Kamal. It is registered in respect of:

Class 29:

Poultry products; poultry products being fresh; poultry products being frozen; poultry products being preserved; poultry products for food for human consumption; pre-packed poultry products being chilled, fresh and frozen; prepared poultry; preserved food products of poultry; preserved poultry; processed poultry; meat and meat products for food being fresh, chilled and frozen; chilled meals made from meat; prepared meat; prepared meat products for food for human consumption.

2. On 09 April 2003, Klaasen & Co NV 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 as follows:

- Under sections 47(2)(b) and 5(4)(a) of the Act as the applicant claims goodwill in the name “PLUVERA”, an unregistered trade mark used in respect of poultry, chicken and poultry and chicken related products and that use of the registration would amount to passing off. The applicant has a registration in the Benelux and is using this as a basis for an International Registration which is being extended to the UK.
- Under sections 47(1) and 3(6) of the Act as the applicant claims goodwill and reputation in the name “PLUVERA” used in relation to chicken products and that the proprietor of the registration had no *bona fide* intention to use the mark in relation to goods for which it was registered.

3. In the statement of case the applicant asserted that their mark had been in continuous use in the UK since 1991 in respect of poultry products. That it was an earlier unregistered trade mark which had been used on advertisements and point of sale material, and from this use the applicant had developed a substantial reputation in respect of their mark. They contend that as a result of the identity of the marks and the identity of the goods, also the reputation and goodwill which has been built up, their mark would be protectable under the common law tort of passing off.

4. On 15 April 2003 a copy of the application for invalidation and the statement of grounds were sent to the address for service recorded on the register. The registered proprietor did not file a counter-statement to defend his registration. The consequences of failure to defend the registration were set out in the letter dated 15 April 2003, 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 2003, the Registrar wrote to the applicant’s representative inviting him 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. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

9. On 21 July 2003 the applicant for invalidity provided a witness statement, with exhibits, to establish the reputation and goodwill the applicant has in the mark “PLUVERA”. They also stated that they were content for the decision to be taken on the basis of the papers filed.

10. The evidence and exhibits submitted consist of the following, a witness statement by Jos Piron, Director of the applicant company, dated 16 July 2003, and eight bundles of exhibits. The witness statement first refers to the applicant’s Benelux trade mark registration, filed on 18 October 1995, the basis for an International registration, filed on 7 June 2002, designating the UK, and that the International registration was provisionally refused on the basis of the trade mark in suit. The statement goes on to comment on

communications between the agents acting for the two parties, and that the agent for Fasil Kamal had received no communication from Mr Kamal. Then the statement goes on to relate the history of the applicant company, originally starting in the chicken business in 1930 the applicant was incorporated in Belgium in 1954 and started trading under the brand name PLUVERA in 1959. It explains that the brand name is an invented word taken from a Dutch phrase “PLUim VEe-RAvels” meaning “poultry from Ravels”, Ravels is the village in which the applicant company is situated. With reference to the company brochure and web site the statement refers to the mark in use, the history of the applicant and its range of products, also photographs of packaging are provided to show the mark in use. The statement goes on to say that prior to 1991 sales to the UK were sporadic but from that date on has been continuous. The main customers are industrial food processing companies purchasing de-boned chicken breast fillets and wholesalers, poultry dealers and retail outlets purchasing a variety of frozen chicken products. They state the turnover in the UK business, per year, as 1991 - £200,572; 1992 - £591,038; 1993 - £1,345,923; 1994 - £1,284,642; 1995 - £1,734,393; 1996 - £1,756,191; 1997 - £1,950,307; 1998 - £1,495,755; 1999 - £776,101; 2000 - £314,149; 2001 - £1,278,959; 2002 - £884,192. To support this they provide as an exhibit a document entitled “Sales of Pluvera Frozen Hen Products in the UK from 10/10/1994 until 13/12/2002”. Since 1991 the applicant has promoted their business through the use of posters, stickers and brochures, also promotional items such as T-shirts, baseball caps and calendars, as well as placing their mark prominently on their packaging. Finally the applicant submits that the proprietor of the mark in suit had no bona fide intention to use the mark and that they can find no evidence of Mr Kamal actually using the mark in relation to poultry products in the UK. The exhibits are:

- Exhibit 1 – a copy of the registration certificate for Benelux trade mark number 581716.
- Exhibit 2 – a copy of a letter, dated 27 February 2003, from the agent of the applicant to the agent of the proprietor of the mark in suit. This lays out their objection to the registration and threatens action if the mark is not assigned to the applicant.
- Exhibit 3 – copies of three pages purporting to be product price lists from 1961 and 1965, however these are in Dutch and have not been translated, therefore they cannot be taken into account. Each page does have the word PLUVERA prominently displayed.
- Exhibit 4 – eleven pages printed on 03 July 2003 from the applicant’s Internet web site, these are all in English and detail the history of the applicant, different branches of the applicant and product range of the applicant. All pages clearly show the applicants PLUVERA mark.
- Exhibit 5 – a colour brochure, undated, giving essentially the same information as in exhibit 4, but this is produced with the text in four languages, Dutch, French,

German and English, with certain parts also produced in Arabic. All pages clearly show the applicant's PLUVERA mark.

- Exhibit 6 – 5 copies of photographs, undated, showing packaging with the PLUVERA mark prominently on each piece.
- Exhibit 7 – a copy of a document, 22 double sided pages, entitled “Sales of Pluvera Frozen Hen Products in the UK from 10/10/1994 until 13/12/2002”. This shows volume of sales, by weight, by product, per year and also lists each individual invoice for each UK trader and lists the products and weight delivered under that invoice. This demonstrates sales to London, Milton Keynes, Worcester, Edinburgh, Sevenoaks, Norfolk, North Yorkshire, Essex, Redditch, Craigavon, Salford, Lincolnshire, Barnsley, Suffolk, Maidstone and Livingstone.
- Exhibit 8 – copies of seven photographs showing promotional items, T-shirt, baseball cap, sticker (2), poster (2) and calendar. These are undated and from the appearance of some of the items, in particular the posters it is questionable whether they would have been used for the UK market.

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

DECISION

12. 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) and 5(4)(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.”

13. First, I dismiss the application in so far as it is based upon sections 47(1) & 3(6) of the Act. No evidence has been put forward by the applicant to lead me to the conclusion that the application was made in bad faith. There is nothing to suggest that the registered proprietor, as an applicant, had no intention of using the trade mark in suit. And there is no evidence that the registered proprietor acted in any way below acceptable commercial standards, see Lindsay J in *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 (at page 379). That leaves the section 47(2) grounds based upon section 5(4)(a) of the Act.

14. With regard to section 5(4)(a) of the Act the requirements for this ground of action have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child* trade mark [1998] RPC 455. Adapted to these proceedings, the three elements that must be present can be summarised as follows:

(1) that the applicants’ goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietor are goods of the applicant, and

(3) that the applicants have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the registered proprietors' misrepresentation.

15. First of all, I believe that there is sufficient evidence to justify the applicant's claim to a reputation under this head. The sales figures, though not put into context, are substantial. I am also satisfied that the goods have been sold under a mark which has become distinctive as a badge of origin of the applicant. That is a mark consisting, primarily, of the word "PLUVERA". As the applicant has established a reputation in use of the "PLUVERA" mark from a date far earlier than the date of registration of the trade mark in suit I am satisfied that there will be misrepresentation and the relevant public will believe that the goods sold under the registered proprietors' trade mark are the goods of the applicant. Though there are differences between some of the goods themselves, the near identity of the trade marks and overall similarity of the goods means that the misrepresentation would extend to the whole of the goods covered by the registration. In the circumstances damage will be suffered by the applicant.

16. The facts set out in the witness statement and accompanying exhibits, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case has been made out that, at the date of the application, Klaasen & Co NV had a reputation for poultry products which was protectable under the tort of passing off. The application for a declaration of invalidity made under section 47(2)(b) based upon section 5(4)(a) of the Act therefore succeeds.

17. As to costs, the applicant has been successful, and I order Fasil Kamal to pay them £600. This sum is to be paid within seven days 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 17th day of November 2003

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