

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 9040
BY CF WEISS GMBH & CO KG
FOR REVOCATION OF TRADE MARK NO 1146757
IN THE NAME OF INTERFAIR PTY LIMITED**

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**IN THE MATTER OF application No. 9040
by CF Weiss GmbH & Co. KG
5 for revocation of trade mark No 1146757
in the name of Interfair PTY Limited**

DECISION

10 Trade mark number 1146757 is registered in Class 25 in respect of:

Articles of gymnastic and sports clothing

15 The registration currently stand in the name of Interfair PTY Limited and the mark is as follows:



25 By an application dated 3 June 1996, CF Weiss GmbH & Co. KG applied for this registration to be revoked under the provisions of Section 46(1) on the grounds that:

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1. Within the period of five years following the date of completion of the registration procedure and subsequently, the mark shown on the United Kingdom trade mark registration no. 1146757 has not been put into genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods for which it is registered and there are no proper reasons for non-use.

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 2. Any use which the proprietor may have made of the trade mark shown on the registration no. 1146757 in the United Kingdom has been suspended for an interrupted period of 5 years, and there are no proper reasons for non use.

40 The registered proprietor filed a counterstatement in which they denied these grounds.

The registered proprietor and the applicants for revocation both ask for an award of costs in their favour.

45 Both sides have filed evidence in these proceedings although neither party has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Registered proprietors' evidence

This consists of a Statutory declaration dated 22 September 1996 and is made by Ashwani Kumar Sachdena, the Managing Director of Interfair PTY Limited, a position he has held since 1979.

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Mr Sachdena begins by confirming that his company is the registered proprietor of registration number 1146757, the particulars of which he sets out, and that his company has used this trade mark in the United Kingdom. He refers to exhibitA which consists of invoices from Intersport, a Singaporean company, relating to the supply of number of items of what could be described as sports or leisure clothing to the Grewal Emporium in London in the period February 1988 to March 1996. The invoices do not show use of the mark as registered but incorporate the word STROBEL in the description of the goods supplied.

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Mr Sachdena explains that the registered proprietor coordinates the overall business activities in respect of goods bearing the trade mark, with Intersport being responsible for the distribution of the goods within the United Kingdom. He says that Intersport is a sole proprietorship and that the proprietor of Intersport is one of two Director cum shareholders of the registered proprietors business.

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Mr Sachdena goes on to refer to exhibitB which consists of a catalogue of items of sports apparatus and clothing products from Interfair PTY Ltd, Australia, most bearing the name STROBEL, either in the form as registered, as a word with the device of a human figure placed between the letters "o" and "b", or as a word alone in plain block capitals. There is nothing which indicates the date of the catalogue or whether it was available in the United Kingdom.

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Mr Sachdena confirms his company's continuing interest in the trade mark and that there has been long and continuous bona fide use up to the present date. He confirms that the registered proprietor is currently looking for a distributor or business partner in the United Kingdom to further expand the business.

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Applicants' evidence

This consists of a Statutory Declaration dated 13 June 1997, and comes from Paul Zarecky, who states he is the sole proprietor of Zarecky International, an investigation agency in the United Kingdom.

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Mr Zarecky says that on 22 February 1996 he was commissioned to carry out investigations into the use made of the trade mark registered under number 1146757. He says extensive enquiries were made but these failed to reveal any use of the trade mark, and refers to exhibit PZ1 which consists of a copy of the report of his investigations prepared for J A Kemp & Co, the applicants' trade mark attorneys. The report confirms that the registered proprietor is using the mark in Australia in respect of sporting goods and that Mr Zarecky made contact by telephone with a Mr Ashley Kumar of Interfair PTY Limited, but did not obtain any information. The report records that Mr Zarecky made a further telephone call and that he spoke with a woman named Rose who stated that the company (Interfair) did not export any of its products, confirmed the company's product range incorporated a range of sporting equipment and trophies, and that STROBEL was the company's trade mark and was applied to such goods in Australia.

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Mr Zarecky goes on to say that in January 1997 he was requested to carry out further enquiries concerning a retail outlet called Grewal Emporium (the UK distributor shown on the invoices at exhibitA) the purpose being to establish whether goods bearing the registered proprietors' STRO BEL mark were on sale. He refers to exhibit PZ2 which consists of a copy of the report of his investigations. The report gives a description of the premises which he says is shared by a hairdresser and a retailer of children's clothing, and recounts Mr Zarecky's investigations via British Telecom's Directory Enquiry Service, a computer search for the existence of a company or business, and a visit to the premises, all of which proved negative.

Mr Zarecky says that he obtained the telephone number of the business operating at the premises, Mirage Beauticians, which he telephoned and asked to speak to Grewal Emporium. He reports that he was told that GREWAL was not present but would be in later, and on phoning back spoke to a female who identified and confirmed herself as the trader GREWAL and that she dealt in babies clothing.

That concludes my review of the evidence.

Decision

With all of the evidence in mind I now turn to consider the grounds on which a revocation may be based, and which are found in Section 46(1) of the Act, which 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;

Although the applicants have not stated under which part of section 46 they object, the wording used indicates that the matter falls to be considered under both subsection (a) and subsection (b) of Section 46. The registered proprietor has provided two examples of the use they have made of the mark; invoices for goods supplied (exhibitA) and a catalogue of their company products (exhibitB).

Although the catalogue shows the mark as registered being used in relation to some of the goods for which it is registered, it does not contain any indication of the date from which it originates, or to show that it has ever been available or used in the United Kingdom. The registered proprietors have not given any information in this respect and I am unable to accept the catalogue as substantiating use of the mark in the United Kingdom prior to the date of the application for revocation of the registration.

5 The invoices relate to the supply of various items of leisure or sports-type clothing by a Singaporean company, Intersport, to a trader in the United Kingdom called Grewal Enterprises. The proprietor has confirmed that Intersport is responsible for the distribution of their goods in the United Kingdom, and that Grewal Enterprises is a business run by one of two director-cum-shareholders of the registered proprietors' company.

10 The invoices date from 14 February 1988 (which is within five years of the date of completion of the registration procedure on 4 July 1984) and from that date show a trade year on year to within a few months of the date on which the application for revocation was made. However, the only apparent use of a trade mark is the inclusion of the word STROBEL in plain block capitals following some of the descriptions of the goods supplied, which is somewhat different to the form in which the mark is registered. I must therefore consider whether the provisions of Section 46(2) are satisfied and determine whether the use of the mark in the form shown on the invoices can be accepted as use of the trade mark in the registered version. Section 46(2) reads as follows:

15 **46(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.

20 The word STROBEL in the registered mark is shown in block capitals although is split into two elements, STRO and BEL, with the device of a human figure holding a racquet placed between. While it is possible that the two elements will still be referred to as one word, this is by no means certain.

25 The shape of a human figures is not an uncommon device used as part of a trade mark for sports related equipment and clothing, albeit varying in the degree of stylisation. While an ordinary representation would be regarded as devoid of any distinctive character, in this case the representation is quite stylised, is taller than the letters and shown in black whereas the letters are in red, all of which increases its significance in the mark. The registered mark also includes a fin shaped device depicted in black, with a thick red line outlining the upper portion. This element is considerably larger than the word and human figure device, and is by far the most prominent element.

30 Adapting the comments of Mr Justice Lloyd in the Elle trade mark case ((1997) FSR at page 533), the question is whether by omitting the device elements and representing the two word elements STRO and BEL as one word, STROBEL, something has been done which alters the distinctive character of the mark from the registered form. Mr Justice Lloyd went on to say:

40 "In my judgement it has. It seems to me that the device is at least as much what makes the mark distinctive as the word.

45 I consider this to be an accurate statement of the position in this case, and consequently, that the registered proprietor cannot rely upon the use of the word STROBEL shown on the invoices.

It is clear from Section 100 of the Act that the onus for establishing the use made of the mark rests with the registered proprietor. Having failed to establish use of the mark as registered, or in a form which does not alter its distinctive character, I find that the application for revocation succeeds.

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The applicant for revocation, having been successful is entitled to a contribution towards his costs. I order the registered proprietors to pay to the applicant for revocation the sum of £635 as a contribution towards their costs.

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Dated this 18 Day of October 1999

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M Foley
For the registrar
The Comptroller-General

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