

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 1586464 IN CLASS 25 IN THE NAME OF
CONTINENTAL SHELF 128 LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION THERETO
(OTHER THAN NON-USE) UNDER No. 11105
BY ELIZABETH FLORENCE EMANUEL**

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**IN THE MATTER OF Registration No. 1586464 in Class 25
in the name of Continental Shelf 128 Limited**

AND

**IN THE MATTER OF AN Application for Revocation thereto
(Other than non-use) under No. 11105
by Elizabeth Florence Emanuel**

BACKGROUND

1. On 9 September 1999, Anthony Drew of 42A Warrington Crescent, London, applied for the revocation of trade mark registration No. 1586464. At the time the application for revocation was filed, the registration stood in the name of Oakridge Trading Limited. I note however that the registration now stands in the name of Continental Shelf 128 Limited of 18-24 Bury New Road, Manchester; the name of the applicant for revocation has also been changed from Anthony Drew to Elizabeth Florence Emanuel; nothing appears to turn on these points and I make no further mention of them in this decision. The trade mark in question is shown below, and was registered with effect from 28 September 1994



for the following specification of goods:

“Suits, articles of underclothing, lingerie, articles of athletic, sporting and gymnastic clothing; stockings, shirts, t-shirts, sweatshirts, blouses, trousers, skirts, dresses, bridal dresses, fancy dress costumes; jackets, overalls, waistcoats, panti-hose, knitted articles of clothing, scarves, dressing gowns, bath robes, sleeping garments, hats, socks, belts, caps, gloves and aprons, all for wear; jeans, neckwear, swimwear, bridal wear and footwear; all included in Class 25.”

I note that the registration is subject to the following disclaimer:

“Registration of this mark shall give no right to the exclusive use of a letter "E" and, separately, of the words "Elizabeth" and "Emanuel.”

2. The basis of the attack (in so far as it is relevant) contained in the applicant's statement of grounds is reproduced verbatim below:

"1. The applicant seeks revocation of the registration of registered trade mark No. 1586464 pursuant to section 46(1)(d) of the Trade Marks Act 1994 on ground 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

2. Without prejudice to the generality of the foregoing the aforesaid mark has been used by the proprietor or with his consent in such a manner as to mislead the public to believe that the designer Elizabeth Emanuel has since on or about the 26th October 1997 continued to design the goods in respect of which the mark has been used or otherwise continued to be associated with the goods in respect of which the mark has been used when such is not the case."

3. On 7 October 1999, the registered proprietor filed a counterstatement in which the grounds of revocation are denied.

4. Both parties filed evidence in these proceedings and both seek an award of costs. The matter came to be heard on 18 April 2002. At the Hearing, the applicant for revocation was represented by Mr Simon Thorley of Her Majesty's Counsel instructed by Collyer Bristow, Solicitors; the registered proprietor was represented by Mr Richard Hacon of Counsel instructed by McNeight & Lawrence, Trade Mark Attorneys.

DECISION

5. In parallel with these proceedings, Elizabeth Emanuel is opposing an application for registration of a trade mark (ELIZABETH EMANUEL) under number 49342 and in which very similar evidence was filed. The two cases were heard at the same time.

6. This revocation action is based upon Section 46(1)(d) of the Act which states:

"46.-(1) The registration of a trade mark may be revoked on any of the following grounds -

(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."

7. In their skeleton arguments the parties framed their cases under this section in the following terms:

Mr Thorley

“The application for Revocation of Mark No: 1,586,464

26. This was commenced on 9th September 1999 and in the Statement of Grounds reliance is placed on Section 46(1)(d) of the Act having regard to the fact that since about 26th October 1997 Elizabeth Emanuel has played no part in the design of clothing marketed by Oakridge and yet the registered mark has continued to be used in relation thereto. Use is not denied by Oakridge.

27. Section 46(1)(d) equates to section 3(3)(b). Accordingly the same question arises and it is submitted that if the opposition under section 3(3)(b) succeeds in relation to the Class 25 goods so also must the application for revocation.”

Mr Hacon

“Ground of Revocation

In consequence of use made by the proprietor, the mark is liable to mislead the public.

21. So far as I am aware, there has been very little judicial guidance as to the effect of section 46(1)(d) or its equivalents in the Trade Marks Directive and Trade Marks Regulation.

22. The closest there has been to judicial comment came in *Scandecor* in the House of Lords (cited above). Section 46(1)(d) was relied upon in the counterclaim for revocation. The basis of the complaint under the counterclaim was that the grant of a bare licence without quality control had rendered the mark deceptive. The House of Lords saw no objection to the use of a mark by a bare licence of that type (36-41), but nonetheless took the view that the point was not *acte claire* and should be referred to the European Court of Justice (50).

23. Otherwise the House of Lords ruled that the question whether a mark had become liable to mislead the public was essentially a question of fact to be determined as of the date of the hearing (49).”

8. Having analysed the evidence of confusion provided by the applicant Mr Hacon concluded:

“Conclusion on Revocation

53. The “deception” on which Mrs Emanuel relies under section 46(1)(d) is an inevitable and lawful consequence of her decision to assign the goodwill in a business conducted under her name. That gives no right of revocation under section 46(1)(d).

54. In so far as her complaint is focussed only on the alleged active attempts by International to suggest that she still designs their garments, that is denied on the

evidence. But even if it were true, her complaint then is about statements made by International, not lawful use of the mark. The remedy against statements of that kind would be to apply to the High Court for relief to prevent International from falsely stating that Mrs Emanuel design's International's dresses when she does not. Yet Mrs Emanuel has avoided going to the High Court to seek that relief.”

9. At the Hearing, both parties agreed that the material date for the purposes of Section 46(1)(d) of the Act is the date of the Hearing ie. 18 April 2002. This is confirmed by the following passage from *Scandecor Development AB v Scandecor Marketing AB* [2002] FSR 7:

“**49** The claim in these proceedings is that, in consequence of the use made of the marks by Scandecor Marketing and Scandecor Ltd with the consent of Scandecor International, the marks are 'liable to mislead the public'. That is essentially a question of fact. That question of fact must be answered having regard to matters as they now are, not as they were at some time in the past. In deciding this issue of fact the court must have due regard, as I have been at pains to emphasise, to the message which a trade mark conveys. But since the question is whether the marks are currently liable to mislead, the message which is relevant is the message which use of the marks conveys today, not the message it would have conveyed to the public in the past.”

10. In my decision in Opposition proceedings No. 49342 referred to earlier, and for the reasons given therein, I dismissed the opposition by Elizabeth Emanuel based on Section 3(3)(b) of the Act.

11. While both Counsel accepted at the Hearing that given the different material dates involved ie. the date of the application for registration (in the case of Section 3(3)(b)) and the date of the Hearing (in the case of Section 46(1)(d)), it was theoretically possible to arrive at different decisions under the respective heads, both agreed that this was not a factor in these proceedings.

12. Given that my decision under Section 3(3)(b) of the Act mentioned above was based on the position as at 18 March 1998, it appears to me that the registered proprietors are in the context of these revocation proceedings, in, if anything, a better position where the issue is to be decided as at the date of the Hearing (18 April 2002). I reach this conclusion on the basis that the public will have had longer to become aware of the sale of the registered trade mark and the associated business to the registered proprietors and in consequence the likelihood of the public being deceived will have diminished. But, for the reasons given in Opposition No. 49342, in relation to an allegation based upon Section 3(3)(b) of the Act, I hold in this case that the use made of the registered trade mark in suit by the registered proprietor is not liable to mislead the public. The revocation action based upon Section 46(1)(d) is therefore dismissed.

13. The application for revocation has failed; and the registered proprietor is entitled to a contribution towards their costs. I order the applicant to pay to them the sum of £1000; this award takes into account the fact that the evidence filed in these proceedings is, for the most part, the same as that filed in the opposition proceedings mentioned above and that a single

Hearing was held in which Counsel made composite submissions. 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 17th day of October 2002

M KNIGHT
For the Registrar
the Comptroller-General