

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 11419
BY J SAINSBURY PLC
FOR REVOCATION OF TRADE MARK No 1247073
STANDING IN THE NAME OF
CAFFREY'S LIMITED

DECISION

- 1) The trade mark GIGGLE is registered under number 1247073 in class 30 of the register in respect of "Non-medicated confectionery".
- 2) The application for registration was made on 27 July 1985 and the mark was placed on the register on 28 July 1986.
- 3) By an application dated 1 February 2000, J Sainsbury PLC applied for the revocation of the registration under the provisions of Section 46(1)(b). The grounds stated that the mark has not been put to genuine use in the UK within the five years and three months prior to the date of the application. Further, they state that there are no proper reasons for such non-use.
- 4) The applicant also states that the registered proprietor has supplied a fax copy of packaging. The applicant submits that this is not evidence of use in the UK. However, should the Registrar accept that the mark has been used in the UK the applicant requests that the registration be revoked in relation to all other goods for which the mark is registered and has not been used.
- 5) On 19 May 2000 the registered proprietor filed a counterstatement stating that the mark registered had been used by the registered proprietor and with its consent in relation to the goods for which it is registered within the last five years. The proprietor asked for the refusal of the request for revocation of registration. Both sides seek an award of costs.
- 6) Both sides filed evidence in these proceedings. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings and the evidence filed.

REGISTERED PROPRIETOR'S EVIDENCE.

- 7) The registered proprietor filed a declaration dated 17 May 2000 by Elizabeth Phillips a Director of Caffrey's Limited. Ms Phillips states that "confectionery bearing the trade mark has been on sale in the UK continuously over the past six years". At exhibit EP1 she provides specimens of labels and packaging showing the mark GIGGLE claimed to have been used in the UK. Also provided is a "representative sample of copies of invoices from Lake Isle Confectionery to customers in the UK".
- 8) Ms Phillips explains that Lake Isle Confectionery is based in Sligo and is one of her company's agents. She states that goods under the GIGGLE mark have been sold into the UK by Lake Isle Confectionery and through other customers.

9) The packaging has the mark in suit printed clearly upon it and it is clearly the name of the product as the only other word is the name of the company Caffrey's. The invoices are dated from April 1994 - March 1997. They show a total of 75 units of "Giggle" products being supplied by Lake Isle Confectionery at a cost of (presumably Irish£) 250 to a company called N S J Agencies in Derry.

APPLICANT'S EVIDENCE

10) The applicant has filed a declaration, dated 20 November 2000, by John Alfred Caisley a director of the applicant's Trade Mark Attorneys. He points out that the evidence provided by the proprietor shows use of the mark in relation to mellow toffee bars only and that sales have been limited to Northern Ireland.

11) Mr Caisley states that his company had investigations conducted as to the use of the mark in suit. A company called Carratu International carried out two investigations. Copies of their reports dated 19 October 1999 and 13 June 2000 are provided at exhibits JC1 & 2. These reports state that the product sold under the Giggle mark is a summer line and that the products were usually sold in Southern Ireland although the overwhelming majority of sales were through wholesalers and cash and carry stores. They state that the proprietor does not trade directly with any company in the UK.

12) The investigators also state that the company NSJ Agencies has not traded from its premises in Londonderry for three to four years and have moved to the Irish Republic. Mr Caisley states that:

"It is clear that although the trade mark GIGGLE may have been used in relation to a mellow toffee bar sold in Northern Ireland at some stage during the last five years, there is no evidence that the trade mark is being used in relation to any other confectionery product or that products have been sold outside Northern Ireland. The applicants therefore requests that if the evidence of use is accepted by the Registrar as being genuine use on sales in Northern Ireland then the specification of goods covered by registration number 1247073 should be limited to "mellow toffee bars for sale only in Northern Ireland". Alternatively if geographical limitation is not granted then the specification should under section 46(5) of the Trade Marks Act, be limited to "Mellow toffee bars".

13) That concludes my review of the evidence. I now turn to the decision.

DECISION

14) The ground of revocation is based on Section 46(1)(b) which reads:

"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;

15) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16) The relevant period has been explicitly specified in this case and is the five years ending three months prior to the date of the application for revocation 1/12/94 - 30/11/99. In considering the matter I rely upon the comments of Jacob J. in *Euromarket Designs Inc. v Peterson & Another* 25 July [2000] ALL ER(D) 1050. The learned judge said that:

“It seems to me that “genuine use” must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of use. In part it is a question of degree and there may well be cases on the border-line. If that were not so, and Ms Vittoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be a “sham”. This to my mind shows that Ms Vittoria’s gloss on the meaning of “genuine” is not enough. And the only stopping place after that is real trade in this country.”

17) The applicant asks for the registration to be revoked in its entirety, and if this is unsuccessful they seek to have the specification restricted. They claim only that the mark in suit has not been used on confectionery in the UK for a period of five years. The only evidence of use offered was:

i) Three invoices issued by a company based in Eire to a single customer. The address of this customer on the invoices was shown as “Euro Centre, Pennyburn Industrial Est, Derry.” The evidence of the applicant makes it clear that this address is not the town of Derry in Eire but Londonderry in Northern Ireland. The invoices show 75 units being supplied at a cost of 250. It is not clear if this is UK£ or Eire£. These invoices are said to be a “representative sample of copies of invoices from Lake Isle Confectionery to customers in the UK”.

18) Section 100 of the Act places a clear responsibility on registered proprietors to make out their case. I take into account the *NODOZ* case {1962} RPC 1. In which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“ The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established,

19) Whilst in this instance the proprietor has filed copies of three invoices, they are all to the same company and amount to less than £300 of goods in the relevant five year period. The proprietor states that these are a representative sample. However, they are all to the same customer and no claims have been made with regard to total sales to either this or other customers in the UK. No details have been given of any promotional activity such as advertising which was undertaken.

20) Neither side has commented on the size of the market for such goods but I take judicial note that the market for confectionery runs into millions of pounds per annum, although what percentage of this market relates to toffee products is less obvious.

21) The level of sales is so minimal that I do not accept that it constitutes genuine use.

22) Given the very specific nature of the revocation action, the proprietor had no reason not to file clear, unambiguous evidence of use of the mark in relation to the goods under attack. I have come to the view that the registered proprietor has failed to discharge the onus that is placed on them by Section 100 of the Act.

23) The application for revocation succeeds. I order the registered proprietor to pay the applicant the sum of £500. This sum 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 9TH day of October 2001

George W Salthouse
For the Registrar
The Comptroller General