

O-586-01

BEFORE:

**THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(MR M KNIGHT)
(Sitting for the Comptroller-General of Patents etc)**

IN THE MATTER OF THE TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NOS
181471, 1521713 AND 1521717 CB CHEQUE BLEU DEVICE
IN THE NAME OF GROUPEMENT CARTE BLEU**

AND

**IN THE MATTER OF REVOCATION PROCEEDINGS THERETO BY
CB RICHARD ELLIS INC UNDER REVOCATION NOS
12212, 12281 AND 12282**

**MR M ENGELMAN (instructed by Field Fisher Waterhouse appeared
on behalf of the Applicant for Revocation**

The Registered Proprietor did not attend and was not represented

D E C I S I O N

1. THE HEARING OFFICER: I have before me a request for summary judgment in respect of three applications for revocation by CB Richard Ellis Inc., a United States corporation, in respect of three registrations owned by Groupement Carte Bleue, a French company.

2. The three registrations the subject of these actions are as follows: Registration No 1521713, which consists of the words CARTE BLEUE within a rectangular device and is registered with effect from 14 January, 1994 for credit card services, banking services, issuing and redemption of travellers cheques, all included in Class 36; Registration No 1521717, which again consists of the words CARTE BLEUE within a rectangular device, but that whole is contained within what would appear to be a further rectangle, and this is registered with effect from 25 November, 1994 in respect of credit card services, all included in Class 36; registration No 1281471 consists of the stylised letters CB together with the words CHEQUE BLEU in a rectangular device. This is registered with effect from 8 May, 1992 in respect of banking services, issuing and redemption of travellers cheques, all included in Class 36.

3. The three applications for revocation under the provisions of Section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 were filed on 9 February, 2001 in respect of the first two registrations, and on 17 January, 2001 in respect of the third registration.

4. In accordance with the Trade Marks Registry's practice under the Trade Mark Rules 2000 - - and I will come back to the rules alter - - copies of the application for revocation were sent to the registered proprietor's trade mark attorneys, Marks & Clerk, under cover of a letter which requested a form TM8 to be completed in respect of each registration, together with a counter-statement and either copies of evidence of use made of the trade marks, or alternatively, reasons for non-use were required. In response, Marks & Clerk, on behalf of the registered proprietor, filed a form TM8, a statement of grounds, and a witness statement by Mr David Robert Thompson of Marks & Clerk in respect of each registration.

5. At this point I should record that in respect of Registration Nos 1521713 and 1521717 the defence was based upon claimed use of the trade mark the subject of the registration, whereas in

relation to Registration No 1281417 the counter-statement states: “The trade mark the subject of Registration No 1281471 (hereinafter the trade mark) has been in use in the United Kingdom (at least in a form differing in elements which will not alter the distinctive character of the mark in the form in which it is registered) in relation to the services covered by the registration during the period of five years leading up to the date which is three months prior to the date of application for revocation.”

6. It seems to me therefore that the registered proprietors are claiming to have used two of their trade marks on the services for which they are registered, whereas on the third they are stating that they have not used the trade mark in question but they have used one which, in their view, is sufficiently similar to that of the trade marks that they have claimed to have used such that the provisions of Section 46(2) of the Act apply. For convenience, Section 42(2) states: “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.”

7. It was at this point that the applicants for revocation, through their trade mark attorneys, sought summary judgment because they said that the registered proprietors had not in fact provided evidence of use of the trade marks as required by the provisions of the Act and Rules. The Trade Marks Registry on 7 September 2001 gave a preliminary view to the effect that, whilst the evidence of use provided by the registered proprietor in all three cases was not extensive, it need not be so at this particular stage of the proceedings. Therefore the Trade Marks Registry was - - and I quote from the letter of 7 September, 2001: “..... happy that it is sufficient enough for proceedings to continue to the next stage.” The applicants for registration therefore sought the hearing which has take placed before me today.

8. The applicants for revocation of these registrations were represented by Mr Mark Engelman of counsel, instructed by Field Fisher Waterhouse. The registered proprietors did not attend and were not represented at the Hearing. However, I have before me a letter form Mr David R Thompson of

Marks & Clerk dated 18 October, making written submissions on the subject. I have a further letter from him dated 31 October, in which he comments and responds to a skeleton argument submitted by Field Fisher Waterhouse and prepared by Mr Engelman. I also have a letter from Field Fisher Waterhouse dated 2 November, commenting on Mr Thompson's letter of 31 October. Finally, I have had the benefit of oral submissions from Mr Engelman, I have therefore had a plethora of paper and very focussed and very pertinent oral submissions, and I take all of those into account in reaching my decision.

9. The applicants for revocation have submitted that the evidence of use filed by the registered proprietors is not sufficient to enable these proceedings to continue and therefore seek summary judgment, the effect of which would be to revoke all three registrations.

10. At this point I should perhaps indicate that although the attorneys for the applicants for revocation are seeking striking out of these registrations or these proceedings on the basis of the Civil Procedure Rules, I do not consider it necessary to consider taking the action sought on that basis. This is because, in the first place, Ferris J in *St Trudo* [1995] RPC 345 indicated that the Rules of the Supreme Court, now of course the Civil Procedure Rules, have no part to play in proceedings before the Trade Marks Registry. Therefore I prefer to look first at the Trade Marks Act 1994 and Trade Mark Rules 2000 in order to determine whether I have the power to take action in this case under those statutory provisions. Having done so, I believe that Rule 31 of the Trade Mark Rules 2000, which deals with the conduct of proceedings before the Registrar in actions for non-use of a registered trade mark, provides me with all the power I need in order to determine the issues before me today.

11. I should perhaps also record that had the Trade Marks Rules been silent on the matter, then I would of course, using the Registrar's inherent jurisdiction to regulate business before the tribunal, have looked for guidance in relation to action that I could or should take by referring to the Civil Procedure Rules and applying them accordingly. However, as I said, I do not need to consider striking out under the Civil Procedure Rules because I believe that the Trade Marks Rules provide the answers to the question that have been posed today.

12. The applicants for revocation base their request on their view that the evidence of Mr David Robert Thompson in the form of a witness statement is not evidence of use of the trade mark as required at this stage of the proceedings. It might be helpful if I quote from the witness statement of Mr Thompson, and I start at what he numbers paragraph 2 of his witness statement. In fact there are two paragraphs 2's, but no matter.

13. I quote: "The facts in this my Witness Statement are my own knowledge, or from my Firm's books and records to which I have full access. I am authorised by my Firm to make this Witness Statement.

14. The Instructing Attorneys in France have directed me to the web-site of the registered proprietor. The web-site is of course accessible in the United Kingdom and is available in French and English; although the web-site is currently under construction and not all of the pages are available in both languages.

15. I attach Exhibit DRT1 which contains copies of pages from the web-site of the registered proprietor, which shows that the trade mark the subject of registration No - - and I will use No 1281471 here as an example - - has been in use in the United Kingdom during the relevant period in respect of the services covered by the registration.

16. It will be noted in particular that the web-site pages contain (a) representations of credit cards which depict the registered trade mark; or at the very least the distinctive CB logo together with the word BLEUE here used in conjunction with the word CARTE rather than the word CHEQUE; (b) references to press releases throughout 1999 and 2000; (c) references to other articles in the press throughout this period; (d) publicity surrounding the services offered under the registered trade mark as available to facilitate e-commerce transactions throughout the world over the Internet and via mobile phone; (e) a list of Group Members who co-operate in the performance of the services under the registered trade mark in conjunction with the registered proprietor, which include UK companies, Barclays Bank plc and Lloyds TSB Bank plc; (f) publicity surrounding the sponsorship of the French Olympic team by the registered proprietor, which would lead to exposure and use of

the registered trade mark in relation to the services covered on television screens and throughout the national press in the United Kingdom.

17. The exhibit to which Mr Thompson refers does contain copies of web-site pages, some of which are in French and some of which show the CARTE BLEUE trade mark within a rectangular device.

18. Press reviews indicate, I think, that press releases were made, but there was no indication of where they might have appeared and no indication that they were taken up by the English press. One of the press releases seems to deal with paying for purchases in total security by a mobile phone. This is about consumers' ability to pay for their purchases directly from their mobile telephone with a CARTE BLEUE card. This, it would appear, followed a market survey covering representatives of French mobile telephone owners.

19. The web page also includes in English frequently asked questions, together with their answers, about secure distant payments using mobile telephones with a CARTE BLEUE card, but I note that in a number of cases there are conversions from the French franc not into pounds but into the euro, which of course is not the currency of the United Kingdom, and is not likely to be for some time. All of these pages from the web-site are dated 14 May, 20-01 which is the day that Mr Thompson signed his witness statement.

20. That last point is the one that the applicants for revocation have taken up, in that they say it provides detail of a situation on 14 May, 2001 whereas the periods the subject of the allegations under Section 46 of the Trade Marks Act were very much earlier, ie the trade mark had not been put to genuine use in the period following registration, or in the five-year period ending with the date of application. The applicants also take the point that the evidence of use, even if it is admitted, is not in fact evidence of use of the trade mark sufficient to discharge the registered proprietor's obligations.

21. For their part the registered proprietors agree that the evidence filed with the counter-statement

in each case is not full evidence. In his letter of 31 October Mr Thompson states that it is merely “evidence which provides some factual support of the registered proprietor’s claim in the counter-statement that the trade marks concerned have been used in the relevant five year period.” In his view the pages from the web-site did not necessarily show use of the trade marks on 14 May, 2001 and only on 14 May, 2001. He considered that there must be a reasonable likelihood that the pages concerned were substantially identical to a number of dates prior to that.

22. It might be helpful at this point if I consider the background to the Act and the Rules as we have them, and I go back to the White Paper entitled “Reform of Trade Marks Law” which was issued in September, 1990 and which was a precursor to the implementation of the EC Trade Marks Directive and other changes to the trade marks law, as embodied in the Trade Marks Act 1994.

23. In relation to what is entitled “Sanctions for non-use of the trade mark”, a chapter which begins on page 23 of the White Paper at paragraph 4-30 it states: “Under the present law [that being the Trade Marks Act 1938] the onus of establishing that a trade mark is not being used rests on the person who is seeking removal of the mark from the register on the grounds of non-use, generally someone who wishes to register and use an identical or similar mark and would be inhibited by the presence on the register of the allegedly non-used mark. It is, however difficult and time-consuming to have to prove a negative, whereas if a trade mark is in fact being used it is a straightforward matter for the proprietor to demonstrate this. The law will therefore provide for a person who is affected by the presence of a mark on the register, for example, a person who has applied to register an identical or similar mark or who is threatened with infringement proceedings, to call upon the proprietor to produce evidence of use. Failure to produce such evidence will be treated as an admission of non-use.”

24. That is the first element. Back in 1990 it was envisaged that if someone wished to challenge the use of a trade mark for whatever reason, then the onus would be on the registered proprietor to show use.

25. I go on to look at Section 46 of the Trade Marks Act which gives that effect. Section 46(1) states: “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.”

26. I have already quoted Section 46(2) earlier in this decision which deals with use of a trade mark which differs in elements which do not alter the distinctive character of the mark.

27. Another important section of the Act is Section 100 which states - - and I think that this gives effect to a particular aspect of the White Paper: “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.”

28. In this case the applicants are alleging, in my view, under Section 46(1)(a) that the trade marks in question have never been used in the five-year period following the completion of the registration procedure. Alternatively, under Section 46(1)(b) that there has been no use of the trade marks in the five year period ending on the date that the applications for revocation were filed.

29. For the practical arrangements relating to these proceedings I look to the Rules, and in particular to rule 31 which states:

“31(1) An application to the Registrar for revocation under Section 46(1)(a) or (b) of the registration of a trade mark shall be made on Form TM26 (N) together with a statement of the grounds on which the application is made; the Registrar shall send a copy of the application and the statement to the proprietor.

(2) Within three months of the date on which a copy of the notice and statement is sent by

the Registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8 and either:

- (a) two copies of evidence of use made of the mark; or
- (b) reasons for non-use of the mark

30. Where such a notice and counter-statement, and evidence of use of the mark or reasons for non-use of the mark, are filed within the prescribed period, the Registrar shall send a copy of the Form TM8 and the counter-statement, and the evidence of use of the mark or the reasons for non-use of the mark, to the applicants.”

31. Section 31(1) and 31(2) describe the arrangements that apply on receipt within the Trade Marks Registry of a request to revoke a registration on the grounds of non-use. Applying those Rules, the Trade Marks Registry are required to send a copy of the form applying to revoke the registration (TM26 (N)) to the registered proprietor, together with a copy of the statement of grounds on which the application is made. The registered proprietor then has three months - - and I note that as a result of Rule 68 that three months is an unextendable period - - ion which to file a form TM8, counter-statement and evidence of use of the trade mark. Alternatively, the registered proprietor can indicate in his counter-statement that there has been no use but there are proper reasons for non-use of the mark.

32. The Rules then go on to indicate that the applicant for revocation may file evidence in support of the allegation, that the registered proprietor may then file his evidence and that the applicant for revocation in turn will have the opportunity to file evidence in reply. In relation to that, what I would term a tennis match, Mr Engelman submitted that the Rules as he saw them provided the registered proprietor with a single opportunity to file evidence of use of the trade mark and that was in the three month unextendable period in which they had to respond tot the form TM26 (N) and statement of grounds sent to them. In his view of the way in which the rules were constructed, the use within Rule 31(6) of the words “..... such further evidence as he may consider necessary in support of the reasons stated in the counter-statement” meant that the registered proprietor could

file evidence at that stage, but only in relation to a defence based upon proper reasons for non-use, because in his view it was the only stage at which the registered proprietor could file such evidence, evidence at the earlier stage being only for evidence of use of the trade mark, where the defence was so based.

33. In my view, taking the Act and the Rules together, they seem to me to envisage that when challenged there is an onus upon the registered proprietor at the outset to provide some evidence that the trade mark the subject of the application for revocation was in use during the relevant period. In that connection, in particular I note that the word “show” is used in Section 100 which suggest in revocation proceedings evidence must be more than mere assertion that the trade mark in question has been used, but must be actual evidence which shows how the trade mark was used. I do not agree with Mr Engelman’s reasoning in relation to Rule 31(6). It seems to me that the Rules uses the word “reasons stated in the counter-statement” as a “catch-all;”, ie you file evidence in support of your proper reasons for non-use as well as evidence in support of your reasons for believing that the trade mark was in use during the relevant period covered by the allegations made by the applicant. The word “reasons” is not therefore a reference back to “proper reasons for non-use.”

34. I note that the Rules 32 and 33 which deal with the procedures for revocation on grounds other than non-use and invalidation have in Rules 32(6) and 33(6) the same wording as 31(6), thus in all three cases a party may “file such evidence as he may consider necessary to adduce in support of reasons stated in the counter-statement” As proper reasons for non-use is not a feature of revocation on grounds other than non-use or invalidation, the use of the word “reasons” in Rule 31(6), 32(6) and 33(6) can not have the interpretation implied by Mr Engelman.

35. I do not consider therefore that the regime requires the registered proprietor to submit within the three-month unextendable period allowed for filing the Form TM8, counter-statement and evidence of use, the entirety of their evidence. In many respects that would be unrealistic in a number of cases. For example, as I indicated during the hearing, if the registered proprietor had licensed use of the registered trade mark which may be registered for, say, tinned fruit, on the basis of exclusive licences, to half a dozen others who each produce a particular type of tinned fruit then it

may take more than three months to gather together evidence or, should I say, complete evidence of use of the trade mark. Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used.

36. Mr Engelman points out to me that the Trade Marks Registry Work Manual sets out the sorts of material that might be acceptable. There has also been a decision by one of the Registrar's Hearing Officers in a case known as **Adrenalin** [O/BL336/99] which also sets out examples of the sorts of things that the Registrar, or, more particularly, the other side might accept and consider as evidence of use of the trade mark.

37. From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question, together with some indication of the sales of goods, or the provision of services during the relevant period. Clearly this cannot be an exhaustive list and is merely an example of the material which might be sent in.

38. I think it is worth noting that I am reinforced in my view that the registered proprietor is required to file at least some evidence of use at the outset by a reference in Kerly at page 279, and this is part of paragraph 9-45. I admit that it is taken somewhat out of context, but it says: "Once the proprietor has filed his evidence of use and/or identified any alleged proper reasons for non-use, the applicant for revocation should consider whether a different five-year period of non-use can be identified." That begs a number of other questions about whether one can have an alternative five-year period, but nevertheless Kerly seems to accept that up-front a registered proprietor is required to provide evidence of use of the trade mark.

39. In this case the registered proprietors, through their instructing attorneys in France, according to Mr Thompson's witness statement, directed him to the registered proprietor's web-site in order

to gather together evidence of use of the trade mark. The problem with that is that the information extracted was current information, as has been pointed out to me at great length in the various documents submitted by the applicants for revocation. By that, I mean that the information was obtained on 14 May, 2001 when the period covered by the allegations of non-use by the applicants for revocation were periods which expired in 1999 or 1997 if one is looking at the allegations made under Section 46(1)(a), or January or February, 2001 if we are looking at the allegations made under Section 46(1)(b).

40. In addition, the material provided does not clearly indicate that the services covered by the registrations, and which I set out at the beginning of the decision, have been offered to customers in the United Kingdom. By that I mean it is not clear that the web-site was at any time used directly to promote the provision of the services under the trade marks to would-be customers in the United Kingdom, or indeed was available to customers in the United Kingdom. For example, I am given no indication of the number of “hits” that the web-site received from the United Kingdom, or indeed from anywhere overseas.

41. Mr Engelman has drawn my attention to a number of cases, including **Euromarket Designs Inc v Peters & Anr** [2001] FSR 20 and **800-FLOWERS Trade Mark** [2000] FSR 697 in support of his claim that use of a foreign web-site may not be use of a trade mark in the United Kingdom, and we had a likely debate on the various judgments therein. In particular, he drew my attention to the judgment of Buxton LJ in **800-FLOWERS AND THAT OF** Parker LJ in the same case. I am prepared to take from those judgments a cautious approach to the use of web-site material in determining whether or not a trade mark has been used in the United Kingdom. However, I am not prepared to rule out the use of such material in order to determine whether or not a trade mark has been used within this jurisdiction.

42. In that connection I note that Parker LJ said: “Nor, in my judgment, is the evidence (such as it is) concerning the applicant’s Internet web-site sufficient to justify the conclusion that accessing the web-site amounts to use of the mark at the point of access.” In my view, that is not stating that use of an overseas web-site cannot be taken into account in assessing whether a trade mark on that

web-site has been used in the United Kingdom but that it depends upon the evidence. In that particular case the evidence was insufficient, but in others the evidence may well be sufficient.

43. I note also the decision of Mr Geoffrey Hobbs QC in **CORGI** [1999] RPC 549, and I quote: “I appreciate that the Registrar is frequently required to act upon evidence that might be regarded as less than a perfect when judged by the standards applied in High Court proceedings. Even so, it is necessary to remember that there is a distinction to be drawn between inference and conjecture.” This was a point which figured in the speeches in the House of Lords in **Jones v Great Western Railway Co.** [1930] 144 LT 194. The question in that case was whether the plaintiff had adduced evidence from which it could reasonably infer that the death of her husband had been caused by negligence on the part of the defendant. Lord MacMillan, commenting on the facts but not as to the applicable principles of law said at 202: “The dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible, but it is of no legal value for its essence is that it is a mere guess. An inference in the legal sense, on the other hand, is a deduction from the evidence and, if it is a reasonable deduction, it may have the validity of legal proof.”

44. In that connection I note that Parker LJ said: “Nor, in my judgment, is the evidence (such as it is) concerning the applicant’s Internet web-site sufficient to justify the conclusion that accessing the web-site amounts to use of the mark at the point of access.” In my view, that is not stating that use of an overseas web-site cannot be taken into account in assessing whether a trade mark on that web-site has been used in the United Kingdom but that it depends upon the evidence. In that particular case the evidence was insufficient, but in others the evidence may well be sufficient.

45. I note also the decision of Mr Geoffrey Hobbs QC in **CORGI** [1999] RPC 549, and I quote: “I appreciate that the Registrar is frequently required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. Even so, it is necessary to remember that there is a distinction to be drawn between inference and conjecture.” This was a point which figured in the speeches in the House of Lords in **Jones v Great Western Railway Co** [1930] 144 LT 194. The question in that case was whether the plaintiff had adduced evidence from which it could reasonably infer that the death of her husband had been caused by

negligence on the part of the defendant. Lord MacMillan, commenting on the facts but not as to the applicable principles of laws said at 202: “The dividing line between conjecture and inference is often a very difficult one to draw. A conjecture may be plausible, but it is of no legal sense, on the other hand, is a deduction from the evidence and, if it is a reasonable deduction, it may have the validity of legal proof.”

46. Having considered all the submissions and the authorities quoted, I reach the view that the registered proprietors have not discharged the onus which was upon them at the start of these proceedings to show use of their trade mark. I reach this view because it seems to me that the information extracted by Mr Thompson and compiled within his witness statement does not show use of the trade mark in the period covered by the allegations made under Section 46(1)(a) and (b) and, whilst, as I indicated earlier, I do not consider that the Trade Marks Registry should, on the basis of what I believe the regime set out in the Act and Rules is, require a registered proprietor to provide full, complete and final evidence within the three months allowed for filing the TM 8 and counter-statement - - that would be unreasonable for the reasons given - - I do consider that some actual evidence which shows use of the trade mark in the period or periods in question must be provided in order to allow these proceedings to be jointed.

47. In this case the evidence shows that one of the registered proprietor’s trade marks did appear on their web-site in 2001, but this was after the relevant date. There is no indication that the web-site has been accessed by anyone from the United Kingdom, there is no indication that the press releases which appear on the site have been taken up by the British press (even if there had been, I am not clear from the information given whether and how they would show use of the registered trade mark); the list of Group Members which Mr Thompson says co-operate under provisions of the services provided under the trade marks does not advance matters.

48. Mr Thompson in his letters has indicated nevertheless that I should infer that these web pages were in place during the relevant period, but I suggest he is in no position to help me make that inference. As the registered proprietor’s trade mark attorney says, and as pointed out by Mr Engelman, Mr Thompson had no access to the registered proprietor’s books or their records., He

merely, for the sake of putting in evidence, looked at the records of his own firm, ie Marks & Clerk, and looked at the web-site. If I am mistaken in that regard, then that mistake derives from the witness statement itself, because he does not explain how or why I should make that inference, simply that I should. Bearing in mind the comments of Mr Hobbs above I decline to make that inference.

49. In this case, it would appear to me that the registered proprietor's attorneys in France were misguided in simply directing the registered proprietor's attorneys in the United Kingdom to the web-site as the answer to the requirement to file evidence of use of the trade mark at the start of the proceedings. The plain fact is that there has been no evidence of use shown by the registered proprietors as a result.

50. I therefore turn to Rule 31(3) which states: "Where a counter-statement, in conjunction with a notice of the same on Form TM 8, and evidence of use of the mark or reasons for non-use of a trade mark are not filed by the proprietor within the period prescribed by paragraph (2), the Registrar may treat his opposition to the application as having been withdrawn."

51. The consequences of my decision above is that the registered proprietors, whilst they may have filed a Form TM 8 and may have filed a counter-statement in relation to all three cases, have not provided evidence of use as required.

52. I digress by saying that, having failed to file evidence of use in relation to two of the trade marks, there is therefore no defence for the third trade mark which relies on use of those two under the provisions of Section 46(2).

53. However, it seems to me that failure on the part of the registered proprietor to file evidence showing use of the trade marks may not be a fatal blow to a registered proprietor because, as a result of the use of the word "may" in rule 31(3) the Registrar does not have to create the opposition to the applications for revocation as having been withdrawn, but may do so.

54. In that connection I sought submissions from the parties prior to the hearing in relation to that issue. From their standpoint Field Fisher Waterhouse, on behalf of the applicant for revocation, relied upon the statement that the Registrar may treat the opposition to the application as withdrawn as being a firm statement of the intention of the Registrar in these circumstances.

55. Mr Thompson, in a further letter, admitted that the evidence could not be said to fail to show use of the trade mark, and that the registered proprietor will have an opportunity to file evidence later in the proceedings. As I have set out already, I believe the registered proprietors only have a second opportunity once they have joined the proceedings by filing evidence of use which can be supplemented at a later stage by further evidence.

56. I therefore have to consider whether, in all of the circumstances, I should exercise a discretion in favour of the registered proprietor to allow these proceedings to continue notwithstanding the fact that they have failed to meet the requirements of the Act and Rules.

57. In his letter on the consideration of the Registrar's discretion, Mr Thompson has not given any further reasons why these proceedings should continue, and therefore I have got no reasons on which to base any consideration of the Registrar's discretion. That being so, I must refuse to exercise it in favour of the registered proprietors.

58. As a consequence I have to deem the registered proprietors' opposition to all three applications for revocation before me as being withdrawn. Therefore the applications for revocation succeed, and under the provisions of Section 46(6) which state: "Where registration of a trade mark is revoked to any extent, the rights of the proprietor will 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", as far as I am concerned, the pleadings by the applicant for revocation did not cover any date earlier than the dates of application, and therefore these trade marks will be revoked from the dates of the applications for revocation.

59. Both sides in these proceedings sought their costs at the outset. I am not going to award costs today, not least because I would like written submissions both from the registered proprietors and from the applicants for revocation as to what the costs order should be. I therefore intend to issue a very short letter today, simply confirming my decision. I will then look at the draft of the decision which Mrs Boyes will let me have, I hope, within a few days. I will then issue that as the formal decision. Once that is in the hands of both parties, they will have one month from that date within which to make written submissions on the subject of costs. That will of course coincide with the period for appeal.

60. Mr Engelman, have I left anything out?

61. MR ENGELMAN: Absolutely not, sir.

62. THE HEARING OFFICER: Thank you very much.