

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
FOR REVOCATION (REVOCATION NO. 9372)
OF TRADE MARK NO. 1069866
IN THE NAME OF AROLI S.A.**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 9372

**By Institut Jeanne Piaubert
For Revocation of
Trade Mark No. 1069866 in the
Name of Aroli S.A.**

DECISION.

The trade mark CERTITUDE is registered under number 1069866 in Class 3 in respect of:

“Soaps, perfumes, non-medicated toilet preparations, essential oils, cosmetics.”

The registration stands in the name of Aroli S.A, and is registered with effect from 4 October 1978.

By an application dated 14 January 1997 Institut Jeanne Piaubert applied for revocation of this registration under Section 46 (1)(b) of the Act claiming that there has been no use of the trade mark in the United Kingdom by the registered proprietor for an uninterrupted period of five years.

The registered proprietor filed a counterstatement stating that there had been use of the trade mark prior to 14 January 1997. As required by Rule 31(3) the registered proprietor also filed evidence of use of the trade mark; I shall review this evidence below.

Both parties seek an award of costs in their favour.

In addition to the registered proprietor’s evidence under Rule 31(3) the applicants for revocation filed evidence under Rule 13, following which a hearing was held on 20 January 1999. At the hearing the applicant for revocation was represented by Mr. Downing of Fry, Heath & Spence, their trade mark agents. The registered proprietors were not represented at the hearing and did not submit written submissions.

Registered Proprietor’s Evidence - Rule 31(3).

This consists of a declaration made by Elisabeth Galande dated 24 April 1997.

Mlle. Galande is a Director of the registered proprietor. She states that the registered proprietor purchased the assets of Société PRODUITS DE BEAUTE PARFUMS JEAN D’AVEZE, a company in receivership. These assets included the United Kingdom trade mark no. 1069866. The registered proprietor applied for recordal of the assignment of the trade mark which was recorded on 20 May 1996.

She states that she does not have access to the records of the previous proprietor and so cannot state if the trade mark was in use immediately prior to the purchase of the assets of the previous proprietor by her company. However, she adds that she has no reason to believe that this was not the case.

Mlle. Galande states that the trade mark had been used by the registered proprietor in the United

Kingdom prior to 14 January 1997. In support of this she exhibits as E.G.1 correspondence between Mr. Terry Ellis of Truefitt & Hill Gentlemen's Grooming Ltd, who variously describes himself as Managing Director and Executive Director, and Jean D'Avèze, the previous registered proprietors, and Aroli; this includes an invoice from Aroli to Truefitt & Hill. Also exhibited is a carton for CERTITUDE Nourishing Bio-Complex, two leaflets relating to the same product and a price list from Jean D'Avèze which includes a reference to CERTITUDE Nourishing Bio-Com.

Applicant's Evidence.

The evidence filed on behalf of the applicants for revocation comprises a declaration by Jacques Konckier and statutory declarations by John Richard Williams and Michael Philip Downing.

M. Konckier states that he is the President of the applicants for revocation. M. Konckier's declaration dated 24 September 1997 relates to the applicants use of the trade mark CERTITUDE in a number of countries. He states that the applicants have not used the trade mark in the United Kingdom owing to the conflict with the trade mark in suit. He states that actions for cancellation of registered trade marks for CERTITUDE and opposition actions have been launched in a number of other jurisdictions. However, as the facts declared to by M. Konckier do not have a direct relevance to this action for revocation in the United Kingdom I have not summarised them in detail.

Mr. Williams in his statutory declaration dated 16 September 1997 states that he is a chartered accountant and is registered to carry out audit work and investment business by the Institute of Chartered Accountants in England and Wales. Exhibited as JRW1 is a copy of the accounts for Truefitt & Hill (Gentlemen's Grooming) Limited dated 11 March 1997 and covering the period 1 June 1995 to 31 May 1996. In the exhibited accounts the accountants for Truefitt & Hill (Gentlemen's Grooming) Limited state that the information in the accounting records demonstrates that:

“the company satisfied the conditions for exemption from an audit of the financial statements for the year specified in Section 249(A) of the Act and did not, at any time within that year, fall within any of the categories of companies not entitled to the exemption specified in Section 249B(1).”

Mr. Williams states that, “This means, in plain English, that the turnover of the company in the year concerned was between £0 and £350,000.” He also states that the records show that during the period of the accounts a Terry Ellis was not a director of the company. The only directors were Alfred George Holgate and Marcelina Joanna Kwasniewska-Blaszczyk-ul.

Mr. Downing states in his statutory declaration that he is a partner of Fry, Heath & Spence, the trade mark agents for the applicants. His declaration relates to a visit he made to the premises of Truefitt & Hill at 71 St James's Street, London, SW1A 1PH on 1 September 1997. He describes the premises as being a small hairdressing establishment with about four or five chairs. Mr. Downing states that there was a window display of products which were sold under the brands of Truefitt & Hill, Trafalgar, Gillette and Roger & Gallet. Tariffs for Truefitt & Hill are exhibited as MPD1, one relates to services, the other to goods; there is no reference to goods sold under the trade mark CERTITUDE.

Mr. Downing goes on to state that he asked to speak to Mr. Ellis but was told that he no longer worked for the company. Consequent upon this he asked to speak to the manager and was introduced to a Mr. Balasingha. Mr. Downing advised Mr. Balasingha that he was a trade mark agent acting in an

5 application to revoke the CERTITUDE registration and asked him about Mr. Ellis and the CERTITUDE trade mark. Mr. Downing states that Mr. Balasingha explained that Mr. Ellis had been a public relations consultant for Truefitt & Hill and had left on 1 July 1997. Mr. Ellis's duties, it is stated, were to revamp the Truefitt & Hill own brand products and having completed that task he was no longer needed; his duties had not included stock purchase.

10 Mr. Downing goes on to state that Mr. Balasingha had stated that he was responsible for the day to day accounts, financial management and stocking level of the company. He would have been aware of any payments made by the company and that he did not recall any payments made to Aroli SA in early 1997. Mr. Downing states that Mr. Balasingha pointed out that a payment to a French company would require a foreign currency order and so would have been unusual for Truefitt & Hill. Mr. Downing also states that Mr. Balasingha claimed to be familiar with the product range of Truefitt & Hill and did not recall a CERTITUDE product and did not believe that the company had sold a non Truefitt & Hill branded product to its customers.

15 Mr. Downing finally states that on his visit to the premises he looked at the shelves carrying products both in the salon and in Mr. Balasingha's office and he did not see any product branded CERTITUDE.

20 The registered proprietor did not file evidence under Rule 13. This therefore completes my survey of the evidence.

Decision

25 This ground of the proceedings is brought under Section 46(1)(b) of the Act. The section reads as follows (I have included subsection (a) as well because it explains the reference to "such use"):-

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

30 (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;

35 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;"

In relation to the issue of use of a registered trade mark it is also necessary to consider Section 46(2)-(3)

40 "(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.

45 (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year

period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.”

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Section 100 of the Act is also relevant, as it explains where the overall burden of proof rests in relation to the question of use. It reads:

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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.

At the commencement of the Hearing I asked Mr. Downing to clarify if the application for revocation was in respect of all goods encompassed by the specification or for only some of the goods. He advised me that the application for revocation was in respect of all goods.

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Mr. Downing submitted that the registration was subject to the proviso to Section 46(3) of the Act in that the preparations for use were not made prior to the proprietor of the trade mark becoming aware that an application might be made. Firstly he based this submission on the applicants having been aware that an application might be made as a facsimile transmission from Fry, Heath & Spence in relation to this matter arrived at the agents for the registered proprietors on 29 November 1996; this is referred to in the counterstatement of the registered proprietors but has not been the subject of the filing of evidence. Further Mr. Downing submitted that the registered proprietors should have been aware that an application for revocation might be made in September 1995 as a non-use action was launched in France in relation to the CERTITUDE mark. Mr. Downing submitted that any reasonable trade mark proprietor would interpret the attack in the French courts as being a warning that their other registrations in respect of the same trade mark were under threat and therefore the evidence relating to the preparations for use of the mark in March 1996 should be discounted owing to the proviso to Section 46(3).

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I cannot accept the above argument. That action to cancel registrations may have commenced in other jurisdictions is not an indication that such action would be launched in the United Kingdom. The registration is inextricably linked to its jurisdiction and in each jurisdiction different factors might apply. In the current case for instance the applicants in the declaration of M. Konckier state that they have not used their CERTITUDE trade mark in the United Kingdom. M. Konckier’s declaration indicates that the applicants have used their CERTITUDE trade mark in other jurisdictions. Both on the facts in this case and on the principle of the law it cannot be assumed or accepted that the registered proprietors were put on warning that their United Kingdom registration was to be the subject of a revocation application because of action in other jurisdictions.

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In the evidence of the proprietors there is a letter dated 21 March 1996 from the registered proprietors to Mr. Ellis at Truefitt & Hill relating to the preparation of CERTITUDE cream, there is also a facsimile transmission dated 28 March 1996 to Mr. Ellis relating to the despatch of a dossier relating to CERTITUDE and samples of the product. These documents are dated some nine months before the application for revocation was filed. If they are accepted as evidence of preparation for use of the mark the registration cannot be revoked on the basis of the proviso to Section 46(3). Mr. Downing cast doubt upon the weight that should be afforded these documents as evidence of preparation for the commencement or resumption of the use of the trade mark. I found this matter very problematic. The only way I could dismiss the documents is if I was to judge that they were not genuine. The evidence

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filed by the registered proprietors has been scant and seemingly partial e.g. there are letters from Mr. Ellis exhibited which do not relate to CERTITUDE, however, there is no letter referring to CERTITUDE. This surprises me as it would seem reasonable to expect that the registered proprietor would be more likely to keep a letter making an order than letters which did not deal with any order for goods. I also note that in her declaration Mlle Galande states that she has no access to the records of Société PRODUITS DE BEAUTE PARFUMS JEAN D'AVEZE. However, she then goes on to exhibit documents from this company. This strikes me as anomalous. Questions must also arise as to the gap between the facsimile transmission of 28 March 1996 and the issuing of the invoice of 9 January 1997. The position of Mr. Ellis is also problematic. He describes himself as variously managing director and executive director but the company records exhibited as JRW1 do not list him as any type of director. Mr. Downing's declaration refers to his conversation with Mr. Balasingha. Mr. Downing accepted that this evidence was hearsay; as the proceedings commenced before 31 January 1997 they are not governed by the Civil Evidence Act 1995. I therefore take into account the St. Trudo case [1995] RPC 370 and the resultant practice direction by the Registrar in relation to hearsay evidence. There is a gap of over two months between Mr. Downing meeting Mr. Balasingha and the swearing of the declaration. It is not indicated if a contemporaneous record of the conversation was made, Mr. Downing's declaration obviously also does not represent a verbatim report of the conversation and so there is a question as to whether Mr. Balasingha made other comments and the context in which the reported comments were made. Mr. Downing submitted that weight should be given to the reported comments of Mr. Balasingha; his declaration had not been challenged and the position of Mr. Balasingha was clearly identified. That the declaration had not been challenged cannot in my opinion be characterised as representing tacit acceptance of the truth of the reported statements of Mr. Balasingha. There is no indication that Mr. Balasingha has seen the declaration and so he is not in a position to comment upon the remarks attributed to him. The registered proprietors may not have challenged the declaration because of cost or because those parts relating to Mr. Balasingha's are hearsay and so in their view not admissible. I do not wish to speculate further on this matter, it goes to the problems of hearsay evidence. I note the comments attributed to Mr. Balasingha but do not consider it appropriate to take them into account in reaching my decision as I consider them second hand hearsay.

In considering the proviso to Section 46(3) I consider it important to also keep in mind the onus which is placed on the registered proprietor by Section 100 of the Act. The only evidence of actual use within the United Kingdom is the invoice dated 9 January 1997 which is exhibited as part of the registered proprietors evidence. This clearly falls within the proviso to Section 46(3). Consequently if the proviso is not to apply the registered proprietor needs to prove that preparations for the commencement or resumption of use of the trade mark commenced more than three months before the date of the application for revocation, i.e. three months before 14 January 1997. The sole indication of such preparation is contained in the two items of correspondence dated 21 March 1996 and 28 March 1996 referred to above. No evidence has been adduced by the registered proprietor to show that this represents preparations for the commencement or resumption of use of the trade mark. These are but two isolated items of correspondence, what led to their generation can only be surmised. For the proviso of Section 46(3) not to be implemented, where there has only been use in the three month period before the application for revocation it is necessary in my view to show real and clear preparations for commencement of the use of the trade mark. I would expect, taking into account the onus of Section 100, for evidence to be adduced which shows such things as discussion by senior staff of the registered proprietor as to the proposed use of the trade mark, evidence of plans in relation to marketing and planning, evidence of sales representatives being advised that the product is to be launched or relaunched. In the case of a foreign registered proprietor I would also consider it reasonable to expect to have evidence adduced to show that the registered proprietor had taken steps to secure a United

Kingdom distributor. The latter might not be necessary if a proprietor was involved in internet trading, but there is no evidence of such trading in this case. However, if internet trading was involved it would be reasonable to expect evidence showing pages from a web site, a site that is in English and ideally a list of “hits” identifying United Kingdom origin. I note that in the Bon Matin case [1989] RPC 537 it was crucial for the registered proprietor to demonstrate the efforts that had been made to obtain a United Kingdom distributor. Whilst I have not sought to set out an exhaustive list of what evidence might be considered appropriate to substantiate a claim that preparations for use of a trade mark had been made. I consider it necessary that evidence needs to be filed that clearly demonstrates that such preparations for a commercial use have commenced. In the current case I am most struck by the absence of evidence, rather than its presence.

In the circumstances I find that there has been no use of the trade mark in the period of five years up to the date of application. Also I find that the registered proprietor has not demonstrated that preparations had been made for the commencement or resumption of the use of the trade mark in the United Kingdom within the period of three months before this application was made. Consequently the proviso to Section 46(3) of the Act is applicable and that the registration should be revoked.

In the event that I am wrong in the application of the proviso to Section 46(3) of the Act I go on to consider if the evidence of use adduced demonstrates genuine use of the trade mark in suit.

In relation to genuine use I must refer back to the concept of bona fide use under the 1938 Act; there being no reported cases as to the meaning of genuine use under the 1994 Act. Bona fide use and genuine use are not interchangeable terms but in many cases the one will encompass the other, and this is such a case.

It was questioned under the old act whether a single act of sale was sufficient to prevent removal. In the Nodoz case [1962] RPC 1 Wilberforce J stated:

“It may well be, of course, that in a suitable case one single act of user of a trade mark may be sufficient; I am not saying for a moment that this is not so; but in a case where one single act is relied it does seem to me that the single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof.”

The sole evidence for usage of the trade mark in suit relates to the sale of 10 containers to Truefitt & Hill, this is exhibited in E.G.1. The other parts of exhibit E.G.1 do not show use of the trade mark in the United Kingdom. The two leaflets and the export price list could be for use in any English speaking country, if they have indeed been used. There is no proof of when and where the packaging has been used. (I take note of the position of the Opposition Division of the Office for Harmonization of the Internal Market in relation to opposition proceedings No. B.1810 in relation to the acceptability of packaging material in relation to an accusation of non-use. In those proceedings they did not consider packaging material with a sell by date represented evidence of use of the trade mark during a five year period. I consider this correct, such evidence without supporting evidence cannot prove actual usage) The sole indication of usage rests therefore on an invoice for ten 50 ml containers CERTITUDE Day and Night Cream to the value of 1250 FF, or approximately £125. I certainly feels that such usage falls within the parameters of the Nodoz case. In relation to the goods upon which evidence of use has been adduced, skin care cream, such use must be considered negligible; this is a large market with a huge turn over in goods. As NODOZ indicates where there has only been a single act there needs to be overwhelmingly convincing proof of the usage; the evidence adduced in these proceedings does not

represent such proof. Indeed it is sparse in the extreme

In *Levi Strauss & Co. v Shah & Another* [1985] RPC 371 at p378 it was held “that to be bona fide any use must be a real commercial use of a substantial scale.”

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The evidence of use that has been adduced in this case is not of a substantial scale, it is of a minimal scale.

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The nature of the evidence of the registered proprietor leaves much concern as to whether there has been use which is not fictitious or colourable. In *Electrolux Ltd v. Electrix Ltd* (1954) 71 RPC 23 it was held:

“The legislative, in my view, had in mind that someone could not gain immunity from attack by asserting use when there was really only some fictitious or colourable use and not a genuine use.”

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As has been referred to above unanswered questions arise as to why there was such a large gap between the correspondence from the registered proprietor in relation to CERTITUDE and the issuing of the invoice to Truefitt & Hill. This evidence is also of concern as the company records would indicate that Mr. Ellis is not a director although he describes himself as such. There is no evidence showing the order from Truefitt & Hill and no evidence as to a delivery being made.

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Consequently I find that there has been no genuine use by the registered proprietors of the trade mark CERTITUDE for the period of five years up to the date of the application for revocation on 14 January 1997.

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The application for revocation succeeds in respect of all the goods encompassed by the specification and I order that registration no. 1069866 is revoked in its entirety. The application having succeeded I order the registered proprietor to pay to the applicant the sum of £835 as a contribution towards the cost of these proceedings.

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Dated this 2 of February 1999

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**Mr. D.W. Landau
For the Registrar
The Comptroller General.**

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