

TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 6978  
BY THE WEST COAST BREWERY COMPANY LIMITED  
FOR RECTIFICATION OF THE REGISTER OF TRADE MARKS  
IN RESPECT OF REGISTRATION NUMBER 1192206  
**GUINNLESS**  
IN CLASS 32  
STANDING IN THE NAME OF  
GUINNESS BREWING WORLDWIDE LIMITED

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IN RESPECT OF REGISTRATION NUMBER 1192206  
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10 DECISION

The trade mark **GUINNESS** (No 1192206) is registered in Class 32 in respect of :

15 “Stout, porter, ale, lager, beer and shandy; non-alcoholic beverages included in Class 32 containing not more than 2% (by volume) of alcohol; preparations included in Class 32 for use in making all the aforesaid beverages; fruit juices for use as beverages; all for sale in England, Scotland and in Wales and for export to the Isle of Man and to the Channel Islands.

20 The registration stands in the name of Guinness Brewing Worldwide Limited.

On 3 August 1991 The West Coast brewing Company Ltd of the King’s Arms Hotel, 4A Helmshore Walk, Chorlton-on-Medlock, Manchester 13 applied for the rectification of the Register of Trade Marks, by the complete removal of Registration number 1192206. The grounds for rectification in summary are:

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- The mark has never been used, or in the alternative, there has never been any real commercial use on a substantial scale, on or in relation to any goods in respect of which the mark is registered.
  - 30 • Use of the mark in suit was not use on or in relation to goods, but use with reference to goods sold under the mark GUINNESS. The mark in suit has been advertised by the proprietor as a reference to people not goods, viz.:

35 “The Guinness are quite simply those who, through nobody’s fault but their own, have left it too long between one Guinness and the next.”

- The mark in suit would infringe on the rights established by the applicant’s registration of its mark DOBBINS GUILTLESS STOUT.

40 The registered proprietor filed a counterstatement denying the grounds for rectification. Both sides filed evidence in these proceedings, following which a hearing was held on 14 July 1999. At the hearing the applicant was not present nor represented. The registered proprietor was represented by Mr David Goldring of J E Evans-Jackson.

45 By the time this matter came to be decided the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act, however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision

are references to the provisions of the Trade Marks Act 1938 ( as amended) unless otherwise indicated.

5 APPLICANT’S EVIDENCE

In support of its case the applicant for rectification filed statutory declarations by Brendan Dobbin, John Gordon Lawrence and Robert M Harston.

10 Mr Brendan Dobbin is the Managing Director of the West Coast Brewing Company Ltd the applicant in this case. As his statutory declaration, dated 22 April 1993, is the same as that filed in regard to an opposition case between the two parties much of the evidence is not relevant to these proceedings. Mr Dobbin claims that:

15 “The fact of the matter is, and everyone in the brewing trade knows it, that there is not and never has been a product sold as GUINNLESS stout. The word GUINNLESS has been used in an advertising campaign for Guinness but with the clear intention of promoting GUINNESS stout and no other. It was even made clear in the advertising campaign that there was no such product as GUINNLESS stout, the GUINNESS, it was said, referring to those who had gone too long  
20 without GUINNESS. ”

Mr Dobbin also comments that the mark in suit was used in “just one advertising campaign involving GUINNLESS and that it was but short-lived. I have no recollection of the campaign lasting beyond the year 1983 and have been unable to find any reference to GUINNLESS after the end of that year.”

25 Mr Dobbin also claims that “when the campaign flopped, the company never referred to GUINNLESS again in any of their advertising.” He also claims that the marks GUINNESS and GUINNLESS are not synonymous to identify the registered proprietor’s stout.

30 The statutory declaration by John Gordon Lawrence is the same as that filed in the opposition case between the two parties and would appear not to have any relevance to these proceedings.

The statutory declaration by Robert M Harston is dated 1 April 1993. Mr Harston is the Managing Director of Wigan Pier Ltd which is a public house and banqueting centre located on Wigan Pier. He  
35 is also the Managing Director of Rowan Inns Ltd, a public house, nightclub and hotel business situated in South Manchester.

Mr Harston states that he has worked in the brewing industry for twenty-five years, including nine years as Regional Managing Director of Mann’s Northampton brewery, and latterly of Drybrough & Company Ltd in Edinburgh. He states:

40 “I clearly recall the GUINNLESS campaign that began early in 1983, and I also recall the surprised reaction in the trade to that campaign, which may have resulted in its being short-lived. I felt that this kind of negative advertising, drawing attention to the fact that there were  
45 people who did not drink Guinness or that it was a drink that people did not drink very often, would be counterproductive. Sales of Guinness in the outlets I controlled at the time certainly did not take off. I did not see GUINNLESS used in any Guinness promotion after 1983 and I am surprised to see from the declaration of Mr Beanland that there was a 1984 calendar.”

Finally Mr Harston states:

5 “Guinness have used other word plays; Mr Beanland’s declaration exhibits them. There has been PURE GENIUS, GENNIUS, AGUINNESS (agin’ us). They have never actually put any of these on a bottle, never called their drink by any of them. The nature of their advertising has always been that the word play is an advertising gimmick intended (if, as we have seen, not always effective) to sell GUINNESS. The man in the street has never seen and has never been led to expect to see a bottle of PURE GENIUS or GENNIUSS or GUINNLESS, always a bottle of GUINNESS.”

#### REGISTERED PROPRIETOR’S EVIDENCE

15 This consists of a statutory declaration by Mr Brian Beanland, dated 4 February 1994, the Secretary of Guinness Brewing Worldwide Limited.

20 Mr Beanland states that in 1983 the name GUINNLESS was adopted for use in connection with the sale of the company’s stout. He provides at exhibit BBREC1 a list of other GUINNESS registrations in the UK. Mr Beanland states that the proprietor’s sell beer produced under the name GUINNESS in the UK and worldwide. At exhibit BBREC2 are examples of labels used in such sales. All show the name GUINNESS prominently on bottles and cans of GUINNESS stout and draught beer.

25 Figures of sales volumes and advertising costs for beer sold under the GUINNESS mark in the UK are provided by Mr Beanland as follows:

Year	Sales volume in bulk barrels (36 gallons)	Turnover	Advertising £million
1980	876,915	over £100 million	2.3
1981	810,047	over £100 million	2.3
1982	765,938	over £100 million	1.1
1983	792,645	over £100 million	8.9
1984	786,864	over £100 million	3.9
1985	836,352	over £100 million	4.4
1986	968,481	over £100 million	2.8
1987	1,003,866	over £116 million	5.3
1988	1,116,092	over £116 million	6.9
1989	1,129,431	over £116 million	6.5
1990	1,186,000	over £116 million	7.0
1991	1,171,000	over £116 million	8.1

40 Mr Beanland states that the product is advertised on television, radio, advertising hoardings, magazines,

local and national press and by means of promotional competitions and incentives.

Mr Beanland claims that by virtue of the above the proprietor has established a massive reputation in the UK in the trade mark GUINNESS. He also claims that:

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“By virtue of its massive sales and reputation in the Trade Mark GUINNESS and by virtue of the fact that the said registration is associated with the registrations of the trade mark GUINNESS under the provision of Section 23 of the Trade Mark Act 1938 and by virtue of the fact that GUINNLESS is so similar to GUINNESS, differing only by the addition of the letter ‘L’, my company contends that under the provision of Section 30 of the said Act the Registrar’s discretion should be exercised to accept the use of the said associated GUINNESS Trade Marks as use of the said registration.”

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Mr Beanland states that the registered proprietor used a slogan “Guinness is good for you”. In 1983 a new advertising slogan was coined “Guinness isn’t good for you” which he claims gives the message that to be without Guinness stout was not good for you. He claims that the GUINNLESS mark appeared in the same distinctive typeface as the word GUINNESS.

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Mr Beanland claims that “considerable sums” were expended on the promotion of GUINNLESS and that this “caused considerable recognition and comment in the press which served to increase the general awareness of the GUINNLESS name”. At exhibit BBREC3 is an article explaining the adoption of the GUINNLESS name together with examples of advertising and extracts from the press showing the use of the mark as part of various advertising slogans. These are all dated in January 1983 although ideas for a 1984 calendar are also shown. Mr Beanland states that by virtue of the use the registered proprietor established “a very wide reputation in the United Kingdom in the trade mark GUINNLESS in relation to the sale of its stout”.

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Mr Beanland contends that it is not necessary for a trade mark to appear on the goods concerned at the time of sale in order for the mark to be recognised as a trade mark and for such use to be accepted as trade mark use. He claims that from the press coverage shown at exhibit BBREC3:

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“It is clear that a large section of the public recognised and accepted GUINNLESS to identify my company’s stout. As a result the name GUINNLESS became well known and was used to identify my company’s goods in the course of trade. This recognition and use of GUINNLESS to identify my company’s goods shows that the name GUINNLESS was used as a trade mark in relation to the goods in the course of trade.”

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“Notwithstanding the above points my company would contend that it is possible for a pure advertising slogan to be used and registered as a trade mark. In this regard I would mention amongst others UK registered trade marks No 1104711 HAVE A BREAK- HAVE A KIT KAT and No 1281238 THE LISTENING BANK. In such cases the slogans clearly identify the origin of the goods / services and are used as trade marks even though no-one would enter a confectionery shop and ask for ‘HAVE A BREAK-HAVE A KIT KAT’ chocolate and biscuit bar. Nor would purchasers expect the words to appear on the goods. The slogan is recognised as identifying the product from the advertising of the product in the same way that GUINNLESS has been used as a trade mark and is recognised as identifying my company’s goods, through the advertising of my company’s goods,”

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Mr Beanland points out that Mr Dobbin in his statutory declaration accepts that the proprietor has used the mark GUINNLESS. Also that Robert M Harston, in his statutory declaration, appears to confirm that upon seeing the name GUINNLESS or one of the proprietor's other names such as PURE GENIUS the man in the street would expect to receive the proprietor's GUINNESS stout product. This claims Mr Beanland confirms that GUINNLESS is directly associated with the proprietor's GUINNESS stout product.

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

## DECISION

At the hearing the registered proprietor raised a preliminary point seeking to have the application struck out on the grounds that there was no longer an applicant. Mr Goldring stated that the company which made the application for rectification was dissolved and so no longer existed. It was also claimed that the assets of the company had not been assigned and so there was no action or case to deal with. He further stated that the application should be struck out as it had not been pursued and also referred to the registered proprietor's costs.

Whilst the applicant, The West Coast Brewery, informed the Registry that it had entered into liquidation no evidence of the company being dissolved has been filed. Therefore the Registry's position is that the application having been made by a legal entity, which to the Registry's knowledge is still in existence then the application cannot be struck out on the ground that there is no longer an applicant. With regard to the application not having been pursued, I note that in February 1995 the applicant, via their trade mark agent, made it clear that they were content for a decision to be made from the papers. The subsequent delay in a decision being made would appear to have been the result of repeated requests by the registered proprietor to have the matter struck out or deemed abandoned. Similarly, it is at the registered proprietors request that a hearing is being held.

I therefore decline to strike out the action.

Although not specified in the grounds for rectification it seems clear that the principal ground is one of non-use, and is brought under the provisions of Section 26(1)(a) & (b) of the Act, which reads as follows:

*"26(1) Subject to the provisions of the next succeeding section, a registered trade mark may be taken of the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, on the ground either-*

*(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application."*

*(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof*

*for the time being.”*

5 The first matter I have to consider is whether the applicant is a person aggrieved. The normal consideration for “persons aggrieved” is that set down by Lord Herschell in *Powell v Birmingham Vinegar Company* (Vol 1894) 11 RPC 4.

10 In the present case the registered proprietor is opposing an application by the applicant to register the mark “Dobbins Guiltless Stout”, and the registration in suit is relied upon as a basis for one of the grounds of opposition under Section 12(1) of the 1938 Act. In these circumstances the applicant clearly satisfies the test laid down by Lord Herschell.

15 It is well established that in any proceedings brought under Section 26, the onus of proof of non-use rests on the applicant for rectification. Only if non-use is established in the prima facie case, does the burden of proof pass to the registered proprietor ( see “TRINA” Trade Mark [1977]RPC 131 which in turn refers to “NODOZ” Trade Mark [1962] RPC).

20 The applicant alleges that the trade mark has never been used in relation to any of the goods for which the mark is registered. Whilst the applicant acknowledges that the mark has been used by the registered proprietor in an advertising campaign during 1983 it is alleged that this use was not trade mark use. The reason given for this contention was that the advertising campaign was for the stout known as GUINNESS and that no products were ever sold with the name GUINNLESS upon them. It is claimed that this is the only time that the mark GUINNLESS has been used.

25 Although the applicant is mistaken in the belief that a mark has to be used on goods for sale in order to meet the criteria of Section 26, a prima facie case with regard to non-use has been made with regard to the whole specification for which the mark is registered.

30 Mr Goldring contended that the grounds pleaded by the applicant referred to the mark in suit never having been used, and did not refer to non use in a specific period. Although the application did not refer to specific subsections of the Act, I do not believe that such a narrow view is acceptable. The application is on the grounds of non use and so Section 26 in its entirety has to be considered.

35 The registered proprietor has filed evidence to show that the mark GUINNLESS was used in an advertising campaign during 1983. This campaign was clearly very extensive and achieved a considerable amount of media coverage. It was also very expensive with approx. £9 million being spent on the campaign. The mark was linked to and intended to promote the proprietor’s stout known as GUINNESS. The word GUINNLESS was a reference to those who had not had a GUINNESS for some time. The campaign featured posters for “relief for the Guinnless”, “Centres for the Guinnless” and also “friends of the Guinnless”. The posters usually incorporated a representation of a pint of Guinness stout and often the name Guinness as well. Although only used during 1983 the mark GUINNLESS was clearly linked to the promotion of the registered proprietor’s stout known as GUINNESS.

45 However, the use shown cannot satisfy Section 26(1)(b) as the use claimed took place over five years and one month before the date of application. Accordingly, even if the use qualifies as trade mark use, it is too long ago to defeat the application.

The registered proprietor has also filed examples of use of the mark GUINNESS on stout and draught beer. In addition sales and advertising costs for beer sold under the GUINNESS mark have been provided for the period 1980 - 1991. It is clear that the registered proprietor enjoys a substantial

reputation for beer under the GUINNESS mark. However, the registered proprietor has not shown use on the other goods for which the mark is registered.

5 The registered proprietor has claimed that the marks GUINNESS and GUINNLESS are very similar differing only by the addition of the letter 'L', and that the marks are associated. As the marks are associated the registered proprietor has claimed that the use and reputation of its GUINNESS mark should be considered as sufficient to protect the GUINNLESS mark. In Kerly's at chapter 5-08 it states:

10 "The main provisions are section 23(2) and (2A), empowering the Registrar at any time to make two confusingly similar marks, registered or sought to be registered in the name of the same proprietor for goods or services, of the same description or associated, into associated marks; and section 30(1) giving any tribunal a discretion to accept use of any one of the associated marks as equivalent to use of any other. This last provision means that associated marks can be used for a purpose going beyond that suggested above: that of enabling a proprietor of a mark  
15 to register also marks he does not himself intend to use but which so resemble marks he does use that their use by others could lead to confusion. These he may register as associated marks of the mark he does use; and if the resemblance is sufficient they will be safe from attack on the ground of non-use."

20 The registrations of GUINNESS and GUINNLESS were associated under Section 23 of the Act. Given this and the fact that they are similar leads me to the conclusion that use of the GUINNESS mark will effectively constitute use of the GUINNLESS mark.

25 I therefore find the rectification to be successful in respect of all goods with the exception of "Stout, porter, ale, lager & beer" and that being the case, under the provisions of Section 26 of the Act, the registration will be revoked in respect of all goods for which it is registered with the exception of "Stout, porter, ale, lager & beer."

30 The other ground of rectification was that the mark in suit would infringe on the rights established by the applicant's registration of its own mark. However, the Guinness mark was registered on 15.3.1983 whereas registration of the applicant's mark was applied for on 17 February 1989, with no prior use evidenced in this action. The registered proprietor's mark is therefore the "earlier" mark.

35 The applicant for rectification, having partly succeeded in respect of the goods for which the trade mark is registered, is entitled to a contribution towards its costs. I order the registered proprietor to pay to the applicant for rectification the sum of £670

40 Dated this 17 day of September 1999

45 George W Salthouse  
For the Registrar  
The Comptroller General