

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION BY
MEDORA OF LONDON (PRIVATE) LIMITED
FOR THE REVOCATION OF AND
A DECLARATION OF INVALIDITY No 9962 IN RESPECT OF
TRADE MARK REGISTRATION No 2005010
STANDING IN THE NAME OF
MAX CARE INTERNATIONAL TRADING
COMPANY LTD**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF AN Application**
by **Medora of London (Private) Limited**
for the revocation of and a Declaration of
Invalidity No 9962 in respect of trade mark
10 registration No 2005010 standing in the
name of **Max Care International Trading**
Company Ltd

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BACKGROUND

Trade mark registration No 2005010 in respect of the trade mark MEDORA OF LONDON
20 stands on the register in the name of Max Care International Trading Company Ltd and was
registered with effect from 14 December 1994. The trade mark is registered in respect of the
following:-

25 Non-medicated toilet preparations; perfumes; essential oils, toilet waters, eau de
cologne; scenting compositions for use in the manufacturing of perfumery and
cosmetic products; all included in Class 3

By an application dated 26 October 1998, Medora of London (Private) Limited of M.A.
Jinnah Road, Karachi, Pakistan, has applied for the revocation of the trade mark and also for a
30 declaration of invalidity. The grounds upon which the action is based are set out in Annex A
and is the actual statement of case presented by Edward Evans & Co on behalf of the
applicants. The registered proprietor did not file a Form TM8 or counterstatement. Williams
& Powell Associates who appeared in the Trade Marks Register as the address for service for
the registered proprietor stated that they were without instructions in the matter. Under the
35 then Trade Marks Rules the registered proprietor was not obliged to defend an action such as
this. Therefore, the proceedings continued and the applicants for revocation and the
declaration of invalidity filed evidence, through their trade marks attorneys, in this matter.

An oral hearing was offered to the parties. There was no response from the registered
40 proprietor or their attorneys and the attorneys for the applicants stated that they wanted a
decision from the papers filed. After careful study of the papers on file and the evidence
submitted, my decision is set out below.

DECISION

Having read, and re-read the evidence against the statement of case set out in the Annex I have come to the conclusion that it does not support any of the grounds on which the application for revocation and the application for the declaration of invalidity are based. There is no evidence to support the allegations that at the date of registration the trade mark in suit was one which fell foul of Section 3(1)(a), (and Section 1(1)), Section 3(1)(b) and Section 3(3)(b). I therefore dismiss the grounds of the application insofar as they are based upon those grounds.

In relation to the Section 5(2) and Section 5(3), grounds set down there is no evidence provided of any earlier trade mark as defined by Section 6 and on which the applicants rely in support of those grounds. Nor is there any evidence to confirm or infer that the applicants have an unregistered trade mark in use within the United Kingdom which could be protected by the law of passing off or indeed any right which could fall to be protected by the provisions of Section 5(4). The grounds of the application insofar as they are based upon Sections 5(2), (3) and (4) are therefore dismissed.

The applicants base the application also on Section 60 which states:

"60.-(1) The following provisions apply where an application for registration of a trade mark is made by a person who is an agent or representative of a person who is the proprietor of the mark in a Convention country.

(2) If the proprietor opposes the application, registration shall be refused.

(3) If the application (not being so opposed) is granted, the proprietor may -

(a) apply for a declaration of the invalidity of the registration, or

(b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

(4) The proprietor may (notwithstanding the rights conferred by this Act in relation to a registered trade mark) by injunction restrain any use of the trade mark in the United Kingdom which is not authorised by him.

(5) Subsections (2), (3) and (4) do not apply if, or to the extent that, the agent or representative justifies his action.

(6) An application under subsection (3)(a) or (b) must be made within three years of the proprietor becoming aware of the registration; and no injunction shall be granted under subsection (4) in respect of a use in which the proprietor has acquiesced for a continuous period of three years or more."

No evidence has been filed, as far as I can see, which shows that the registered proprietors of the trade mark in suit was either the agent or representative of the applicants in the United Kingdom. Moreover, there is no corroborative evidence which supports the applicants' claim to a registration of the trade mark 'MEDORA OF LONDON' in a Convention country. This ground of the application is therefore dismissed.

The only ground upon which this application may have had substance is that based upon Section 47(1) and Section 3(6).

Section 47(1) states:

"47.-(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered."

Section 3(6) states:

3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

From the evidence submitted, which consists of Statutory Declarations by Mr S.M. Naseem Allawala, Chief Executive of the applicant company, I am satisfied that Medora of London (Private) Limited was based in Karachi, Pakistan, that they carried on business as a manufacturer and merchant of cosmetics and that they used the trade marks MEDORA and MEDORA OF LONDON in a number of Asian and Middle Eastern countries. Through sales in those markets, I am prepared to accept that the applicants established a reputation as a manufacturer and merchant of cosmetics, cosmetic products and similar goods sold under those trade marks.

Insofar as the allegation that Max Care International Trading Company Ltd acted in bad faith in seeking to register the trade mark in suit, Mr S.M. Naseem Allawala's Statutory Declaration dated 7 December 1998 states:

"10. Accordingly, Max Care International Trading Limited have acted in bad faith in registering Trade Mark Registration No. 2005010 MEDORA OF LONDON, the subject matter of these proceedings. Evidence of their bad faith was first brought to my company's attention by way of a complaint from one of my company's dealers that counterfeits of my company's products were seen in the markets under the name "MEDORA OF LONDON". Subsequently, my company arranged for a search to be conducted of the United Kingdom Register of Trade Marks, and we were concerned to learn of the registration of Trade Mark No. 2005010 MEDORA OF LONDON in Class 3 in the name of Max Care International Trading Limited, in respect of "non-

medicated toilet preparations, perfumes, essential oils, toilet waters, eau-de-cologne; scenting compositions for use in the manufacturing of perfumery and cosmetic products; all included in Class 3"; advertised on the 9th August 1995 with application date of 14th December 1994. Now produced and shown to me marked Exhibit SMNA2 is the photocopy of a certified copy of the said registration. I hereby confirm that the said photocopy is a true and correct copy of the said certified copy.

11. As a result of further investigations undertaken by my company, it was discovered that Max Care International Trading Limited had been incorporated in the United Kingdom on the 8th July 1994, with the following shareholders:

Mr. Mohammed Azeem,
Habib Bank Limited Building,
4th Floor, Flat No. 402,
Creek Road,
Deira, Dubai,
U.A.E.

99 shares

Mr. Jamil Ahmed,
21, Lakevien Estate,
Old Ford Road,
Bow,
London, E2 5TB

1 share

Mr. Azeem appears to be the sole Director of the said company and Mr. Jamil Ahmed appears to be the company secretary. Now produced and shown to me marked Exhibit SMNA3 is a photocopy of the Certificate of Incorporation and other company details issued by the Registrar of Companies. I hereby confirm that this is a true and correct copy of the said documentation. The gentlemen in question are both Pakistani nationals, and at the very least, Mr. Azeem is familiar with my company's trade marks and the reputation and goodwill built up in connection therewith in connection with cosmetics and related goods, as will be become apparent from subsequent paragraphs of my Declaration.

12. We have established that Mr. Azeem had earlier represented himself as General Manager and subsequently Managing Director of Ahmed Rajab Abdullah Trading Est, Riyadh, Saudi Arabia, and had several meetings in early 1992 with several executives of my company, and had negotiated for the procurement, purchase and/or import of cosmetics products under the trade marks MEDORA and MEDORA OF LONDON from my company. The firm Ahmed Rajab Abdullah Trading Est. placed various orders with my company, and letters of credit with a view to paying for the said consignments were established. Payment was made against documents for various consignments of cosmetics goods, principally lipsticks and nail polish under the said

trade marks. Now produced and shown to me marked Exhibit SMNA4 is a bundle of correspondence between my company and the company Ahmed Rajab Abdullah Trading Est. I hereby confirm that the copies forming this exhibit are true photocopies of the correspondence exchanged. These documents consist of a letter from my
5 company to Mr. Azeem dated 16th February 1992 forwarding a proforma invoice and discussing despatch of goods marked with my company's trade marks. The second document is a copy of invoice number 004/92/ARA dated 16th February 1992; the subsequent documents consist of a facsimile received from Ahmed Rajab Abdullah Trading Est. addressed to Mr. Iqbal Siddiqi, an employee of my company, again
10 regarding shipment; a similar facsimile received from the said company with Mr. Azeem's name at the bottom; a further letter received from the said Trading Company dated 14th August 1993; a letter from our Mr. Siddiqi to Mr. Azeem dated 16th December 1993; a copy of a fax received from Ahmed Rajab Abdullah Trading Est.; a letter to Mr. Azeem from my company (again signed by Mr. Siddiqi) discussing
15 export prices; a copy of a further facsimile message from Ahmed Rajab Abdullah Trading Est.; a further letter from us to Mr. Azeem dated 16th March 1995; a fax message from Ahmed Rajab Abdullah Trading Est. dated 18th March 1995, as the subsequent document; further correspondence from us to Mr. Azeem dated 17th May 1995; correspondence from Mr. Azeem dated 22nd May 1995, 1st June 1995, 7th
20 June 1995 and 26th June 1995; and finally our letter to Mr. Azeem dated 28th June 1995. From this it can be seen that there has been a continuous course of dealing by Mr. Mohammed Azeem acting as General Manager of Ahmed Rajab Abdullah Trading Est. of Riyadh with a view to purchasing and importing my company's goods.

13. The said documentation in my view goes to prove that Mr. Azeem was fully aware of my company's reputation in the trade marks MEDORA and MEDORA OF LONDON. It is also my view that in order to assess for himself the strength, notoriety and commercial value of my company's goods Mr. Azeem had undertaken the dealings represented in the evidence filed in Exhibit SMNA4. Now produced and shown to me
30 marked Exhibit SMNA5 is a bundle of copy documents representing shipping documents, invoices, packing lists, letters of credit representing various consignments of my company's goods. Again, it will be seen that my company's trade marks are mentioned in many of these documents to specifically identify goods being shipped from my company to Saudi Arabia for the benefit of the company Ahmed Rajab
35 Abdullah Trading.

14. Mr Azeem, in his capacity as General Manager and subsequently as Managing Director of Ahmed Rajab Abdullah Trading, also obtained sales promotion and publicity materials for the products of my company marketed under the Trade Marks MEDORA and MEDORA OF LONDON. Now produced and shown to me marked
40 Exhibit SMNA6 are photocopies of various shipping documents relating to such materials with Ahmed Rajab Abdullah Trading as the consignee/buyer. It is my company's view that Mr. Azeem intended to use these documents for the illegitimate purpose of disposing of his counterfeit products using the company Max Care
45 International Trading Limited."

5 The exhibits confirm the contents of the Statutory Declaration. In particular there is the correspondence by letter and facsimile between the applicants for the declaration of invalidity and M/s. Ahmed Rajab A. Trading Est, for the attention of Mr Mohammed Azeem which deals with the placing of orders for lipsticks, creams etc. A significant number of these exchanges deal simply with shades of lipstick to be supplied.

10 It seems to me that Mr Mohammed Azeem who is alleged to have represented himself as the General Manager and subsequently Managing Director of Ahmed Rajab Abdullah Trading Est in Riyadh, Saudi Arabia must have been, or have become, aware of the applicants' trade marks and their reputation. However, apart from the fact that both bear the same name there is nothing in the evidence which enables me to establish, or indeed infer, that Mr Mohammed Azeem of the Saudi Arabian company is the same Mr Mohammed Azeem the Director of Max Care International Trading Company Ltd, despite the fact that the declarant states "we have established that Mr Azeem represented himself as General Manager of Ahmed Rajab Abdullah trading Est" . The fact that both have the same name may be coincidental. Without evidence to connect the two names with the same individual the Registrar should be slow to assume any such connection. In those circumstances it would be wrong to find for the applicants under Section 47(1) and Section 3(6).

20 In reaching this view I have taken into account the fact that the registered proprietors have not sought to take part in these proceedings, and have therefore not denied any of the allegations. However, the then rules did not require them to. Nevertheless, I have considered whether in the light of the seriousness of the allegations there was some onus on them to provide some explanation of their conduct. But as the applicants have not established a prima facie case in support of any of their allegations, and for the reasons given above, I do not believe that any onus transferred to the registered proprietor. The application for revocation and a declaration of invalidity is refused in its entirety.

30 Dated this 17 day of May 2000

35 M KNIGHT
For the Registrar
the Comptroller-General

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A N N E X A

IN THE MATTER of Trade
Mark Registration no.
2001050 of Max Care
International Trading
Limited

- and -

IN THE MATTER of an
application to revoke the
Registration and for a
declaration of invalidity
thereof by Medora of
London (Private) Limited.

TRADE MARK ACT 1994

TM26

STATEMENT OF CASE

1. The date of Registration of the Trade Mark in Suit is 14th December 1994.
2. The Applicant asks that the Registration of the Trade Mark in Suit be revoked in accordance with Section 46(1)(d) of the Trade Marks Act 1994 because in consequence of the use made of the Trade Mark in Suit by the proprietor or with its consent in relation to the goods for which it is registered it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods.
3. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(1) of the Trade Marks Act 1994 because the Trade Mark at its date of registration was not capable of distinguishing goods or services of one undertaking from those of other undertakings and accordingly was registered in breach of Section 3(1)(a) of the Trade Marks Act 1994.
4. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(1) of the Trade Marks Act 1994 because the Trade Mark was at its date of registration devoid of any distinctive character and accordingly was registered in breach of Section 3(3)(b) of the Trade Marks Act 1994 and, in consequence of use which has been made of it, it has not after registration acquired a distinctive character in relation to the goods or services for which it is registered.
5. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(1) of the Trade Marks Act 1994 because use of the Trade Mark in Suit, at its date of registration, was prohibited in the United Kingdom by enactment or rule of law or by Community law and accordingly it was registered in breach of Section 3(3)(b) of the Trade Marks Act 1994.
6. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(1) of the Trade Marks Act 1994 because the application for registration of it was made in bad faith and accordingly the Trade Mark in Suit was registered in breach of Section 3(5) of the Trade Marks Act 1994.

7. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(2) of the Trade Marks Act 1994 on the ground that, at the date of registration of the Trade Mark in Suit, there was an earlier trade mark and the goods for which the Trade Mark in Suit is registered are identical with the goods for which the earlier trade mark was protected and accordingly the conditions set out in Section 5(1) of the Trade Marks Act 1994 obtain.
8. The applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(2) of the Trade Marks Act 1994 on the ground that at the date of registration of the Trade Mark in Suit, there was an earlier trade mark and the Trade Mark in Suit is identical with the earlier trade mark and was registered for goods similar to goods or services for which the earlier trade mark was protected or the Trade Mark in Suit is similar to the earlier trade mark and was registered for goods identical with or similar to the goods or services for which the earlier trade mark was protected and accordingly the conditions set out in Section 5(2) of the Trade Marks Act 1994 obtain.
9. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(2) of the Trade Marks Act 1994 on the ground that at the date of registration of the Trade Mark in Suit there was an earlier trade mark and the Trade Mark in Suit was identical with or similar to the earlier trade mark and the earlier trade mark had a reputation in the United Kingdom and the use of the Trade Mark in Suit without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark and accordingly the conditions set out in Section 5(3) of the Trade Marks Act 1994 obtain.
10. The Applicant asks that the Registration of the Trade Mark in Suit be declared invalid in accordance with Section 47(2) of the Trade Marks Act 1994 on the ground that, at the date of registration of the Trade Mark in Suit, there was an earlier trade mark and the use of the earlier trade mark was liable to be protected by virtue of a rule of law protecting an unregistered trade mark or other right or sign used in the course of trade or by virtue of an earlier right other than that referred to in Section 5, sub-sections (1) to (3) of the Trade Marks Act 1994 or by virtue of any rule of law protecting it as a registered trade mark and accordingly the conditions set out in Section 5(4) of the Trade Mark Act 1994 obtain.
11. The Applicant asks that the Trade Mark in Suit be declared invalid in accordance with Section 60(3)(a) of the Trade Marks Act 1994 because the proprietor is or was at the material time, an agent or representative of the Applicant.
12. In the alternative to the grounds set out in paragraph 11 the Applicant ask that the Register be rectified so as to substitute the Applicant's name as the Proprietor of the Registered Trade Mark, in accordance with Section 60(3)(b) of the Trade Marks Act 1994.

13. The Applicant asks that an award of costs be granted in its favour.

Dated this 14th day of January 1998.

Edward Evans & Co.

Edward Evans & Co.

Agents for the Applicants for Revocation, Invalidity and Rectification

