

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION No 1228540
IN THE NAME OF PRIMARK STORES LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
THERE TO UNDER No 10506 BY PRIMARK CORPORATION**

**IN THE MATTER OF TRADE MARK REGISTRATION No 1239922
IN THE NAME OF PRIMARK STORES LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
THERE TO UNDER No 10505 BY PRIMARK CORPORATION**

**IN THE MATTER OF TRADE MARK REGISTRATION No 1282235
IN THE NAME OF PRIMARK STORES LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
THERE TO UNDER No 10507 BY PRIMARK CORPORATION**

**IN THE MATTER OF TRADE MARK REGISTRATION No 1429600
IN THE NAME OF PRIMARK STORES LIMITED**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION THERE TO
UNDER No 10503 BY PRIMARK CORPORATION**

TRADE MARKS ACT 1994

**IN THE MATTER OF Trade Mark Registration No 1228540
in the name of Primark Stores Limited**

and

**IN THE MATTER OF AN Application for revocation
thereto under No 10506 by Primark Corporation**

**IN THE MATTER OF Trade Mark Registration
No 1239922 in the name of Primark Stores Limited**

and

**IN THE MATTER OF AN Application for revocation
thereto under No 10505 by Primark Corporation**

**IN THE MATTER OF Trade Mark Registration
No 1282235 in the name of Primark Stores Limited**

and

**IN THE MATTER OF AN Application for revocation
thereto under No 10507 by Primark Corporation**

**IN THE MATTER OF Trade Mark Registration
No 1429600 in the name of Primark Stores Limited**

and

**IN THE MATTER OF AN Application for revocation
thereto under No 10503 by Primark Corporation**

BACKGROUND

1. On 23 December 1998 Primark Corporation of Waltham, United States of America applied to revoke registration Nos 1228540, 1239922, 1282235 and 1429600 standing in the name of Primark Stores Limited. The registrations are in respect of the trade mark **PRIMARK** which stand registered for specifications of goods and services which read as follows:

No 1228540

Weighing apparatus, swimming aids being lifesaving apparatus; fire extinguishing apparatus, photographic apparatus and instruments, apparatus for recording and reproducing audio and visual signals; electrically heated appliances for curling and waving the hair; parts and fittings included in Class 9 for all the aforesaid goods.

(The registration was filed on 19 October 1984 and the registration procedure completed on 11 September 1987.)

No 1239922

Weighing and photographic apparatus; swimming jackets, swimming belts and lifebelts, all for use in life saving; life saving garments; goggles for use in swimming; apparatus for recording and reproducing audio and visual signals; kettles and flat-irons, all being electric; electric utensils and appliances, all included in Class 9; sunglasses, spectacles, binoculars, telescopes and micro-computers.

(The registration was filed on 16 April 1985 and the registration procedure completed on 23 October 1987.)

No 1282235

Management of commercial businesses; management consulting services; all included in Class 35. (The registration was filed on 1 October 1986 and the registration procedure completed on 20 May 1988.)

No 1429600

Paper articles, cardboard articles, labels; printed matter, books, pictures, posters, photographs, pencil sharpeners, binders, files, all being articles of stationery; playing cards, decalcomanias, writing implements, rubber erasers, notepads, drawing rulers, drawing pins, paper weights; calendars; bibs, serviettes, posters, table mats, all of paper; artists materials; instructional and teaching materials; greeting cards and gift wrappings; all included in Class 16.

(The registration was filed on 14 June 1990 and the registration procedure completed on 12 November 1993.)

2. The applicants' basis of attack is that the trade marks are not used in the United Kingdom by the proprietor or with the consent of the proprietor. They ask that the registrations be revoked in accordance with the provisions of Section 46(1)(a) of the Trade Marks Act 1994.
3. On 1 April 1999, the registered proprietor filed counterstatements. In summary they deny the assertions of non use made within the Statement of Case and Grounds for Revocation. The registered trade marks have they say been used in the United Kingdom within the past five years as is shown from the evidence (summarised below).
4. Both sides seek an award of costs. Both sides filed evidence. The matter came to be heard on 6 June 2001, when the registered proprietors were represented by Ms Fiona Clark of Counsel instructed by Maguire Boss, Trade Mark Attorneys. The applicants for revocation were represented by Roger Wyand of Her Majesty's Counsel instructed by Grant Spencer Caisley & Porteous, Trade Mark Attorneys.

5. Though they have not been consolidated these actions deal with the same trade mark, in the same ownership, with the same applicants for revocation. The evidence filed by the parties was, apart from a degree of particularisation, the same in each case, as were the submissions by learned Counsel. In the circumstances a single decision is appropriate. Where there are differences in evidence or submission I have so indicated.

REGISTERED PROPRIETORS' EVIDENCE

6. This consists of statutory declarations dated 29 March 1999 by Elizabeth Healy. Ms Healy explains that she is an employee of Primark Stores Ltd of Dublin Ireland, adding that she is authorised by her company to make her declaration on their behalf. The information comes from Ms Healy's own personal experience or from the records of the company to which she has access.

7. Ms Healy states that in the preceding five years, her company has made use of the mark PRIMARK in respect of the majority of goods and services for which the mark is registered. Exhibit EMH1 contains details of the company's retail sales figures (which includes separate figures for the United Kingdom) from March 1975 to September 1998 inclusive. Ms Healy points out that the company's sales figures in the last five years have all been in excess of £100m.

8. Exhibit EMH2 consists of details of the company's advertising costs in the United Kingdom, together with the costs incurred in relation to items of packaging material (also between March 1975 and September 1998) and upon which, Ms Healy says, the company's trade mark is prominently displayed.

9. In relation to the registrations dealing with the Class 9 goods she states in the relevant declarations:

"I swear and confirm that in the five years preceding the application for revocation company sold a wide range of goods generally described as electrical items and as generally listed in class 9 of the international classification of goods"

10. With the declaration dealing with the Class 16 goods she exhibits a copy of part of a roll of wrapping paper on which she claims the company's trade mark is displayed. And with the declaration dealing with the Class 35 registration she exhibits copies of correspondence dated 1995 from Jurys Hotel Group Plc (a United Kingdom firm) which, says Ms Healy, shows that the company's mark has been used in respect of "management consultancy services".

APPLICANTS' EVIDENCE

11. This consists of two statutory declarations. The first dated 24 June 1999 is by Julian Hill. Mr Hill explains that he is a private investigator and the Managing Director of Julian Hill Associates Limited of London. Mr Hill states that he specialises in private investigations in the intellectual property field generally and in trade marks in particular. The second is by Garry John Marshall also dated 24 June 1999. Mr Marshall is employed by Julian Hill Associates Limited as a researcher.

12. Mr Hill explains that in the Autumn of 1997 he received verbal instructions from Jackie Simpson of Grant Spencer Caisley & Porteous (GSCP) to investigate the commercial interests of Primark Stores Limited and in particular to ascertain whether the company sold any computer hardware, software or other office equipment. A copy of Mr Hill's report dated 5 November 1997 is provided as exhibit JH1. The report is reproduced in full below:

“The Primark Customer Services Department was contacted (01344 482929), and a list of all their Primark stores was requested. A fax was subsequently received from Joan Harvie, entitled Penneys/Primark Store Directory which I attach for your information.

The fax reveals that stores in the United Kingdom are called Primark with the addresses incorporating the words Primark Stores Ltd. However, some of the stores listed in the Directory within the London, Kent, West Sussex, Middlesex, Motherwell and Yorks, do not mention the name Primark (or Penneys) at all.

All of the store names in the Republic of Ireland are called Penneys, while the addresses incorporate the words Primark, Penneys Stores.

A Companies House search was made of Primark Stores Limited which shows that the company was incorporated on 30 April 1948 and has not changed its name since that time.

In addition a Primark Store was visited at 365 Mare Street, Hackney London and it was noted that the shop signage reads PRIMARK. The store sells mostly clothes, shoes and some bedding. All sales tags and hangers bear the name Primark and there are some ranges of own label clothing as well, the majority of which is sports and leisure wear. There is extensive use of the name Primark throughout.

Further enquiries with the Primark Customer Services Department have confirmed that the company do not sell any computer hardware, software or other office equipment.”

13. Approximately a year later, explains Mr Hill, he was asked again by GSCP to find out whether Primark Stores Limited had expanded their range to include goods such as computers, audio and video equipment, or stationery and printed matter. A copy of Mr Hill's second report dated 10 November 1998 is provided as exhibit JH2. With the exception of the telephone enquiries with the head office of Primark Stores Limited which were conducted by Mr Hill's colleague, Garry Marshall (Mr Marshall's Statutory Declarations of 24 June 1999 simply confirms that fact), all of the enquiries referred to in his reports were conducted by Mr Hill himself. Once again the content of the report is reproduced in full below:

“Initially, a visit was made to the Hackney Primark store at 365 Mare Street, E8. The shop sells predominantly clothes, along with accessories and also bed linens. Nothing appears to be labelled Primark although the name is printed on coat hangers and different ranges of clothing have their own names eg. Jumpers with the collar label “Cedarwood State”. In addition Primark is printed on receipts.

Subsequently, Directory Enquiries supplied a head office number in Bracknell 01344 482929. We spoke to the receptionist who informed us that this office was just the Buyers department. She did however explain that all Primark stores stocked the same products and this did not include anything like computers, audio and video equipment, or stationery.

We were advised to speak to the head office in Dublin 00353 18727 788 who in turn advised us to speak to the Belfast office, 01232 242 288. We spoke to Damien McCloskey who has been with the company for seventeen years. Mr McCloskey told us that they stock ranges of mens, womans and childrens clothing including lingerie. They also sell accessories such as shoes, handbags, scarves, gloves, socks, and they also sell new born baby wear.

The only paper products they sell are Christmas decorations. They have no catalogues and Mr McCloskey could only supply a list of their stores, which is enclosed for your reference”.

REGISTERED PROPRIETORS’ FURTHER EVIDENCE

14. This consists of a further statutory declaration by Ms Healy dated 20 December 1999. The declaration consists of, in essence, a response to the evidence of Mr Hill. Ms Healy makes the following points:

- in paragraph 1 of Mr Hill’s first report (5 November 1997) he says that a call was made to Primark Customer Services Department. However, the number quoted by Mr Hill, is, says Ms Healy, that of the company’s buying Office in Bracknell adding that the company’s Customer Services Department is in fact located at the company’s Head Office in Dublin
- that all stores operated in the United Kingdom by the company trade under the name PRIMARK
- that the company currently known as Primark Stores Limited was incorporated on 30 April 1948 under the name Stevenage Bakeries Limited and underwent name changes in 1964, 1972 and particularly 17 May 1974 when the name was changed to Primark Stores Limited
- that in so far as Mr Hill refers to a visit to a Primark store in Hackney, Ms Healy observes that this is one of the company’s smaller stores. While the store would stock the company’s core range of products which consist of clothing, bedding and other textile products, it would not, says Ms Healy, stock computer software. Ms Healy adds that computer software is sold by the company on a seasonal basis, mainly over the Christmas period and comments that even if the store visited were to stock computer software, it would not have done so at the time of the investigation

- whilst PRIMARK do not manufacture equipment and computer hardware for use in an office, they do sell stationery, and computer software under the mark PRIMARK. Computer games software, Christmas wrapping paper, Christmas cards and other forms of seasonal stationery are, says Ms Healy, covered by the appropriate registrations adding again that the market for these goods is limited and seasonal
- Ms Healy levels much of the same criticisms at the second of Mr Hill's reports (10 November 1998) ie. the timing of the visit to the store, the choice of store, together with the choice of contacts on whom Mr Hill bases his findings.

15. Ms Healy concludes her declaration in the following terms:

“Notwithstanding the above confusion has occurred between my company's use of their name on both the product in the above registration and in general. Now shown hereto under Exhibit EMH2 is a letter from Allied Irish Banks directed to Ms Sandra Reynolds of the Primark Corporation. Although clearly addressed to Primark Corporation, Dublin address, the letter was delivered to my company's offices in Dublin. Although this evidence of confusion has occurred in the Republic of Ireland, it is clear that my company's reputation in the name of PRIMARK is such that confusion will also occur in the United Kingdom”.

16. In fact I note that exhibit EMH2 consists of two documents. The first is the letter dated 16 September 1999 to Ms Reynolds at the Primark Corporation mentioned above; the second consists of a single page document on the letter headed paper of Primark Stores Ltd, Dublin, Ireland and is dated 16 December 1999. This document also refers to confusion between the respective parties.

17. That concludes my review of the evidence in so far as I think it necessary.

PRELIMINARY ISSUE

18. At the start of the hearing Ms Clark submitted that Mr Wyand's skeleton foreshadowed submissions on the nature of the use by the registered proprietors of the trade mark in suit and therefore the evidence submitted by them. In essence she said that the attack was becoming focussed on whether the use claimed was trade mark use. This point had not been pleaded, was unexpected and her clients ought to be allowed an opportunity to consider matters. Mr Wyand submitted that his clients had no need to plead the point. The Act and the Trade Marks Rules required the registered proprietors to show what use there had been of the trade marks. It was thereafter a matter of law as to whether the trade marks had in fact been used in relation to the goods and services covered by the registrations and whether that use had been trade mark use.

19. Though the pleadings were somewhat vague (and some of the points in evidence related to a period other than that set out in it), I have considered these applications for revocation as based entirely on Section 46(1)(a), which states:

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

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;”

That had to be read in conjunction with Section 100 of the Act which states:

"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."

20. This means that a registered proprietor, on notice that they are alleged not to have used their trade mark in the five year period, can seek to counter the allegation by showing what use has been made of the trade mark. In this case Counsel for the registered proprietors objected to the fact that in the skeleton argument Counsel for the applicants was indicating that the use that the registered proprietors claim to be making of the trade marks was not what is termed “trade mark use”. I was asked to bar that line of attack. In part those submissions were based on the fact that the registered proprietors are a retailer and therefore there might be special circumstances surrounding the use by a retailer of their trade mark in relation to goods and which might require the registered proprietors to put in additional evidence or alternative submissions.

21. It seemed to me that this was a straightforward attack under Section 46(1)(a) based upon whether or not the registered proprietors have used the trade marks in suit in relation to the goods and services covered by the registrations. It was up to the registered proprietors in those circumstances to determine what evidence they needed to put in in order to demonstrate and confirm that the mark had been used. As far as I was aware there was (and is) no particular practice before the Registrar in relation to Section 46 about what evidence could or should be filed by retailers in order to demonstrate that they have used a trade mark. No authorities were drawn to my attention in that respect.

22. The fact that the Registrar had in the very recent past changed her practice in relation to the acceptance for registration of trade marks for what might otherwise be termed the service of retailing did not have any bearing on the matter. Section 46(1)(a) was on the statute book and had been on the statute book since 1994, and it had from that time been the responsibility, when challenged, for a registered proprietor, whatever the nature of their business, to demonstrate what use they had made of their trade mark. On the basis of that evidence it was then open to the other side to either withdraw from the scene (perhaps with costs implications) or to continue the attack. And indeed in some instances to continue the attack (by way of submissions) on the basis that the use shown by the registered proprietor was not what has been termed ‘trade mark use’. I saw no reason why because that particular point was being utilised by Counsel for the applicants for revocation in his submissions that I should either adjourn the proceedings or allow the registered proprietors time to put in additional evidence.

23. The grounds of attack had always been known and the registered proprietors' position as a retailer was also an established and known fact. It had therefore been up to them to choose how to defend themselves against the allegation. It was not appropriate to seek to change or add to their evidence at this late stage simply on the basis of submissions to be made by Counsel on the other side based upon the facts in evidence. For those reasons I determined that the hearing should continue, on the basis of the pleadings, evidence and skeleton arguments then before me.

24. During her submissions, Ms Clark made a number of points concerning the onus placed upon registered proprietors in actions under Section 46 of the Act, and in particular the evidential burden. In Ms Clark's view the nature and extent of the evidence provided by a registered proprietor was determined by the detail in the pleadings. She stated "So that for example if you have an applicant who puts in an application for revocation in respect of a specific period, but that is not supported by any evidence that the mark was not used in that period that really places not very much burden on the registered proprietor at all ..." In her view, if an applicant for revocation on the grounds of non use does not provide evidence supporting the detail of such an allegation, the application should be struck out. The burden on the registered proprietor to show use of the trade mark when challenged only arose when the applicants detailed evidence was in place. Mr Wyand for his part disputed this view.

25. As indicated earlier, it seems to me that in cases such as this, Section 46 of the Act has to be read in conjunction with Section 100 of the Act - both provisions are set out earlier in this decision. Also, the provisions of the trade marks rules are relevant and I note that in the current Rules (Trade Marks Rules 2000) and the earlier versions there has always been a requirement for the registered proprietor, when faced with a request for a registration to be revoked, in whole or in part, on the grounds that the trade mark in question has not been used for all or some of the goods and services of the registration, to file evidence to show what use they have made of the trade mark within the same unextendable time period for filing the Form TM8 and Counterstatement. That, in my view is right. Following on from Section 100, it seems to me that there is an onus upon the registered proprietors to 'show' what use they have made of the trade mark in suit. In that connection I note that the 'Notes on the Trade Marks Act 1994', which were based upon the Notes on Clauses which were prepared for use in Parliament while the Trade Marks Bill was before it, says:

"SECTION 100: BURDEN OF PROVING USE OF TRADE MARK

SUMMARY

1. Section 100 declares that it is for the proprietor of a trade mark to prove use of the trade mark if this is called into question. The provision was foreshadowed in paragraph 4.30 of the White Paper.
2. This section places the burden of proof of use of a trade mark on the proprietor of the mark when the question of its use is raised in civil proceedings. Thus, in proceedings under section 46 for the revocation of the registration of a trade mark on the ground of non-use, if the proprietor does not produce evidence of use (for example, if he simply fails to respond), then the application for revocation will succeed by default."

26. This is not conclusive. But it is clear that there is an onus on the registered proprietor which is not discharged by assertions or claims to use, for the Act requires the registered proprietor to *show* (my emphasis) what use they have made of the trade mark. And because only the registered proprietor will have full knowledge of the use made of the trade mark it is only reasonable that they should be required to show that use at the commencement of proceedings, thus enabling the applicant for revocation to withdraw or amend his application accordingly.

27. I therefore disagree with Ms Clark, the level of the registered proprietors' evidence in a case such as this does not depend upon the nature of the applicants' evidence. There is from the time the action is launched an onus upon the registered proprietor to show what use they have made of the trade mark. I go on therefore to consider the case on that basis.

28. There are four registrations under attack here and I consider each separately against the evidence filed and the individual submissions made by Counsel. But before doing so, I should record that it was accepted on the evidence filed that the registered proprietors were a large retailer in the United Kingdom, selling a variety of goods, providing a turnover of £220m per annum. Their trade mark is PRIMARK and that this is used on the shop signage, swing tags, hangers, carrier bags and receipts etc. I go on to consider whether the trade mark has been used in relation to the goods and services of the individual registrations.

29. The authorities against which I consider the issues are *Euromarket v Peters* [2001] FSR 288. In particular paragraphs 50 to 51, where Jacob J deals with what can be regarded as genuine use of a trade mark where he states:

“Assume, however there were these three things, namely the packaging on a few items posted at the U.S. customer's request to the United Kingdom, Gift Registry sales, and a tiny amount of spillover advertisements in what the reader in the United Kingdom would know as U.S. journals. Do they individually or collectively amount to “genuine use” of the United Kingdom registered mark? Miss Vitoria contends they do. She says the reference to “genuine” is merely in contradistinction to “sham”. Small though the use may have been, there was nothing fake about it. The mark appeared in the United Kingdom in connection with genuine transactions and that is enough.

I disagree. It seems to me that “genuine use” must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of the use. In part it is a question of degree and there may be cases on the borderline. If that were not so, if Miss Vitoria were right, a single advertisement intended for local consumption in just one U.S. city in a journal which happened to have a tiny distribution in the United Kingdom would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be “sham”.

This to my mind shows that Miss Vitoria's gloss on the meaning of “genuine” is not enough, and the only stopping place after that is real trade in this country. I think all the examples relied upon are examples of trade just in the U.S.”

30. Also paragraphs 56 to 57 where the learned judge, dealing with the nature of use, states:

“That is not all on the question of non-use. If one looks at the advertisements they are essentially for the shops. True it is that some of the goods mentioned in the advertisements fall within the specification, but I doubt whether the reader would regard the use of the shop name as really being “in relation” to the goods. I think this is an issue worthy of trial itself. The argument is that there is an insufficient nexus between “Crate & Barrel” and the goods; that only a trade mark obsessed lawyer would contend that the use of “Crate & Barrel” was in relation to the goods shown in the advertisement.

In this connection it should be borne in mind that the Directive does not include an all-bracing definition of “use”, still less of “use in relation to goods”. There is a list of what may *inter alia* be specified as infringement (Article 5(3), corresponding to section 10(4) and a different list of what may, *inter alia*, constitute use of a trade mark for the purpose of defeating a non-use attack (Article 10(2), equivalent to section 46(2)). It may well be that the concept of “use in relation to goods” is different for different purposes. Much may turn on the public perception of the use. For instance, if you buy Kodak film in Boots and it is put into a bag labelled “Boots”, only a trade mark lawyer might say that Boots is being used as a trade mark for film. Mere physical proximity between sign and goods may not make the use of the sign “in relation to” the goods. Perception matters too. That is yet another reason why, in this case, the fact that some goods were sent from the Crate & Barrel U.S. shops to the United Kingdom in Crate & Barrel packaging is at least arguably not use of the mark in relation to the goods inside the packaging, and all the more so if, as I expect, the actual goods bear their own trade mark. The perception as to the effect of use in this sort of ambiguous case may well call for evidence.”

31. There is also a line of authorities *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767 *Pomoco Limited v Reed Consumer Books Limited* [2000] FSR 734 and culminating in *Decon Laboratories v Fred Baker Scientific Ltd* [2001] RPC 217 where Pumfrey J stated at paragraph 24:

“I think that the correct starting point as a matter of principle consists of the list of articles for which the proprietor has in fact used the mark. ... There is no pressing need, therefore, to confer on the proprietor of a wider protection than his use warrants by unduly broadening the specification of goods. There is a balance to be held between the proprietor, other traders and the public having regard to the use which has in fact taken place.”

32. Against that background, I go on to consider the individual cases.

33. The first is:

1228540

Weighing apparatus, swimming aids being lifesaving apparatus; fire extinguishing apparatus, photographic apparatus and instruments, apparatus for recording and

reproducing audio and visual signals; electrically heated appliances for curling and waving the hair; parts and fittings included in Class 9 for all the aforesaid goods.

34. The relevant period under the provisions of Section 46(1)(a) is the five years from the date the registration procedure was completed on 11 September 1987. The registered proprietor is therefore required to show what use they made of the trade mark PRIMARK in the five years following that date ie up to 10 September 1992, in respect of the goods covered by the registration. Ms Healy on behalf of the registered proprietor states in her Statutory Declaration that the trade mark has been used on the majority of the goods; her declaration sets out the specification of goods in full. There are no exhibits showing the trade mark in use on any of the goods (ie no brochures or catalogues), nor any exhibits showing that goods such as those covered by the specification have been ordered from suppliers, nor any indication given of the scale of use. Ms Clark was critical in her submissions of the applicants' evidence because in her view it established that no enquiries had been made of the registered proprietors by the investigator about their use of the trade mark in suit in respect of any of the goods falling within the scope of this registration. But, as I have concluded earlier in this decision, it is for a registered proprietor when challenged to show what use has been made of the trade marks. It is not primarily for an applicant for revocation to show that there has been no use. So, has the registered proprietors shown use on any of the goods? The answer is no. The assertions or claim to have used the trade mark on the 'majority' of goods covered by the specification can not in the circumstances be sufficient to show genuine use; it does not begin to show how the trade mark was used, on what goods and in what volumes to satisfy me that genuine use has been made of the trade mark in the relevant period, or indeed in any period. In the circumstances, the application for revocation in respect of registration No 1228540 succeeds because no use of the trade mark PRIMARK has been shown in relation to any of the above goods.

35. The second is:

1239922

Weighing and photographic apparatus; swimming jackets, swimming belts and lifebelts, all for use in life saving; life saving garments; goggles for use in swimming; apparatus for recording and reproducing audio and visual signals; kettles and flat-irons, all being electric; electric utensils and appliances, all included in Class 9; sunglasses, spectacles, binoculars, telescopes and micro-computers.

36. Again the evidence of use in this case is a statement from Ms Healy to the effect that the registered proprietor has used the trade mark on the 'majority' of the goods together with the statement:

“I swear and confirm that in the five years preceding the application for revocation my company sold a wide range of goods generally described as electrical items and as generally listed in class 9 of the international classification of goods”.

37. There are no supporting exhibits. Ms Clark submitted that the applicants' evidence did not support their case; there had been no enquiry, for example, of the lady who sold children's swimwear whether the store sold rubber rings or swimming goggles. But, in my view there

was no requirement for them to do so. In a case such as this, where the registered proprietor has not shown use of the trade mark on any of the goods covered by it, there is no onus upon the applicant, in my view, to then go out and prove the negative. The application for revocation in respect of registration No 1239922 succeeds in full because no use has been shown of the trade mark PRIMARK in any period in respect of the above goods. I should add that the reference to registered proprietors' computer software and computer games software in Ms Healy's evidence in reply is not relevant, neither goods are covered by the specification of the registration in suit.

38. The third is:

1282235

Management of commercial businesses; management consulting services; all included in Class 35.

39. The relevant five year period is 20 May 1988 to 19 May 1993. Again the evidence of use consists of assertions of use across the 'majority' of services. But in respect of this registration there is exhibited correspondence between the registered proprietors and Jurys Hotel which it is claimed shows use of the PRIMARK trade mark in respect of management consulting services. The correspondence consists of a letter dated 18 July 1995 from Deidre Godfrey, Marketing Executive of Celtic Vision Products Ltd to Mr Paddy Prior of Penneys providing him with details on Celtic Vision, the first full time Irish television channel to go on the air in the United States of America, in Boston. The letter encloses a rate card for advertisements and programme schedules. There is then a letter dated 21 July from Mr Prior to Mr Seamus McGowan of Jurys Kensington Hotel in London, simply passing the letter and attachments on. Then on 1 August 1995 Mr McGowan, who describes himself as General Manager, of, presumably, the Jurys Kensington Hotel, thanks Mr Prior for the information, says that he has passed it to the Group Marketing Department who will deal direct with Celtic. He goes on to thank Mr Prior for the lead given regarding 'By Design'.

40. The assertions, again, do not assist. And the evidence does not in my view show use of the trade mark in relation to any of the services covered by the registration. To begin with there has been no information provided in respect of any turnover in relation to any services - all the figures provided by Ms Healy relate to retail sales - there are no examples of any material, list of customers; no copies of tenders in respect of work sought. In making these comments I take into account that there is no need for a service to be provided for money or money's worth. But in order to defend a registration against an allegation of non use, more should be provided more than assertions together with submissions that correspondence (outside the relevant period) should be construed as indicating that its contents showed that a party was employed in providing another with management consultancy services. As Mr Wyand said:

"This appears no more than two businessmen having met, one saying to the other "I am looking for an Irish television company to advertise with. Can you help me?" The other saying "I will write you a letter telling you who they are and sending you their details." One just cannot tell what this incident was."

41. I agree. I therefore have to hold that there has been no use, genuine or otherwise, shown on any of the services covered by registration No 1282235 since the trade mark was registered or in any period since and the application for revocation succeeds in full in respect of this registration.

42. Finally:

1429600

Paper articles, cardboard articles, labels; printed matter, books, pictures, posters, photographs, pencil sharpeners, binders, files, all being articles of stationery; playing cards, decalcomanias, writing implements, rubber erasers, notepads, drawing rulers, drawing pins, paper weights; calendars; bibs, serviettes, posters, table mats, all of paper; artists materials; instructional and teaching materials; greeting cards and gift wrappings; all included in Class 16.

43. The relevant period in this case is the five years following the completion of the registration procedure 12 November 1993 to 11 November 1998.

44. We again have the assertions from Ms Healy that the trade mark was used on the 'majority' of the goods covered by the registration. In addition there is exhibited a copy of part of a roll of wrapping paper which is said to show use of the trade mark PRIMARK in relation to such goods. A copy of that exhibit is annexed to the decision and I will refer to it later. Also, there is the applicants' evidence which indicates, as a result of a telephone discussion with a Mr McCloskey at the registered proprietors' Belfast Office, that Christmas decorations were and are sold by the company. Ms Healy's evidence in reply states that Christmas cards, Christmas wrapping paper and other 'seasonal stationery' are sold by the registered proprietors under the trade mark.

45. Turning first to the evidence of the part of the roll of wrapping paper (at Annex A). Ms Clark said that she did not know what other trade marks appeared on the roll, but it had on it Primark's bar code which included the PRIMARK trade mark. This she submitted was enough to show that it had been used in relation to the goods. In that connection I was referred to the list of uses of a trade mark set out in Section 10(4) of the Act which sets out those acts which may result in infringement action. In Ms Clark's view her client had demonstrated that PRIMARK had been used in relation to relevant goods by reference to that list and, referring to the Dee Corporation Plc and others [1990] RPC 159 - the goods in this case were not ancillary to the retail service but necessary adjuncts.

46. Mr Wyand for his part submitted that the Dee Corporation case referred to the old law which had been superseded by the current law. In that connection he referred me to Canon v MGM (1999 ETMR1) which established that the essential function of a trade mark was to guarantee the identity of the origin of the trade mark and product to the consumer. The fact that a retailer puts a price sticker bearing their own trade mark on an item does not indicate that the retailer is the origin, merely that they have provided the service of retailing. He submitted therefore that the exhibit did not show use of the trade mark in relation to wrapping paper, or any other goods covered by the specification.

47. Like Mr Wyand, I discount the relevance of the Dee Corporation case. It dealt primarily with whether or not the service of retailing could be registered as a service mark under the Trade Marks Act 1938 (as amended). What I have to decide in this case is whether the proprietor of a registered trade mark has shown genuine use of that trade mark on the goods and services covered by the registration.

48. In considering this matter I draw upon the views of Jacob J in *Avnet Incorporated v Isoact Ltd* [1998] FSR page 20 where he stated:

“I do not think that what the defendants do falls within class 35, as explained by the Registrar’s officer. Certainly it is not shown to be within class 35 to Order 14 standard. So I do not think there is infringement of the mark established on that ground.

It is not necessary to go on further, but since the matter was argued, I will do so. The defendants counterclaim for rectification of the register or a declaration that the mark is invalid under section 46 and section 47 of the Trademarks Act. It is common ground that although two grounds are relied upon, they effectively boil down to the same thing: do the plaintiffs use the mark for services covered by the registration?

It seems to me that it is well arguable that they do not. What the plaintiffs do is to run a business of selling goods by catalogue - a catalogue equivalent of a retail business. In the course of that business they therefore carry advertisements of the goods of a variety of different manufacturers. In relation to those advertisements they enter into discussions with their suppliers, because it is important in a technical catalogue that the goods are described accurately. So they enter into discussions as to the precise description of the goods to be carried in their catalogue. That in itself I do not think could amount to the provision of advertising and promotional services. It is no different from a supermarket discussing and obtaining material for a special promotion of a particular manufacturer’s goods.

However, the plaintiffs do more than that. They not only enter into discussions with their suppliers, but they charge the suppliers something for carrying the advertisement in their catalogue. Again, this is much the same as a supermarket proprietor, going in for a special promotion of a manufacturer’s goods and asking the manufacturer to contribute to the cost of the special promotion.

Essentially, though, these plaintiffs in their retail sales by catalogue and the supermarket in its retail sale from a shop are conducting the same function. They are conducting the business of retail sales.”

49. In this case the registered proprietor relies upon the fact that on all goods in the store they put a price ticket which bears their trade mark and a bar code, as shown in the annex. This price ticket, bearing in mind the above decision, is, in my view, a statement of the provider of the retail service. It does not indicate the origin of the goods. It is the originator of those goods (and whose trade mark is likely in any event to be on the goods) who would be responsible for the quality of those goods and not the retailer who, under consumer protection

legislation must ensure that they are of merchandisable quality, but no more. Thus, as indicated by Jacob J, a retailer can not claim to have used their trade mark on goods merely by affixing to them their name and price bar code. The list of uses of a trade mark set out in Section 10(4) is not directly relevant in a case such as this. This is because the retailer is not seeking to infringe the trade mark by confusing the public as to origin. The public is well able to discern that the originator of the goods can be different from the entity selling those goods. For example a public house chain such as Wetherspoons providing public house services could not claim to have used the trade mark WETHERSPOONS in relation to whisky, simply because they have sold, as part of the public house service they provide, JOHNNY WALKER whisky. Thus, there has been no genuine use in my view of the trade mark PRIMARK on wrapping paper by the registered proprietor in any period.

50. As far as the other goods covered by the specification are concerned, again there are only assertions and nothing has been produced which shows use of the trade mark. In the circumstances, I conclude that the trade mark has not been used by the registered proprietor on any goods covered by the specification of registration No 1429600. The application for revocation therefore succeeds.

51. The registered proprietor asked for this decision to be suspended pending the judgment of the European Court of Justice in *Scandecor Developments AB v Scandecor Marketing AB* [2001] UKHL 21 where the House of Lords had referred to it the question of residual discretion under Section 46. As no basis for the exercise of discretion was put to me and because there has been no use shown of the trade mark on any of the goods and services of the registrations in suit, I see no reason to defer a decision in this case.

52. In view of my decisions above, all of the registrations mentioned shall be revoked. As the various actions were brought under the provisions of Section 46(1)(a) of the Act and having regard to the provisions of Section 46(6)(b), the registrations shall be revoked from the following dates: 1228540 (10 September 1992); 123992 (22 October 1992); 1282235 (19 May 1993) and 1429600 (11 November 1998).

53. The applicants have succeeded in full on all four cases. Bearing in mind that they only had, in effect, one set of evidence to look at, and one hearing only to prepare for and attend, I order the registered proprietors to pay to the applicants for revocation the sum of £3000 in respect of all these proceedings. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 15th day of August 2001

M KNIGHT
For the Registrar
the Comptroller-General