

TRADE MARKS ACT 1994

**IN THE MATTER OF AN APPLICATION
UNDER NUMBER 9441 BY THE HEARST CORPORATION
FOR REVOCATION OF TRADE MARK
NUMBER 601990 IN THE NAME OF
JL AND COMPANY LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF an application
under number 9441 by The Hearst Corporation
5 for revocation of trade mark number 601990
in the name of JL and Company Limited**

DECISION

10 Trade mark registration No. 601990 is in respect of the mark ESQUIRE and is registered in Class
25 in respect of:

Boots and shoes.

15 The registration currently stands in the name of JL and Company Limited.

By an application dated 27 February 1997, The Hearst Corporation applied for the registration
20 to be revoked under the provisions of Section 46(1) on the grounds that:

the mark is not being used in the United Kingdom by the registered proprietor or with his
consent in relation to the goods for which it is registered

25 that within a period of five years following the completion of the registration the mark has
not been put into genuine use in the United Kingdom by the registered proprietor or with
his consent in relation to the goods for which it is registered and there are no proper
reasons for non-use.

30 that such use has been suspended for an uninterrupted period of five years and there are
no proper reasons for non-use.

The registered proprietor filed a counterstatement in which they say that the mark has been used
within the relevant five year period.

35 The registered proprietor and the applicants for revocation both ask for an award of costs in their
favour.

40 Both sides have filed evidence in these proceedings. The matter came to be heard on 11 May
2000, when the applicants were represented by Ms Lindsay Lane of Counsel, instructed by Ms
Elaine Rowley of Marks & Clerk, their trade mark attorneys, and the registered proprietors by
Mr Rory Sullivan of Counsel, instructed Mr Graham Farnsworth of Lewis Silkin, their trade mark
attorneys.

Registered proprietors evidence (Rule 31(3))

45 This consists of a Statutory Declaration dated 22 April 1997, and comes from Julian America, the
Company Secretary of J.L. & Company Limited.

Mr America goes to the Statement of Grounds on which the application is based and refers to the investigations carried out into his company's use of the trade mark ESQUIRE, which he concludes cannot have been very thorough. He states that his company has used the trade mark and refers to exhibit JA1 which consists of three invoices from Edward Green and Company Limited relating to the supply of footwear and accessories in December 1993. Mr America explains that Edward Green & Company Limited was, until 26 July 1994 the name of his company.

Applicants' evidence (Rule 13(4))

This consists of a Statutory Declaration dated 27 November 1997, and comes from Ms Elaine Rowley, a partner in the firm of Marks & Clerk, the applicants' trade mark attorneys in these proceedings.

Ms Rowley begins by referring to an investigation into the registered proprietors' use of the trade mark ESQUIRE, the results of which are shown as exhibit EDMR1. The exhibit is a report dated 27 September 1996, and sets out details of the registered proprietors' company, and the conclusions drawn from the investigations that the registered proprietors have not used the trade mark ESQUIRE for at least the previous six years.

Ms Rowley criticises the evidence filed by the registered proprietors under Rule 31(3), concluding that it does not counter the allegations made in the Statement of Grounds.

Registered proprietors' evidence (Rule 13(6))

This consists of two Statutory Declarations. The first is dated 22 May 1998, and comes from Andre Hernandez, a Manager of J & L Co Limited. Mr Hernandez says that he has been employed by the company for 12 years, 8 of which as manager responsible for product development and production. He confirms that he has full access to the company records and files and that he is authorised to make the Declaration.

Mr Hernandez refers to exhibit AH1 which consists of a copy of the Declaration made by Elaine Rowley and comments on the report shown as exhibit EDMR1 to that Declaration. He says that he can clearly recall the ESQUIRE brand being used in 1993, and that the shoes came in a number of styles such as Berkley, Elmsley, Cadogan, Winton, Bogart, Treganna and Chelsea. Mr Hernandez says that the range was to be manufactured in Italy and that he went to Naples to deliver the designs and brief the Italian manufacturers, Compagnia of Via Napoli Roma. Mr Hernandez says that he had substantial involvement with the ESQUIRE brand.

The second Statutory Declaration is dated 27 May 1998, and is a further Declaration by Julian America.

Mr America comments on Elaine Rowley's criticisms of his earlier evidence, noting that it does not acknowledge that it shows use of the trade mark ESQUIRE. He refers to exhibit JA2 which consists of a collection of invoices and credit card payment slips for sales made June to September 1993, and a page from the company accounts. The invoices relate to sales of goods described as ESQUIRE in conjunction with the styles referred to in Mr Hernandez's Declaration. The page

from the accounts shows a date of 1993 and records sales of goods under the ESQUIRE trade mark to the amount of £33,132.

Mr America next refers to exhibit JA3 which consists of:

5

S two letters dated 21 December 1992 and 15 February 1993 from the registered proprietors relating to sales of goods under the ESQUIRE name.

10

S a telefax to Baker McKenzie in Milan instructing them to contact Campanile's lawyers to tell them not to use the name ESQUIRE BY EDWARD GREEN.

S notes of a meeting with Luciano Campanile on 14 November 1992 relating to arrangement for the sale of ESQUIRE shoes.

15

He concludes his Declaration by referring to exhibit JA4, which consists of an Asset Sale Agreement dated 20 October 1994 transferring the assets of Edward Green and Company Limited to JL and Company Limited, and including 18 pairs of ESQUIRE shoes.

Decision

20

At the hearing I raised a preliminary point in respect of exhibit JA2. This consists of a number of sales invoices accompanied by a credit card payment slip bearing the name of the card holder, their account number and the date of issue and expiry of their card, information which could be used by others to fraudulently obtain goods. I do not consider that such information should be a matter of public record, and with the agreement of both Mr Sullivan and Ms Lane, under the provisions of Rule 44(4)(a) I order that the credit payment slips contained within exhibit JA2 shall remain confidential and not open to public impaction.

25

30

I now turn to consider the grounds of revocation. These are found in Section 46(1)(a) and (b) of the Act, which read as follows:

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

35

(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;

40

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

45

Although the applicants have not stated under which part of section 46 they object, the wording used indicates that the matter falls to be considered under both subsection (a) and subsection (b) of Section 46.

Where the registered proprietor claims that there has been use of the trade mark, the provisions

of Section 100 of the Act makes it clear that the onus of showing use rests with him.

The registered proprietors' evidence mainly consists of a range of invoices (exhibit JA2), which clearly date from within the relevant period, and relate to sales of ESQUIRE footwear. Ms Lane
5 did not dispute that there had been use of ESQUIRE, or that the use was anything other than genuine. Ms Lanes's arguments was that the use on the invoices was as some internal coding used by the registered proprietors, that the purchaser will not have seen the invoices, and that in any case, the requirement is that the mark has been used as a trade mark and that such use was not trade mark use.

10 Exhibit JA3 refers to use of the names ESQUIRE BY EDWARD GREEN and ESQUIRE on the shoes, and to the use of ESQUIRE on box labels. Although the exhibit relates to the company's activities in Italy, I consider it likely to be representative of the way they use the name in the United Kingdom and see no reason why I should conclude that ESQUIRE was a form of internal
15 company coding

An invoice informs a customer of how much they have to pay. While I acknowledge Ms Lanes' argument that this may well have been by means of a till receipt and the customer did not get to see the invoice, I do not believe that to be the position. The invoices are hand written and include
20 details of how the goods were paid for and the name/address of the customer. Some invoices show the goods as having been paid for by cash, although primarily by credit card. In quite a few instances the customer details have clearly been entered in different handwriting to the information relating to the goods purchased, and in at least one instance, has been signed with the same signature shown on the associated credit card slip. From this I consider it reasonable to infer that
25 these customers had sight of, if not this invoice, at least a copy.

In support of her assertion that use on invoices did not constitute use as a trade mark, Ms Lane contrasted the wording of Section 10(4)(d) which specifically mentions that for the purposes of Section 10, use on business papers will be regarded as use of the sign, with Section 46(2) which
30 contains no such mention. .

Mr Sullivan referred me to the Cheetah trade mark case ((1993) RPC 173), in which it was held that use of a registered trade mark on invoices and delivery notes was still use in the course of trade, even if rendered long after the sale and delivery of the goods, and constituted an
35 infringement. Ms Lane took the view that the case was of little assistance saying that for there to be an infringement the use did not necessarily have to be use as a trade mark, whereas for the purposes of Section 46(1) it did. Reference was also made to the use of the word "sign" in Section 10 as opposed to "trade mark" in Section 46, although in my view nothing turns on this point.

40 In the Wet Wet Wet trade mark case (1996) FSR 205, Lord McCluskey accepted that for an infringement to occur the use had to be in a trade mark sense, although Jacob J in the Treat trade mark case (1996) RPC 281, did not consider this to necessarily be the case, which does not take this any further forward. In any case, I do not consider the fact that Section 46(2) does not
45 specifically mention use on documentation means that such use is not to be taken as trade mark use. In my view the instances mentioned are by way of example and cannot be intended as an exhaustive list, for if this were to be the case, use such as on the goods themselves would not be

use as a trade mark.

5 I am satisfied that the evidence shows that the registered proprietors have used ESQUIRE as a
badge of origin for their goods, albeit only in respect of shoes. As a consequence the specification
for which the mark is registered must be limited accordingly and the reference to “boots”
removed. Boots are essentially the same goods as shoes and while I see little if anything to be
10 gained by removing them from the specification, this is a course of action requested by the
applicants, and accepting that there is no evidence of use in respect of such goods, required by
the Act. I therefore find that the application for revocation is successful, albeit in part, and under
the provisions of Section 47(5) order that the registration be declared invalid in respect of boots.

15 The application for revocation having been successful, the applicants are entitled to a contribution
towards their costs. That said, the application has only succeeded in part by removing one of the
two items for which the mark is registered. Consequently I do not consider that the applicants
should be awarded their full costs. I therefore order the registered proprietor to pay the applicant
the sum of £320 within seven days of the expiry of the period allowed for filing an appeal or, in
the event of an unsuccessful appeal, within seven days of this decision becoming final.

20 **Dated this 13 Day of June 2000**

25 **Mike Foley**
For the registrar
The Comptroller-General