

TRADE MARKS ACT 1994

**IN THE MATTER OF Trade Mark Registration
No 1053626 in the name of Automobiles Citroen**

**AND IN THE MATTER OF An Application by
Tata Engineering & Locomotive Company Limited
under No 10619 for the Revocation of the Registration**

Background

1. The trade mark SAFARI was placed on the register on the 10 December 1980. The specification of goods is as follows:

Estate wagons being motor land vehicles, and parts and fitting therefore included in Class 12, but not including tyres or inner tubes.

2. The registration currently stands in the name of Automobiles Citroen. On 26 February 1999 Tata Engineering and Locomotive Company Limited of Bombay India, applied for the revocation of the trade mark. The Statement of Grounds records that:

“The grounds of revocation are that the trade mark registered under No 1053626 has not been put to genuine use in the United Kingdom for an uninterrupted period of 5 years prior to the date of this application by any proprietor thereof as a trade mark upon or in relation to any of the goods covered by the said registration and there are no proper reasons for non-use.

The applicants request that trade mark No 1053626 be revoked in respect of “Estate wagons being motor land vehicles; and parts and fitting therefore included in Class 12” pursuant to Section 46 of the Trade Marks Act 1994 and that costs be awarded to them. (the applicants)”

The Law

3. The relevant statutory provisions are Section 46(1) and 46(5) of the Trade Mark Act 1994. Section 100 of the Act is also relevant. These provisions are reproduced below:

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;

- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
 - (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
 - (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

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.

4. It is clear from Section 100 of the Act that the onus rests on the registered proprietor to show that there has been use of the mark in the relevant period. The applicant's grounds for revocation appear to me to present a case under Section 46(1)(b) of the Act. The relevant period for establishing use of the mark is therefore the period commencing on 26 February 1994 and ending on 25 February 1999.

5. The registered proprietor's evidence takes the form of two declarations by Françoise Bouet, who is the head of the trade mark department of Automobiles Citroën. Paragraphs 2 to 4 of M. Bouet's first declaration are as follows:

"In the course of 1998 my company reached an agreement with Rover Group Limited ("Rover") regarding use in the United Kingdom of the trade mark SAFARI permitting Rover to use the mark on a limited series between July and December 1998 subject to the terms of an undertaking in which Rover acknowledges the rights of Automobiles Citroën in the trade mark SAFARI. Attached hereto marked "FB 1" is my company's letter dated 9 March (with the certified translation into English) authorising use of the mark by Rover and a copy of Rover's letter dated 13 July 1998 confirming conclusion of the agreement with attached undertaking.

Rover commenced an advertising campaign in the national press shortly thereafter. Attached here to mark "FB 2" by way of example is a one page advertisement which appeared in the Daily Telegraph dated 31 July 1998.

The trade mark SAFARI also appeared on promotional material relating to the goods. Attached hereto marked "FB 3" is a copy sample leaflet produced on behalf of and distributed by Rover in connection with the goods over the period in question."

5. The terms of the undertaking referred to in M. Bouet's evidence is as follows:

“Whereas the undersigned, Rover Group Limited of International Headquarters, Warwick Technology Park, Warwick, CV34 6RG, England, wishes to use the SAFARI trade mark in International Class 12 in Great Britain to denote “a limited series of the DISCOVERY Vehicle”;

And whereas Automobiles Citroen of 62 Boulevard Victor Hugo, 92200 Neuilly-Sur-Seine, France, is holder of the SAFARI trade mark No 1053626 in Great Britain;

In view of the consent to use the SAFARI trade mark granted by Automobiles Citroen, the undersigned ROVER GROUP LIMITED hereby undertakes;

1. To restrict the use of the SAFARI trade mark to a series of approximately 1,200 vehicles, to be marketed between July 1998 and December 1998 in the United Kingdom, (including and together with the Isle of Man and Channel Islands);
2. Not to claim any right against Automobiles Citroen or the latter's subsidiaries on the basis of the use of the aforementioned trade mark in Great Britain;
3. To ensure, also, that the present undertaking is complied with by its successors and assigns.”

6. The undertaking is signed by Philip J Cooper as the Head of the Trade Marks Department of Rover Group Limited. Exhibit FB2 to M. Bouet's first declaration consists of an example of a full page advertisement of Rover's limited edition DISCOVERY SAFARI vehicle. The advertisement was featured in the Daily Telegraph on Friday 31 July 1998. It features a picture of a rhinoceros under which appear the words “luckily, on the limited edition DISCOVERY SAFARI , a protection bar, running boards and a ladder are fitted as standard.”

7. The applicant filed evidence in response in the form of two statutory declarations by Mr H Rohinesh, who is the Senior Deputy General Manager (Law) of the applicant company. Mr Rohinesh's evidence is not factual in nature. Rather it sets out the applicant's arguments and makes various criticisms of the evidence filed by the registered proprietor, which I will come to later.

8. M. Bouet filed a further declaration in response. The most relevant parts of his second declaration are as follows:

“The evidence on file clearly establishes that RGL (Rover Group Limited) are using the signs SAFARI as a trade mark in relation to motor land vehicles. The motor land vehicles sold under the DISCOVERY brand are in the nature of cars with a long body containing a large carrying space reached through a back door often referred to as the fifth door. There is now shown to me the following exhibits:

- 2.3.1. Exhibit SAF 1 consisting of a copy of an article entitled “Ten Years of Discovery” from a magazine entitled “LRM Land Rover Monthly” and, available in the United Kingdom through newsagents and the like. It can be seen from the photographs from the physical nature of the DISCOVERY vehicle is as described above.
- 2.3.2. Exhibit SAF 2 consisting of copy extracts taken from Collins English Dictionary (3rd edition, reprinted 1995) relating to the words ESTATE, WAGON and SAFARI.

In respect of the word SAFARI, I shall be making reference to this term in paragraph 2.4 below. It will be noted that the definition for an “estate car” is given as a “car with a comparatively long body containing a large carrying space reached through the back door.” It will also be noted that the same entry gives the alternative reference used in the USA as being an “estate wagon”. Equally, it will be noted that the definition given for wagon is “any of types of wheeled vehicles ranging from carts to lorries” with further reference given to station wagons in respect of Canada and the USA. The wording used in the specification of goods covered by the registration in suit is in general accordance with the dictionary definitions.

- 2.3.3. Reverting to the article contained in Exhibit SAF 1, it will be noted in the interview with the Commercial Director for Land Rover at the time of the launch of the vehicle sold under reference to the trade mark DISCOVERY. It will be noted that one of the target segments of the car market was the Volvo Estate car - first paragraph of the third column of page 28 of the magazine refers. The vehicle had been designed to appeal to people as being a primary or secondary car. It will be noted that from the final page of the extract that the launch of the DISCOVERY was a considerable success in persuading Volvo Estate drivers and the drivers of many other cars to switch to the DISCOVERY. It is clear that the DISCOVERY should be considered very much as an estate wagon type car.

I believe that the use of SAFARI by Land Rover as a limited edition sub-brand for its DISCOVERY vehicle is in keeping with the goods as covered by the registration in suit and in accordance with the dictionary definitions”.

“I now consider the issue of the use of the limited edition names and/or tertiary marks. It is long been my experience that it is commonplace within the field of motor manufacturing for limited edition names and/or tertiary marks to be used to denote a line of a particular model having a particular set of features. By way of example there is now shown to me Exhibit SAF 4 consisting of further extracts taken from “What Car magazine” as described above at paragraph 2.4. It will be noted that from the extracts that examples of tertiary marks being used to note a particular model.

In anticipation of an argument as to token use of the SAFARI trade mark, I point first to the copy undertaken to be found at Exhibit FB 1 of my earlier declaration. It will be

noted that authority was given for the use of the SAFARI trade mark in relation to 1,200 vehicles. Turning now to the contents of Exhibit FB 3 of my earlier declaration it will be noted from the copy advert that the average retail price of vehicles sold under reference to SAFARI was £27,923.00 per vehicle. On the basis of the authorisation for use to be made in relation to 1,200 vehicles, the total retail value of the authorisation to use amounted to approximately £33,600,000 - a not insignificant figure.”

The Hearing and the Applicant’s Arguments

9. The matter came to be heard on 4 June 2001 when the Registered Proprietor was represented by Mr St Ville of Counsel, instructed by Baron & Warren, Trade Mark Attorneys, and the applicant was represented by Mr Blum of Gill, Jennings & Every, Trade Mark Attorneys. The applicant’s arguments can be summarised as follows:

- a. That the use shown by the registered proprietor is not use with the consent of Automobiles Citroen because Citroen had no control over the use made of the mark SAFARI by Rover Group Limited;
- b. That the use shown was not trade mark use - it was simply use of the words SAFARI as an adjunct to the mark Land Rover or as a description;
- c. That the use shown was not genuine use because the scale of use was of a token nature;
- d. That the use shown was not in relation to the goods for which the trade mark SAFARI is registered.

10. I shall deal with each of these points in turn.

Not use with the Registered Proprietor’s Consent

11. Mr Blum submitted that the registered trade mark had not been used with the consent of the registered proprietor, but with his mere acquiescence. He submitted that the evidence failed to show that there had been any input from Citroen into the way the mark had been used by Rover Group Limited or with respect to the goods to which the mark was affixed. He invited me to conclude that if Rover had used the mark at all, they had used it as their own mark.

12. It seems to me that the difference between acquiescence and consent is that acquiescence only requires some form of tacit acceptance, whereas consent requires positive agreement. It is clear from Exhibit FB 1 to M. Bouet’s first declaration that the registered proprietor gave consent to Rover Group Limited to use the mark SAFARI in the UK. It appears to me that the applicant’s principal criticism of the use made of the mark SAFARI by Rover Group Limited is that the registered proprietor exercised little or no control over the way in which the mark was used and/or had no input into the quality of the goods offered under the mark. Section 46 of the Act is based upon, and is intended to give effect to, Articles 10 to 12 of the

First Council Directive 89/104 approximating the Trade Mark Laws of Member States. Article 10(3) of the Directive is in the following terms:

“Use of the trade mark with the consent of the proprietor or by any person who has the authority to use a collective mark or a guarantee or certification mark shall be deemed to constitute use by the proprietor.”

12. This may be contrasted with the wording of Article 8(1) of the Directive, which is as follows:

“A trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Member State concerned. A licence may be exclusive or non-exclusive.”

13. The wording of these provisions suggest that “consent” has a broader meaning than “licence”. This suggests that consent given by the registered proprietor to another party to use the registered trade mark may be relevant for the purposes of Section 46 of the Act even if the registered proprietor exercised no control over the quality of the goods to which the other party applies the trade mark through a traditional licence arrangement.

14. At first sight this conclusion seems difficult to square with the function of a trade mark, which has been described by the European Court of Justice in the following terms:

“The essential function of a trade mark is giving to the consumer or ultimate user a guarantee of the identity of the origin of the marked product by enabling him to distinguish, without any possible confusion, that product from others of a different provenance. For a trade mark to perform this function, it must offer a guarantee that all the goods bearing it have originated under the control of a single undertaking which is responsible for their quality.”

15. Mr St Ville accepted that the consent given by the registered proprietor in this case was analogous with a bare licence. The issue of bare licences has arisen recently in a case which came before the House of Lords: Scandecor Development AG v The Scandecor Marketing AV and Others, 4 April 2000. Lord Nicholls of Birkenhead dealt with the question of bare licences in paragraphs 36-41 of his opinion before concluding that:

“The House should refer to the European Court of Justice the question whether a trade mark is to be regarded as liable to mislead the public within the meaning of Article 12(2)(b) if the origin of the goods denoted by the mark is a bare exclusive licensee.”

16. Paragraphs 56 and 57 of Lord Nicholls’ opinion appear to be of particular relevance to this case. They are reproduced below.

“56. For completeness, I mention the contention of Mr Rosen QC based on Article 10(3) of the Directive. Article 10 makes provisions regarding the non-use of trade marks. Article 10(3) provides that “use of the trade mark with the consent of the proprietor shall be deemed to constitute use by the proprietor.” Mr Rosen

submitted that the proper interpretation of this article is that use with consent constitutes deemed use by the proprietor for all purposes. Accordingly, the use of the marks by Scandecor Marketing and Scandecor Limited on their goods was not likely to “mislead the public”. Their use is deemed to be use by the proprietor of the marks, Scandecor International. The 1994 Act should be construed accordingly.

57. I cannot accept this. I agree with Lloyd J that the context of Article 10(3) makes clear that Article 10(3) is directed at the non-use provisions of Articles 10 and 11. It is not applicable to the revocation provisions in Article 12(2)(b). Those are the provisions carried into Section 46(1)(d) of the Act. The Act incorporates the effect of Article 10(3) into Section 46(1)(a). A mark may be revoked if, for a period of 5 years, it has not been put to genuine use “by the proprietor *or with his consent.*”

I consider this is *Acte Clair*. The Court of Justice should not be burdened with this further point. That Court is burdened enough without being asked questions to which the answer is obvious.”

17. It appears from this that:

1. Use with the consent of the registered proprietor of a trade mark is deemed to be use by the proprietor himself for the purposes of Section 46(1)(a) and (b) of the Act;
2. This is reconciled with the function of a trade mark by Section 46(1)(d) of the Act which states that use (with the proprietor’s consent) which results in deception of the public as to the origin or the quality of the goods, renders the registration of the trade mark liable to revocation;
3. The question of whether the registered proprietor has exercised sufficient control over the use of his trade mark is therefore a matter which may be raised by way of an attack under Section 46(1)(d) of the Act, but it is not a matter which is relevant to the question of whether the mark has been used for the purposes of Section 46(1)(a) and (b) of the Act.

18. It follows from these conclusions that the applicant’s argument about the use by Rover Group Limited being on their own account, rather than being use on behalf of the registered proprietor, is misconceived. Any use with the registered proprietor’s consent is deemed to be use by the proprietor. Thus the proprietor’s failure to control the use made of the mark with his consent cannot have any bearing on whether such use is “genuine” because it is deemed to be use by the proprietor itself. For the same reason I also reject Mr Blum’s submission that the use shown by Rover Group Limited cannot accrue to the registered proprietor because the public would have been unaware of any connection between the goods marketed under the trade mark SAFARI and the registered proprietor. It has never been the law that a trade mark must inform the public of the name of the trade mark owner. It is sufficient that the trade mark informs the public that all the goods marketed under the mark are goods to which the proprietor of the mark is prepared to affix his “banner”.

Not use as a Trade Mark

19. Mr Blum submitted that the use shown by Rover Group Limited was not, in any event, use as a trade mark. As I understood it, this criticism takes two forms. Firstly, that use of SAFARI was not use as a trade mark because the goods in question were primarily identified by the marks “Land Rover” and “Discovery.” There is no rule that a secondary or even third level product identifier cannot be a trade mark. On the contrary, it is easy to think of examples, such as Ford Escort **XR3i** and Ford Sierra **Cosworth** where the third level identifier is plainly a trade mark. Each case therefore turns on its own facts.

20. The second leg of Mr Blum’s submission is that the word SAFARI is descriptive of the goods in respect of which the mark was used: that the use of SAFARI was analogous to signs such as “five door” or “V8.”. It is not obvious to me what characteristic of the goods is described by the word “safari”. It is true that the promotion of the mark SAFARI by Rover Group Limited plays upon a safari “theme.” The vehicle in question is said to come with a protection bar, running boards and a ladder, all of which may suggest that the vehicle is suitable for use on a safari. However, the vehicle also comes with metallic paint, five spoke sports alloy wheels, and a CD player. The registered proprietor’s evidence suggests that Rover Group Limited used the mark SAFARI in a fanciful way in relation to a vehicle which, whilst undoubted having off-road capabilities, was, in reality, promoted as an up-market form of transport for the UK rather than as a specially adapted vehicle for use on “safari” in Africa or other distant places.

21. Mr Blum referred me to a promotional brochure for the Land Rover Discovery Safari exhibited as FB 3 to M. Bouet’s first declaration. Mr Blum pointed out that the second page of the brochure listed the three models available under the name SAFARI (Safari Tdi, Safari Tdi Automatic, Safari V8i Automatic) under the heading of “Description”. However, it appears to me that the brochure is, as one would expect, providing descriptions of the various models available for sale. It is in this sense that the word SAFARI is used as a description. I do not think that brochure supports the applicant’s contention that the word SAFARI was used as a description of a characteristic of the goods in the way that “V8” and “five door” plainly are. I have therefore reached the conclusion that the use shown of the trade mark by Rover Group Limited (with the registered proprietor’s consent) is use as a trade mark in relation to a motor land vehicle.

Not Genuine Use

22. Mr St Ville referred me to paragraph 9-60 of Kerly’s Law of Trade Marks and Trade Names (13th edition) which deal with the question of genuine use. However, in the end I understood Mr St Ville to accept that the law is as stated by Jacob J. in Euromarket Designs Inc v Peterson & Another 25 July [2000] ALL ER (D) 1050. The learned judge said that:

“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 border-line. If that were not so, and Ms Vittoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have

a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be a “sham”. This to my mind shows that Ms Vittoria’s gloss on the meaning of “genuine” is not enough. And the only stopping place after that is real trade in this country.”

23. Is the use of SAFARI shown in the evidence sufficient? The registered proprietor gave consent for the sale of 1,200 vehicle in the period between July and December of 1998. The evidence does not establish how many of these 1,200 vehicles were actually sold. It is clear that the promotion of these vehicles went ahead. The full page advert in the Daily Telegraph of 31 July 1998 is testament to this. The Daily Telegraph is, of course, a popular national newspaper and, although I have not been provided with distribution figures, I think it is safe to conclude that it has a substantial distribution within the United Kingdom. Moreover, as Mr St Ville’s suggested, in the case of vehicles costing well over £20,000 it would be surprising if the 1,200 vehicles produced by Rover Group Limited did not stay on sale until such time as they were all sold. I do not think that Mr Blum seriously contended otherwise. Further, even without details of individual sales, I believe that the promotion of the trade mark in a major national newspaper is sufficient of itself to constitute genuine use of the trade mark in the United Kingdom. In this respect I note that in ELLE Trade Mark 1997 FSR Page 529, Lloyd J. accepted that offering goods for sale under the Trade Mark ELLE in a single French edition of the magazine of the same name constituted genuine use of that mark in the United Kingdom. The learned judge noted in so finding that the case was a borderline one. This case is also borderline but, in my view, rather less so than in the ELLE case. I conclude that Rover Group Limited made genuine use of the trade mark SAFARI with the consent of the registered proprietor.

Is the use in relation to goods for which the trade mark is registered?

24. The applicant argues that the vehicles offered for sale by Rover Group Limited under the trade mark SAFARI were not “estate wagons”. The registered proprietor relies upon the definition of “estate car” in Collins English Dictionary which defines an “estate car” as a “car with a long body containing a large carrying space reached through a fifth door.” The registered proprietor claims that the goods shown in evidence fall within this description. The registered proprietor points out that:

1. “Estate wagon” is an expression used in the USA for what would be known as an “estate car” in the United Kingdom;
2. The registered proprietor further points out that the various press articles contained within Exhibit SAF 1 to M. Bouet’s second declaration indicate that the target market for the Land Rover Discovery vehicle included Volvo Estate drivers.

25. The applicant submitted no evidence to rebut the registered proprietor’s evidence on this point. However, at the hearing Mr Blum invited me to conclude, “as a matter of common sense”, that the vehicles shown under the mark SAFARI in evidence were not the sort of vehicle that would ordinarily be described as an estate wagon or estate car. In this respect he

observed that an estate is usually a variant on a saloon model. Mr Blum pointed out that there was no evidence that either the registered proprietor or Rover Group Limited described the Discovery vehicle as an estate wagon or estate car.

26. I do not accept that the definition of an estate wagon can be determined by reference to the answer to the question of whether there is also a saloon equivalent of the same vehicle. It is true that there is no evidence that either the registered proprietor or Rover Group Limited call the Discovery vehicle an estate car or estate wagon. I also accept that many people would describe the vehicle in question as a 4X4 or off-road vehicle. However, I do not believe that either of these observations are conclusive. Vehicles may be placed in more than one category. In this respect I note that the edition of "What Car?" magazine exhibited as SAF 3 to M. Bouet's second declaration, describes a Range Rover, which I believe to be a similar type of vehicle to a Discovery, as a "luxury estate". It appears to me that the same description could be applied to a Land Rover Discovery Safari. I accept that the point is not beyond argument, but taking account of all the above, I am prepared to accept that the goods shown in evidence do fall within the specification of goods of the registered trade mark.

27. Mr Blum pointed out that the registered proprietor had not shown any use of the mark on its own account, or with its consent, in relation to parts and fittings for estate wagons. This point was raised for the first time in Mr Blum's skeleton argument. Mr St Ville invited me to infer that if the mark had been used in relation to motor vehicles then it followed that there would have been subsequent use of the mark in relation to parts and fittings for those vehicles. In the alternative, he suggested that because the limited edition SAFARI vehicle came with its own unique parts and fittings that the use of the mark SAFARI in relation to the vehicle as a whole was also use in relation to parts and fittings for that vehicle.

28. I do not accept the latter point. However, in view of the likelihood of a trade in vehicles leading to a trade in parts and fittings for those vehicles under the same mark, and the applicant's delay in identifying its concern about this aspect of the registered proprietor's evidence of use of its trade mark, I would have been prepared to allow the registered proprietor a further short period of time within which to have submitted further evidence on this point. In the end this was not necessary because I understood Mr Blum to accept that if the applicant could not succeed in relation to the primary goods then it would not pursue revocation of the trade mark in respect of parts and fittings for estate wagons as a separate matter. In the light of my earlier findings there is therefore no need for me to say anything further about the use in relation to parts and fittings.

Conclusion

29. For the reasons set out above, I have decided that each of the applicant's attacks on the registered proprietor's evidence of use of its mark fails. I have concluded that the registered proprietor has shown genuine use with its consent of the trade mark SAFARI in the United Kingdom in relation to the goods for which the mark is registered. The application for revocation under Section 46(1)(b) of the Act therefore fails.

Costs

30. The application having failed, the registered proprietor is entitled to a contribution towards its costs. I therefore order the applicant to pay the registered proprietor the sum of **£1,000** as a contribution towards its costs. This to be paid within seven days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within seven days of the final determination of the matter.

Dated this 12th Day of July 2001

**Allan James
For the Registrar
The Comptroller General**