

## **TRADE MARKS ACT 1994 AND THE TRADE MARK RULES 2000**

**IN THE MATTER OF Trade Mark N<sup>o</sup>: 1216385  
in the name of The Jacob's Bakery Limited**

**and**

**IN THE MATTER OF an application for  
revocation N<sup>o</sup>: 11928 by the Kellogg Company.**

### **BACKGROUND**

1. The trade mark TEMPTATION (N<sup>o</sup>:1216385) was registered on 23<sup>rd</sup> November 1990 and stands in the name of The Jacob's Bakery Limited (the registered proprietors, who I will call 'Jacob'). The specification, for goods in Class 30, is as follows:

'Rice, pasta; cereals and cereal preparations, all for food for human consumption; sugar; syrups for food (not medicated and not for making beverages); nut confectionery, cakes, pastries, biscuits (other than biscuits for animals), bread; foodstuffs prepared in the form of savoury snackfoods or fillings, mixes for making bakery products and for making puddings, all included in Class 30; but not including any such goods containing or coated with chocolate or cocoa.'

2. On 15<sup>th</sup> September 2000, the Kellogg Company (the applicants, who I will call 'Kellogg') applied to revoke the registration under section 46(1)(b) in the following terms:

'The Applicants for revocation have reason to believe that the trade mark subject of Registration No. 1216385 has not been put to genuine use in the United Kingdom, by the proprietor or with his consent in relation to all of the goods for which it is registered, at any time during the last five years, and there are no proper reasons for non-use'.

3. After the statutory evidence rounds the parties said that they did not wish to be heard and so this decision is written on the basis of the papers on file, which include written submissions from the registered proprietors filed at the conclusion of the evidence rounds. As is usual I will review the evidence first.

### **The registered proprietors' evidence (r. 31(2)).**

4. Linda Bray is a trade mark attorney acting for the registered proprietors. In a Witness Statement dated 22<sup>nd</sup> December 2000, which constitutes the Counterstatement, she says that she has been provided with information from Brian Dyer, Jacob's Legal and Financial Manager. Mr Dyer advises Ms. Bray that the registration has been used in the last 5 years. Exhibit LAB1 is a selection of invoices relating to sales of biscuits under the mark during 1999 and 2000. The registered mark is clearly referred to in the invoices and the customer on each invoice appears to be the same, Irish Biscuits Ltd. of Dublin, Ireland. Exhibit LAB2 is a copy of the lid and one side of a tin of TEMPTATION biscuits which, says Ms. Bray, she holds in her office, and demonstrates the way the mark has been used in the relevant period.

**The applicants' evidence (r. 31(4)).**

5. Jane More O'Ferrall is a trade mark attorney of the firm acting for the applicants, Kellogg. Her evidence, in a Witness Statement dated 24<sup>th</sup> April 2001, consists solely of a commentary on Linda Bray's evidence. She says that only one customer is shown on the invoices and that is Irish Biscuits Ltd. of Dublin, and accordingly the registration should be limited to goods for export only. She also notes that use is only shown in respect of biscuits, whereas the specification is much broader and, in any event, the specification should thus be limited to those goods for which use has been demonstrated.

**The registered proprietors' evidence (r. 31(6)).**

6. Linda Bray says in response, in a further Witness Statement dated 20<sup>th</sup> July 2001, that her earlier Statement is evidence of use, in that the mark has clearly been applied to goods manufactured in the UK. She does not admit that the mark has been used only for export purposes, but even if it had that would be sufficient to defeat the application for revocation. She also says that it is implicit in section 46(2) that partial cancellation of a registration in these circumstances to goods for export from the UK only is not appropriate or justified.

**The applicants' evidence (r. 31(7)).**

7. Jane More O'Ferrall states, in a further Witness Statement dated 23<sup>rd</sup> November 2001, that it is not disputed that Jacob has filed evidence demonstrating some use of its UK trade mark; rather the issue is '...the extent to which that registration should be cut down'. Only export use has been demonstrated, and accordingly the specification of goods should reflect this. Ms. O'Ferrall cited the following words of Jacob J in *Minerva Trade Mark* [2000] FSR 734, that:

'...if non-use in respect of a significant subset of a wide general description is established, then I see no reason why the court should not eliminate that subset from the registration.'

And also that of Pumfrey J in *Decon Laboratories v Fred Baker Scientific Ltd* [2001] ETMR 46, where he said the task of deciding to what extent a registration might be cut down was:

'...best performed by asking what would be a fair specification of goods having regard to the use that the proprietor has in fact made of the mark ... In arriving at a fair specification having regard to the proprietor's use it is also necessary to remember that the effect of Section 10(2) ... is to give the proprietor protection outside his specification of goods but in areas where he can demonstrate a likelihood of deception in the wide sense, that is, deception as to trade origin leading to association among the relevant public. There is no pressing need therefore, to confer on the proprietor a wider protection than his use warrants...'

In that case, the registered proprietors' specification was restricted by including the words 'all for non-domestic use'.

8. Ms. O'Ferrall also stated that judicial knowledge of the registered proprietors established distribution networks, market share, should be taken: on doing so it was clear that those networks have not been used in respect of this mark. Her final submission is that the specification should be reduced to 'biscuits and cookies, all for export to the Republic of Ireland.'

### **The registered proprietors' submissions.**

9. Further submissions were provided by Jacob in a letter dated 28<sup>th</sup> February 2002. In essence, these amount to the following:

- objection is taken to, first, the inadequacy of the pleadings: in particular, the reformulation of Kellogg's attack from total to partial revocation without amendment to the Statement of Case and, second, the presentation of submission as evidence;
- Jacob has provided evidence to show use in accordance with section 46(2), and that the use is genuine in accordance with *R. v. Laboratories Goemar SA's Trade Marks; Applications for Revocation by la Mer Technology Inc.* [2002] E.T.M.R. 34; and
- even if partial revocation was found, a specification could not be restricted to: 'biscuits and cookies, all for export to the Republic of Ireland', because revocation can only be in respect of categories or species of goods, not in respect of uses or characteristics of goods.

### **DECISION**

10. S. 46(1)(b) 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;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (2) .... use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (3) .. ,
- (4) .. ,
- (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.
- (6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from -
  - (a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.'

I feel that the issues in this matter can be fully accommodated by 'walking through' the points raised by Jacob in paragraph 8 above. I will consider each in turn.

### **The technical objection to the applicants' case.**

11. Jacob say that the pleadings are deficient because they were not amended to withdraw the full revocation case and replace it with a partial attack. In particular, they state:

'6. There is no mention of a partial revocation attack or of the relevant section, s 46(5), just as there is no mention of any of the other grounds of revocation, for example, ss. 46(1)(c) or (d) regarding generic or misleading use. Referring to "all" the proprietor's goods in paragraph 1 does not make it clear to the proprietor or to the Registry that the application is for partial revocation'.

I am referred to the following authorities:

'If the pleadings do not identify the right issues, the issues the parties propose to argue about, then it cannot be expected that with any consistency the right evidence will be adduced at the hearing. The pleadings are supposed to identify the issues to which evidence will be directed. If the pleadings do not properly identify the issues someone, sooner or later, is going to be taken by surprise.' (*Julian Higgins' Trade Mark Application* ("NASA") [2000] R.P.G 321, p. 324, line 20).

'Considerations of justice, fairness, efficiency and economy combined to make it necessary for the parties in Registry proceedings to provide a focused statement of the grounds upon which they intended to maintain that the tribunal should or should not do what it has been asked to do.' (*Demon Ale Trade Mark* [2000] RPC 345 at 357, line 15).

Jacob comments:

'In the present case the Registry was originally asked to revoke the mark in its entirety, not to revoke it partially. There is a fundamental difference between the way the case was originally pleaded and the manner it is now proceeding'.

They also believe that Kellogg's pleading was in contravention of the Registry's own guidance, in TPN 1/2000, which states as follows (paragraphs 21-22):

'In general the claimant (i.e. the person initiating the proceedings) should set out in their statement: the matter in issue; the facts to be relied on, and the relief sought. Whilst sometimes the **matter in issue** is implicit in the nature of the proceedings, generally it needs to be set out in detail. For example, the grounds on which revocation of a patent or invalidation of a trade mark is sought must be set out fully. The **facts to be relied on** (as distinct from the evidence that will later be adduced to prove those facts) should also be set out concisely but fully. Whilst in the past statements filed in proceedings before the Comptroller have sometimes been lacking in real detail as to the facts, statements must now

be reasonably detailed. The **relief sought** should be clearly stated. Costs need be not specifically claimed in a statement, though they usually are.’ (original emphasis)

12. Jacob ask, therefore, that the partial revocation attack should be disallowed on the basis that it was not in the form TM26(N).
13. There might be support for Jacob’s position, here, if Kellogg’s Statement of Case was so poorly or imprecisely formulated that the issues at stake were not identifiable by either Jacob or by myself. However, though the statement of case is terse, and refers only to s. 46(1)(b), I considered, on first reading that its objective was clear enough: revocation because the mark had not been used during the last five years (i.e. from the 15<sup>th</sup> September 1995 to the date of application) ‘in relation to all of the goods for which it is registered’. I understood this to mean that the mark is open to revocation because the specification has not been fully utilised, not that the mark should be revoked because it has not been used at all, on any of the goods for which it was registered.
14. Further, Jacob only raised this ‘technical’ defect once all the ‘evidence’ had been filed, and have not clearly been prejudiced by the issue. There is nothing to suggest, for example, that more evidence of use existed that could have been filed had Jacob understood the Statement of Case.
15. I also consider that ss. 46(1) sets out the grounds for revocation of a mark, and the following sub-sections qualify and delimit it. Apart from the fact that there is simply no compelling case to refuse the partial attack on the basis that Kellogg’s action is poorly pleaded – to do so would, more than likely, force the parties to incur extra cost and delay while the technical deficiency is remedied - I am not convinced that it is always necessary to clearly indicate such in revocation grounds anyway. The applicant asserts non-use: it is for the registered proprietor to then show ‘..what use had been made of..’ their mark (s. 100). The application of the word ‘what’ here is suggestive of the nature of use, that is, its extent and its character.
16. Finally, it seems to me that there are good policy reasons for removing unused marks from the Register. I note the following from *R. v. Laboratories Goemar SA’s Trade Marks; Applications for Revocation by la Mer Technology Inc.* [2002] E.T.M.R. 34, at paragraph 19, where Jacob J stated:

‘(a) There is an obvious strong public interest in unused trade marks not being retained on the registers of national trade mark offices. They simply clog up the register and constitute a pointless hazard or obstacle for later traders who are trying actually to trade with the same or similar marks. They are abandoned vessels in the shipping lanes of trade.

(b) The 8<sup>th</sup> recital of the Directive gives express recognition of that public interest. It says: “Whereas in order to reduce the total number of trade marks registered and protected in the Community and, consequently, the number of conflicts which arise between them, it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocation.” ’
17. As to the point made about legal submission being repeatedly made under the guise of ‘evidence’, and Kellogg’s evidence not being strictly in reply, I think these criticism are fairly made. However, I note that in the *Academy Trade Mark* case (BL O/169/00), the Appointed Person’s criticism did not lead to any increased costs award. He states that (paragraph 9) it is ‘..important in proceedings ... that a proper line is drawn between that which is truly evidence ... and submissions or arguments in relation to the matter in dispute..’ because ‘..to allow the two to be

present in the same document is bound to lead to confusion and misunderstanding'. Nevertheless, as his next comment shows (see paragraph 10) there was no such consequent on mixing evidence and submission in the *Academy* case, and I do not believe there was any here.

18. In summary, I accept that the extent to which Kellogg's have sought revocation was not crystal clear at first, and changed as the matter proceeded; I reflect this in the costs award below. However, I think any problems this might have introduced for Jacob was more to do with disputation than substance, as my comments above reveal. I intend to conduct these proceedings on the basis of Kellogg's assertion that the specification of the mark be revoked to 'biscuits and cookies, all for export to the Republic of Ireland.'

### **The substantive case: partial revocation.**

19. In their later Witness Statements (which were really submissions) I do not understand Kellogg to be arguing that the use demonstrated here does not constitute 'genuine use' (see O' Ferrall Statement, dated 23<sup>rd</sup> November 2001, paragraph 3), and so I do not need to refer to *Laboratories Goemar*, or any other case on this point. However, Kellogg make their case for partial revocation as set out in paragraph 7 above.
20. I observe, first, that Kellogg have asked me to take judicial notice of the established market position of the registered proprietors in the UK, and the fact that they have not evidently used their large distribution network for the products sold under this mark. I am not sure of the significance of this submission. It could be a reprise of an argument questioning genuine use by Jacob, but I take it as buttressing Kellogg's (latter-day) aim of confining the specification of the mark to biscuits and cookies, all for export to the Republic of Ireland.
21. In any event, I decline to take judicial notice of Jacob's distribution network as this is not a matter of common knowledge or 'notorious fact' for which no evidence is necessary (*Phipson on Evidence* 15<sup>th</sup> ed. Paragraph 2-21). As the registered proprietors point out in their submissions this is precisely the sort of fact which the registrar or court needs to be supported by evidence.
22. The real issue in this case is the nature of the restriction which should be imposed on the registered proprietor's specification. I take the view that I should not restrict the registered proprietors specification in the manner requested by the applicant for the following reasons.
23. First, section 46(5) states :

'Where grounds for revocation exist only 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.'

24. As the registered proprietors submit, revocation can only, in my view, be in respect of categories (species) of goods or services and not in respect of uses of those goods or services. I was referred to *Decon Labs v Fred Baker* [2001] RPC 293, where Pumfrey J said (at paragraph 23):

'Let me take the example to which Neuberger J refers to in Typhoon. There, the registration was (inter alia) for "domestic containers". Suppose the proprietor uses the mark only on red tea caddies. How does one limit the registration? Obviously the use of the colour red is irrelevant, since it does not define a species of goods.'

25. Naturally, a proprietor may voluntarily limit their protection to colour or geographical usage. That is quite different however to the situation where a court or the registrar intervenes to restrict protection in a non-use revocation action. As I have said, in my view, I believe section 46(5) allows restriction only in relation to qualitative species of goods or services.
26. Second, even if I felt that I did have the power to restrict the registration to non-qualitative uses, to restrict in the way requested by Kellogg would, I believe, run counter to the express statutory provision (section 46(2)), that use solely for export constitutes use in the UK. In accordance with statute, the registered proprietors have demonstrated use in the UK. Use for export is as much use in the UK as if the biscuits were sold in every supermarket in the country. By implication, Kellogg are asking me to regard use for export as a 'lesser form' of use. Yes, it saves the mark but only for those goods which are exported to Ireland. If the registered proprietors choose to sell goods under the mark in the UK later, or even if they choose to export other than to Ireland, they are left without the benefit of registered protection. This cannot be just when they have shown use in the UK.
27. So, what should the registration be restricted to, if at all? In the *Decon* case, referred to above, Pumfrey J states at paragraph 24:
- ‘I think 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. In arriving at a fair specification having regard to the proprietor’s use, it is also necessary to remember that the effect of section 10(2) (and of 10(3), in limited circumstances) is to give the proprietor protection outside his specification of goods but in areas where he can demonstrate a likelihood of deception in a wide sense, that is, deception as to trade origin leading to association among the relevant public. There is no pressing need, therefore, to confer on the proprietor a wider protection than his use warrants by unduly broadening the specification.’
28. Applying this to the circumstances here, the registered proprietors have shown use in respect of biscuits (other than biscuits for animals), but nothing else in their specification. They have failed to show use of the trade mark TEMPATATION in respect of the other goods falling in Class 30 within the period set by s. 46(1)(b). The action was initiated on 15<sup>th</sup> September 2000. As such, I order that trade mark registration N<sup>o</sup> 1216385 is revoked in respect of goods falling in Class 30 with effect from 15<sup>th</sup> September 2000, with the exception of ‘Biscuits (other than biscuits for animals).’
29. On the question of costs the applicants for revocation have been mostly successful and are entitled to a contribution towards their costs. Therefore, I order that the registered proprietors pay to the applicants the sum of £700-00. 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    Day of July 2002.**

**Dr W J Trott  
Principal Hearing Officer  
For the Registrar, the Comptroller General**