

O-292-03

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION NO. 2282612A
IN THE NAME OF AMELCA PLC.**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 81059
THERE TO BY DOVE VALLEY (ASHBOURNE) LTD.**

IN THE MATTER OF trade mark registration No. 2282612A
in the name of Amelca plc.

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 81059 thereto by Dove Valley (Ashbourne) Ltd.

BACKGROUND

1. The trade marks “Dove Valley”, “Dove Valley Dairy”, “Dove Valley Dairy Products”, “Dove Valley Dairies”, “Dove Valley Milk”, “Dove Valley Cheese”, “Dove Valley Cream”, “Dove Valley Whey”, “Dove Valley Yoghurt”, “Dove Valley Organic”, “Dove Valley Organics” and “Dove Valley Organic Products”, a series of twelve, have been registered since 03 May 2002 under number 2282612A and stand in the name of Amelca plc. It is registered in respect of:

Class 29:

Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies; jams; fruit sauces; eggs; egg products; milk; milk products; cream; cheese; yoghurt; whey; dairy products; edible oils and edible fats.

2. On 28 October 2002, Dove Valley (Ashbourne) Ltd. filed an application for a declaration of invalidity of the registration. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are as follows:

- Under sections 47(2)(b) and 5(4)(a) of the Act as the applicant claims goodwill in the name “Dove Valley”, an unregistered trade mark used in respect of poultry, chicken and poultry and chicken related products and that use of the registration would amount to passing off.

3. In the statement of case the applicant asserted that their mark had been in continuous use since 1957 in respect of poultry, chicken and poultry and chicken related products. That it was an earlier unregistered trade mark which had been used on packaging, advertisements and trade literature, and also applied as part of the livery of the applicant’s vehicles. The applicant also asserted that as a consequence of this use over a period of nearly 45 years they had established a substantial and valuable reputation and goodwill in the UK. They contend that as a result of the identity or similarity of the marks and the identity or similarity of the goods there is a likelihood of damage to the applicant’s reputation and goodwill which would be protectable under the common law tort of passing off.

4. On 4 November 2002 a copy of the application for invalidation and the statement of grounds were sent to the address for service recorded on the register. The registered proprietor did not file a counter-statement to defend his registration. The consequences of

failure to defend the registration were set out in the letter dated 4 November 2002, namely that the application for declaration of invalidity could be granted in whole or in part.

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to prove why it is that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transaction of it.”

8. With this in mind, on 5 February 2003, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed. The original period set, one month, for the filing of evidence was extended twice at the request of the applicant for an additional period of three months in total.

9. On 4 June 2003 the applicant for invalidity provided a witness statement, with exhibits, to establish the reputation and goodwill the applicant has in the mark “Dove Valley”. They also stated that they were content for the decision to be taken on the basis of the papers filed.

10. In submission in the covering letter to the evidence the applicant stated that the registered proprietor was in receivership and that attempts to purchase the registration from the Official Receiver had been unsuccessful.

11. The evidence and exhibits submitted consist of the following, a witness statement, by Christopher Charles Grenville Trafford, chairman and founder of the applicant company, dated 2 June 2003, and seven bundles of exhibits. The witness statement first deals with

the nature of the applicant's business, the production of fresh chicken for sale as meat products and meals; this is supported by the first exhibit. It gives an estimate for the total turnover of the applicant as £530 million, with the turnover in recent years, in £ million, being, 1997 - £34, 1998 - £35, 1999 - £37, 2000 - £43, 2001 - £55 and 2002 - £75. Then the witness statement goes on to state that the applicant promotes its goods by reference to their trade mark, although this has changed in detail over time it always incorporates the words "Dove Valley", in a number of manners. They go on to describe the use by reference to an article in a trade journal upon the company's 40th anniversary, packaging, in advertising and promotional activities, use on vehicles and on employees protective clothing and also on promotional items: this is supported by six exhibits. Finally, the applicant provides a representative list of cities to which their products have been distributed and also major customers, Tesco, Morrisons and the Co-Op, the applicant contends that this is supported by the invoices in exhibit 1.

- Exhibit 1 – ten invoices, one dated 1994 and the remainder dated 1998. These are for a variety of customers, including Tesco and CRS, and for a variety of locations, London, Cardiff, Glasgow, Preston, Huddersfield, Rochdale, Stoke on Trent, Wrexham and the USA. The 1994 invoice has words "Dove Valley Poultry" and a logo being the stylised head of a chicken, and the 1998 invoices show an updated version of the applicant's mark incorporating the words "Dove Valley".
- Exhibit 2 – a copy of an extensive article, celebrating 40 years of business activity for the applicant company, from the trade journal Poultry World, dated July 1997.
- Exhibit 3 – product labels, incorporating the words "Dove Valley", and blank letterhead note paper, with an updated version of the applicant's mark incorporating the words "Dove Valley", neither can be dated
- Exhibit 4 – a copy of an advertisement feature in the Meat Trades Journal, dated 18 June 1992, relating to the applicant and development of their business. Also a copy of pages from a commemorative brochure relating to a football match between English and American soccer teams, in which the applicant placed an advertisement. Neither show the form of the mark in use.
- Exhibit 5 – two colour brochures produced by the applicant, one hand dated as 1984, with the words "Dove Valley Poultry" and a logo being the stylised head of a chicken, and the other dated 1997, showing an updated version of the applicant's mark incorporating the words "Dove Valley".
- Exhibit 6 – two colour photographs, undated, one showing the side of a lorry carrying an updated version of the applicant's mark incorporating the words "Dove Valley" and the other showing the badge on an employees protective coat with the words "Dove Valley Poultry" and a logo being the stylised head of a chicken.

- Exhibit 7 – a photograph of a promotion item, a commemorative mug celebrating the 40th anniversary of the applicant company and showing an updated version of the applicant’s mark incorporating the words “Dove Valley”.

12. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

DECISION

13. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 3(6), 5(2)(a) and/or (b), 5(3) and 5(4)(a). The relevant parts of the Act are as follows:

“47. - (1)

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) , or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“5. - (1)

(2)

(3)

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or
- (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

14. With regard to section 5(4) (a) of the Act the requirements for this ground of action have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child* trade mark [1998] RPC 455. Adapted to these proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicant's goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietor are goods of the applicant, and
- (3) that the applicant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the registered proprietors' misrepresentation.

15. First of all, I believe that there is sufficient evidence to justify the applicant's claim to a reputation under this head. The sales and promotion figures, though not put into context, are substantial. I am also satisfied that the goods have been sold under a mark which has become distinctive as a badge of origin of the applicant. That is a mark consisting, primarily, of the words "Dove Valley". As the applicant has established a reputation in use of the "Dove Valley" mark from a date far earlier than the date of registration of the trade mark in suit I am satisfied that the public will believe that the goods sold under the registered proprietor's trade mark are goods of the applicant. Though there are differences between some of the goods themselves, the near identity of the trade marks could lead to confusion. In the circumstances damage will be suffered by the applicant.

16. The facts set out in the witness statement and accompanying exhibits, which have not been challenged by the registered proprietor, in my view, establish that a prima facie case has been made out that, at the date of the application, Dove Valley (Ashbourne) Ltd had a reputation for poultry, chicken and poultry and chicken related products which was protectable under the tort of passing off. The application for a declaration of invalidity made under sections 47(2)(b) and 5(4)(a) of the Act therefore succeeds.

17. As to costs, the applicant has been successful, and I order Amelca plc to pay them £600. 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 19th day of September 2003

**Graham Attfield
For the Registrar
the Comptroller General**