O-335-04

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION No. 818077 IN THE NAME OF SOCIÉTÉ DES PRODUITS NESTLÉ S.A.

AND

IN THE MATTER OF AN APPLICATION FOR REVOCATION THERETO UNDER No. 81236 BY APPLE PAN LIMITED

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IN THE MATTER OF an Application for Revocation thereto under No. 81236 by Apple Pan Limited

BACKGROUND

1. On 7 April 2003, Apple Pan Limited applied to revoke registration No. 818077 standing in the name of Société des Produits Nestlé S.A.. The registration is for the mark THOMY which is registered in respect of the following goods:

Class 29: Meat extracts; fruit and vegetables, all being preserved dried and cooked; jellies (for food), marmalade, jam; edible oils and edible fats; mayonnaise; fruit preserves and vegetable preserves.

Class 30: Coffee, tea, cocoa, mixtures of coffee and chicory; malt preparations for use as a substitute for coffee; bread, biscuits (other than biscuits for animals), cakes, pastry, non-medicated confectionery, edible ice, honey, treacle, yeast (for food), baking powder, salt (for food), mustard, pepper, vinegar, sauces, and spices (other than poultry spice).

2. The application for revocation is made under Section 46(1)(b) and is expressed as follows:

> AYthat within the five years prior to the date of this application for revocation the trade mark has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to some or all of the goods for which it is registered, and there are no proper reasons for non-use, and that the registration of the trade mark should therefore be revoked either in full by virtue of Section 46(1)(b) of the Trade Marks Act 1994 or in part by virtue of Section 46(5) of the Trade Marks Act 1994.@

3. On 15 July 2003, the registered proprietors filed a counterstatement in which they deny the grounds on which the application has been made.

4. Both sides seek an award of costs.

5. Both sides filed evidence in these proceedings. The matter came to be heard on 24 May 2004, when the applicants were represented by Mr Tim Pendered of R G C Jenkins & Co, their trade mark attorneys. The registered proprietors were represented by Ms J Mutimear of Bird & Bird, solicitors.

Registered proprietors' evidence-Rule 31(2)

6. This consists of a Witness Statement dated 14 July 2003, by Rachel Delamere, the Regional Intellectual Property Adviser in the Legal Department of Nestlé UK Limited. Ms Delamere says that she has recently been appointed to this position but has been employed by her company since January 2000 although does not say in what capacity.

7. Ms Delamere says that her company is licenced to use the mark in the UK on goods that since the early 1960s have been imported from a sister company, Nestlé Switzerland. Ms Delamere says that more recently the mark has been used on a condiment dispenser that dispenses tomato ketchup and mustard. Exhibit RD1 consists of a leaflet depicting examples of dispensers bearing the THOMY name, that appear to be for dispensing tomato ketchup and mustard in commercial rather than domestic situations, and a large sachet of mustard clearly for use in the dispenser. The exhibit also includes a list of the companies that have purchased the dispensers.

8. Exhibit RD2 consists of a collection of invoices that inter alia, shows sales of THOMY ketchup, mustard and dispensers within the relevant period.

Applicants' evidence-Rule 31(4)

9. This consists of a Witness Statement dated 28 October 2003, by Thomas Albertini, an Associate with R.G.C. Jenkins & Co, the applicants' trade mark attorneys.

10. Mr Albertini states that the evidence provided by the registered proprietors shows use of a THOMY logo and not the plain word THOMY as registered. He says that in the event that it is found that there has been genuine use of the mark as registered, it does so only in respect of a narrow range of goods, namely, tomato ketchup and mustard, and the registration should be revoked accordingly.

11. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

12. The statutory provisions of Section 46 under which this application has been made are as follows.

> **A46**.-(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.
>
> (2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and 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) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:
>
> Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any case the application is made to the registrar, he may at any stage of the proceedings refer to the application to the court.

(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."

13. Section 100 is also relevant. It reads:

"**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."

14. In their Statement of Grounds and evidence, the applicants set out their attack on the registration in a number of ways. Mr Albertini alleged that insofar as the registered proprietors= evidence showed use of THOMY, this was in the form of a logo rather than the plain words in which it is registered. This allegation was subsequently withdrawn. The applicants= most sweeping ground is based on the assertion that there had been no eligible use of the mark in respect of any of the goods for which it is registered. However, in his submissions, Mr Pendered accepted that there had been use of the mark, and focussed on the applicants= secondary attack, namely, that whilst there had been use, this had only been in respect of tomato ketchup and mustard, but even so, this use did not mean that the mark should remain on the register even in respect of such goods, at least not unqualified.

15. In their counterstatement, the registered proprietors= defence was that there had been genuine use of the mark in respect of all of the goods covered by the registration. However, at the hearing, Ms Mutimear conceded that the evidence only established use in respect of ketchup and mustard, and on current case law this warranted the mark

remaining on the register in respect of goods falling within the description of Acondiments@.

16. The applicants have accepted that there has been use of THOMY and have not questioned the genuineness of that use; I see no reason to do so. Therefore, the first matter for me to look at is the nature and extent of the use made.

17. Mr Pendered stated that the registered proprietors= mustard and ketchup had only been sold wholesale, that is to commercial food providers such as fast-food outlets, canteen and restaurant facilities. He argued that that being the case, the specification of the registration should not only be reduced to the actual goods for which use has been shown, namely ketchup and mustard, but also qualified to reflect the way in which the trade has been carried out.

18. The invoices exhibited by the registered proprietors establish that they have made use of THOMY within the relevant period in respect of mustard and tomato ketchup. Sales have been in 3 kilogram packs, and to organisations rather than to members of the public. Some entries in the invoices relate to sales of dispensers for the mustard and ketchup, reflecting the fact that these condiments have been sold to the trade. The registration does not cover dispensers so there is no question to be answered in relation to such goods. However, the fact that the mustard and ketchup is provided by means of the dispenser is of relevance.

19. Exhibit RD1 consists of a leaflet. Although undated, Ms Mutimear asked that I consider it to be representative of the manner in which trade has been carried out within the relevant period. I do not recall Mr Pendered arguing that I should not do so, The leaflet depicts dispensers bearing the name THOMY and a mustard product showing this to be packaged in boxes marked THOMY, each box containing 3x3kg packs. The individual packs bear no marking, brand or otherwise, and have a large nozzle or outlet at one end presumably to enable the contents to be removed, clearly indicating that these packs are for use in the dispenser. Although there is no depiction of the ketchup packaging, given that it is sold in same size pack as the mustard it seems reasonable to infer that the ketchup is provided to the retailer in the same manner, and used in the same way. There can be no doubt, and there is no dispute that this is a product for commercial rather than domestic use.

20. Mr Pendered submitted that these dispensers would be used Aback of house@ and away from the customer, therefore removing the opportunity for the mark to make contact with the public at large. The promotional leaflet describes the dispenser as being Aideal for front and back of house use@ but of itself this provides little assistance. In my experience, where a condiment such as mustard or ketchup is being dispensed for the customer, it is common for this to be done in full view to ensure the desired amount is supplied. Although they may have this contact as part of the provision of a food service, this does

not remove the significance or impact of the mark in relation to the product.

21. The position I arrive at is that although the product is bought by the retailer, the likelihood is that the end consumer, the public at large is likely to come into contact with the mark. But whether or not that is the case, the fact is that the mark has been used, albeit only on mustard and tomato ketchup.

22. Both sides referred me to *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2003] RPC 32, in which Aldous L,J conducted a useful critique of recent case law relating to revocation. Referring to the decision in *Deacon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293, Aldous L.J. stated:

> APumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?@

23. On this basis I should begin from the position that there has been use in respect of mustard and tomato ketchup, and go on to consider whether, as Ms Mutimear desires, I should accept this as being use in respect of a commercial subset of goods being condiments, or, as Mr Pendered asserts, I should pare the specification to the specific goods and trade for which use has been shown, that is, Amustard and tomato ketchup, all for sale to providers of food services@.

24. In the *Thomson* case, Aldous L.J. considered the approach to be taken in determining the specification, stating:

> APumfrey J. in Decon suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use@.

25. Ms Mutimear made two proposals, the first being that I should restrict the registration to Acondiments@. The ordinary meaning of condiment in Collins English Dictionary is stated to be:

> AAny spice or sauce such as salt, pepper, mustard, etc,@

26. The on-line version of the Oxford English Dictionary gives the definition as:

> Aa seasoning or relish for food, such as salt or mustard.@

27. From this it is clear that mustard and tomato ketchup fall within the general description of Acondiments@. However, this description does not appear in either of the classes of the registration. It appears to me to be a term capable of encompassing goods that are not within the scope of the registration; I do not know and in my view the onus is on the registered proprietors to establish this one way or the other. Limiting the specifications in the way Ms Mutimear suggests may have the effect of widening the specification, an action prohibited by Section 39(2) of the Act, and if only for this reason I do not consider that I can accept this proposal.

28. In the alternative, Ms Mutimear suggests that the specification should be scrutinised and everything that would not be considered to be a Acondiment@ removed. It is clear that the registered proprietors have not used the mark on condiments per se, only on two items that are part of the range of goods that fall within this description. In the case of *West t/a Eastenders v Fuller Smith & Turner plc* [2003] FSR 44, the registered proprietors had only been able to show use of their mark for Abitter beer@, whereas the registration covered ABeer@. Mr Christopher Floyd QC, sitting as a Deputy Judge in that case determined that the registration should be revoked in respect of beer other than bitter beer. In the subsequent appeal, Pumfrey J considered Mr Floyd=s decision in the light of the later *Thomson* case, commenting that he saw no difference in the test applied by Mr Floyd QC and that used by Aldous L.J. in *Thomson*, stating this to be what is:

> A...A fair description which would be used by the average consumer for the products in which the mark has been used by the proprietor.@

29. To my mind, when seeking to buy mustard the Anotional consumer@ will not be thinking of a Acondiment@, but rather which variety they want, be it mild or strong, French, English, powder, ready-mixed or whatever. In my view the consumer will regard mustard as describing a distinct set of goods. The same can be said of ketchup although in that case the product may be referred to by a more general description Asauce@. I do not consider that the consumer would describe or take items such as spices, preserves, mayonnaise, salt and pepper as being a ketchup or sauce or the same type of goods as ketchup or sauce.

30. Adapting the question posed by Aldous L.J. in *Thomson*, what I have to determine is whether, having regard to the use made of the mark, the registration should be in respect of sauce, ketchup, or tomato ketchup? I consider that if a group of Anotional consumers@ were to be asked to describe the registered proprietors= product, they would be just as likely to use the term Asauce@ as Aketchup@; the two in my mind are interchangeable. However, if the same Anotional consumers@ were to be asked what they understood the term Asauce@ to mean, they would in all probability describe a number of products, including sauces in which meat and vegetables are cooked, to ready-made sauces such as bolognaise, which in my view the consumer would regard as being different to a sauce added to food as a condiment. For this reason I consider that unless qualified to its particular subset, that is condiments, the term Asauce@ would fall outside of the Afair description@ test for the goods on which the registered proprietors have used the mark.

31. Having determined that the registration should remain in respect of Amustard; sauces being condiments@ I need to determine whether, as Mr Pendered, suggests, the registration should be further restricted to being Aall for sale to providers of food services@.

32. From my own knowledge I am aware that goods are sold in larger quantities commonly referred to as Acatering packs@, but are these sold exclusively to providers of a food service? I have not been directed to any evidence that establishes that this is the case. I am aware that such goods are sold through wholesalers who serve a variety of traders many of whom are not in the business of providing a food service, or may do so as an adjunct to the provision of another service, for example, hotels and bed and breakfast establishments. In *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, Neuberger J. did not consider that the specification could be limited by the use of the colour Ared@ because the colour Adoes not define a species of goods@. I am not convinced that there is a species of goods that is provided to those in the food service trade, and that the limitation requested by Mr Pendered would create a specification of uncertain scope. I therefore reject his request.

33. The position, therefore, is that I find the application to be successful in respect of Class 29 in its entirety, and Class 30 in respect of all goods other than:

> Mustard; sauces being condiments.

34. In the event that there is no appeal, if the registered proprietors file a Form TM21 within one month from the end of the appeal period restricting the registration as stated, under the provisions of Section 46(5) the registration will be allowed to remain on the register. Should they not file such a request, the application will be considered to have been successful in its entirety and the registration revoked accordingly.

35. The application for revocation has been successful in these proceedings to the extent that if the registration is to remain on the register the registered proprietors will have to restrict their specification of goods as suggested above. The applicants are therefore entitled to a contribution towards their costs. I order the registered proprietors to pay the applicants the sum of £2,700 in respect of this application. This to be paid 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.

Dated this 8th day of November 2004

Mike Foley
for the Registrar
The Comptroller General