

O/453/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF REGISTRATION NO 2044089  
IN THE NAME OF MRS MARIA DE LOS ANGELES BROTONS MOLLA  
OF THE TRADE MARK:**



**AND AN APPLICATION FOR REVOCATION THERETO  
UNDER NO 83919  
BY EGMONT UK LTD**

## Trade Marks Act 1994

**In the matter of registration No 2044089  
in the name of Mrs Maria de Los Angeles Brotons Molla  
of the trade mark:**



**and an application for revocation  
thereto under no 83919  
by Egmont UK Ltd**

### **BACKGROUND**

1. On 24<sup>th</sup> November 2010, Egmont UK Ltd ('Egmont') filed an application for the revocation of registration number 2044089 as above. The mark is registered in respect of the following goods:

*Footwear being articles of clothing*

The above goods are in Class 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2. Completion of the registration procedure took place on 24<sup>th</sup> March 2000. It is registered in the name of Mrs Maria de Los Angeles Brotons Molla ('Mrs Brotons Molla').

3. Egmont sought revocation of the registration for all goods under sections 46(1) (b) of the Trade Marks Act 1994 ('the Act'). Egmont claims there has been no genuine use of the mark between 24<sup>th</sup> November 2005 and 23<sup>rd</sup> November 2010. The five year period under section 46(1)(b) thus ends with the date of application for revocation, being 24<sup>th</sup> November 2010, and if Egmont is successful the registration will be revoked with effect from 24<sup>th</sup> November 2010

7. Mrs Brotons Molla filed a counterstatement, denying that the registration had not been put to genuine use within the period specified and also denying that she had received notification of the revocation action as of 1<sup>st</sup> November 2010.

8. Both parties have filed material intended as evidence which I shall summarise below. Submissions have also been filed by Egmont which I have taken into account.

9. Both parties seek an award of costs. They were advised that they had a right to a hearing and that if one was not requested a decision would be made from the papers

and any written submissions received. Neither side requested a hearing and so this decision has been made after a careful reading of the papers on file.

### **The registered proprietor's statement**

10. This is in the form of a statement dated 22<sup>nd</sup> March 2011 from Mrs Brotons Molla. She says that although the mark is registered to her personally, it is used with her consent by her companies, Idea New Trading SL ('Idea') and Union Dos SL ('Union').

11. She says her mark is used in the precise form registered on her companies' invoices relating to sales of footwear, promotional items relating to sales of footwear, footwear packaging, carrier bags, promotional items such as shoe horns and shoe cleaning clothes, tags for affixing to the goods, stationery for in store use and insoles bearing the mark which are incorporated into the goods themselves.

12. Exhibit 1 comprises a 'representative selection of orders' for goods originating from UK retail customers. She confirms these orders were fulfilled. Mrs Brotons Molla then says that a representative selection of 'invoices' is also supplied. A full list of the orders and invoices is provided below. The last three documents of the list below, all sent to Macsimillion of Oxford, represent the 'invoices' and all the preceding documents represent the 'orders'.

<b>Date</b>	<b>UK Customer/Address/Order No</b>	<b>Amount (Euros)</b>	<b>Quantities/sole styles</b>
29 <sup>th</sup> March 2006	X2zee, c/o Western Road Brighton, East Sussex. 34	2,188,50	42 pieces total. Pulgas, Mas-Mas, Kraus
1 <sup>st</sup> May 2006	Jane Shilton plc, 90 Peterborough Road, London SW6 3BW. 62	1,475,70	30 pieces total. Yenka, Mas-Mas, Pulgas
7 <sup>th</sup> September 2006	Fleetmill Footwear, 240 Camden High Street, London NW1 8QS. 95	11,111,70	237 pieces total. Happy, Pulgas, Mas-Mas
1 <sup>st</sup> December 2009	Carli Gry (UK) Ltd. Hurlingham Business Park, Fulham, London SW6 3DU. 904	1,307,40	26 pieces total. Alta, Nachos
1 <sup>st</sup> December 2009	JTA Jacquie Trievnor, Noel Street, London W1V 3RB	7,577,70	143 pieces total. Alta, Quadra
26 <sup>th</sup> May 2010	Unnamed company. GB169094336025, Imports Dept, London Head Office London	1,934,30	35 pieces total. Traction, Chava
9 <sup>th</sup> August 2007	Macsamillion Ltd, Oxford Road, Grove, Wantage OX12 7PE	3,817,20	60 pieces total. Tiffany, Traction, Cayen

14 <sup>th</sup> 2007	August	Macsamillion Ltd as above	1,388,40	24 pieces total. Tiffany Cayen
8 <sup>th</sup>	August 2008	Macsamillion Ltd as above	4,952,40	72 pieces total. Tiffany

13. Each of the documents listed contains the mark as registered in the top left hand corner of the invoice, alongside Idea's address in Elche, Spain.

14. She says total sales of goods bearing her mark in the UK for the last 5 years are as follows:

<b>Year</b>	<b>UK Sales in Euros (wholesale)</b>
2006	28,750,20
2007	72,156,40
2008	111,090,40
2009	85,250,70
2010	29,740,30

15. Exhibit 2 comprises publicity and promotional material as follows:

- A copy of a product brochure entitled 'One step ahead'. It is undated but Mrs Brotons Molla says it was distributed in the UK in 2006 and has the mark as registered on, what I assume to be, the last page. There is also some material in Spanish on this last page.
- A copy of an undated brochure entitled 'Always step by step', which Mrs Brotons Molla says was distributed in the UK In 2007. This is in English and shows the 'Kraus' style of shoe, which appears to in the form of a stylish walking boot. There are photos of walkers and mountains to emphasise the outdoor and rugged nature of the shoe, which is described as 'designed to resist the challenges of everyday life'. The mark as filed is shown on the front of the brochure and on the 'tongue' of the shoe itself.
- A copy of a product brochure entitled 'The memories are like a new hat and imagination like a new shoe' which, Mrs Brotons Molla says, was distributed in the UK in 2007. This shows, on the front of the brochure, a different version of the mark with just the word 'ROVERS', with the 'O' blacked in, and surrounded by a rectangle. Inside, the 'Green Isle' style of shoe is shown, again in the style of a walking boot, with the mark as registered on the tongue of the shoe. The accompanying text is in both English and Spanish.
- An undated photo of a shoe box showing mark as filed on the box along with the website [www.rovers-shoes.com](http://www.rovers-shoes.com).
- An undated photo of a carrier bag again showing the mark as filed along with the words 'Always step by step'.

- An undated photo of a cleaning cloth and show insoles both with the mark as filed on them.
- An undated photo showing product tags and labels, all with the mark as filed.
- An undated photo showing items of stationery including notepads and stickers, all with the mark as registered prominently shown.
- An undated photo of a shoehorn with the mark as filed.
- An undated photo of a plaque bearing the mark as distributed to “19 authorised retailers” in the UK for display purposes. The plaque shows the mark as filed with the words ‘Authorized Dealer’.

16. Mrs Brotons Molla says all the above documents and items were distributed to her wholesale customers in the UK at various times between 2006 to 2010.

17. She says her main customer in the UK is Macsamillion Ltd in Oxford.

18. She concludes by saying she carries on a genuine business in various states of the EU, including the UK. She says, as can be seen from the wholesale prices, her shoes are expensive, high quality items which retail at higher prices still of course. In the present economic climate, sales have suffered but they are nonetheless genuine sales and it is her intention to continue to promote and sell her shoes in the UK.

19. Whilst I have faithfully recorded what Mrs Brotons Molla has said in her statement I was concerned that it did not contain the customary statement of truth required in a witness statement. Evidence in registry proceedings is governed by rule 64 of The Trade Marks Rules 2008 (‘TMR’), which reads in full:

**“Evidence in proceedings before the registrar; section 69**

**64.—**(1) Subject to rule 62(2) and as follows, evidence filed in any proceedings under the Act or these Rules may be given—

- (a) by witness statement, affidavit, statutory declaration; or
- (b) in any other form which would be admissible as evidence in proceedings before the court.

(2) A witness statement may only be given in evidence if it includes a statement of truth.

(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.

(4) For the purposes of these Rules, a statement of truth—

- (a) means a statement that the person making the statement believes that the facts stated in a particular document are true; and
- (b) shall be dated and signed by—

- (i) in the case of a witness statement, the maker of the statement,
- (ii) in any other case, the party or legal representative of such party.

(5) In these Rules, a witness statement is a written statement signed by a person that contains the evidence which that person would be allowed to give orally.

(6) Under these Rules, evidence shall only be considered filed when—

- (a) it has been received by the registrar; and
- (b) it has been sent to all other parties to the proceedings.”

20. It is plain from this rule that the absence of a statement of truth is fundamental and renders the material inadmissible.

21. I was, of course, aware Mrs Brotons Molla is resident in Spain and probably a Spanish National. I asked the Registry Case Worker to write to Mrs Brotons Molla to get her to rectify matters by filing a proper witness statement or a sworn affidavit before a notary public or its equivalent in Spain. This was done by letter dated 5<sup>th</sup> October 2011, sent to her address of record in Elche, Spain. Attorneys in the UK, Williams Powell, previously acting for her, had by letter dated 4<sup>th</sup> July 2011 removed themselves from the record. I notice the address on the letter contained a minor typographical error; instead of the street name ‘Manuel Lopez Quereda 31’, the designation ‘Manual Lopez Quereda 31’ was used. There is no information before me however that would suggest this letter was not received. The letter gave one month in which Mrs Brotons Molla could rectify matters. No reply to this letter was received.

### **Evidence of the applicant for revocation**

22. This takes the form of a witness statement dated 6<sup>th</sup> June 2011 from Godwin Sharples, an investigator with Farncombe International Ltd (‘Farncombe’) which has been providing intellectual property related searches to major law firms and brand owners worldwide for 25 years. Farncombe was instructed to investigate the sales of goods referred by Mrs Brotons Molla in her statement and Mr Sharples report is exhibited at Exhibit 1

23. The report is dated 16<sup>th</sup> May 2011. Its Executive Summary says that of the alleged recipients of orders/invoices from Idea, the only company that confirmed it stocked ROVERS branded shoes in the past is Macsamillion Ltd. “We were told that they had imported about 10 different styles of shoes in 2007 but they were perceived to be too expensive and were not imported again.”

24. The Executive Summary continues, “Representatives of Debenhams, Carly Gry (UK) Ltd, Fleetmill Footwear, Jane Shilton PLC and JTA Trievnor have all stated that they have never dealt with Idea, nor have they stocked ROVERS branded footwear.

25. It was not possible to contact Panos Agopian, the owner of the Brighton shop x2zee which reportedly closed in 2009.”

26. The report then details the full investigation, starting with the company profile of Idea, saying that the company was formed in 2006, based in Elche, Spain and its activity is stated to be wholesaler of shoes and leather products. In 2009 it had a turnover of 1,458,619,31 Euros and in 2008, 1,587,041,89 Euros.

27. As to the specifics of the investigation into Carly Gry (UK) Ltd, this company was dissolved on 7<sup>th</sup> September 2004 (some years before the date of the invoice supplied by Mrs Brotons Molla). One of the former directors, Mr Malcolm Foreman, was interviewed on 13<sup>th</sup> May 2011 at LSA International Ltd. He confirmed he had been an officer at Carly Gry but had left in 2001 and that the company had been dissolved soon afterwards. He had never heard of ROVERS branded shoes. In addition, the telephone number for Carly Gry given on the invoice 0171 (Now 0207) 371 8989 was the fax number of a carpet and rug manufacturer.

28. As far as x2zee is concerned, there are no current or dissolved UK companies called x2zee. A trade listing indicated that the company behind x2zee was BEST YET LTD, whose sole director was Mr Panos Agopian of Western Road, Brighton. The premises at 65 Western Road are now occupied by a cosmetics retailer called Beauty Secrets. The investigator was unable to contact Mr Agopian. Interviews with local shopowners revealed that Mr Agopian's shop on Western Road closed during 2009.

29. As far as Fleetmill are concerned, this company was incorporated in 1992 with Mr Hossein Rezvani being named as an officer. Mr Rezvani was interviewed and he said he had dealt with a number of Spanish shoe manufacturers in the past. He had heard of the 'ROVERS' brand but he was quite certain his company had never dealt with Idea, or imported ROVERS branded shoes.

30. The unnamed company referred to in the invoices was identified as Debenhams Plc, being located at W1A 1D, and telephone 0171 (now 0207) 408 3366, being identified as the fax number of Debenhams. Two unnamed employees of Debenhams were interviewed, both of whom stated that they had never stocked ROVERS branded shoes.

31. As far as Macsamillion Ltd were concerned, the investigator spoke to 'Richard', who had worked for the company in 2006/2007, then left but returned to the business in 2011. He stated that the company had imported approximately 10 styles of ROVER shoes during 2007 and although some had sold better than others, the brand was found to be too expensive and they decided not to stock the shoes any more.

32. None of the employees at Jane Shilton Plc spoken to remembered ever stocking ROVERS shoes. Pages posted historically at [www.janeshilton.co.uk](http://www.janeshilton.co.uk) do not include any references to ROVERS shoes.

33. The investigator spoke to Jacquie, the owner of JTA Distributors, who stated they were distributors of Nisa and Victoria branded footwear. She says she has never heard of Idea and had never heard of or imported ROVERS shoes.

34. No evidence in reply was filed by Mrs Brotons Molla.

## Decision

35. Section 46 of the Act reads as follows:

“(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 other case the application is made to the registrar, he may at any stage of the proceedings refer 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.”

36. Consideration has to be taken, also, of section 100 of the Act which states:

“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.”

37. I have already recited rule 64 TMR above in relation to evidence in proceedings.

38. The consequence of rule 64 and the absence of a statement of truth in Mrs Brotons Molla’s ‘statement’ is that it cannot constitute evidence before me and I am obliged, accordingly, to rule it inadmissible.

39. This has the further consequence that the legal burden faced by the registered proprietor to prove its use in this case has not been discharged and the application for revocation must then succeed.

40. I say this with some regret. Had Mrs Brotons Molla’s evidence been formally acceptable, in my view, she would have had, on the face of it at least, a strong defence against the application. In this regard, although certain alleged ‘discrepancies’ in her ‘evidence’ may have been exposed, it must nonetheless be accepted by Egmont that, at least, the retailer Macsimillion in Oxford imported ROVERS shoes in 2006/2007. Other criticisms by Egmont of Mrs Brotons Molla’s ‘evidence’ are themselves undermined by absence of detail, for example, in relation to the people at Debenhams to whom the private investigator spoke. There is no information as to who they were or what responsibilities they had, and thus whether they may have been expected to speak with any knowledge of the facts. In the circumstances, however, it is not for me to conduct a full analysis as to whether, had Mrs Brotons Molla’s statement been formally acceptable, she would have demonstrated genuine use.

**41. The application for revocation, accordingly, succeeds in its entirety and the mark is revoked with effect from 24<sup>th</sup> November 2010.**

## **Costs**

42. Egmont has been successful in its application for revocation. I take account of the fact that no hearing took place. In the circumstances I award Egmont UK Ltd the sum of £1000 as a contribution towards the cost of these proceedings.

Statutory filing fee - £200

Preparing a statement and considering other side's argument - £300

Filing evidence - £500

Total: £1000

43. I order Mrs Maria De Los Angeles Brotons Molla to pay Egmont UK Ltd the sum of £1000. 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 14<sup>th</sup> day of December 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**