

O-520-15

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 2619173
IN THE NAME OF NOBEL CONTROL LTD
IN RESPECT OF THE TRADE MARK:

**Starlet
Clothing**

AND
AN APPLICATION FOR A DECLARATION OF THE INVALIDITY
THEREOF UNDER NO 500638 BY KULDEAP SINGH MEHAT

BACKGROUND

1. Trade mark No. 2619173 shown above stands registered in the name of Nobel Control Ltd (the proprietor). It was applied for on 27 April 2012 and completed its registration procedure on 7 September 2012; it is registered for the following goods in class 25:

Class 25

Clothing, clothing accessories and footwear.

2. On 2 October 2014, Kuldeap Singh Mehat (the applicant) filed an application to have this trade mark declared invalid under the provisions of sections 47(2)(a) and section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) which state:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) ...”

And:


“5. - (2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

3. The applicant relies upon the following UK trade mark:

| Mark details: | Goods: |
|---|--|
| <p>TM: 1243814</p>  <p>Filing date: 12 June 1985 Date of registration: 13 May 1987¹</p> | <p>Class 29 Articles of sports clothing; articles of clothing for gymnastics; articles of underclothing; anoraks, jackets, blazers, tracksuits, car coats, waterproof suits, overalls, slacks, blouses, shirts, T-shirts, skirts, shorts, swimming costumes, cardigans, pullovers, sweaters, scarves, riding coats, riding breeches, cravats, sweatbands (for wear), hats, bathing robes; jeans, caps, ties, gloves and mittens, all being articles of clothing; sleeping garments, housecoats, dressing gowns; all for women and girls; but not including footwear.</p> |

4. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

¹ prior to June 1986, the date of the Journal in which the fact of registration was recorded in the list of trade marks registered is the actual date of registration; see the decision of Geoffrey Hobbs Q.C., as the appointed person, in WISI [2006] RPC 22

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

5. The applicant's mark is an earlier mark, which is subject to proof of use because, at the date of the application for invalidity it had been registered for five years.²

6. On 4 February 2015, the proprietor filed a counter statement in which it denies the grounds of invalidation. At paragraph 7 with regard to its request to prove use it states:

“I would like to see evidence of proof of use of all the goods. I need to see these items – I need to put the applicant to proof of the claim that our trade mark is similar to the mark that the applicant has registered, for similar goods.”

7. The applicant filed evidence. Neither side filed submissions or requested a hearing.

EVIDENCE

The applicant’s evidence

Witness statement of Kuldeap Singh Mehat with exhibits KSM1 – KSM9

8. Mr Mehat states that his evidence comes from his own knowledge, or from the records of his own companies. His statement is dated 12 May 2015.

9. The first company mentioned in Mr Mehat’s statement is Lilys of London International Ltd. He states that he was a Director of the company and its sole shareholder, until it was dissolved in 2013. It is not clear when this company was incorporated. Mr Mehat is also the sole shareholder of Black Ruby Ltd, which trades as True Corset UK. He states that all of these companies used the STARLET mark under licence.

10. With regard to turnover, Mr Mehat states:

“2. I estimate that the total sales turnover in relation to the goods offered under the trade mark from the date of first use to date to be in the region of 10,000,000.”

11. He provides the following figures for 2007-2014.

² See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

| | |
|-----------|-----------|
| 2007/2008 | £48903.25 |
| 2008/2009 | £43591.20 |
| 2009/2010 | £32701.00 |
| 2010/2011 | £31389.75 |
| 2011/2012 | N/A |
| 2012/2013 | £17837.00 |
| 2013/2014 | £21898.00 |

12. Exhibit KSM1 is what Mr Mehat describes as sample invoices. The letterhead is Lilys Of London International Ltd. There are ten invoices provided which are dated between 27 January 2009 and 10 October 2011. The addresses and prices of items have been redacted. Seven of the ten invoices have STARLET in the box headed 'brand'. One has STARLET and PLAYGIRL and the remaining two have STARLET and PLATGIRL. It is not possible from the goods description to determine which goods refer to which brand on those invoices where more than one brand is listed. The invoices range in value from £6.61 to £2116.00.

13. Exhibit KSM2 comprises 85 sample invoices from True Corset UK dating from April 2013 to February 2015 which Mr Mehat states show sales of STARLET products to customers in the UK in various locations. None of the invoices show the earlier registered trade mark or refer to 'STARLET' in the description. All of the invoices have the following letterhead and are addressed to purchasers throughout the UK:



14. At exhibit KSM3 Mr Mehat provides prints from www.truecorset.com which he states are the goods shown on the invoices in the previous exhibit. The pages were printed on 8 May 2015. The goods shown in the prints at KSM3 match the numbers on the invoices. Each product listing includes a photograph of a model wearing the particular corset referred to, along with a brief description and a section where the sizes and colours are listed. However, none of the descriptions of the goods on the 'truecorset' website contain the word 'STARLET' or are referred to as 'STARLET' products.

15. The following is shown to the right of the text at the end of each listing:



16. Its presentation is indistinct and fairly small in relation to the rest of the page but it seems to be a coloured representation of the mark referred to in the first paragraph of Mr Mehat's witness statement in which he provides an example of a mark he calls a variant of his earlier registered mark, as follows:



17. Exhibit KSM4 is a further extract from the 'truecorset' website. The pages were printed on 8 May 2015. Mr Mehat states that the pages show the products available which show use of the STARLET trade mark. Eight pages make up the exhibit, the first page of which is titled, "SEARCH RESULTS FOR...'STARLET'". Fifteen pictures of models are shown, each one wearing a corset. Below each image is a brief description of the style, colour and price of the item. The prices range from £38 to £59.95. Neither the registered mark, nor the mark described by Mr Mehat as the variant mark, is featured on any of the pages or on any of the goods shown.

18. Exhibit KSM5 is a page printed from *amazon uk* on 8 May 2015. The breadcrumb trail at the top of the page shows that the search terms entered were "True Corset: Starlet". Twelve results were returned, each of which is a photograph of a model wearing a corset. Under each image is a brief description and price. Each begins with the word 'Starlet' before the description. For example, the first description reads, "Starlet Black Jacquard Boned Corset With Ribbon Trim & G String." Neither the registered mark nor the variants are shown on the results page or on any of the goods shown in the list of results.

19. The sixth exhibit, KSM6, is a photograph of a corset which Mr Mehat states is on sale in the UK and contains the STARLET trade mark on the front of the garment. The photograph shows a close up of red and black material. A swing tag and neck label are shown as follows:



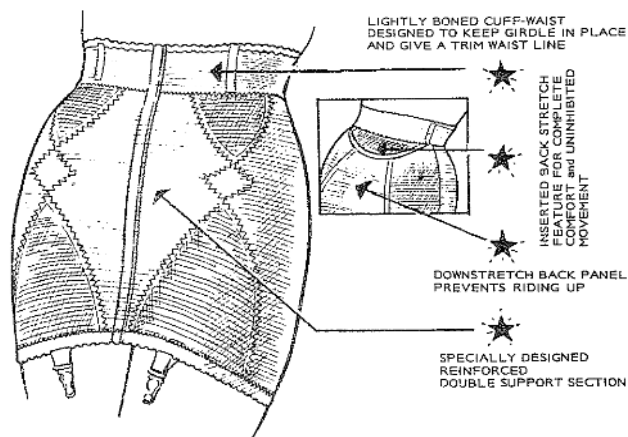
20. Exhibits KSM7 and KSM8 are photographs of T-shirts, the second of which is described as a child's t-shirt. Mr Mehat states that they are both on sale in the UK and have the STARLET trade mark on the front.

21. They are depicted as follows:



22. Exhibit KSM9 is reproduced in full below. It is described by Mr Mehat as a page from a STARLET mail order catalogue, circa 1960s. The registered mark is shown at the bottom left of the page, however, it is clear from the pre-decimal pricing that this exhibit dates from outside the relevant period.

SPECIAL OFFER



High cuff-waisted Lycra/Nylon girdle from famous Swedish manufacturer's range, has specially designed front panel support section and downstretch back panel.

In addition a cleverly designed extra inserted back stretch feature, as shown, gives complete comfort and uninhibited movement.

WAIST SIZES:- 27/28 - 29/31 - 31/32" - WHITE ONLY

MADE TO RETAIL at 54/6d.

Special 'STARLET' bulk purchase enables us to offer this wonderful girdle at the once only price of **39/11d.** P & P - 1/6d.

PLEASE NOTE once stock is sold we can never repeat at this price.



Importers and Distributors of Fine Lingerie and Foundation Garments

STARLET CREATIONS
Moss House, Moss Street, Bury, Lancashire
Telephone 061-754 8845 & 061-766 3981
Telex 668446

Proof of use

23. The applicant's mark completed its registration procedure on 13 May 1987. The application for invalidation was made on 2 October 2014. Consequently, this mark is subject to proof of use, as per Section 47(2) of the Act and the proprietor has requested the applicants prove use of it in respect of all of the goods for which it is registered.

24. The relevant period is the five year period ending on the date of application for invalidation, namely 3 October 2009 to 2 October 2014. The onus is on the applicant, under section 100 of the Act, to show use of their mark during this period in respect of those goods on which it seeks to rely. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

25. In *Stichting BDO v BDO Unibank, Inc.*, [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

"51. Genuine use. In *Pasticceria e Confetteria Sant Ambroeoous Srl v G & D Restaurant Associates Ltd (SANT AMBROEUS Trade Mark)* [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV (C-40/01)* [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA (C-259/02)* [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH (C-495/07)* [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the

purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”.

Use in a differing form

26. In the first paragraph of Mr Mehat’s witness statement he states:

1. The UK Trade Mark No 1243814 STARLET & DEVICE

The logo for 'Starlet' features the word 'Starlet' in a stylized, black, serif font. The letter 'S' is large and has a starburst effect at its top left. There are two smaller starburst symbols above the 'a' and 'l'.

and the variants

A variant of the 'Starlet' logo, where the word 'Starlet' is written in a cursive, script font. The 'S' is large and has a starburst effect at its top right. There are two smaller starburst symbols above the 'a' and 'l'.

STARLET and

which do not alter the distinctive character of the registered trade mark, have been used in the UK since 1969, and have been used continuously since that time in relation to clothing, including “robes, housecoats, sleeping garments, shoes, underclothing, girdles, jackets, blouses, tops, skirts, dresses, swimming costumes, shapewear, lingerie”.

27. The law in relation to use of a mark in a differing form focuses on the alteration of distinctive character. The use of ‘variant marks’ was considered in *Nirvana Trade Mark*,³ in which Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under s.46(2) of the Act as follows:

³ *BL O/262/06*

"33. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."⁴

28. In considering the distinctive character of the earlier mark I also bear in mind the comments of Lord Walker of Gestingthorpe in *Bud/Budweiser Budbrau*⁵ where he stated:

"43 The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?"

44. The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry: 'Bare ruin'd choirs, where late the sweet birds sang' is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault-like trees in winter, and the dissolution of the monasteries).

45. Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of whose eyes? - registrar or ordinary consumer?' is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgement, to analyse the 'visual, aural and conceptual' qualities of a mark and make a global appreciation' of its likely impact on the average consumer, who: 'Normally perceives a mark as a whole and does not proceed to analyse its various details.' The quotations are from para [26] of the judgement of the Court of Justice in Case 0-342/97 *LloydSchuhfabrik Meyer GmbH v Klijsen Handel BV* [1999] E.C.R. 1-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

29. The concept concerning variant marks outlined above is equally applicable in the context of proof of use, bearing in mind the provisions set out in section 47(2)(2C) of the Act.

30. The first question I must consider is, 'what sign was presented as the trade mark on the goods and in marketing materials during the relevant period?' Mr Mehat refers to two variations of the mark that have been used, in addition to the mark registered. The first is a

⁴ See also *Remus Trade Mark* – BL O/061/08 (*Appointed Person*) & *OAO Alfa-Bank v Alpha Bank A.E.* - 2011 EWHC 2021 (*Ch*) and *Orient Express Trade Mark* - BL O/299/08 (*Appointed Person*).

⁵ [2003] RPC 25

script and device mark and the second is STARLET presented in block capitals, with no additional stylisation.

31. It is clear from the evidence that use within the relevant period is only shown where the word STARLET is used as a description on invoices. In my experience it is not uncommon to see goods described in this way on invoices and in any case, Mr Mehat has shown that those goods named on the invoices were in fact sold under the following mark presented in red:



32. The remaining evidence is either outside the relevant period as is the case with the prints from *Amazon* at KSM5 which are dated 8 May 2015; or it unclear when or where they were made available, or if they were available within the relevant period, as is the case with exhibits at KSM6-8. Exhibit KSM4 does not show any 'Starlet' marks.

33. With regard to the first part of the second question, 'what is the distinctive character of the registered trade mark?' The registered trade mark is:



34. It comprises the single word 'Starlet' in title case. The lettering is upright with the capital S separate from the next three letters, 't-a-r', which are joined in the manner of handwriting. These are in turn separate from the last three letters, 'l-e-t', which are joined together in the same way. The letter S is larger and considerably thicker than the remaining letters and is shaded at its top, in the middle and at the bottom. The blunt ends of the letter S are jagged, in a zig-zag manner as if cut on a tape dispenser. A black five pointed star overlaps the top left curve of the letter S. The outline of a five pointed star sits above the letter r. It is possible that the 'S' may be considered a separate stylistic element followed by the word 'tarlet', though it is, in my view, more likely to be considered in its totality, to be the common English word 'Starlet'. The distinctive character of the mark rests in both the word itself and its particular presentation, particularly the distinctive capital S presented as a woosh at the start of the mark. The two stars are less significant, reinforcing the message of a 'starlet' but are still noticeable.

35. The mark used by the applicant in its evidence is the word 'Starlet' presented in italic script. The S is larger than the remaining letters and is formed into a fairly elaborate script which gives a similar impression to that of a treble clef in musical notation. At the end of the mark are three stars which emanate from three curved lines with a common point of origin to the right of the mark. This device element is fairly large being equal in size to at least the last four letters of the mark. Whilst it comprises three stars, it is not simply a star device, but creates a noticeable arrow shape at the end of the mark.

36. I will now turn to the final question, 'do the differences identified...alter the distinctive character...' Both marks are the word 'Starlet' however, in both cases the marks are more

than just simply a plain word but have distinctive character which rests in the word and its particular presentation. The distinctive S at the beginning of the registered mark is presented in a way which is markedly different from the remaining letters and it is not present at all in the mark used in evidence. The letters of the mark as used are all presented in the same italic script with a scripted S which is not similar to that used in the registered mark. In addition it includes the triangular three star device I have described above and which does not feature in the mark as registered and cannot be ignored.

37. Taking all of these factors into account, in my view, the use of the marks shown in evidence alters the distinctive character of the applicant's registered trade mark. Consequently, the application for invalidation fails at the first hurdle.

38. Turning to the plain word 'STARLET', this has only been shown on the invoices provided at KSM1 and on the front of a single t-shirt. Mr Mehat states that the t-shirt is 'on sale in the UK'. I have already identified the distinctive character of the mark as registered, its distinctive character resting in both the word and its presentation. The variant mark relied on by Mr Mehat is simply the word STARLET in plain block capitals, its distinctive character resting in the word alone. When compared to the mark as registered, they are both clearly the same word but the variant lacks any of the distinctive elements of presentation included in the registered mark. The registered mark has a highly distinctive first letter in the stylised S which separates it from the remaining letters which are divided into two groups of three and are shown in an upright script.

39. Consequently, I find that use of the plain word STARLET alters the distinctive character of the applicant's registered trade mark.

40. If I was found to be wrong in this, and use of STARLET was considered an acceptable variant, the only evidence before me of use of the work in connection with any goods is the word on the front of a single t-shirt. I have no evidence of a single sale or any information as to where the t-shirt might be made available or during what time period it has been on sale. Such evidence would fall short of satisfying the use requirement in any case.

Conclusion

41. The applicant has failed to show use of its registered mark in the relevant period. Consequently, the application for invalidation fails.

COSTS

42. The proprietor has succeeded and is entitled to a contribution towards its costs. The proprietor filed a TM8 without an additional counterstatement and did not file evidence or written submissions. In making the award I have taken into account that the only submission made by the proprietor throughout these proceedings is the sentence I have reproduced at paragraph 6 of this decision. The award stands as follows:

| | |
|---|------|
| Preparing a statement and considering the other side's statement: | £200 |
| Total | £200 |

43. I order Kuldeap Singh Mehat to pay Nobel Control Ltd the sum of £200. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of November 2015

**Ms Al Skilton
For the Registrar,
the Comptroller General**