

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 8237 BY JULIUS SAMANN
FOR RECTIFICATION OF THE REGISTER OF TRADE MARKS
IN RESPECT OF REGISTRATION NO. 1377790
STANDING IN THE NAME OF L & D SA**

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

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**IN THE MATTER OF Application No. 8237 by Julius Samann
for rectification of the Register of Trade Marks
in respect of Registration No. 1377790
standing in the name of L & D SA**

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DECISION

15 Trade mark no. 1377790 is registered in respect of:

“Air freshening preparations; deodorants; deodorising preparations and substances; all included in Class 5”.

20 The mark which stands in the name of L & D SA is as follows:

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40 By application filed on 28 October 1994 Julius Samann of Switzerland applied for
rectification of the Register of Trade Marks by the removal of the above mark on the grounds
that the entry was made without sufficient cause and wrongly remains on the Register. This
goes to Section 32 of the Act. In particular the applicant for rectification says that he is the
proprietor of a number of registrations, details of which appear below and that he has made
extensive use of these marks. Accordingly he contends that the registration at issue was
45 granted contrary to Sections 11 and 12 of the Act. He further argues that at the date of
registration the mark was not capable of distinguishing the proprietors' goods for the purpose

of Section 10 of the Act. I should add that the applicant also refers in his statement of grounds (and evidence) to earlier proceedings between the parties in relation to application no. 1262675 which was successfully opposed by the applicant for rectification. He says that the grounds for refusal of that application are applicable also to the registration now in issue.

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Details of the registrations referred to above are as follows:

No.	Mark	Class	Journal	Specification
10	790315	05	4235/1081	Deodorants

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833966		05	4416/523	Deodorants
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20 The registered proprietors filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

Both parties filed evidence and the matter came to be heard on 7 December 1998 when the applicant to rectify was represented by Mr C Morcom of Her Majesty's Counsel instructed by
25 Mewburn Ellis, Trade Mark Attorneys and the registered proprietors were represented by Mr B Bird of Linklaters & Paines, Solicitors.

By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance
30 with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

Applicant for rectification's evidence (Rule 49)

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Some nine Statutory Declarations have been filed. The first dated 10 October 1995 comes from Julius Samann, the beneficial owner of Car Freshener Corporation.

40 He firstly confirms that he is the proprietor of the three registered trade marks referred to above and says that the tree device is a principal feature of those marks. It has been used both in printed form on labels, packaging, wrappers etc, in advertising and in the form of air-freshening products themselves made from thin felt cardboard or other materials.

45 He says that the air freshening products have at all times been made for him or by licensees, in strict accordance with the formula and specifications he has laid down. The products marketed in the United Kingdom were originally, from about 1952, made by Car-Freshener

Corporation under licence in the USA and imported into the United Kingdom. From the mid-1960s until about March 1976 the United Kingdom Distributor of the products was David Franklin Limited ("Franklin"); at about that time Franklin were manufacturing the products and selling them in the United Kingdom under licence. Franklin were registered users of the trade marks from 1 August 1986. In 1991 Franklin ceased manufacture and distribution of the products which have since then been manufactured under licence by Car-Freshener Corporation and imported into the United Kingdom and marketed by the current sole distributor Saxon Automotive Industries of Hungerford, Berkshire.

A sample of the products is at Exhibit JS1. They are, particularly aimed at motorists who account for about 80 per cent of sales in this country and are thus widely sold through garages and motor accessory retail outlets. They are, however, suitable for use in many other places where air fresheners are needed and are thus also sold through other retail outlets including supermarkets and hardware stores.

Details of United Kingdom sales and advertising/promotion are given from 1978 to 1995. It will suffice if I give the figures up to the year covering the filing date of the registration under attack (21 March 1989):

YEAR	UNIT SALES	£ VALUE WHOLESALE	£ RETAIL VALUE	EXHIBITIONS ADVERTISING PROMOTION
1978	250,000	35,000	95,000	1,000
1979	402,000	61,000	125,000	2,000
1980	502,000	90,500	200,000	3,000
1981	650,000	105,000	240,000	7,000
1982	750,000	126,000	300,000	6,000
1983	740,000	126,000	300,000	11,000
1984	875,000	159,000	350,000	11,000
1985	1,100,000	164,000	600,000	13,000
1986	1,200,000	221,000	700,000	17,000
1987	1,600,000	398,000	1,000,000	14,000
1988	1,600,000	400,000	1,000,000	
1989	2,300,000	550,000	1,200,000	

He also exhibits:

JS2 - press articles dating back to 1952

JS3 - press and publicity articles

5 JS4 - leaflets relating to air freshening products marketed by others in the trade.
Mr Samann is not aware of anyone apart from the registered proprietor who uses tree devices

10 JS5 - copies of the decisions of the Registry Hearing Officer and that of Mummery J on appeal in relation to application number 1262275

Finally, Mr Samann says that whilst no. 1377790 is still on the Register he is unable to bring infringement proceedings against the proprietor. This, he says, makes him person aggrieved.

15 The second declaration is dated 17 October 1995 and comes from David William Lake, a Director of Farncombe International Ltd, an intellectual property consultancy and investigation firm.

20 He exhibits (DL1) a copy of a letter from Mewburn Ellis commissioning investigations into the type of air freshener product sold by the registered proprietors. Samples supplied by the company showed products cut into various shapes such as trees, leaves, football kits and insects. Example of the tree and leaf shapes are at exhibit DL2. The mark SILVESTER's is only used in relation to tree-shaped air fresheners. As a result of further enquiries L & D SA supplied Mr Lake with samples of a new AIRE ALPINO fibre board tree-shaped air freshener (DL3).

30 The third Statutory Declaration is dated 19 December 1995 and comes from Roger Stuart Grimshaw, the applicant's trade mark agent. He describes the background to and results of a questionnaire survey involving some 180 randomly selected addresses for car accessory dealers and petrol filling stations. The addressees were shown the mark under attack and invited to comment on the name of the manufacturer or any association it suggested with a particular firm. 20 completed questionnaires were returned and six respondents who made reference to his client's (the applicant) mark or related companies subsequently filed Statutory Declarations. The individuals concerned are

35 Alan Charles Jansch, Philip Vaughan Irwin, Brian Armstrong, Alan S Pauley, Derek Millar and Gordon Gaffney. A copy of Mr Jansch's completed questionnaire is at Annex A to indicate the form of the questions asked and the type of response received.

40 Registered proprietors' evidence (Rule 50)

The registered proprietors filed a Statutory Declaration dated 25 April 1997 by David Fernandez Torres, their Managing Director, a position he has held since 1980.

45 He says that L & D have been selling scent-impregnated card air fresheners throughout Europe and in the United Kingdom for 9 years. Since 1988 its range has included air fresheners in the shape of the trade mark in suit. In 1988 the UK distributor was R F Simms.

In 1989 it was Auto Aftermarket Distributors (Europe) Ltd and between 1990 and 1992 it was Belcar Ltd. In support of this he exhibits:

5 DFT2 - copy invoices addressed to the above mentioned distributors

DFT3 - a picture of an air freshener contained in Belcar's 1991 catalogue

DFT4 - a sample of the air freshener concerned

10 He goes on to comment on the issues of comparison of the marks and the earlier trade mark proceedings bearing on no. 1262675. I take these comments into account in reaching my own view of the matter. He says the registered proprietors spent time and money creating the stylised arrow and crescent device. He also makes a number of comments in relation to the issue of confusion. He considers there is little likelihood of confusion because the goods
15 have co-existed in the market for a number of years without any instances of confusion coming to his attention. Also the public are familiar with the use of "tree symbols" for such goods. He says that "many of those products incorporate the fragrances of pine trees or other trees, and so such symbols are obvious choices. Such fragrances are symbolic of cleanliness and freshness". He supports this with an extract from a book entitled "Perfume and Flavor
20 Materials of Natural Origin" (DFT5) and the following examples of other traders who are said to be using similar shapes.

DFT6 - Medo Industries Inc's Ultra Norsk brand which he compares with Car Freshener's product (DFT7)

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DFT8 - Highland Fresh which is said to be marketed by Jet garages in the UK

DFT9 - Impex's Abeto Aromatico

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DFT10 - LR Kosmetik of Switzerland's Luc Raymond

He adds that equivalent marks to the trade mark in suit have been granted without opposition in a number of (primarily) European countries and exhibits a registration certificate to this effect (DFT11). It is estimated that the approximate number of units exported to and sold in
35 these countries amount to 15 million.

Mr Torres makes a number of criticisms of the applicant's evidence. In particular

40 - he says that Saxon Industries have never been a registered user of the applicant and that any such use by them should not be treated as use by the applicant.

- he says that no documents are produced in support of the applicant's sales figures. Nor is it clear what products or marks were involved.

45 - he expresses surprise that Mr Samann was not aware of his company's use of the mark at issue or use of other tree-related marks by others.

- he suggests that the size of the questionnaire survey was not statistically significant and elicited a limited response only. He also questions whether the results are indicative of confusion amongst retail customers.

5 - he exhibits (DFT12) a further 13 responses where no user evidence of confusion was referred to.

10 - he comments on the circumstances surrounding retail sale of air fresheners which in his view renders the risk of confusion negligible. He exhibits (DFT13) an example of his company's display stand which he considers to be different to that of the applicant.

Applicant's evidence in reply (Rule 51)

15 Ronald F Samann, the son of Julius Samann filed a Statutory Declaration dated 28 October 1997. He is responsible for the day to day running of his father's business. He responds to points made in Mr Torres' declaration. In summary he makes the following observations:

20 - the registered proprietors have filed no actual evidence to support their claim to use and in particular no sales figures are given. The copy invoices all refer to somewhat different marks and, therefore, the issues of co-existence and absence of confusion must be seen in this context.

25 - the registered proprietors argue that representations of trees are non-distinctive for air fresheners. This suggests that they must consider their mark to be such a device.

- the device elements of the respective marks are likely to carry more weight with purchasers and increase the risk of confusion.

30 - in relation to the registered proprietors' claim that they spent time and money creating their stylised mark, he says it is not clear whether this was before or after the earlier proceedings between the parties.

35 - in relation to Mr Torres' claim that evidence of confusion on the part of wholesale buyers does not necessarily signify confusion at the level of the retail customer he argues that there is actually a greater risk and the latter will purchase with a lesser level of care and attention.

40 - he comments on Mr Torres' evidence as to other co-existing marks containing tree devices and says that there is no evidence that they have been marketed at a significant level in this country or, in the case of Ultra Norsk, are leaf devices rather than trees.

45 - he denies the relevance of all Mr Torres' comments in relation to Saxon Automotive Industries and foreign registrations.

- in relation to the negative questionnaire responses he points out that the issue of confusion would not have arisen because the respondents had not come across the mark.

5 - in response to Mr Torres' criticism he confirms that the sales figures in his father's declaration represented products sold under the trade marks the subject of the applicant's tree registrations referred to above. He exhibits (RFS1) a copy of a declaration filed in related proceedings to show which marks have been applied to particular products.

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That completes my review of the evidence.

A request by the registered proprietors to file further evidence was dealt with as a preliminary point at the hearing. The material sought to be introduced was in response to statements made in Mr Samann's declaration of 10 October 1995 and purported to indicate the state of the trade in air fresheners. It also sought to clarify references to the registered proprietors' products in Mr Torres' declaration. After hearing the parties I decided not to admit this further evidence. In summary my reasons were that:

20 - I did not think that sufficiently compelling reasons existed for introducing the material at such a late stage nor was it clear why the trade enquiries that underlay the evidence could not have been conducted earlier in the proceedings.

25 - whilst I understand the registered proprietors' wish to challenge Mr Samann's claim to have been unaware of other "tree" air freshener products on the market I did not regard the evidence as being sufficiently material or conclusive to warrant admission.

30 - as Mr Morcom pointed out there was a considerable amount of hearsay in the evidence which did not comply with the Office's Practice Direction of 20 June 1995 and in my view there was insufficient justification for exercising the residual discretion referred to in paragraph 6 of the Direction.

35 - a particular problem would have arisen in relation to statements attributed to Mr David Franklin who was the applicant's former distributor. Quite apart from the fact that Mr Franklin had not made a statutory declaration of his own, given his former status it would have necessitated offering the applicant an opportunity to file further evidence of his own or to seek cross-examination.

40 - much of the material seemed to be of doubtful relevance given the material date in these proceedings.

- to the extent that the evidence was clarification of material already in the proceedings (exhibit DFT8) it added little.

45 - I could see no great prejudice to the registered proprietors in not admitting the further evidence.

I now turn to the grounds for rectification. Section 32 of the Act (so far as is relevant) reads as follows:

5 "32.-(1) Any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongly remaining on the register, or by any error or defect in any entry in the register, may apply in the prescribed manner to the Court or, at the option of the applicant and subject to the provisions of Section 54 of his Act, to the Registrar, and the tribunal may make such order for making, expunging or varying the entry as the
10 tribunal may think fit."

The nub of the case relates to the applicant's objections that the mark was entered on the Register without sufficient cause having regard to Sections 11 and 12 of the Act and wrongly remains on the Register. However I will deal firstly with two other points that arise. To
15 bring himself within the scope of the Section the applicant needs to show that he is a person aggrieved. At the hearing Mr Bird did not take issue with the applicant's claim in this respect. I have no difficulty in formally finding that Mr Samann has the necessary status. The second point is the objection raised under Section 10 (the application proceeded in Part B only). The ground has not been specifically addressed in evidence or submissions save to the
20 extent that the registered proprietors themselves contend that tree devices are common in the trade for air fresheners. I note that Mr Morcom in his skeleton argument indicates that Section 10 "is not relied upon independently of other grounds". I cannot see that the mark as a whole is incapable of distinguishing the proprietors' goods. This ground of objection, therefore, fails.

25 Sections 11 and 12 of the Act read:

30 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

35 12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 40 a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description."

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

5 Lord Diplock commented on the legal status of a registered trade mark the use of which is likely to cause confusion in his speech in the case of the GE Trade Mark, (1973) RPC 11 at page 334, line 27 et seq. He said:-

10 “..... the legal status under the Act of 1938 of a registered trade mark the use of which is likely to cause confusion can be summarised as follows:-

- 15 (1) The fact that the mark is entered upon the register is prima facie evidence of the validity of the original registration and of the right of the registered proprietor to the exclusive use of the mark, subject however to the rights of concurrent user by any registered proprietor of an identical mark or one nearly resembling it.
 - 20 (2) If the mark was likely to cause confusion at the time when it was first registered it may be expunged from the register as “entry made in the register without sufficient cause” unless the proprietor of the mark at that time would have been entitled to have it entered on the register by reason of his honest concurrent use of the mark as a trade mark before the original registration of the mark.
 - 25 (3) If the likelihood of causing confusion did not exist at the time when the mark was first registered, but was the result of events occurring between that date and the date of application to expunge it, the mark may not be expunged from the register as an entry wrongly remaining on the register, unless the likelihood of causing deception resulted from some blameworthy act of the registered proprietor of the mark or of a predecessor in title of his as registered proprietor.
 - 30 (4) Where a mark is liable to be expunged under (2) or (3) the Court has a discretion whether or not to expunge it and as to any conditions or limitations to be imposed in the event of its being permitted to remain on the register.”
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The applicant’s principal claim is within heading (2) of Lord Diplock’s analysis. Although the registered proprietors claim to have been using their mark since 1988 there is no concrete information as to volume of sales, promotional expenditure etc. In any case I do not understand them to say that they could claim honest concurrent use at the material date in these proceedings. I, therefore, have only to decide if the mark was likely to cause confusion when it was first registered.

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The tests for objections under these provisions are the well established ones set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496.

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It seems that in practice the registered proprietors use their mark without the L & D SA element or if the latter is present it is not necessarily positioned or presented in the form set out above. It was suggested, therefore, that I should consider the matter on this basis. I am not persuaded that this is the correct approach as both the Section 11 and Section 12 tests
5 assume normal and fair use of the mark applied for (and in this case registered). So far as the applicant's own position is concerned I must assume normal and fair use of their registrations for Section 12 purposes and the actual user under Section 11. I have set out the respective marks at the start of the decision but there is one other factor which I should refer to at this point and that is the previous proceedings between the parties. The applicant included in his
10 evidence a copy of the Registry decision and that of Mummery J on appeal. At the hearing both sides referred to Mummery J's remarks in support of their positions.

Attached at Annex B is L & D SA's mark that was the subject of the earlier proceedings. In relation to the matter of comparison of the parties' marks Mummery J concluded, inter alia,
15 that the fir tree device was an essential feature of both L & D SA's applied for mark and the registrations of the opponent (the current applicant); that L & D SA's fir tree device was similar in appearance to the device of the registered marks (and that the words "Aire Alpino" were not sufficient to eliminate the likelihood of confusion); and that a fir tree device was not descriptive of the character or quality of the goods. I think it will be readily apparent that
20 L & D SA's mark in those proceedings was closer to Mr Samann's marks. However, whilst both sides have drawn my attention to the findings in relation to the earlier proceedings, I must consider the mark at issue before me on its merits and not on the basis of whether, or to what extent, it is a progression from or development of the device element of the earlier mark. Nor do I draw any particular conclusions from the chronology of events (the registration
25 under attack was applied for and registered after opposition proceedings were launched in the earlier action but before a decision was issued).

I will deal firstly with the position under Section 12. It is not disputed that identical goods are involved. The registered proprietors' mark is a composite one made up of the word and
30 letters SILVESTER'S, L & D, S.A. and a device. The word and letters are certainly not negligible elements in the mark but equally I consider that the device creates a strong visual impact and must be held to be one of the essential features of the mark. The fir tree device is also an essential feature of the applicant's registrations. Whilst I do not forget the need to consider the overall impact of the respective marks it is not surprising that submissions at the
35 hearing concentrated to a large extent on the device elements. Mr Morcom took the view that whatever differences in detail might exist between the devices they were not enough to detract from the overall similarity and the other matter was insufficient to distinguish. Mr Bird, on the other hand, made a number of submissions on the issue of essential features by reference to Kerlys Law of Trade Marks and *Laura Ashley v Coloroll* 1987 RPC 1. To the
40 extent that his arguments were intended to cast doubt on the relevance of the device element they cannot in my view succeed (the considerations in the above case were quite different). So far as the nature of the device was concerned he took the view that it could be seen as a number of things. In particular he instanced an arrow head, a sailing boat, a dagger, a child's self righting toy, etc. He conceded that it might also be seen as a highly stylised tree but that
45 would leave the crescent shaped base unexplained. In practice there is no evidence as to how the average customer would see the registered proprietors' mark. When the question is

posed within the context of trade mark proceedings and with the benefits of Mr Morcom's submissions it is indeed possible to come to the view that the device could be a tree or a shape based on a tree. But that is a somewhat artificial comparison and I must come to my own view on what impact the mark would have in the normal circumstances of trade.

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Both sides have adduced evidence to persuade me towards their particular view of the matter. The registered proprietors have exhibited a number of examples of similar products which they say show that tree devices are common to the trade and, therefore, the public has got used to differentiating even if their mark is considered to be a stylised tree. The registered proprietors' purpose in advancing these arguments was, Mr Bird acknowledged, not to challenge the validity of the applicant's registrations but rather their scope. I have a number of difficulties with their evidence and the related submissions to the extent that

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- the Impex Abeto Aromatico and Luc Raymond products are said to be available in this country but whether in commercially significant quantities and from what dates is not clear
- the Ultra Norsk device is clearly a leaf rather than a tree
- the Highland Fresh product clearly shows fir trees and is available in this country but its relevance in terms of the material date in these proceedings and commercial availability is not clear.

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Accepting the difficulty of collecting material relevant to the material date some years after the event I have some sympathy with the registered proprietors' position but I do not give it great weight mainly because it has not been clearly established that other traders were active on a commercial scale in March 1989 (bearing in mind also Mr Morcom's reference to the extract from the Harrods case referred to in Kerlys at 17.12).

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The applicant for his part conducted a questionnaire survey which he contends supports the view that consumers are likely to be confused. The survey was criticised by Mr Bird principally on the grounds that

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- it was not of a statistically significant size (see *Imperial v Philip Morris* 1984 RPC 293)
- only 6 respondents provided statutory declarations and this could not be taken as a reliable indicator
- only a limited range of retail outlets were covered
- if the survey was evidence of anything it was what he termed a likelihood of "association" rather than any real confusion
- the views of traders were not necessarily indicative of those of end customers.

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There is some force to these criticisms though in fairness I do not think Mr Morcom would say that his client's case stood or fell on the basis of the survey. For my part I find the results to be inconclusive. It seems to me that only Mr Gaffney by answering "Magic Tree Saxon Industries" to question 5 (see the sample completed questionnaire at Annex A) gave evidence of actual confusion. A number of the responses suggest to me that the effect of questions 4 to 6 was to encourage respondents to speculate as to a possible answer. Mr Armstrong's response takes the process a stage further. Having answered "No" to questions 4 and 6 he says in response to 7 "I personally would not confuse it with any other. I would, however, suggest that some people may well associate the overall shape with the well known and popular Magic Tree range of air fresheners".

It must be borne in mind that the respondents were experienced people from the motor accessories/car care products trade. Not surprisingly the parties have conflicting views as to whether their opinions are really indicative of those of retail customers. One view, expressed by Mr R Samann, is that if the trade would be confused then an even greater level of confusion would exist amongst retail customers. The counter view is that wholesale or retail traders have a much keener appreciation of what is on the market and particularly if invited to speculate, may make associations that would not occur to their end customers. For my part I do not find the survey itself to be sufficiently substantiated or the results to be so clear cut as to be of assistance in reaching my decision. I was referred also to Mummery J's comments in the earlier proceedings in relation to trade evidence where he concluded that such evidence "fails to meet the point of the risk of deception or confusion at the level of the retail customer". That comment seems apposite here. In the absence of evidence from customers themselves I treat the survey material with caution.

In the event I am drawn back to reaching my own view on the issue of possible confusion based on the marks themselves. I have not found this to be an easy matter to decide but have come to the view that the applicant has not discharged the onus that is upon him in a rectification action. Even if it is accepted that one view of the registered proprietors' mark is that it is a tree device (and I do not think that is necessarily the case) it is in my view stylised almost to the point of abstraction. On that basis I am not convinced that there is a real risk of confusion. The presence of other matter, that is the word and letters SILVESTER'S, L & D, S.A. provides an added point of differentiation. I should say in passing that there was some discussion at the hearing as to the possible meaning of SILVESTER'S (it was said to be part of the registered proprietors' address but also part of the Latin name for a type of pine tree). There is no evidence before me that either meaning will be apparent to or recognised by customers. It is in my view far more likely that the word will be seen as a forename or surname. To that extent it is in a different category to the words "Aire Alpino" in the mark that was the subject of the earlier proceedings. In short I have come to the view that the applicant fails in his attack under Section 12.

I go on to consider the position under Section 11 taking account of the use claimed by each of the parties. The applicant says that he has used his mark since 1978. In practice the basic mark has been used in a number of forms including with the words MAGIC TREE contained within the device and with other words or symbols of a descriptive nature substituted for the words MAGIC TREE. My impression from the evidence is that use with the words MAGIC

TREE prevails but I do not think anything turns on this point. The applicant has on my appraisal established significant user of his marks. The registered proprietors claim to have been using their mark since 1988, that is to say about a year prior to the filing date of the registration in suit. I share the applicant's view that their use has not been fully substantiated in so far as no information is given on turnover, promotional expenditure or other indications as to consumer recognition of the mark (the invoices at exhibit DFT2 are largely after the material date and of marginal assistance). However I do not understand the registered proprietors to claim that they would have been entitled to proceed on the basis of honest concurrent use at the material date. The examples of the registered proprietors' mark in use in the Belcar catalogue (DFT3) and the sample (DFT4) show the mark as applied for but without the letters (company name) L & D, S.A. Taking both sides' evidence into account I cannot see that any significantly different issues arise under this Section than under Section 12 - in effect the matter still rests on my view of the marks themselves. As I am not persuaded that the mark at issue was likely to cause confusion when it was first registered it does not fall to be expunged from the Register as an entry made without sufficient cause.

My above findings are based primarily on a consideration of whether the initial entry in the Register was validly made (reflecting, I think, the course of the evidence and submissions at the hearing). I do not forget that the applicant also says that the mark wrongly remains on the Register. The point is dealt with in paragraph 3 of the extract from Lord Diplock's speech in GE Trade Mark referred to above. It seems from his comments that I would only need to go on to consider this separate ground of attack if the likelihood of causing deception resulted from some blameworthy act of the registered proprietor and notwithstanding that there was no likelihood of confusion at the time the mark was first registered. The applicant does not say how he could succeed under this head given my above findings. In practice I do not think it arises as a separate issue. Moreover the claimed trend towards use of tree type devices for air fresheners to symbolise cleanliness and freshness (and incorporating pine fragrances for instance) would militate against any such finding though I accept that further and better evidence as to the extent and concurrency of trade use would be needed to properly substantiate the position.

There is one final aspect of the case which I was taken to principally, I think, as a matter of discretion. Mr Torres stated in his declaration that time and money had been spent creating the device that is part of the mark in suit. The applicant says that it is not clear when the mark was conceived or what the design brief was. The suggestion is that the registered proprietors are sailing close to the wind as it were by not putting sufficient distance between their mark and Mr Samann's, having regard also to the earlier proceedings. I have already indicated that the registration before me was applied for after the earlier opposition proceedings were launched but before the outcome was known. It is also said that the same, or substantially the same, mark is marketed in many countries as well as being the subject of international registrations. The packaging is, I note, in a variety of languages reflecting wider marketing considerations. I do not, therefore, think that there are any or sufficient reasons for drawing any adverse conclusions from the registered proprietors' actions.

In the event the application for rectification is unsuccessful and the registered proprietors are entitled to a contribution towards their costs. I order the applicant to pay the registered proprietors the sum of £635.

5 **Dated this 29th day of December 1998**

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M REYNOLDS
For the Registrar
the Comptroller General

QUESTIONNAIRE

1. Please give your full name and address

A. C. JANSCH
c/o WHEELSPIN
373 LEITH WALK
EDINBURGH

2. Please give the name of your company, the nature of your company's business, and the position which you currently hold

WHEELSPIN, CAR ACCESSORY SPECIALISTS
PROPRIETOR

3. What is the length of your experience in the kind of business carried on by your company?

24 yrs.

4. Have you ever come across an air freshener product in the form of the attached mark?

NO

5. If the answer to Question 4 was "yes", please give the name of the manufacturer or producer of the product

6. If the answer to Question 4 was "no", and you were to come across the product, would you associate it with any particular firm or company? If so, which firm or company?

SAXON IND LTD.

7. Please give your reasons for your answer to Question 6.

SIMILAR TO F-R TREE (MAGIC TREE)

8. Have you any other comments?

NO

9. Would you be prepared to confirm your answers by a short affidavit?

YES

Signed

A. C. Jansch

Date

21.10.73



[Handwritten signature]

L. & D. S.A.'s mark that was the subject of the earlier proceedings (No 1262675)



L & D, S. A.