

**TRADE MARKS ACT 1994**

**IN THE MATTER OF CONSOLIDATED  
APPLICATIONS NOS. 9160 AND 9161  
BY WORTH B V FOR REVOCATION  
OF THE REGISTER OF TRADE MARKS  
IN RESPECT OF REGISTRATIONS  
NOS. 1233063 AND 922188  
STANDING IN THE NAME OF SIDNEY MASSIN**

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15 **Background**

Trade mark registration No. 922188 for the word WORTH is registered in Class 25, in respect of the following:-

20 'Coats, dresses, suits, hats and gloves, (for wear) all for women; ties and gloves, all for wear, suits coats, trousers jackets and shirts, all for men'.

Trade mark registration number 1233063 for the words HOUSE OF WORTH, is registered in Class 25, in respect of the following:-

25 'Coats, suits and gloves (for wear), all for men and women; dresses and hats, all for women; ties (for wear), trousers, jackets and shirts, all for men'.

30 Both registrations stand in the name of Sidney Massin.

On 3 September 1996 Worth B V filed applications for the revocation of these registrations on the grounds that the trade marks had not been put to genuine use by the proprietor, or with his consent, in relation to the goods for which they are registered, either in the five years  
35 following the date of the completion of the registration procedure or in the five year period ending three months prior to the date of the applications for revocation. The applicants ask for an award of cost.

The registered proprietor filed counterstatements, denying the grounds of revocation and asking that the applications be rejected. They also seek an award of costs. The two sets of proceedings were subsequently consolidated.

At this point I record that these trade mark registrations were the subject of applications by Worth BV for the rectification of the register under the Trade Marks Act 1938 (as amended)  
45 on similar grounds, ie. Worth BV alleged that the trade marks had not been used. In the event the Assistant Registrar, in his decision dated 31 July 1996 in respect of proceedings No. 7513 and 7514, decided that the registered proprietor had a personal reputation in these trade marks in suit; that Mr Massin had not abandoned the trade marks and that negotiations to appoint licensees were on hold pending the outcome of the proceedings. The Assistant Registrar  
50 found that the applicants for rectification failed in their applications.

5 Both the applicants and the registered proprietor filed evidence in these further proceedings  
and the matter came to be heard on 25 March 1998 when the registered proprietor, Mr Sidney  
Massin, was represented by Mr Brian March, his Trade Mark Attorney. The applicants,  
Worth BV, did not attend the hearing but their representatives, S J Berwin & Co, provided  
written submissions.

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**Registered Proprietor's evidence**

This consists of a Statutory Declaration, dated 25 November 1996, by Mr Sidney Massin. Mr  
Massin states that he acquired the trade marks by assignment in 1993. He points out that  
15 these applications to revoke these registrations were made just over one month after the  
Assistant Registrar's decision in respect of the earlier proceedings involving these trade marks,  
under Rectification Nos. 7513 and 7514. He adopts and refers to the evidence filed in those  
proceedings where he was the Intervenor. For the record I adopt the summary of that  
evidence by the Assistant Registrar in those proceedings and for convenience set it out at  
20 Appendix 1 to this decision.

Mr Massin goes on to state that since the filing of the earlier applications to rectify on the  
7 January 1993, and up to the date of the Assistant Registrar's decision of 31 July 1996, the  
validity of his trade mark registrations was in doubt. He states that he made efforts to appoint  
25 licensees to use the trade marks in question, but the fact that the registrations were under  
continuous threat from 1993 made it impossible for him to secure a satisfactory licensing  
arrangement. In Mr Massin's words, "no licensee in their right mind would commit  
themselves to the substantial investment required in terms of both time and money in the  
manufacture of branded articles of clothing if there was doubt as to the ability of that licensee  
30 to use the mark without fear of third party attack".

Mr Massin also states that he was informed of the Assistant Registrar's decision on the earlier  
proceedings by a letter from his Trade Mark Attorney which he received on 13 August 1996.  
Thus, Worth BV in filing these applications to revoke on the 2 September 1996, in effect,  
35 allowed him just over two weeks during which the registrations were not under attack or  
threat of attack, to find a licensee, complete all the necessary negotiations with the licensee  
and put the marks into use in the United Kingdom. This, he states, was simply not possible in  
the timescale. He believes that Worth BV, in filing Revocation Nos. 9160/1 so soon after  
receiving an unfavourable decision in their attempt to rectify the register are acting cynically  
40 and attempting to harass him into relinquishing valuable trade mark rights in the United  
Kingdom. Mr Massin confirms that it is still his intention to appoint licensees to use the trade  
marks in suit in the United Kingdom and claims that in the circumstances he describes there  
are proper reasons for non-use of the trade marks in question in the relevant period.

45 There is also provided a Statutory Declaration, dated 11 September 1997 from Mr Martin  
McCarthy. He states that he is a developer and designer of products such as articles of  
clothing, leather goods and personal accessories and that he represents a consortium of  
manufacturers which trade internationally and sell clothing in a number of countries in the  
world, including the United Kingdom. He goes on to state that he has for many years been  
50 interested in acquiring an interest in the trade marks WORTH and HOUSE OF WORTH in  
that connection.

5 On 4 July 1991 Mr McCarthy states that he met with Sidney Massin and his son and business partner, Marc Massin, at Le Reserve Hotel, Fulham Road, London, together with an Italian lawyer, Gian Paolo Zini of the law firm Pavia e Ansaldo of Milano. A number of potential formats for co-operating together were discussed and it was agreed that these very amicable and useful discussions should continue. There followed an exchange of correspondence and information between himself and the Massins. Further correspondence was entered into between himself and the Massins but some disagreements arose about the terms of the proposed agreement. However, says Mr McCarthy, at no stage did he or, as far as he was aware, the Massins consider that the relationship between them would be terminated. Indeed, following correspondence between them in July 1993, Mr McCarthy again met, on 27 August 1993, Mr Marc Massin. Those discussions progressed the negotiations but it was agreed that the outcome of the rectification action commenced by Worth BV should be awaited before attempting to finalise the arrangements.

Mr McCarthy concludes by stating that correspondence and discussions resumed with Marc Massin, Sidney Massin and his accountants and Trade Mark Attorneys, after the unsuccessful application by Worth BV to have their registrations rectified. Mr McCarthy states that he is still hopeful of securing an agreement with Sidney Massin, enabling him to commence use of the trade marks WORTH and HOUSE OF WORTH in the United Kingdom in respect of various articles of clothing.

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#### **Applicants for revocation's evidence**

This consists of Statutory Declarations by Mr Eric Golding and Mr Robert Cook.

30 Mr Goldings' Statutory Declaration is dated 14 March 1997, and he states that he is a Director of Worth Fine Fragrances PLC, the parent company of Worth BV on whose behalf he is authorised to make the declaration. The information provided comes from his own knowledge or from research he has conducted.

35 Mr Golding states that in September 1996 he instructed S J Berwin & Co to arrange for the filing of revocation actions to remove registration numbers 922188 and 1233063 from the Trade Marks Register. These applications were filed on 2 September 1996. He believes that these registrations are an impediment to Worth BV's legitimate business activities and that Worth BV's commercial position is prejudiced by the existence of these trade marks.

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Mr Golding goes on to refer to and adopt the evidence filed by him on behalf of Worth BV in the earlier proceedings and in particular he adopts the contents of his Declaration dated 28 January 1994. Again, I adopt the summary of this evidence by the Assistant Registrar set out in the earlier proceedings which for convenience is at Appendix 2 to this decision. Mr Golding states that he has been advised by S J Berwin & Co that if a trade mark has not been put to genuine use in the United Kingdom by the proprietor or with his consent for an uninterrupted period of five years prior to the filing of a revocation action under Section 46 of the Trade Marks Act 1994, that registration may be revoked. Mr Golding submits that from the evidence submitted by Sidney Massin in the earlier rectification proceedings and his Statutory Declaration, dated 25 November 1996, filed in the present proceedings, no use of the marks WORTH and HOUSE OF WORTH has taken place in the five years up to the filing of the

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5 applications for revocation, namely from 3 September 1991 to 3 September 1996. In Mr Golding's view the evidence provided by Sidney Massin shows that business activities ceased towards the end of 1989 and no use of the trade marks is claimed to have taken place since that date.

10 Mr Golding goes on to state that Sidney Massin in his Statutory Declaration refers to an alleged intention to appoint licensees to use the trade marks in the United Kingdom but that does not alter the fact that no use of the trade marks has taken place in the statutory time period of five years. In his view, Sidney Massin's comments in his Statutory Declaration cannot and do not constitute proper reasons for non-use of the trade marks.

15 Mr Goldings finally expresses the view that Sidney Massin, if he had any intention to use the marks or licence the trade marks, would have to do so through his extensive contacts in the trade and by giving warranties as to the validity of the registrations to any would-be licensee, despite the fact that they were under threat of removal from the register.

20 Mr Cook's declaration is dated 10 March 1997 and refers to the Statutory Declaration dated 26 January 1994, he filed in the earlier proceedings. That is summarised also in Appendix 2 to this decision.

## 25 **Decision**

With the evidence filed by the parties in mind I turn to consider the grounds of revocation. These are found in Section 46(1) of the Act, the relevant parts of which reads as follows:-

30 **46.(1)** The registration of a trade mark may be revoked on any of the following grounds-

35 (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;

40 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

In my view, the evidence filed in these proceedings points to the fact that there has been no use of these trade marks in the five year period ending three months prior to the date of these applications for revocation ie. from September 1991.

45 Whilst the evidence filed in the earlier proceedings between the parties indicates that there was some use of the trade mark WORTH on invoices in 1989 by Sydney Massin Limited there was no subsequent use of the trade marks by that company, which was subsequently struck off the Register of Companies. The trade marks were subsequently assigned to Sidney Massin, the current proprietor, but there is no evidence that he personally has used either of the trade marks, WORTH or HOUSE OF WORTH on any of the goods covered by the registrations since the assignment.

5 In the circumstances, I hold that there has been no use of the respective trade marks WORTH  
and HOUSE OF WORTH demonstrated, either in the five years following the completion of  
the registration procedure (though there was subsequently) or in the five year period ending  
three months prior to the date of the applications for revocation. I go on therefore to consider  
whether there were, nevertheless, proper reasons for non-use during the latter period.

10 The Act does not define what are proper reasons for non-use. However, in INVERMONT  
1997 RPC 125, the Registrar's Hearing Officer, Mr M J Tuck, considered the matter and  
concluded that the word proper, in the context of Section 46 meant apt, acceptable,  
reasonable, justifiable in all of the circumstances. I proceed to consider the circumstances of  
15 this case against that definition.

Negotiations were taking place between Mr Massin (and his son) and Mr McCarthy in  
connection with a licensing arrangement. These negotiations started in 1991 and have, it  
would seem, continued throughout the period during which the registrations have been under  
20 threat, first of all of rectification and now revocation. The applicant for revocation submits  
that notwithstanding the threat Mr Massin, with his extensive contacts within the clothing  
trade, could have secured a licensing arrangement if he had been determined enough,  
providing, if necessary, warranties as to the validity of the trade marks. Mr Massin on the  
other hand (with Mr McCarthy's support) submits that "no licensee in their right mind would  
25 commit themselves to the substantial investment required in terms of both time and  
money..... if there was any lingering doubt as to the ability of that licensee to use the  
mark without fear of third party attack". Mr Massin also submits that in the very short period  
between the receipt of the information that Worth BV's applications for rectification had failed  
and the filing of their applications for revocation the conclusion of the negotiations between  
30 himself and Mr McCarthy was not possible.

The negotiations between the registered proprietor, Mr Sidney Massin, and Mr Martin  
McCarthy, the potential licensee, were conducted for the most part against a background of a  
threat that one or both of the trade marks may be removed from the register. In those  
35 circumstances it would be, I would have thought, most unusual for any small business to be  
prepared to give any open ended warranty to a would-be licensee. Nor would it be in either's  
interests, it seems to me, to commence use of the trade marks and thus incurring significant  
and perhaps nugatory costs. It would, also in my view, be unreasonable to expect a registered  
proprietor who was legitimately seeking or negotiating to licence the use of an un-used trade  
40 mark, or a trade mark which was not currently in use, to put that mark into use in order to try  
and avoid the revocation of the trade mark. Any such use would be unlikely to be regarded as  
genuine. In all of the circumstances of these cases it seems to me that such negotiations,  
against a background of a threat by a third party to rectify or revoke the trade marks are  
justifiable reasons for non-use. I consider therefore, that though the trade marks have not  
45 been used for a period exceeding five years prior to the applications for revocation, there were  
proper reasons for non-use in that the registered proprietor was negotiating a licence for their  
use, on the goods covered by the registration, but was unable to conclude the agreement until  
the rectification/revocation proceedings were concluded.

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5 There was, of course, a period between the decision in the earlier rectification proceedings and  
the date of the applications for revocation in these proceedings during which there could have  
been a settlement between Mr Massin and Mr McCarthy. However, in my view, that period of  
just over one month , or in fact only two weeks after Mr Massin was told that his registrations  
10 were to continue in being, was not sufficient in my view to enable a final, considered  
settlement to be agreed. Thus I do not consider the fact that for a period of about a month in  
the period January 1993 to April 1998 the threat of removal of the trade marks was lifted as  
militating against the finding that there are proper reasons for non-use. However,  
notwithstanding the above as the Assistant Registrar said in his decision in the earlier  
15 proceedings “Clearly if the marks are to continue to be validly registered they need to be put  
into use soon”. But the registered proprietor and the potential licensee must be allowed a  
commercially reasonable amount of time to reach (or not reach) an agreement. Any early  
attempt therefore by Worth BV to again seek to revoke these registrations may well be  
considered by a Court or a Tribunal as vexatious.

20 In the event that I am wrong in holding that there are proper reasons for non-use I go on to  
consider whether, nevertheless, I should exercise the Registrar’s discretion, as established by  
the Registrar’s Hearing Officer in the INVERMONT 1997 RPC case, in favour of the  
registered proprietor. For the reasons already outlined, I believe that it would be right to do  
so in this case.

25 The applications for revocation in respect of registration Nos. 922188, for the trade mark  
WORTH and No. 1233063 for the trade mark HOUSE OF WORTH fail on all grounds.

30 Mr March requested an award of costs off the scale which reflected the applicants attempts,  
at low cost, to disrupt the registered proprietor’s legitimate business negotiations and thus the  
expense he has had to bear in defending these registrations over the last five years. Bearing  
this request in mind, I order the applicants to pay to the registered proprietor the sum of  
£1,500 as a contribution towards their costs.

35 **Dated this 27 day of April 1998**

40

45 **M KNIGHT**  
**Principal Hearing Officer**  
**for the Registrar**  
**the Comptroller General**

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The principal Statutory Declaration is by Mr Sydney Massin who now lives at Apartment Coral 3-D, Sa Coma, Majorca. It is dated 2 November 1994.

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Mr Massin says he has been involved in the fashion industry for over 60 years and during that period has traded as Sydney Massin trading as Massin Furs, Sydney Massin Limited, Worth Limited, House of Worth Limited, Miss Worth Ltd and at various times, other companies which contained the name WORTH. He says he was a director and principal shareholder of these companies and adds that Massin Furs is a retail and design business which, since his retirement, is carried on by his son.

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Mr Massin gives details of his business career and goes on to say that in 1968 he acquired from the Paquin Group the HOUSE OF WORTH business. Press cuttings exhibited under SM1 refer to the transaction. A number of WORTH marks were registered over the years in the name of Sydney Massin Ltd but some have been allowed to lapse and only Nos. 922188 and 1233063 remain. These two marks are the subject of these proceedings.

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It is claimed by Mr Massin that during the past two or three years discussions have been taking place with an Italian company named McCarthy about the licensing of these two marks but such negotiations cannot be finalised until these proceedings have been completed.

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During the period 1977 to 1989 Mr Massin says that as director and principal shareholder of Sydney Massin Ltd he carried on the business of clothing retailer under the name WORTH. In 1989 the lease of the premises terminated and the business was transferred to 25 Bruton Street, London. Under Exhibit SM2, Mr Massin provides a copy of a circular letter dated June 1988 which is headed - MASSIN FURS & WORTH - END OF LEASE - CLOSING DOWN CLEARANCE - which he says was sent to customers. Under SM3 is a copy of an advertisement by City Property Management Services Limited about the sale of the lease of 50 Wigmore Street.

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Mr Massin says that the name WORTH was prominently displayed on the shop front of 50 Wigmore Street and articles purchased carried HOUSE OF WORTH or WORTH labels and were packaged in bags marked WORTH. Photocopies of these labels and a sample of a carrier bag are exhibited under SM4.

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Under Exhibit SM5 Mr Massin provides a selection of invoices relating to sales from the Wigmore Street premises from December 1987 onwards.

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Under Exhibit SM7 Mr Massin provides a selection of copies of forms completed under the Retail Export Scheme for 1987, 1988 and 1989 showing sales to visitors to the UK.

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Towards the end of 1989 Mr Massin says that due to ill health he was unable to pursue his normal business activities. This, combined with the effect of the anti-fur campaign,



seriously affected his business, but he says, he still continued to promote the name WORTH.

5 On 8 March 1992 (corrected date) the trade mark registrations WORTH and HOUSE OF WORTH were assigned from Sydney Massin Ltd and says Mr Massin, at his request the company was struck-off the Register of Companies. After dissolution Mr Massin says he continued to trade under the name Massin Furs Ltd.

10 Mr Massin goes on to say that he had had discussions with the opponents in 1988 and says he thought there was agreement between the parties at that time. He is therefore concerned and upset by the opponents rectification proceedings.

15 A Statutory Declaration dated 24 October 1994 is provided by Mr Anton Raymond Goldstein who is a Chartered Accountant and partner with the firm of Kimches. Mr Goldstein says that his firm has acted for Mr and Mrs Massin and their companies since the late 1970's.

20 Mr Goldstein says that Mr Massin traded from premises in Wigmore Street which is about 150 yards from his office. He says he visited the premises on many occasions and states that Mr Massin's businesses were involved in the sale of haute couture and furs. A fur remodelling and cleaning service was also provided for customers.

25 Mr Goldstein confirms that Mr Massin's premises in Wigmore Street had the name WORTH prominently displayed on the fascia of the shop and the trade mark appeared on garment bags, notepaper, labels, in garment and advertisements in national newspapers, Vogue and Harpers & Queens etc. He says that members of his family have purchased items labelled WORTH from Mr Massin's premises and he provides an example of a letterhead showing use of WORTH and dated 8 December 1988 and this is attached as Exhibit ARG1.

30 Mr Massin organised and ran fashion shows of ladies wear, including evening wear from his premises says Mr Goldstein, and he attended on some occasions. He states that such events occurred during the period 1988 - 1991 at which time the premises were vacated by Mr Massin.

35 Mr Goldstein explains that Mr Massin, his wife and son were co-directors of Miss Worth Limited, a firm acquired in 1968. Miss Worth traded in ladies fashion, and accounts for the year ended September 1990 show sales of £84,000. This shows says Mr Goldstein that that company was not dormant.

40 In the past Mr Goldstein says that Mr Massin had promoted the name WORTH and merchandise bearing the name WORTH had been sold under the label MADAMOISELLE WORTH in such stores as Harrods, Harvey Nichols, Simpsons etc. More recently, Mr Goldstein says he has been aware of correspondence between Martin McCarthy and Mr Massin about the possibility of licensing the trade marks owned by  
45 Mr Massin. Copy correspondence dated 1992/1993 is exhibited under ARG2.

Under Exhibit ARG3 Mr Goldstein provides a letter from Mr Massin's doctor which details the medical problems which Mr Massin has experienced during the past few years.

5 A Statutory Declaration dated 26 October 1994 is provided by Mr David J Miller who is a Solicitor and Partner in the firm of Grangewoods Partnership. Mr Miller says that Mr Massin was a friend and client of his partner Mr Abraham Davidson and that association stretched back to 1956. In 1991 on the death of Mr Davidson, Mr Miller says he took over all matters and correspondence relating to Mr Massin's affairs.

10 Mr Miller also confirms the use of the name WORTH on the facade of the shop premises at Wigmore Street and states that to the best of his knowledge and belief Mr Massin and/or his companies were trading at Wigmore Street until late 1989 and at Bruton Street until August 1991.

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5 A Statutory Declaration dated 28 January 1994 is filed by Mr Eric Golding. Mr Golding is a Director of Worth Fine Fragrances PLC which is the parent company of Worth B.V.

10 Mr Golding reports that in 1992 he was instructed to arrange for the filing of applications to register the trade mark WORTH in the UK in respect of clothing. In the course of preparation to file these applications, the registrations for WORTH, then in the name of Sydney Massin Ltd., were discovered. Mr Golding claims these registrations are an impediment to the applicants' business activities and its commercial position is prejudiced by the existence of these marks.

15 Enquiries were made, says Mr Golding, and it was discovered that Sydney Massin Ltd had been struck from the Register of Companies. Mr Golding says he has worked in the fashion and perfumery industries for the past 15 years and had never encountered Mr Massin or his business. He attaches as Exhibit EG1 a letter from a Mr B A Nathan of Texgori (UK) Ltd who claims to have 20 years experience in the garment business. He says he has never heard of Mr Sydney Massin or a company with that name.

20 A Statutory Declaration dated 26 January 1994 is filed by Mr Robert Cook who is a Commercial Investigator. He is a member of the Institute of Professional Investigators and has over 30 years experience.

25 Under Exhibit RC1 Mr Cook files copies of documents filed at Companies House which he says confirms that by 1 February 1988, Sydney Massin Ltd had become a de facto (non trading) dormant company. This is confirmed, says Mr Cook, by the copy of the Accounts filed for the year ended 31 January 1989, showing no profit or loss entries other than a net loss of £42 for accounting expenses and bank interest charges. The Company was finally struck off the Register on 17 November 1992, and dissolved by Notice in the London Gazette dated 24 November 1992.

35 Because of the assignment of the marks at issue to Mr Sydney Massin, Mr Cook says he subsequently carried out an investigation into the use of trade marks by Mr Massin.

40 Mr Cook made enquiries at Mr Massin's former premises at 50-54 Wigmore Street, London, W1, where he spoke to Mr Philip Parkes, General Manager of a nearby chemist shop. Mr Parkes recalled Mr Massin trading from the Wigmore Street premises in connection with furs. After consultation with colleagues (Mr Wills and Mr Souter) Mr Parkes said he believed Mr Massin had moved from Wigmore Street in late 1988 or early 1989.

45 Mr Cook also spoke direct with Mr Souter, now working at 50-54 Wigmore Street, who confirmed that he had commenced work there in February 1989 and by that time significant alterations to the premises had taken place.

Contact was also made with a Mr Cory at the Planning Department of Westminster City Council who stated that a planning application for a new shop front for 50-54 Wigmore Street was received on 22 July 1988 and was granted on 30 August 1988.

- 5 Mr Cook confirms that as part of his investigations he also spoke to several fur traders about the trading activities of Mr Massin. Mr John Gratter of Calman Links Trading said, after Mr Massin left Wigmore Street, he had traded as either Massin Furs or Sydney Massin Furs. Mr Zwirn's secretary employed at J Zwirn & Co., stated that she knew Mr Massin through normal trade contact. She confirmed that Mr Massin had
- 10 traded from Bruton Street under the trade name Massin Furs but had ceased trading in 1991. Mr Thomas Holder of Alan Sandler Furs provided the same information. At Exhibit RC2 Mr Cook provides extracts from various telephone directories giving entries for Massin Furs at Bruton Street.
- 15 Under Exhibit RC3 Mr Cook provides extracts from the British Clothing Industry Year Book for the year 1988 and he points out that it contains no mention of the brand names WORTH or HOUSE OF HOUSE.

- 20 As a result of his enquiries Mr Cook claims that there would appear to have been no user of the marks at issue by Mr Massin during the relevant period, though he adds a rider that certainly no user occurred after Mr Massin left his premises in Wigmore Street.