

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 9211 BY
ZOLOTAS JEWELERS S.A.
FOR REVOCATION OF TRADE MARK NO. 1009680
IN THE NAME OF ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS**

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5 **FOR REVOCATION OF TRADE MARK NO. 1009680
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10 **DECISION**

Trade Mark No. 1009680, is registered in Class 14 in respect of :

15 “Articles for personal adornment and smokers’ articles included in Class 14, all made
of precious metal or coated therewith; jewellery, precious and semi-precious stones,
watch cases and watch bracelets.”

The mark is:

20 **CHRYSOTHEQUE
ZOLOTAS**

25 I note that it is entered in the Register as a stylised word but nothing appears to turn on this
point. The registration stands in the name of Zolotas-La Chrysotheque Zolotas.

30 By application dated 1 October 1996 Zolotas Jewelers S.A. applied for this registration to be
revoked on the grounds that, if there had been any genuine use of the mark following the date
of completion of the registration procedure, such use has been suspended for an uninterrupted
period of at least five years and there are no proper reasons for non-use. Revocation is,
therefore, sought under Section 46(1)(b).

35 The registered proprietors filed a counterstatement denying the above grounds and saying that
they rely on use made in the United Kingdom with their consent by the applicants for
revocation. Both sides ask for an award of costs in their favour.

40 Both sides filed evidence. Neither side has requested a hearing. Acting on behalf of the
Registrar and after a careful study of the papers I give this decision.

Registered proprietors’ evidence

45 The registered proprietor filed a statutory declaration by Michael Arthur Lynd of Edward
Evans & Co, their professional representative in this matter. He confirms that the information
contained in his declaration is known personally to him and/or abstracted from the records of
his firm or the records of the proprietors.

In view of the somewhat complicated background to this case and the divergence of views that exists on the underlying circumstances I propose to record in full the substance of each side's evidence.

5 Thus Mr Lynd declares as follows :

- 10 “3. On 22 April 1971 a company was incorporated in Greece with the company name: “Company Limited - by Shares for the Trade and Manufacture of Goods from Gold and precious stones”, and with the trading name “ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS”. In 1986 that company acquired the Company Registration no. 1593/01/B/86/1592. There are now shown to me marked **Exhibit MALI** certified copied of publications in the Greek Government Gazette concerning that company, together with certified translations into English thereof. I observe firstly that the original subscribers to the company included Xenophon ZOLOTAS and his wife Kallirroi ZOLOTAS. I further observe that the original person appointed to the [sic] Managing Director of the company was “Maria wife of Constantine CHRISTOPOULOS daughter of Aristides PAPASTAMOU”. I observe that she remained Managing Director until 21 August 1995 and that she remains on the board of Directors of the company.
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- 25 4. On 13 April 1973 there was filed the Trade Mark Application that resulted in the Registration in Suit. The Application was filed in the name of ZOLOTAS, a Société Anonyme organized under the laws of France. The French company ZOLOTAS was closely associated with the aforementioned Greek company. Maria CHRISTOPOULOS, the Managing Director of ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS, was a director of the French company. The Registration in Suit was assigned on 25 February 1994 from the French company to ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS”. A copy of that assignment document is now shown to me marked **Exhibit MAL2**. I observe that Maria CHRISTOPOULOS has signed the document both on behalf of the French company (the Assignor) and on behalf of ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS (the Assignee).
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- 35 5. On 9 December 1988 another company was incorporated in Greece (under Company Registration No. 1843/01/B/88/658):- ZOLOTAS JEWELERS S.A. A certified copy of publications in the Greek Government Gazette concerning the company ZOLOTAS JEWELERS S.A. and certified translations thereof are now shown to me marked **Exhibit MAL3**. I observe that, up until 20 December 1995 Maria daughter of Aristides PAPASTAMOU (i.e. Maria CHRISTOPOULOS) was a director of ZOLOTAS JEWELERS S.A.
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- 45 6. The company ZOLOTAS JEWELERS S.A. was formed in order to provide a manufacturing facility for jewellery and the company not only manufactured jewellery and supplied it to ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS but was also responsible for exporting the jewellery from Greece to the rest of the world including the United Kingdom. In other words, the company

ZOLOTAS JEWELERS S.A. was, in effect, the export arm of ZOLOTAS - LA CHRYSOTHEQUE ZOLOTAS. The Trade Mark CHRYSOTHEQUE ZOLOTAS was used by ZOLOTAS JEWELERS S.A. with the consent of ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS. As evidence of the consent of ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS to the use by ZOLOTAS JEWELERS S.A. there is now shown to me marked **Exhibit MAL4** a certified copy of Minutes No. 223 of the Meeting of the Board of Directors of the Proprietor dated 28 September 1990 together with a certified translation thereof. I note that the minute records the granting of consent by the Proprietor to the registration in Greece by ZOLOTAS JEWELERS S.A. of the words ZOLOTAS - Jewelers.

7. The distributor in the United Kingdom for ZOLOTAS JEWELERS S.A. for the Class 14 products sold under and by reference to the Trade Mark of the Registration in Suit was, up until a few months ago, Reposs & Co. of 174 New Bond Street, London W1. The distributor is now Luxgem Limited, a British limited liability company of Zakhem House, 123 Old Brompton Road, London SW7 3RP. As evidence of this latter fact, there is now shown to me marked **Exhibit MAL5** a copy of a facsimile letter from Luxgem Ltd. dated 8 January 1997. I observe that Mr Mounir Abujawdch confirms that Luxgem is ZOLOTAS JEWELERY S.A.'s representative in the United Kingdom.

8. Because the use of the Trade Mark of the Registration in Suit in the United Kingdom was by ZOLOTAS JEWELERS S.A. with the consent of the Proprietor, and not by the Proprietor itself, the records and details relating to that use of the Trade Mark of the Registration in Suit in the United Kingdom are in the custody, possession or control of ZOLOTAS JEWELERS S.A. Because that company is now the applicant for revocation these records and details are not available to the Proprietor. They are however available to the Applicant for Revocation and, on behalf of the Proprietor, I ask that the Registrar make an order for discovery against the Applicant for Revocation requiring it to produce for inspection all documents and records in their custody, possession or control relating to the use in the United Kingdom of the Trade Mark of the Registration in Suit for the period September 1991 to November 1995.

(It seems that the case for an Order for Discovery was subsequently held not to have been made out).

Applicants' evidence

The applicants filed a statutory declaration by David Alan Taylor of Mewburn Ellis, Zolotas Jewelers S.A.'s (referred to as ZJSA in what follows) professional representative in this matter. He also makes his declaration on the basis of information held in his firms' records or supplied by Zolotas Jewelers SA.

He declares as follows:

- 5 “2. Shown to me now and marked [DAT-1] is a Certified Translation of a Declaration made by the Board of Directors of ZJSA, stating that there has been no agreement of any kind between ZJSA and Zolotas-La Chrysotheque Zolotas S.A. (“ZLCZSA”) with regard to the use of the trade mark CHRYSOTHEQUE ZOLOTAS by ZJSA; and that the products of ZJSA have always been sold under the trade mark ZOLOTAS JEWELERS exclusively.
- 10 3. Shown to me now and marked [DAT-2] is a Certified Translation of the Minutes of the meeting of the Board of Directors of ZJSA, on 28 September 1990, at which approval was given for the registration, in Greece, by Zolotas-La Chrysotheque Zolotas, of the trade mark ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS, in relation to gold, precious stones and luxury
- 15 goods.
- 20 4. Shown to me now and marked [DAT-3] are copies of a letter from Marrienne Papalexis of ZJSA to Miss Amal Sparkis of Luxgem Ltd., dated 31 October 1994, and discussing the designation of the Repossi Company shop in Bond Street in London as the main United Kingdom showcase and retail outlet for ZJSA ZOLOTAS jewellery products; together with copies of invoices sent by ZJSA to Luxgem Limited in 1994, 1995 and 1996.
- 25 5. Exhibit MAL4 to the Statutory Declaration made by Mr M A Lynd on behalf of ZLCZSA (“Mr Lynd’s Declaration”), Exhibit [DAT-2] hereto, and Exhibit MAL2 to Mr Lynd’s Declaration, appear to indicate that ZJSA and ZLCZSA wished to own and trade under their own eponymous trade marks.
- 30 6. In paragraph 6 of his Statutory Declaration, Mr Lynd claims that “The Trade Mark CHRYSOTHEQUE ZOLOTAS was used by ZOLOTAS JEWELERS S.A. with the consent of ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS.” However, Exhibit [DAT-1] states that there was no use of the trade mark CHRYSOTHEQUE ZOLOTAS by ZJSA.
- 35 7. Mr Lynd continues in paragraph 6 of his Declaration, to say “As evidence of the consent of ZOLOTAS-LA CHRYSOTHEQUE ZOLOTAS to the use by ZOLOTAS JEWELERS S.A. there is shown to me now marked Exhibit MAL4 a Certified Copy of Minutes No. 23 of the Meeting of the Board of Directors of the Proprietor dated 28 September 1990 together with a Certified
- 40 Translation thereof. I note that the minute records the granting of Consent by the Proprietor to the registration in Greece by ZOLOTAS JEWELERS S.A. of the words ZOLOTAS JEWELERS”.
- 45 8. Exhibit MAL4 to Mr Lynd’s Declaration does not mention any consent given by ZLCZSA to the use by ZJSA of the trade mark CHRYSOTHEQUE ZOLOTAS in Greece or in the United Kingdom or anywhere else. Indeed, Exhibit MAL4 shows the Board of Directors of La Chrysotheque Zolotas S.A .

5 approving “the combination of the foreign words ‘ZOLOTAS-Jewelers’ and the depiction of the Greek letter ‘Z’, as this letter is formed with consecutive curved lines and consecutive triangles within the two curves, and which is destined to distinguish (protect) the exact same products and merchandise as our own (i.e. cl. 14)...” - a mark quite different from CHRYSOTHEQUE ZOLOTAS and apparently deemed sufficiently different therefrom to enable the products of ZLCZSA and of ZJSA to be distinguished from one another.

10 9. In paragraph 7 of his Statutory Declaration, Mr Lynd observes that “up to a few months ago” Repossi & Co. of 174 New Bond Street London W1 were distributors in the United Kingdom for ZJSA “for the Class 14 products sold under and with reference to the Trade Mark of the Registration in suit” and that “The distributor is now Luxgem Limited”.

15 10. Exhibit [DAT-3] hereto indicates, and I am advised, that some of the ZOLOTAS products of ZJSA were distributed by Luxgem Limited through the Repossi & Co. Shop mentioned by Mr Lynd; ZJSA had a “corner” of the Repossi & Co. shop for the display and sale of their ZOLOTAS goods. The arrangement with the Repossi & Co. shop ceased, but Luxgem Limited continue to distribute the ZOLOTAS products of ZJSA through other shops. As stated in Exhibit [DAT-1] hereto, there was no use of the trade mark CHRYSOTHEQUE ZOLOTAS by ZJSA.”

25 I go on to consider the matter in the light of the above evidence.

Section 46(1) of the Act, so far as is relevant, reads:

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;

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

40 I have included sub-paragraph (a) because it indicates how “such use” is to be construed in (b).

Section 100 is also relevant and reads:

45 “100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

This is a case where the proprietors make no claim to have used the mark themselves; nor do they suggest that there are proper reasons for non-use. Unusually, they rely on use with their consent by the applicants for revocation. As a result it is said that details of use are not available to the proprietors and they have to rely on the applicants' records.

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The key dates to emerge from the evidence are:

- 22 April 1971 - a company was incorporated in Greece with the trading name Zolotas-La Chrysotheque Zolotas
- 13 April 1973 - UK trade mark application (now the registration under attack) filed by Zolotas SA, a French company said to be associated with the Greek company
- 9 December 1988 - Zolotas Jewelers SA (the applicants) was incorporated in Greece.
- 28 September 1990 - the Board of Zolotas-La Chrysotheque Zolotas approves and accepts the trade mark (Zolotas-Jewelers and Z device) of the "sister company". This appears to relate to a trade mark filing in Greece.
- 28 September 1990 - the Board of Zolotas Jewelers approves and accepts the trade mark (Zolotas-La Chrysotheque Zolotas) of the sister company.
- 25 February 1994 - Zolotas S.A (the French company) assigns registration no. 1009680 (CHRYSOTHEQUE ZOLOTAS) to Zolotas-La Chrysotheque Zolotas.

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Although the evidence refers to sister and associated companies the precise relationship between them is not clear in the sense that it is not possible to establish whether any one of the companies was in a position to control the others, whether they were part of a larger group or connected by common shareholdings. Assuming some form of corporate connection existed at one time, I infer from the launching of this action that it no longer exists or at least that the relationship between the companies has broken down. The one common thread that is referred to in the evidence is the presence of Maria Christopoulos (Papastamou) on the Board of both companies and she appears to have been present at the Board meetings that took place on 28 September 1990. She also signed the assignment document in February 1994 (for reasons which escape me she used the name Christopoulos for one company and Papastamou for the other).

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Crucially there is a conflict of evidence as to what agreement (if any) existed between the Greek companies as regards use of a trade mark in the United Kingdom. Mr Lynd says that "the trade mark CHRYSOTHEQUE ZOLOTAS was used by Zolotas Jewelers Ltd with the consent of Zolotas-La Chrysotheque Zolotas". Mr Taylor on the other hand in paragraph 2 of his declaration says that there has been no agreement between the two companies with regard to the use of the mark. He backs this up with a translation of a Board Declaration to this

effect. The Declaration is not dated and should in my view have been in proper evidential form if it was prepared specifically for these proceedings. Against this there has been no challenge to the document. This is also a case which would probably have benefited from direct evidence from representatives of the parties, particularly Ms Christopoulos. In the absence of such assistance I must make the best I can of the evidence.

Section 46(1) refers to use with the consent of the proprietor. The most obvious form this might take is a licensing arrangement but the Act is not limited in this way. Consequently use by, for instance, subsidiary or associated companies within a group could, circumstances permitting, be held to be with the consent of the proprietor. No decided cases dealing with this issue under the 1994 Act have been brought to my attention though there were a number of cases involving somewhat similar circumstances under the preceding Act (see for instance ASTRONAUT Trade Mark 1972 RPC 655 and TROOPER Trade Mark 1994 RPC 26).

I have already indicated that the exact nature of the relationship between the two Greek companies in this case is not fully explained so I approach the matter with some caution. Apart from the common director (Ms Christopoulos) the closest one gets to establishing the nature of any business link between them is the suggestion in paragraph 6 of Mr Lynd's declaration that Zolotas Jewelers was formed to manufacture and supply jewellery to Zolotas-La Chrysotheque Zolotas and acted as the latter's export arm. However, the consent referred to in the same paragraph of the declaration and Exhibit MAL4 relates not to the mark CHRYSOTHEQUE ZOLOTAS but the words ZOLOTAS-Jewelers and Z device.

Arising from this I conclude that:

- there was a clear and formally adopted process whereby the parties approved and accepted each others' marks as set out in the Board resolutions of 28 September 1990.

- there is nothing to indicate that these agreements dealt with the position outside Greece.

- no separate agreement or consent has been filed which has the effect of permitting or requiring Zolotas Jewelers S.A. to use the mark CHRYSOTHEQUE ZOLOTAS in the UK or elsewhere and

- - the declaration of the directors of Zolotas Jewelers suggests that no such agreement or consent ever existed (though for the reasons set out above I have reservations about relying on this document).

It would be curious if two companies which had gone to some trouble to set out and acknowledge their respective rights in their domestic market in 1990 had taken no steps to regulate activity in other countries in similar fashion, particularly if Chrysotheque Zolotas had really intended Zolotas Jewelers to use the former's mark in the United Kingdom. There is a further unexplained point in that Zolotas-La Chrysotheque Zolotas only took assignment of the mark CHRYSOTHEQUE ZOLOTAS in 1994 from the French Zolotas company. Perhaps this was simply a formal recognition of a transfer that had in practice already taken place. If so I would have expected this to be made clear. Otherwise it becomes difficult to reconcile

this 'exchange of consents' in September 1990 with the fact that Zolotas-La Chrysotheque Zolotas only became owner of the mark by assignment in 1994.

5 Had the matter rested on the above I cannot see how the registered proprietors would have
satisfied me that they had consented to, or exercised control over the use of the mark
CHRYSOOTHEQUE ZOLOTAS in this country. But they face the added difficulty that even
had they established that much they would still need to demonstrate that actual use had taken
10 place. They have provided no evidence of their own but say they are unable to do because
such information is held by the applicants. The applicants have provided copy invoices
relating to distribution of Zolotas Jewelers S.A.'s products by Luxgem Ltd for sale in Repossi
& Co's shop. There is nothing in this material which shows use of the mark
CHRYSOOTHEQUE ZOLOTAS. Although the registered proprietors have not responded to
15 this evidence they would no doubt want me to regard the evidence with some suspicion for the
simple reason that the applicants would be unlikely to willingly file evidence which undermined
their own case. Even so, had there been use with the proprietors' consent they would surely
be able to point to records of their own by way of indirect evidence at least that a trade had
taken place. A proprietor whose mark is being used by another organisation would either
20 expect to receive royalties or licence fees or, in the case of, for instance, a subsidiary or related
company there would be some account of profit between the companies. The registered
proprietors here point to none of these things. Nor do they say what steps had been taken at
any time during the relevant period to enquire what use the applicants had made of the mark
supposedly to be used with their consent.

25 In the absence of any positive indications from the registered proprietors it seems to me that
even if they cannot be said to have abandoned their mark they have certainly failed to exercise
any control over it. In summary the registered proprietors have failed to show that they ever
consented to the applicants using the mark in this country. They have also failed to show that
there has been use of the mark in this country during the relevant period.

30 I, therefore, find that the applicants succeed and that the registration will be revoked in its
entirety. The effective date of revocation will be 30 September 1996 which is the end of the
five year period in question.

35 The applicants are entitled to a contribution towards their costs. I order the registered
proprietors to pay them the sum of £635.

40 Dated this 27 day of 1999.

45 M REYNOLDS
For the Registrar
the Comptroller General