

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

**IN THE MATTER OF CONSOLIDATED APPLICATIONS NOS. 6640,
6643, 6644, 6645, 6646, 6647, 6648, 6649, 6650, 6651 and 6652
BY GERBER FOODS INTERNATIONAL LTD FOR
RECTIFICATION OF THE REGISTER OF TRADE MARKS IN RESPECT
OF REGISTRATIONS NOS. 511239, 841755, 841756, 843485,
852458, 852459, 852460, 852461, 852462, 852463
AND 852464 STANDING IN THE NAME OF GERBERKASE AG
AND GERBER PRODUCTS COMPANY**

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DECISION

15 Gerberkase AG are the registered proprietors of trade mark No. 511239 and Gerber Products
Company are the registered proprietors of the other trade marks referred to above. Full
details of the marks themselves and the specifications in respect of which they are registered
are given in the Annex to this decision.

20 By applications filed on 23 July 1990 Gerber Foods International Ltd applied for rectification
of the register of trade marks by the removal of the above registrations. The grounds for
rectification are in each case expressed in the following terms:

25 “i) That up to one month before the date of this application a continuous period of
5 years or longer elapsed in which the trade mark was a registered trade mark
and during which there was no bona fide use thereof in relation to any of the
goods in respect of which the trade mark is registered by any proprietor thereof
for the time being.

30 ii) The trade mark is not distinctive of the goods of the registered proprietor nor
adapted to distinguish the goods of the registered proprietor within the
meaning of the Trade Marks Act 1938, and the use of the said Trade Mark by
the registered proprietor in relation to the goods in respect of which the trade
35 mark is registered is calculated to deceive or cause confusion. Furthermore it
is contended that any unauthorised use by persons other than the registered
proprietor has rendered the mark deceptive, and registration is contrary to
section 11 of the Trade Marks Act 1938.”

40 These grounds go to Sections 26 and 32 of the Act.

The applicants for rectification are themselves applicants for registration of the mark
GERBER in Class 5 and GERBER PRIDE in Classes 29, 30 and 32 and have had the marks at
issue cited against them. They, therefore, claim to be persons aggrieved by the registrations.

45 The registered proprietors did not file counterstatements and only the applicants filed
evidence. The parties have not requested a hearing. Acting on behalf of the Registrar and
after a careful study of the papers I give this decision.

By the time this matter came to be decided, the old Act had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. These proceedings having begun under the provisions of the Trade Marks Act 1938 however, they must continue to be dealt with under that Act in accordance with the transitional provisions set out at Schedule 3 of the 1994 Act. Accordingly, all references in this decision are references to the provisions of the old law, unless otherwise indicated.

Applicants' Evidence

The applicants filed a statutory declaration by Helen Michelle Whelbourn, their trade mark attorney, the purpose of which is to exhibit and introduce into these proceedings

HMW1 - a copy of a statutory declaration by David Elias Fine dated 18 November 1992 together with six exhibits labelled A-F.

HMW2 - a copy of a statutory declaration by Sean Francis McManis dated 23 November 1992 together with eight exhibits labelled SFM1 to SFM8.

I should say for the sake of good order that the cases which are the subject of these applications were consolidated at an early stage and the correspondence on file indicates that the parties have proceeded on this basis. Ms Whelbourn's declaration properly sets out the rectification numbers concerned but omits reference to registration No. 511239. I take this to be no more than a clerical error. However prior to the preparation of this decision the discrepancy was pointed out to the parties and confirmation was received from the applicants' trade mark attorneys that the proceedings were indeed intended to cover No. 511239. The registered proprietors have given no indication to the contrary.

Mr Fine is the Managing Director of Gerber Foods International. He comments extensively on his company's own business. I do not need to review this material for present purposes save to say that the group appears to have traded on a substantial scale (sales in 1990 are said to have been in excess of £165 million) in relation to a range of food and drinks: As a result of his involvement with the group since 1980 Mr Fine says he has a good knowledge of the activities of other traders and the products stocked by wholesalers and retailers in the food industry including the main supermarket chains.

In relation to the registered proprietors' position he says

“18. I am aware that prior to 1980, Gerber Products Company's goods, bearing the GERBER trade mark, were manufactured and distributed in the United Kingdom by the company CPC (United Kingdom) Limited.

19. I believe that Gerber Products Company withdrew from the UK market around 1979-80 and ceased selling goods marked with the GERBER trade mark in the United Kingdom around that time. This belief has been confirmed by my enquiries.

20. Exhibited hereto and marked "D" is a copy of an article which appeared in the magazine Super Marketing on 30 March 1979 and in which it is stated, inter alia, "CPC", which manufactures Gerber under licence from the Gerber Products Company of the USA will phase out the range during a period of approximately four months".

21. Exhibited hereto and marked "E" is a copy of an article which appeared in The Grocer magazine on the 31st March 1979, which describes Gerber Products Company's withdrawal from the UK market and further states that "Gerber who have been constantly informed of the situation have not indicated that the franchise will be offered to anyone else in the UK."

22. My company has been making enquiries to support our allegations that Gerber Products Company has not sold any goods bearing the GERBER trade mark during the five years and one month preceding the filing of my Company's applications for rectification of the Trade Marks and no use has been discovered, despite extensive enquiries."

He goes on to provide further information on the enquiries made and directed towards companies such as Boots, H J Heinz and Cow & Gate. The consensus appears to be that the GERBER marks have not been used since about 1979-80. As a result of these enquiries and his own knowledge Mr Fine believes the registered proprietors' marks have not been used in this country during the five year and one month period preceding the applications for rectification.

Mr McManis is a Trade Mark Executive with Trade Mark Owners Association Ltd, the applicants' professional representatives. He exhibits a questionnaire and covering letter sent to companies with an interest in infants' and invalids' foods, distributors of such products and editors of publications known to circulate in the relevant industry. He further exhibits

S all the answered questionnaires

S a draft statutory declaration for use by persons answering the questionnaires

S a copy of the statutory declaration of Mr Adrian Binsted who was the only person to claim awareness of the use of the mark GERBER.

S copies of the other executed declarations.

Finally Mr McManis exhibits instructions to Gibbins & Co for a common law search in respect of GERBER and a copy of Mr Andrew Lloyd's (the searcher) declaration detailing the results of his search and indicating that he found no reference to GERBER as a baby food product.

The above is a brief review only of the evidence but I confirm that I have reviewed all the material filed.

Section 26 of the Act, so far as is relevant, reads as follows:

5 “26.- (1) Subject to the provisions of the next succeeding section, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, on the ground either -

10 (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

15 (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.”

20 The applicants’ case here appears to be based on sub-paragraph (b) above. The first matter I have to consider is whether the applicants to rectify are persons aggrieved.

25 The normal consideration for “persons aggrieved” is that set down by Lord Herschell in the Powell-v-Birmingham Vinegar Company case (Vol 1894) 11 RPC 4 at page 7 line 44 which reads as follows:

30 “The respondents are in the same trade as the appellant; like the appellant, they deal amongst other things in sauces. The courts below have held that the respondents are “persons aggrieved”. My lords, I should be very unwilling unduly to limit the construction to be placed upon these words, because, although they were no doubt inserted to prevent officious interference by those who had no interest at all in the Register being correct and to exclude a mere common informer, it is undoubtedly of public interest that they should not be unduly limited, inasmuch as it is a public mischief that there should remain upon the Register a mark which ought not to be
35 there, and by which many persons may be affected who nevertheless would not be willing to enter upon the risks and expense of litigation.

40 Wherever it can be shown as here, that the applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark if remaining on the Register would or might limit the legal rights of the applicant so that by reason of the existence of the entry upon the Register he could not lawfully do that which but for the appearance of the mark upon the Register he could lawfully do, it appears to me that he has a locus standi to be heard as a “person aggrieved”.”

45 This guidance was quoted in the KODIAK trade mark case 1987 RPC 269, headnote 1 of which reads

“1 a locus was conferred on an applicant for rectification if his application for registration was blocked by the presence on the register of an allegedly unused mark.”

5 In the present case the applicants wish to register marks similar to those belonging to the registered proprietors and say in their statements of grounds that the Registrar has cited the latter’s registrations against their own applications.

10 The registered proprietors have filed no counterstatement challenging this claim. I have no hesitation in finding that the applicants are persons aggrieved.

15 The next matter I have to consider is whether the applicants have made out a prima facie case of non-use during the relevant period (that is the five year period to 23 June 1990). It is well established that, only if a prima facie case of non-use is made out, does the burden of proof of showing actual user shift to the registered proprietors (see Kerly’s Law of Trade Marks and Trade Names, 12th Edition at 11-41). Moreover it has been said that the prima facie case calls for more than just the evidence of one man, unless someone apparently particularly knowledgeable such as an official of a trade association (see REVUE Trade Mark case 1979 RPC 27). These considerations must also be balanced by the inherent difficulty of ‘proving a negative’ and, in these particular proceedings, the fact that the registered proprietors have filed no counterstatement or otherwise taken an active part.

I will say at the outset that the applicants seem to me to have made out a persuasive case. They are themselves a group with longstanding experience in the food and drinks industry (since about 1925 in the UK) and with a significant level of trade which encompasses dealings with leading retailers, wholesalers, producers and suppliers of food and drinks in this country. The applicants are thus in a position to speak with some authority in their own right about the industry and players in it. However the evidence goes further than this and establishes a strong case for saying that, whatever presence the registered proprietors may have had in the past in the UK market, their trade went into decline and was phased out sometime around 1979/80. Independent support for this claim can be found in the articles in Super Marketing magazine (dated 3 March 1979) and The Grocer magazine (dated 31 March 1979) both of which refer to and describe Gerber Products’ withdrawal from the UK market. I note too that one of the respondents to the applicants’ questionnaire (Mr De Angeli) adds a postscript saying “I thought Gerber withdrew from the market about 10-12 years ago”. As the questionnaires were issued towards the end of 1992 this statement is broadly consistent with the suggestion that the registered proprietors ceased to have an active presence from about 1980. The only other respondent (and declarant) who was aware of the name GERBER was Mr Binsted, a Director of Food Trade Press Ltd who subsequently confirmed that the company he had referred to as being known to him for nearly 30 years was in fact the UK company known as Gerber Foods (that is to say the applicants).

45 There is also the common law search undertaken to determine whether there had been any use of the mark by the registered proprietors. The enquiries appear to have concentrated on the infants’ and invalids’ foods market reflecting I assume the area where the registered proprietors had previously been active (a view supported by the press cuttings at Exhibits D and E of Mr Fine’s declaration). The search encompassed periodicals (Food Trade Review,

Food Processing and Food Manufacture) for the years 1985 to 1990 as well as the established food and drinks industry magazine, The Grocer. The only 'Gerber' advertisements found were those placed by the applicants.

5 In summary therefore, the applicants have gone to some lengths to try and establish what use, if any, had been made of the registered proprietors' marks during the relevant period. I have no difficulty in accepting that they have established a prima facie case of non-use. As the registered proprietors have not responded that effectively decides the matter in the applicants' favour.

10 The applicants' evidence goes essentially to supporting the Section 26 ground dealt with above. In view of the clear finding I have been able to reach under that Section and the fact that the registered proprietors have not defended their position I do not need to consider the remaining or alternative grounds which go to issues under Section 32 of the Act.

15 As I have found that the applications succeed under Section 26 I direct that the register be rectified by the removal of all the registrations that have been the subject of these consolidated actions.

20 The applicants are also entitled to a contribution towards their costs. I order the registered proprietors to pay the applicants the sum of £1685 in respect of these consolidated proceedings.

25 **Dated this 12 day of November 1999**

30 **M REYNOLDS**
For the Registrar
The Comptroller General

Details of the registrations under attack:

5	No.	Mark	Class	Specification
	511239	(Schedule 3)	42	Cheese.

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841755

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Meat; fish and poultry, none being live, preserved, dried and cooked fruits and vegetables; jellies (for food), jams, fruit preserves, and vegetable preserves.

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Gerber

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841756

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All goods included in Class 30.

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Gerber

No.	Mark	Class	Specification
843485		32	Beer, ale and porter; non-medicated mineral and aerated waters; non-alcoholic drinks included in Class 32; preparations included in Class 32 for making beverages.

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Gerber

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852458		30	All goods included in Class 30.
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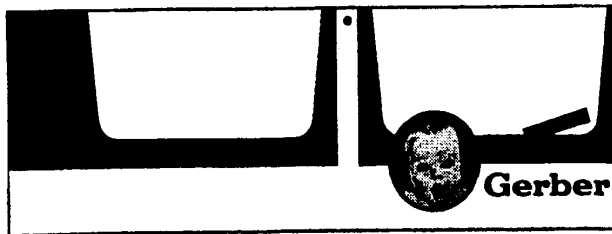
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852459		29	Meat; fish and poultry, none being live; preserved, dried and cooked fruits and vegetables; jellies (for food); jams; fruit preserves and vegetable preserves.
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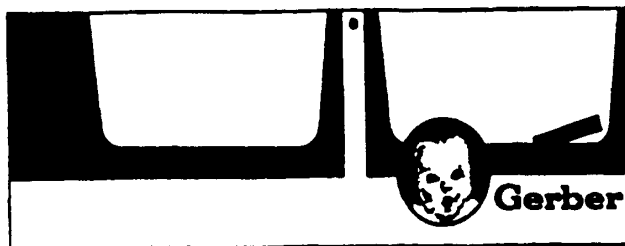


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852460		30	All goods included in Class 30.
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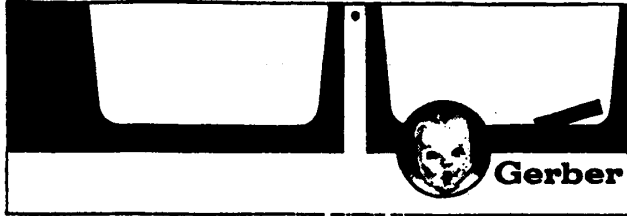


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No. Mark Class Specification

852461 32 All goods included in Class 32.

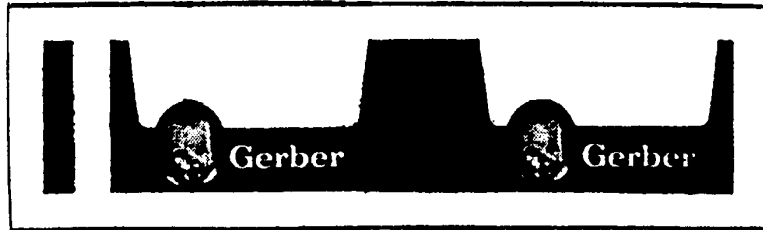
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852462 29 Meat; fish and poultry, none being live; preserved, dried and cooked fruits and vegetables; jellies (for food); jams; fruit preserves and vegetable preserves.

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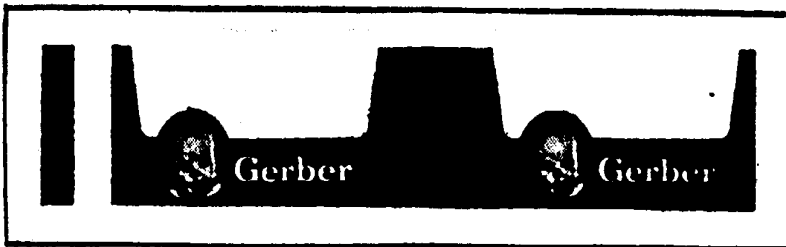


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852463 30 All goods included in Class 30.

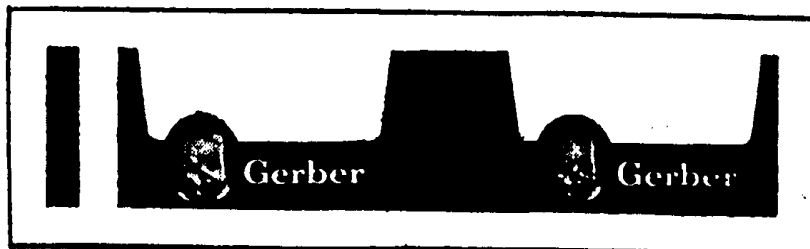
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852464 32 All goods included in Class 32.

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