

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 9082
BY CAMERON MACKINTOSH LIMITED
FOR REVOCATION OF TRADE MARK NO. 1324658
IN THE NAME OF OLIVER TWIST BERND FREIER GmbH**

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5 FOR REVOCATION OF TRADE MARK NO. 1324658
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10 **DECISION**

Trade mark no. 1324658 a registered in Class 25 for “articles of outerclothing and articles of clothing for children”. The mark is OLIVER TWIST. It is registered in the name of Oliver Twist Bernd Freier GmbH.

15 By application dated 4 July 1996 Cameron Mackintosh Limited applied for this registration to be revoked on the grounds that it has not been used on any of the goods for which it is registered during the past five years and there are no proper reasons for non-use.

20 The registered proprietors filed a counterstatement denying the above ground.

Both sides ask for an award of costs in their favour.

25 Both sides filed evidence. The matter was due to be heard on 15 February 2000 though the registered proprietors had indicated that they would not be represented at the hearing. Subsequently the applicants also said that they did not wish to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Section 46(1) of the Act, insofar 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;

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

It is clear from the applicants’ statement of grounds that the attack is under sub-section (b) but I have included (a) because it indicates how the term “such use” is to be interpreted. Section
45 100 is also relevant and places an onus on a registered proprietor to show what use has been made of his mark if the issue arises in civil proceedings.

In defence of their position the registered proprietors filed statutory declarations as follows:

Louise Westbury - dated 4 October 1996

Harold Arthur True - dated 22 October 1997

5 Mrs Handan Parente - dated 25 November 1997

Ms Westbury is a registered trade mark agent acting for the registered proprietors. The substance of her declaration is as follows:

10 “..... the mark has been used in relation to goods which are purchased by UK entities from the proprietor for sale in the UK, and in relation to goods which are surplus production in Italy and Turkey and are sold in the UK with the consent of the proprietor by remainder dealers. I have seen a copy and a translation of the proprietor’s instructions to its German trade mark agents setting out the aforesaid use.

15 There is now produced and shown to me marked LW1 a copy of an invoice issued by a remainder dealer in Turkey to Tutto Diffusion Limited of Unit B, Crusader Industrial Estate, 167 Hermitage Road, Harringey, London N4 1LZ for export of sweat shirts, jackets and pullovers from Turkey to the UK under the mark OLIVER TWIST.”

20 Mr True is a director of Whatbaron Ltd, an English company based in Lancashire. Whatbaron is a manufacturer of sportswear and outdoor leisurewear.

25 “5. During 1992 Whatbaron Ltd supplied Oliver Twist with sportwear and leisurewear which included articles of outerclothing and articles of clothing for children. The garments in question were made in the UK by Whatbaron Ltd and were exported to Germany for resale in Europe or were sold in the UK through Whatbaron Ltd’s warehouse shop. They all had a label bearing the mark in the neck.

30 6. There is now produced and shown to me and attached hereto marked HAT1 a copy of invoices dated 14 May, 16 June and 1 September 1992 issued by Whatbaron Ltd to Oliver Twist. The invoices are in respect of manufacture by Whatbaron Ltd of garments as set out in paragraph 5 above.

35 7. There is now produced and shown to me and attached hereto marked HAT2 a copy facsimile dated 22 July 1992 from Oliver Twist to Whatbaron Ltd which refers to an order made by Oliver Twist for garments as set out in paragraph 5 above to be manufactured in the UK.”

40 Mrs Parente was for four years the Manageress of Matt Ltd, a company based in Wood Green, North London which had retail premises selling clothing items supplied by a number of manufacturers.

45 Mrs Parente says that during that period, Matt Limited took regular deliveries of dresses under the trade mark OLIVER TWIST, supplied by Oliver Twist Bernd Freier GmbH. She exhibits (OL1) a sample delivery note dated 13 October 1995 received from Oliver Twist Bernd Freier GmbH confirming that Matt Ltd was due to receive 8 cartons of dresses, style number 8382,

from the Turkish manufacturer used by Oliver Twist Bernd Freier GmbH. She adds that the total number of dresses received in this consignment was 300 and says that similar consignments of goods bearing the trade mark OLIVER TWIST were received by Matt Limited at regular intervals during the time when she was Manageress of the business.

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The applicants filed evidence by Mary Alexandra Browne covering a statutory declaration by Michael Storey, Commercial Director of Dewynters plc, a company which acts on behalf of the applicants. The only point I need to record is that Mr Storey notes that the registered proprietors' evidence contains no turnover figures for goods sold under the mark and provides no examples of goods or packaging to which the mark has been applied. Furthermore Mr Storey notes that the invoice at LW1 to Ms Westbury's declaration appears to be dated 26 August 1996 which is after the relevant date in these proceedings.

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On the basis of the claims made in the evidence there are a number of different strands to the registered proprietors' business. It is fair to say that the full extent of the claim was not made apparent in Ms Westbury's initial declaration on the proprietors' behalf. I recognise that she was working from her own firm's records but she does also claim to have seen a copy of the proprietors' instructions to their German trade mark agents. As I understand the position the business is variously said to cover goods purchased from the proprietors in Germany for sale in the UK; surplus production from Italy and Turkey sold in the UK with the consent of the proprietors by remainder dealers; goods manufactured in the UK and exported to the proprietors in Germany; goods manufactured in the UK and sold through Whatbaron's warehouse shop. Insofar as the proprietors rely on and are able to substantiate use of the mark on goods for export they are entitled to benefit from the provisions of Section 46(2).

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The proprietors have made no attempt to quantify or otherwise indicate the overall size and geographical extent of their business. No indication has been given as to what (if any) expenditure has been incurred in advertising and promoting the goods. No sample of goods bearing the mark have been supplied and no other indicators of use such as swing tags and labels have been exhibited. I have only the limited order/invoice evidence exhibited to the declarations filed on the proprietors' behalf to assist me. I go on to consider these documents.

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The invoice at LW1 is said to be from a remainder dealer in Turkey. The document is a poor quality photocopy and in the version filed at the Registry what I take to be the issuing company's name and details have been blanked out. The invoice is addressed to Tutto Diffusion, a company with a London address and relates to an order for sweat(shirts?), jackets and pullovers. The description of goods reads "Oliver Twist 40001 Sweat" and variations on the number and type of goods. It seems therefore that these were goods to be sold under the mark OLIVER TWIST. However, as the applicants point out, the invoice appears to be dated '26.08.1996'. I put it that way because it is difficult to read the date on the Registry's copy of the invoice but the registered proprietor's have not disputed the applicants' interpretation of the date. On the basis that the invoice is dated almost two months after the filing date of the application for revocation it is of no assistance to the proprietors.

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Mr True supplies three invoices all bearing dates in 1992 which place them within the relevant five year period. The invoices relate to goods manufactured by his company and are addressed to the registered proprietors at their address in Germany. In the passage from his

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declaration quoted above Mr True does not expressly say in paragraph 6 that the garments the subject of the invoices bore the mark OLIVER TWIST but I infer from the preceding paragraph that such a claim is being made. However I find it difficult to reconcile Mr True's statements with the invoices filed in evidence. Firstly one of the invoices (dated 16 June 1992) relate to tins of wax dressing and not garments at all. The invoice of 14 May 1992 has under the reference heading 'Ainsdale Jacket Childrens ref No. 5349'; and under the heading description a colour and size reference. In the absence of any explanation I am left with the impression that the mark applied to the goods was AINSDALE and not OLIVER TWIST. The third invoice (dated 1 September 1992) has under the heading description - 'Ains Childs 128 Green' (along with variants of the number and colour references). The reference is not explained though it is perhaps not unreasonable to infer that 'Ains' is an abbreviation of Ainsdale. In any event I am unable to accept this as substantiating use of the mark OLIVER TWIST on garments exported from the UK. The final exhibit to Mr True's declaration is a copy of a faxed order from the registered proprietors dated 22 July 1992 for a number of items of clothing along with tins of wax. Other than as part of the company name on the fax header I can see no reference to OLIVER TWIST. There is thus no explicit reference to the mark to be applied to the goods. I note, however, that the document refers to this being a repeat order for article 5349. The latter is also the reference number shown on the 14 May 1992 invoice which was said to be in respect of Ainsdale children's jackets. I cannot, of course, say that OLIVER TWIST did not also appear as a mark on the goods but the point has simply not been established on the evidence.

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Finally, there is Mrs Parente's evidence. She says that the company she worked for received regular consignments of dresses under the mark OLIVER TWIST. The only substantiation of this claim is a single delivery note (OL1) which is a poor quality photocopy containing German text. It is from the registered proprietor and addressed to Matt Ltd. There is a reference to 'Art 8382' and an indication which I think (in the absence of a certified translation) means clothing but no indication of the mark or marks applied to the goods. Mrs Parente also comments that although the sample delivery note emanated from the German proprietor the goods were due to be received from their Turkish manufacturer. I assume that this squares with the reference in Ms Westbury's declaration that part of the trade involved the sale of surplus production from Italy and Turkey by remainder dealers in the UK. That might raise issues as to whether such a trade constituted genuine use judging the matter by normal commercial standards. However, I do not need to speculate further on that point because as indicated above it is not apparent from the single supporting exhibit what mark was being used.

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The onus is on the registered proprietors to make out their case. I am prepared to accept that the nature of the trade as described in the evidence may have meant that conventional advertising and promotion was not used. The evidence does not make clear the overall size, regularity and extent of the trade and as noted above no examples of clothing bearing the mark or supporting items such as labels or swing tags have been filed. The absence of such indicators may not necessarily be determinative of the matter but it suggests that the proprietors needed to establish their case based on other material with some care. As will be apparent from my appraisal of the exhibits I am not satisfied that they have discharged the onus that is on them.

Accordingly the action succeeds and the registration will be revoked with effect from 4 July 1996 (no earlier date having been specified).

5 As the applicants have been successful I order the registered proprietors to pay them the sum of £635.

Dated this 17 day of February 2000.

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