

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 10382
BY DR SCHOLVIEN GMBH & CO
FOR REVOCATION OF TRADE MARK No 1399367
IN THE NAME OF DSM N.V.**

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5 **IN THE MATTER OF Application No. 10382**
by Dr Scholvien GmbH & Co
for Revocation of Trade Mark No. 1399367
in the name of DSM N.V.

10 **DECISION**

Trade Mark no 1399367 is registered in the name of DSM N.V. The trade mark is the word PLANTEX. Following a request to merge the registration with trade mark number 1399366, the trade mark is registered for the following specifications of goods:

15 **Class 29**

Soups, conserved soup vegetables, soup preparations; salad dressings; all included in Class 29.

20 **Class 30**

Sauces; aromatic preparations, aromatic substances; farinaceous products; vermicelli; all included in Class 30.

25 By application dated 3 November 1998 Dr Scholvien GmbH & Co applied for this registration to be revoked. The grounds as set out in the accompanying statement of case can be summarised as:

- 30
1. Within the period of 5 years following the date of completion of the registration the trade mark has not been put to genuine use in the United Kingdom by the proprietor or with its consent in relation to the goods for which it is registered and there are no proper reasons for non use.
 2. In the alternative that any use of the trade mark has been suspended for an uninterrupted period of 5 years and there are no proper reasons for non use.
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These grounds go to Section 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994. The registered proprietors filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour. Both sides filed evidence and both sides have requested that a decision be taken from the papers filed in the proceedings. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

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At the time that the application for revocation was filed, the registered proprietors were shown on the register as Gist-Brocades B.V. However, following an assignment, DSM N.V. were recorded as the registered proprietors on 8 November 1999. As the change of proprietor took place part way through these proceedings it follows that the bulk of the registered proprietors' evidence is in the name of Gist-Brocades B.V. In the normal course of events one might have expected the new registered proprietors to apply to intervene in the proceedings in

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accordance with rule 31(5) of the Trade Marks Rules 1994 (as amended). No formal application for intervention was filed. However, the applicants for revocation do not appear to have objected to DSM N.V. carrying on with the defence of this registrations and in my view, an application for intervention by the new proprietors of the trade mark would have been
5 allowed. As stated above, the new registered proprietors have requested in their letter of 2 June 2000 that these proceedings should be determined on the basis of the papers on file. Therefore, I go on to consider this application on the basis that the new registered proprietors are defending their registration.

Registered Proprietors' Evidence under Rule 31(3)

The registered proprietors filed a single statutory declaration dated 18 February 1999 by Keith Richard Havelock of D Young & Co, Patent and Trade Mark Attorneys, the registered proprietors representatives in this matter.

Mr Havelock states that he has had professional conduct for all trade mark matters for Gist-Brocades B.V. in the United Kingdom for about 20 years. He states that the information given in his statutory declaration is from his own knowledge or has been obtained by him from the registered proprietors. Mr Havelock states that the registered proprietor is Gist Brocades
20 B.V. and that the products sold under this mark are manufactured by Exter Aroma B.V. He goes on to say that Andover Natural Products Limited are the sole distributors of PLANTEX Products in the United Kingdom. He says that Andover have been engaged in the distribution of PLANTEX products in the United Kingdom since January 1993 and that annual turnover for goods sold under the mark exceeds £100,000. Mr Havelock states that the products are
25 tailor made protein savoury food ingredients, based on yeast extracts giving specific flavours. At KRH-1 he exhibits a leaflet which he says is typical of the kind distributed to customers to promote the products and which he says has been supplied to him by Andover Natural Products Limited. I note that the exhibit is dated January 1999 which is after the material date in these proceedings, that is, 3 November 1998, the date of application for revocation. The
30 exhibit shows a list of products under the heading HVP/PLANTEX Range. Those listed under PLANTEX include the following flavours general savoury, chicken, meat, cheese, fish and others including vegetable and tomato.

Applicants' Evidence

The applicants filed a single statutory declaration dated 24 May 1999 by Alan Porteous of Grant Spencer Caisley & Porteous, trade mark attorneys, the applicants representatives in this matter.

Mr Porteous states that his firm instructed the Carratu International Group Limited who are investigators, to investigate what if any use had been made of the trade mark PLANTEX by the registered proprietors and by Andover Natural Products, their distributor. Mr Porteous states that the subsequent investigation established that the trade mark PLANTEX was being used on "yeast based flavour enhancer for use with savoury products". He states that it was
45 also noted that the products sold under the mark was described as a "savoury ingredient for taste improvement and flavour enhancement of fresh and processed meats". He goes on to say that although the investigation was extensive, no indication was found that the mark is used or

has been used on any other products whatsoever. He says that this is consistent with the statements made in the evidence filed with the Registrar with the Form TM8. At AP1 he exhibits a copy of the original investigation report.

5 Mr Porteous concludes by stating that there is no evidence of use of the mark in relation to any goods covered by the registration. He says that the only mention of the name of any goods being sold under the name PLANTEX is provided in exhibit KRH-1 to Mr Havelock's declaration. He said that not only does the exhibit simply state that the mark has been used on "savory products based on yeast extract", which he says are not goods covered by the registration, but also that the exhibit is dated January 1999 which is after the relevant date in these proceedings.

Registered Proprietors' Evidence

15 The registered proprietors filed a further statutory declaration and an affidavit. The statutory declaration is dated 19 August 1999 and is by Susan Jane Cox, a director of Andover Natural Products Limited, a position she has held since her company started trading in January 1993.

20 Ms Cox states that since 1993 her company has distributed the PLANTEX products of Gist - Brocades B.V. in the United Kingdom. She lists the figures for UK sales of the PLANTEX products for the years 1994 through to 1998, as follows:

	Year	£
25	1994	30,754
	1995	39,182
	1996	173,170
30	1997	337,254
	1998	496,701

35 At SJC1 Ms Cox exhibits what she says to be a small selection of invoices referring to the trade mark PLANTEX and confirming sales of products under that mark in the United Kingdom in the years 1994 through to 1998. The first of these is dated 10.10.94 and is from Andover Natural Products to McCormic Glenthams of Northampton and it is for a quantity of product which is shown in the description as 'PLANTEX Tomato', the invoice total is shown as £182.71. The second invoice is dated 30.11.95 and is to IFF (GB) Limited of Haverhill, Suffolk, it is for a quantity of products described as 'Plantex Standard BST11' and the invoice total is for £2,546.81. The other invoices are for '96 '97 and '98, they all show sales in the United Kingdom of products ranging from 'Plantex Mushroom' to 'Plantex Chicken Bouillon'.

45 Ms Cox states that PLANTEX products are used in the following end products; dry soups and sauces, canned soups and sauces, seasoning, snacks, stews, pies and ready meals. At SJC2 she

exhibits copies showing use of the trade mark PLANTEX in relation to two products in the PLANTEX range along with supporting product specification sheets relating thereto. The first document in the exhibit shows two tubs, one with 'Plantex roast beef' on the label and the other shows 'Plantex Basic Bouillon taste'. Product information is shown under 'savoury ingredients' with a description of Plantex products, the first of these shows 'Plantex® BST11' the description states "Bouillon powder based on autolysed yeast extract imparting a meaty bouillon taste. The product enhances and improves natural occurring savoury flavours". The application shown for this product is "soups, sauces, snacks, stews, pies, ready meals, Indonesian meals, canned foods, etc". The ingredients are shown as "yeast extract, salt, vegetable fat". The second shows 'Plantex® MBE20' with the description "Flavouring based on yeast extract with the flavour and taste of roasted beef". The application for this product is shown as "This product is used to impart the typical roasted beef note to ready meals...". The ingredients are shown as "Flavourings (containing yeast extract, salt, flavour enhancers E621, 622, 631, sucrose, colour E150 (caramel), vegetable fat)."

The registered proprietors also filed an affidavit dated 16 November 1999 by Jaco Fok, who is the business manager of Gist Brocades B.V. Mr Fok states that he has been employed by his company for a period of 11 years and he has over 4 years experience in the flavourings industry. He says that his company's PLANTEX product range as sold in the United Kingdom are savour powders based on yeast extract which provide specific flavours. He says that flavours necessarily consists of 2 elements, taste and smell/aroma. Mr Fok says that in fact only 4 different tastes exist namely sour, sweet, salty and bitter. He says that the flavour of, for example, an orange is perceived by the combination of a taste sweet, sour and a specific smell/aroma.

At JF1 he exhibits extracts from a book entitled 'Savoury Flavors' in which he says the above supposition is explained in more detail. He states that in particular it is noted that aroma is considered a key factor in determining subtle nuances in flavour perception.

At JF2 he exhibits an extract from 'Websters Dictionary' which he says defines flavour as a blend of taste and smell sensations. He says that flavour is also defined as:

- (a) a quality which affects the sense of smell; or
- (b) a sense of taste.

Mr Fok concludes by stating that when a sample of his Plantex product is mixed with hot water, a clear smell eg of pork or mushroom, is formed.

That concludes my review of the evidence.

DECISION

Section 46 of the Trade Marks Act 1994 reads as follows:

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

- 5 (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;
- 10 (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- 15 (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

20 (2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

25 (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

30 Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be

35 made.

(4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that -

- 40 (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- 45 (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

5 (6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from -

(a) the date of the application for revocation, or

10 (b) if the registrar or court is satisfied that the grounds for revocation existed at an earlier date, that date.”

In addition Section 100 of the Act is relevant. It reads:

15 "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."

20 The applicants' grounds of attack go to sections 46(1)(a) and (b) of the Trade Marks Act 1994. Once this application was made, the effect of section 100 was to place the onus on the registered proprietors to show the extent and nature of the use made by them of the mark; as noted by Mr Clarke Q.C. sitting as the Appointed Person in *CHRYSOTHEQUE ZOLOTAS* (0/464/99) and *FLORIS* (0/465/99). I note that the proprietors have not sought to rely on any proper reasons for non-use and so I need not consider that point further. With this in mind I go on to consider the evidence submitted by the registered proprietors in this case.

30 From the evidence on file there seems little doubt in my mind that the trade mark PLANTEX has been used within the United Kingdom in the period 1994 - 1998. Even the applicants' evidence supports use of the name PLANTEX on certain products. However, in order to prevent revocation of their trade mark, the proprietors must show that the use that has been made of the trade mark was "...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....."; section 46(1)(a). Whilst this wording is absent from section 46(1)(b) the reference in that section to "such use" is a reference back to the requirements for genuine use as set out in section 46(1)(a).

35 Having regard to the evidence on file there seems little doubt that the trade mark has been put to "genuine use" in the United Kingdom. Equally, the use seems to me to have been with the consent of the proprietors, through their suppliers Exter Aroma and their distributors in the United Kingdom Andover Natural Products Limited. Again, it seems to me that the evidence of the applicants does not seek to dispute either of these points.

40 However, that of itself, is not sufficient to satisfy the requirements of section 46(1)(a) or (b). The use that is made of the trade mark must be in relation to the goods for which the trade mark is registered. Although set out in the introduction to this decision, I reproduce the goods for which the trade mark PLANTEX is registered below:

Class 29

Soups, conserved soup vegetables, soup preparations; salad dressings; all included in Class 29.

5 **Class 30**

Sauces; aromatic preparations, aromatic substances; farinaceous products; vermicelli; all included in Class 30.

10 Where grounds for revocation exists in respect of some of the goods for which the trade mark is registered then the revocation shall relate to those goods only; section 46(5) of the Act. From the specification of goods listed above it seems to me that no use of any kind has been shown in relation to the following goods: soups, conserved soup vegetables, soup preparations; salad dressings; sauces; farinaceous products or vermicelli. Whilst Ms Cox in her declaration states that “PLANTEX products are used in the following end products; dry soups and sauces, canned soups and sauces, seasoning, snacks, stews pies and ready meals”, the fact that they may be used in such end products does not to my mind satisfy the requirement that the proprietors must show use in relation to the goods for which the trade mark is registered. A PLANTEX product may well be an ingredient in a soup but that does not show use of the trade mark PLANTEX in relation to soups.

20 From the evidence submitted by both parties in these proceedings, it seems to me, that the goods on which the trade mark has been used can be described as “tailor made protein savoury food ingredients, based on yeast extracts giving specific flavours”; per Mr Havelock in his statutory declaration and as “savoury powders based on yeast extract which provides specific flavours”; per Mr Fok in his affidavit. The applicants’ evidence points to a similar description for the goods, in particular the report exhibited at AP1 to Mr Porteous’ declaration.

30 In seeking to support part of the specification, the registered proprietors case seems to be that as aroma is an important aspect of flavour, use of the trade mark on products which provide specific flavours is the same as use of aromatic preparations and aromatic substances. Even if I accept that argument, the effect of section 46(5) would be that the registration would be revoked for all the goods with the exception of aromatic preparations and substances. However, for the reasons given below I do not accept the registered proprietors argument on this point.

35 Mr Fok in his affidavit states that “Flavor necessarily consists of two elements taste and smell/aroma. In fact only four different tastes exists namely sour, sweet, salty and bitter”. He gives the example of an orange and states that the flavour of an orange is “..perceived by the combination of the taste sweet, sour and a specific smell/aroma”. The extract from the book entitled ‘Savoury Flavors’ attached as exhibit JF-1 to his affidavit states as follows:

40 “Flavor is one of the key attributes considered important in determining food acceptability. It is often defined as the sensation perceived by a combination of the senses taste and smell and to some degree the pungency, pain, heat, cooling and mouthfeel sensed by the tactile receptors within the oral cavity.....

45However, the factor that influences the savoury food flavor most is the aroma.”

Section 46(1) makes it clear that use of the trade mark must be "in relation to the goods or services for which it is registered....". As set out above, the evidence goes to use in relation to products which provide specific flavours. I can accept that a product added to food as a flavouring may sometimes have an effect on the smell of that food and equally, I accept also that smell can be an important aspect of the overall appreciation of food. However, I do not accept the proposition that a flavouring will always have an effect on the smell or aroma of the food to which it has been added. It seems to me that the primary role of a product which is said to be a "savoury powder based on yeast extract which provides specific flavours" is to impart flavour to the product to which it is added. If it has an effect on the smell of that product then that is a secondary effect and not the reason that it was added to that product.

To save the registration from revocation the registered proprietors must show use in relation to aromatic preparations or aromatic substances. In my view use on products which impart a specific flavouring for use in foods cannot be said to be use in respect of either. There is no defence available to a proprietor who can only show use on similar goods even if they were held to be such. The position can thus be contrasted in this respect with Section 26 of the Trade Marks Act 1938 which did provide for use on goods of the same description as a possible line of defence. On that basis the registered proprietors cannot succeed.

It follows that the revocation request is successful and the registration should be revoked in its entirety. The applicants sought revocation under section 46(1)(a) and (b). The effect of an order for revocation under section 46(1)(b) would be to revoke the trade mark with effect from the date of the application for revocation, that is 3 November 1998. The effective date of an order for revocation under section 46(1)(a) would be 9 August 1996, that is five years after the date of completion of the registration procedure. As set out above, I have found that the proprietors have failed to show that there has been any use of the trade mark PLANTEX in relation to the goods for which it is registered. It follows that the effective date for revocation should be the earlier of the two dates and therefore I order that the registration be revoked in its entirety with effect from 9 August 1996.

The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay the applicants the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29 day of November 2000

S ROWAN
For the Registrar
the Comptroller General