

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 10122
BY ANDRE DEUTSCH LIMITED FOR REVOCATION
OF REGISTRATION NO 1246357 STANDING IN
THE NAME OF STIEFEL LABORATORIES INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 10122
by Andre Deutsch Limited for Revocation of
Registration No 1246357 standing in the name
of Stiefel Laboratories Inc**

DECISION

1. Trade Mark No 1246357 is registered in the name of Stiefel Laboratories Inc for “printed matter; newspapers and periodical publications; but not including any such goods relating to reptiles”. It stands registered as of the filing date of 17 July 1985. The mark itself is as follows:-



2. On 20 May 1998 Andre Deutsch Limited applied for this registration to be revoked on the grounds that:
 - (i) the mark has not been put to genuine use in the UK in relation to all the goods for which it is registered within the period of five years following the date of completion of the registration procedure. This goes to Section 46(1)(a)
 - (ii) that use has been suspended for an uninterrupted period of five years. This goes to Section 46(1)(b).
3. In each case the applicants also claim that there are no proper reasons for non-use. They ask that the registration be revoked in whole or, alternatively, in respect of those goods for which the mark has not been used.
4. The registered proprietors filed a counterstatement denying the above grounds.

5. Both sides ask for an award of costs in their favour.
6. Both sides filed evidence. The matter was scheduled to be heard on 13 February 2001. However shortly before the hearing the attorneys acting for the applicants for revocation indicated that they had received instructions to allow the matter to proceed without legal representation at the hearing. The registered proprietors' attorneys subsequently indicated that they also would not be attending the hearing. In lieu of such attendance they put in written submissions (Dr Ruth French's letter of 12 February 2001). I take these written submissions into account.
7. Section 46 reads as follows:

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

- (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;
- (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.

(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.

(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:

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 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-

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

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

9. Section 100 is also relevant. It reads:

"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."

10. It is clear from Section 100 that the onus is on the proprietor to demonstrate use once a challenge has been raised.

11. The applicants for revocation filed a statutory declaration by Lindsay Hudson a Manager at CDR International Ltd, an investigation agency. The registered proprietors' evidence comes in the form of two statutory declarations by Colin Trinder, Marketing Director of Stiefel Laboratories (UK) Ltd and one from Ruth French, the proprietors' professional representative in this matter.

12. The principal conclusions of the investigation report conducted on the applicants' behalf are that:

"To date we have been unable to locate any other material produced by Stiefel that makes use of a chameleon logo.

Indications are the only printed matter that currently uses this logo, is the Skin Forum lecturer detail sheets.

The only printed matter that made use of the chameleon, of which we are aware, is the journal called Skin Forum, which is no longer produced by Stiefel, production having been terminated some years ago.

Stiefel only develop and produce dermatology products. These are not, however, produced under a chameleon logo.

Stiefel do not charge for the lectures or any associated printed matter. Any printed matter is merely to support the lectures. Stiefel do not publish books, leaflets or journals.”

13. Mr Trinder, for the registered proprietors, says that the mark has been in use in the UK since at least 1982 and up to the present time (his declaration is dated 24 August 1998). It is said to be used in connection with the organisation of a continuing programme of education regarding clinical practice, including a series of lectures and seminars under the title Skin Forum. The mark is used on printed matter comprising stationery, letterheads, programmes, publicity materials and communication papers in these seminars and, in the 1980s, in a companion Skin Forum Journal. Samples of such use are shown at Exhibit CT1. Also attached at CT2 is a photocopy of the front page of the first journal produced in association with lectures and discussions.
14. Mr Trinder gives the company’s annual turnover for the years 1993 to 1997 but does not say whether the sums involved are under the mark and in relation to the goods at issue. The outlay in organising the lecture series over the five year period is said to be just under £500,000. About £30,000 is expended annually on promoting and advertising the mark. The mark is promoted by means of use in Skin Forum stationery used for all communications, programmes and invitations. The company has a mailing list of some 3000 General Practitioners to whom it sends publicity and information regarding the lecture series. The lectures themselves are held in about 30-40 hospitals throughout the UK. Exhibits CT3, CT4 and CT5 are examples of the type of printed matter and information sent out bearing the mark.
15. I should say at this point that I have not found it necessary to record full details of the evidence resulting from the applicants’ investigative work. It confirms the proprietors' involvement in the lecture series and exhibits examples of pro forma invitation sheets which are identical in form (and mark used) to those provided by Mr Trinder. The only additional point of interest is that the investigator exhibits a transcript of a telephone conversation with a contact at the company as confirmation that the Skin Forum Journal was discontinued some time ago. In response to this Mr Trinder acknowledges that the mark has not been used in association with a newspaper or journal for some time but contends that “the leaflets sent out to the relevant public, in advance of the meetings, contains information regarding the next series of lectures and provide information in a similar way to a periodical publication.”
16. Ruth Frenchs’ evidence is by way of submissions on the application of the law to the facts of the case before me. I take her comments into account in reaching my decision.
17. That completes my review of the evidence.
18. The relevant period under subsection (1)(a) for the purpose of these proceedings is 30 May 1987 to 29 May 1992, the registration procedure having been completed on 29 May 1987. The applicants have not specified a period under subsection (1)(b) so I take it to be the five year period up to the filing date of the application for revocation, that is starting from 20 May 1993.

19. Before turning to the evidence there is a matter I need to deal with which affects the scope of the specification and which Dr French relies on in her submissions to demonstrate that her client's position is consistent with the approach adopted by Jacob J in *Minerva Trade Mark*, 2000 FSR 734. Subsequent to the date set for the hearing but before this decision was ready for issue a Form TM23 (notice of partial surrender of the specification) has been filed on the registered proprietors' behalf. The intention is to reduce the broad categories of goods within the specification to those of specific interest to the proprietors. The requested surrender is in respect of:

"Printed matter; newspaper and periodical publications; none relating to medical matters and care of the skin."

That is to say the surrender would leave the goods concerned but only to the extent that they relate to medical matters and care of the skin.

20. The Form TM23 replaces a previously filed but unactioned (and now withdrawn) TM23 which did not meet the proprietors' intended purpose. Although the recently filed TM23 is itself as yet unactioned I propose to consider the revocation action on the basis that it in principle reflects the proprietors' wishes. If, in the event of an appeal, I am held to be wrong in my primary finding below then the Form TM23 will need to be processed by the Registry (including any attention needed to the terms in which the partial surrender has been expressed).
21. Turning to the evidence before me I have recorded above an outline of the registered proprietors' claim regarding use of the mark. I can take no account of the company turnover figures for the reasons given. However the outlay on the lecture series in connection with which the mark is used is significant at £500,000. The mark is said to be promoted by means of use in Skin Forum stationery used for all communications, programmes and invitations. I will return to the question of precisely what mark is used a little later but I first need to consider the exhibits relied on to support the claim to use. I will take them in turn.
22. CT1 contains four items - a piece of stationery which corresponds to the format used for lecture invitation/programme sheets (see below); a specimen card notifying the recipient of the details of the next Stiefel Skin Forum; a compliment slip; and an envelope. All of these are uncompleted sample documents. They do not in themselves evidence any trade in goods or services.
23. CT2 is a sample page from the Skin Forum Journal. It is dated January 1982 which precedes the filing date of the registration under attack. It is of no assistance to the proprietors in the context of the relevant periods set out above. Moreover it is conceded that "the mark has not been used in association with a newspaper or journal per se for some time" (paragraph 4 of Mr Trinder's second declaration).
24. CT3, CT4 and CT5 are single page invitations to Skin Forum lectures along with Freepost reply envelopes. They set out, as one might expect, the venue and programme and invite the recipient to complete and return the reply slip at the bottom of the page to indicate whether they will be able to attend. The events covered by these invitations were scheduled to take place in February and March 1998 at venues in Leeds, Portsmouth and Bath. That places them in the relevant time frame. No further information is given as to the number of potential participants mailed or attending.

25. That in essence is the proprietors' evidence of use. It seems to me that there is a fundamental problem with this evidence from the point of view of a defence to the current action. I do not think any one receiving any of the above mentioned items would have considered that the proprietors were conducting a trade in printed matter or any of the other goods covered by the specification. Jacob J said in MINERVA:

"The specification of goods poses difficulties. "Printed matter" as a pure matter of language, I suppose, covers anything upon which there is printing. In a sense, every trade mark for whatever goods could also therefore be registered for printed matter if one reads "printed matter" perfectly literally. Every packet has printed matter on it. This specification of goods has not only got "printed matter" specified, but also stationery. Mr Carr suggests that I should read "printed matter" as though it was qualified by the word "stationery" in which case, of course, he would in effect get a finding that his clients did not infringe the registration. Alternatively, he says, "printed matter" means printed matter other than "stationery" because stationery is already specified, so there should be a rectification using the powers under Section 46(5).

"Printed matter" cannot in my judgment mean merely that the trade mark is printed on something. For example, if there is a registration for "printed matter" but the only use is on labels for, say, soap or bananas, there has not been use for printed matter."

26. The invitation/programme leaflets (and associated envelopes, compliment slips etc.) would be taken to be the means by which the proprietors' lecture series is promoted. Such activity may support a claim to a trade in organising and conducting lectures but it is not in itself evidence of a trade in goods.
27. Mr Trinder says in his second declaration (paragraph 4) that "..... the leaflets sent out to the relevant public, in advance of the meetings, contain information regarding the next series of lectures and provide information in a similar way to a periodical publication". If that is a reference to the invitation leaflets at CT3 to CT5 (and there is no other obvious piece of evidence the comment could refer to) then I cannot accept that submission. The leaflets are no more than notification of events. They convey little beyond the bare factual details of the lecture programmes. They are not akin to periodical publications and would not be seen as such. That is not, of course, to say that printed matter or publications might not accompany a lecture programme. Quite conceivably it would and such use might well support a registration in Class 16 for goods of the kind at issue. But on the basis of the material before me that is not the case here. I find that the registered proprietors have shown no use on the goods claimed even allowing for the intended reduced scope of their specification.
28. There is a further reason why I do not think the registered proprietors can succeed in this action. The mark as registered is shown at the start of this decision. All the documents provided in evidence show use of a composite mark with the chameleon device placed within two partially overlapping square boxes with the words SKIN FORUM set at right angles to one another in the lower box. The lower box is also usually brown in colour with the word SKIN in white and FORUM in black. The whole has the appearance of an integrated design. It does not appear to be a case where independent marks happen to have been brought together. Rather the chameleon device features as an integral element within the totality of the mark I have described. I have no doubt that it is a significant element and, subject to the impact the words have, might be said to be a dominant feature of the mark. Section 46(2) of the Act provides that "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". The question is not, therefore whether the chameleon device is a significant or dominant element but whether the distinctive character of the registered mark has been altered by the presence of the other matter. In my view it has. The visual characteristics and features of the mark as used create a different identity to the chameleon device on its own. On that basis and with the necessary caveat that I have not had submissions on the point I would hold that the registered proprietors cannot bring themselves within Section 46(2).

29. In summary I find that the evidence at best establishes use in relation to the arranging and conduct of a lecture/seminar programme rather than a trade in the goods of the (reduced) specification. Furthermore the mark that has been used differs in elements which alter the distinctive character of the mark as registered. The application for revocation is, therefore, successful. The registration will be revoked in its entirety with effect from 29 May 1992 (this being the date five years after the completion of the registration procedure).
30. The applicants are entitled to a contribution towards their costs. I order the registered proprietors to pay them the sum of £735. 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 6th day of March 2001

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