

O-222-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 80879
BY AUSTRALIAN APPLE AND PEAR GROWERS ASSOCIATION INC
FOR REVOCATION OF REGISTRATION No. 525262
STANDING IN THE NAME OF MATTHEW CLARK BRANDS LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 80879
by Australian Apple and Pear Growers Association Inc
for Revocation of Registration No. 525262
standing in the name of Matthew Clark Brands Limited**

BACKGROUND

1. The trade mark PINK LADY is registered in the name of Matthew Clark Brands Limited in respect of wines and spirits (Class 33). The registration is numbered 525262.
2. On 27 June 2002 Australian Apple & Pear Growers Association Inc., applied for this registration to be revoked under the provisions of Section 46(1)(b) on the basis of non-use (and no proper reasons for non-use) for a continuous period of five years up to the date of the application. The initial request was that the registration should be revoked in its entirety. Following the filing of the registered proprietors' counterstatement and evidence the applicants amended their statement of case so as to restrict the scope of the revocation to "all the goods for which it is registered other than "wines made from pears"." This reflected the applicants' understanding of the position set out in the registered proprietors' evidence.
3. Both sides ask for award of costs in their favour.
4. The Registry wrote to the parties on 4 June 2003 noting that both parties had indicated their wish that a decision should be taken from the papers. A period was allowed for any written submissions the parties wished to file. None have been received. I, therefore, take this decision on the basis of the papers available to me.

The Law

5. Section 46 of the Act reads:

“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 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.

(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.”

Evidence

6. The only evidence filed in this case is a witness statement by Judith Barrass, the Assistant Company Secretary of Matthew Clark Brands. Her evidence is that “sales have only been made in relation to wines made from pears and not spirits”. She adds that it is recognised that under Section 46(1)(b) the revocation should be successful in relation to spirits. I infer that Ms Barrass is suggesting that the registration should be preserved in respect of ‘wines’. The difference between the parties’ positions therefore, resides in the scope of the specification to be retained.

Decision

7. It seems to me that one approach to this matter is to say that the registered proprietors have shown use in relation to wines made from pears; the applicants have restricted the scope of their action to reflect this fact; no use has been shown in relation to other goods (wines other than those made from pears); and, therefore, that the application should succeed in relation to the balance of the specification.

8. The registered proprietors could have sought to dispose of the action by surrendering their registration in terms which would reflect their actual use. They have not done so and, as I have said above, the clear inference is that the registered proprietors consider that they should retain their registration in respect of ‘wines’ at large. In the circumstances of this particular case I do not think that approaching the matter from this angle produces a different result but I need to explain why this is so.

9. The approach to be adopted in amending a specification to reflect the actual use made of a mark has been the subject of a number of reported cases including, notably, *Minerva Trade Mark* [2000] FSR 734, *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, *Decon Laboratories Ltd v Fred Baker Scientific Ltd* [2001] RPC 293 and, more recently, the Court of Appeal’s judgment in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*, [2003] RPC 32. The latter contains a review of the earlier cases. The key passage reflecting the Court of Appeal’s view on the approach to be adopted can be found in paragraphs 29-31 of the judgment:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks

to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to “dig deeper”.

But the crucial question is – how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

10. The task of deciding what is fair should thus be carried out so as to limit the specification to reflect the circumstances of the particular trade and the way the public would perceive the use.

11. There is no evidence to assist me on these points. The term ‘wines’ is most commonly associated with wines made from grapes. Within that broad category the trade and consumers would also recognise sub-categories such as white, red, sparkling etc. But the term wines is not restricted to grape wines. The registered proprietors’ position is a case in point – they use their mark in relation to wines made from pears. Wines can also be made from a variety of natural products (elderflowers, strawberries, gooseberries etc). These are sometimes referred to as country wines. It seems to me that these categories are discrete areas of trade. I doubt that manufacturers of such wines also produce grape wines though I accept that evidence on the point could prove me wrong. But even then I believe the trade at large and consumers would regard grape wines and wines made from pears to be commercially different products. Generally speaking I do not think that consumers would regard the two classes of wines as interchangeable purchases at least not in the sense that they might regard red and white (grape) wines as offering alternative choices.

12. The position here seems to me to be comparable to that in *David West T/A Eastenders and Fuller Smith & Turner* [2003] ETMR 30 where Mr Christopher Floyd QC, sitting as a Deputy High Court Judge found in relation to a registration for ‘beer’ that “lager and bitter are different types of beer, commercially more different than red and white wine, but perhaps not as different as whiskey and gin” and “The class of articles represented by beer has a number of significant sub-sets of which bitter is only one”. That decision was upheld on appeal, ([2003] EWCA Civ 48).

13. I find that wines made from pears is a sub-set of the broad term wines and, in the absence of evidence to the contrary, that the trade and consumers would treat them as such. Accordingly the registration falls to be revoked under Section 46(5) in relation to all goods except “wines made from pears”. Under the terms of Section 46(6) the registration will be revoked accordingly with effect from 26 June 2002.

14. Turning to costs, Ms Barrass’ evidence contains the following submission:

“As regards costs, it would appear that the investigation referred to in paragraph 1 of the Statement of Case provided by Kilburn & Strode was flawed. Further, neither Trade Mark Owners Association Limited, the Agent acting on behalf of Matthew Clark Brands Limited, nor Matthew Clark Brands Limited the proprietors of trade mark registration No. 525262 PINK LADY, were approached prior to the filing of the application for revocation. As a result the time which Matthew Clark Brands Limited and their agents have had to spend in dealing with this revocation application could have been averted and the costs incurred by the registered proprietors, Matthew Clark Brands Limited been substantially less. In the circumstances we request that the order for costs in favour of the Applicant for Revocation be rejected and that an order for costs be made in favour of the registered proprietor of trade mark registration No. 525262 PINK LADY.”

15. As the applicants have not disclosed the details of the investigation referred to it is not possible to say how comprehensive it was or why it led them to initially launch a full revocation action. However, the applicants reduced the scope of their action to reflect the registered proprietors’ use once the latter had been established through evidence. The proprietors, for their part, have not offered to surrender their registration in a manner that would have reflected their use. The applicants have, therefore, had to pursue the action in order to bring about the result that I have arrived at. It might have been possible to avoid such a state of affairs if the registered proprietors had taken positive action to part surrender their registration.

16. In my view the applicants are entitled to an award of costs to reflect their success but recognising at the same time that they have not needed or chosen to file evidence of their own. I order the registered proprietors to pay the applicants the sum of £900. 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 7th day of August 2003

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