

O-044-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 82467 BY
PRAMIC LIMITED FOR REVOCATION OF
REGISTRATION NO 2193250 STANDING IN THE NAME
OF F. BENDER LTD**

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**IN THE MATTER OF Application No 82467 by
Pranic Limited for Revocation of
Registration No 2193250 standing in the name
of F. Bender Ltd**

BACKGROUND

1. Trade Mark No 2193250, MATE, is registered in respect of:

Catering rolls, towels, tissues, wipes, table napkins, tablecloths, handkerchiefs, place mats, doyleys, serviettes, coasters, bibs, all made wholly or principally of paper; toilet paper; all included in Class 16 and being for sale to the vending machine, food, catering and hotel trades.

2. The registration stands in the name of F. Bender Ltd. The application that resulted in this registration was filed on 30 March 1999 with registration being achieved on 17 September 1999.

3. On 22 March 2006 Pranic Limited applied for revocation of this registration under Section 46(1)(a) and/or (b) of the Act. In relation to (b) the five year period that has been specified is 16 December 1999 to 15 December 2004.

4. The registered proprietor filed a counterstatement claiming continuous use since at least 1999.

5. Both sides have filed evidence. For the record it is as follows:

Registered proprietor's evidence (filed with counterstatement)

Witness statement by Anjum Sheikh Bashir with exhibits ASBI-ASB2

Applicant's evidence in chief:

Witness statement by Joanne Elaine Goodchild with exhibits JEGI-JEG2

Registered proprietor's evidence in support:

Witness statement by Anjum Sheikh Bashir with exhibits ASB1-ASB2

Witness statement by Adrian Francis Pratt with exhibits AFP1-AFP3

Applicant's evidence in reply:

Witness statement by Joanne Elaine Goodchild with exhibits JEGa-JEGd

6. Ms Bashir and Ms Goodchild are registered trade mark attorneys acting for the parties. Mr Pratt is the proprietor's Marketing Manager.

7. The parties were reminded of their right to be heard. Neither side has requested a hearing. Witness submissions have been received from W P Thompson & Co on behalf of the applicant and Sceptre on behalf of the registered proprietor. Both sets of submissions are dated 24 January 2008. Acting on behalf of the Registrar and with the above material in mind I give this decision.

The Law

8. 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 purpose 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.”

9. The onus is on the proprietor to show use when a challenge arises (Section 100).

Relevant five year periods

10. On the basis of the pleaded case these are:

- (i) under Section 46(1)(a) – 18 September 1999 to 17 September 2004.
The earliest revocation date would be 18 September 2004.
- (ii) under Section 46(1)(b) – 16 December 1999 to 15 December 2004.
The earliest revocation date would be 16 December 2004.

Issues of peripheral relevance

11. Ms Goodchild’s evidence indicates that the applicant for revocation has a trade mark filing of its own which faces objection on the basis of the registration under attack. She goes on to explain that her client’s request for consent was rejected. Internet research failed to disclose use of the mark that is the subject of this action. Hence, the filing of the revocation action.

12. Ms Bashir’s evidence picks up on these issues from the registered proprietor’s perspective and challenges the extent of the internet research undertaken by the applicant. She acknowledges the existence of the request for consent but says that the applicant failed to supply sufficient clarification of the nature of the goods of interest to it.

13. The position is, therefore, that these preliminary skirmishes failed to produce a resolution of the issues between the parties. The fact that these exchanges took place is now of limited relevance and the non-use action falls to be decided on its merits.

The registered proprietor’s use

14. Both Ms Bashir and Mr Pratt provide evidence of use by the registered proprietor. There is some duplication of evidence notably the invoices that have been submitted. Mr Pratt describes the company’s trade under the MATE mark as follows:

- “2. My company supplies a range of products including “catering rolls, towels, tissues, wipes, table napkins, tablecloths, handkerchiefs, placemats, doilies, serviettes and coasters”.
3. My company has used the Mark since 1980. It has been in continuous use in the United Kingdom since that date. My company has used the Mark both as a stand alone Mark, and in combination with other words such as DEMI MATE, MULTI MATE, SUPER MATE, MIDI MATE, CHECKMATE and BENDER MATE. My company has used, and continues to use the mark on paper products for food and non-food related applications.
4. The MATE range of paper products are sold throughout the hotel and catering industries. Products branded MATE are distributed by my company through a number of specialists, catering wholesalers. These wholesalers will then sell my company’s Mate branded products to the end-user market. This distribution channel ensure that my company’s products reach the widest possible audience in the catering market.
5. My company’s MATE branded products are sold to approximately 117 customers in the United Kingdom and 15 customers abroad. In most cases, the customers are wholesalers. The wholesalers are invoiced by my company for the MATE products and will, in turn, sell MATE branded products to their customers.
6. Wholesale customers to whom the MATE products are sold include Bunzl, Bunzl Retail Supplies, King UK, Coogan & Watts, Coffeeman, Coptrin Rothwell, Good Morning Disposables, Double R, Donovan Bros, George Craig, Instock, Innerglass, Malsar Kest, Midland Catering, Odeon Cinemas, Polymer UK, RS Sales, WK Thomas, Yate Disposables, Booker, 3663, Irish Merchants, AVA Papierwaren, Distrimondo, Andersen’s Emballasje and Metroplex.
7. There is now produced and shown to me, Exhibit AFP1 which comprises a list of our customers, together with the geographical location in which they are based.”

15. In further support of the above Mr Pratt exhibits (AFP2) 14 invoices demonstrating use of the mark during the relevant periods. In fact, as the applicant’s written submissions point out, a number of the invoices are from after the relevant periods. Nevertheless, most clearly fall within the relevant timeframes.

16. Turnover directly attributable to the company’s MATE products is given as follows (taking relevant years only):

YEAR	TURNOVER
Nov-Dec 1999	£1.5 million
2000	£8.5 million
2001	£7.9 million

2002	£8.6 million
2003	£8.7 million
2004	£7.9 million

17. There is a sales team of eight people promoting the MATE range. The brand is also promoted by means of brochures and A4 inserts. The brochure itself is called Perfect Settings. In the years 2003 to 2005 approximately 5000 such brochures were distributed, the majority to customers in the UK but also for export to other countries.

18. Exhibit AFP3 contains the following:

- Extracts from, and the front cover of, The Perfect Settings brochure 2006.
- Extracts from, and the front cover of, The Perfect Settings brochures 2005/2006.
- Extracts from, and the front cover of, The Perfect Settings brochure 2003, 2001, 1998, 1996, 1995.
- COVERTALK brochure dated Spring and October 1995.
- Extracts from the Quality at Your Fingertips brochure dated 1990.
- A4 insert entitled Christmas Portfolio dated 1990.
- A product list titled Bender's Product Portfolio dated January 1990.
- A Promotional insert which dates from around 1990 entitled We Cater for Caterers.
- Bender's Dispenser Napkin Portfolio which dates from before 1990.
- A promotional leaflet entitled Introducing Super Mate which dates from before 1990.
- A promotional leaflet entitled Bender Mates Dispenser Napkin System dated 29 August to 11 September 1980.
- An example of the Benders Mate packaging wrap which has been used for at least the last 10 years.
- An example of a leaflet entitled Benders Mate dated from before 30 September 1995 (date from which coupon is valid on front page).

19. Ms Bashir's evidence supplements the above with copies of extracts from brochures for the years 1999, 2000 and 2004.

20. The amount spent in producing promotional material to make the product known from the date of first use, to date, is approximately £110,000 and approximately £6,000 per year is spent on advertising and trade support.

21. The amount spent in promoting the mark via direct marketing including calls and visits from the sales team in the relevant period between 1999 and 2004 was approximately £185,000 per year.

Appraisal of the evidence

22. The applicant for revocation's submissions offer a number of criticisms of the evidence. In substance it questions whether the evidence establishes (i) use of the mark (ii) in the UK (iii) within the relevant periods and (iv) for all of the goods.

23. More specifically, the applicant notes that some of the invoices are after the relevant dates and that “insofar as the presence of Mate, Demi Mate, Super Mate, Multi Mate and Midi Mate appearing on the relevant invoices constitutes evidence of use of the Mark in respect of the Goods, such use is limited to napkins”.

24. The applicant is right to say that the registered proprietor sells goods under a number of MATE marks. The above mentioned marks are used to differentiate between napkins of varying sizes and qualities usually for sale with dispenser systems. That much can be gleaned from a review of the exhibited brochures. It is not entirely clear what view the applicant takes about the consequences of use of a ‘family’ of MATE marks and, in particular, whether this gives rise to a question under Section 46(2) as to whether such use is “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”. That is not however a point I need to resolve. I am satisfied that the brochures show use of MATE solus and that sufficient of the invoices are for that mark to validate the proprietor’s claim to have shown genuine use. The other MATE marks do not disclose use on additional or different goods.

25. It is not clear whether the quoted turnover and marketing spend figures relate purely to the mark MATE or include the other MATE-themed marks. I rather suspect it is the latter. In the context of marketing expenditure, it seems unlikely that the proprietor would have any reason to attribute costs to the individual MATE sub-brands.

26. However, taking matters in the round I do not think it can be seriously argued that the collective force of the evidence is sufficient to establish genuine use.

27. Furthermore, I find that that use has been in relation to napkins.

The parties’ submissions on a fair specification

28. The real issue in this case it seems to me is, based on the above finding, what constitutes a fair specification. The parties have clear positions in this respect that I will set out before reaching my own conclusion on the matter.

29. The applicant’s position is that the registration should be revoked in respect of all goods except disposable paper napkins or white disposable paper table napkins (paragraph 13 of the written submissions). The applicant rejects the following submission contained in paragraph 7 of Ms Bashir’s second witness statement:

“UK Trade Mark Registration No 3193250 [actually 2193250] covers goods including “towels, tissues, table napkins, wipes, handkerchiefs, serviettes ... all made wholly or principally of paper”. Paper napkins are the same as “towels, tissues, table napkins, wipes, handkerchiefs, serviettes ... all made wholly or principally of paper” because the public may describe a paper napkin as, a tissue, a paper towel, a paper wipe, a paper handkerchief or a paper serviette. The public may also consider catering rolls of paper to be paper napkins, tissues, paper towels, paper wipes, paper handkerchiefs or paper serviettes, provided on a roll. The Registered Proprietor has therefore,

clearly demonstrated use of the Mark upon and in relation to towels, tissues, table napkins, wipes, handkerchiefs and serviettes all made wholly or principally of paper. Furthermore, since catering rolls made wholly or principally of paper are merely napkins on a roll, I contend that the Mark has also been used upon, and in relation of catering rolls.”

30. The applicant also rejects the further submission that the remaining goods of the registration (tablecloths, place mats, doyleys, coasters, toilet paper and bibs) are similar to towels, tissues, table napkins, wipes, handkerchiefs, serviettes all made wholly or principally of paper.

31. The submissions filed on behalf of the registered proprietor reiterate the above-quoted claim that napkins are synonymous with towels, tissues, table napkins, wipes, handkerchiefs and serviettes all made wholly or principally of paper. The generality of this claim is supported by reference to dictionary definitions from Collins Concise English Dictionary and the Oxford Concise English Dictionary. If the registered proprietor wished to place reliance on dictionary definitions then this material should have been filed in evidence. As matters stand I intend to approach the terms used in the specification on the basis of the meaning that the relevant consumer would attach to them (in this particular case the specification records that the goods are for sale to the vending machine, food, catering and hotel trades i.e. trade customers).

32. The proprietor, therefore, submits that use has been shown in relation to the first group of goods (paper napkins, paper towels, tissues, table napkins, wipes, handkerchiefs and serviettes).

33. In relation to catering rolls it is said that this is merely the commercial name for a stream of usually square pieces of paper which may be used while eating to protect the clothes, wipe the mouth, nose etc. That is to say serviettes on a roll so that individual sheets can be torn off as required.

34. A bib is said to be merely a piece of cloth or paper used to protect one’s clothes whilst eating. On that basis a paper bib is argued to be identical or closely similar to a napkin. Place mats, doyleys, coasters and table cloths are all used to dress a table and are also said to be identical or closely similar goods.

35. In summary the proprietor argues for retention of the whole specification (with the possible exception of toilet paper). In the alternative the application for revocation should be dismissed in respect of catering rolls, towels, tissues, table napkins, wipes, handkerchiefs, serviettes and bibs all made wholly or principally of paper.

The authorities on constructing a fair specification

36. The correct approach to reducing a specification has been considered in a number of cases that have been before the High Court and Court of Appeal. Richard Arnold QC, sitting as the Appointed Person, considered the accumulated authorities in *Nirvana Trade Marks*, BL O/262/06. I adopt the following propositions that he derived from his consideration of the case law:

- (1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
- (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
- (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
- (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
- (5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].
- (6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].
- (7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].
- (8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

37. The registered proprietor's written submissions also refer me to a number of other cases. Firstly in *WISI Trade Mark* [2006] RPC 22, the Appointed Person held that:

"12 The task is to reduce the coverage of the registration so as to prevent the proprietor from claiming absolute protection for the trade mark under ss5(1) and 10(1) of the Act (Arts 4(1)(a) and 5(1)(a) of Council Directive 89/104 of 21 December 1988) in relation to goods of the kind for which there has without proper reason been no genuine use. The goods for which such protection is to remain in place should be defined with due regard for the principles of legal certainty and proportionality. That is to say, the goods for which the trade mark remains registered need to be specified in terms that clearly (as a matter of linguistic expression) and fairly (as a matter of commercial reality) define the limits within which it would be appropriate to accept that "a likelihood of confusion shall be presumed" in the event of

unauthorised use of an identical sign for identical goods: see the tenth recital to the Directive and Art. 16(1) of the TRIPs Agreement.”

38. In *Reckitt Benckiser (España) SL v OHIM*, Case T-126/03, (*Aladin*) the Court of First Instance held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner.”

39. In that case, in the context of proof of use in an opposition, the Court took the view that ‘polish for metals’ was an appropriate specification rather than the unduly restrictive “product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)”.

40. Finally, by reference to *Animal Trade Mark*, [2004] FSR 19 the proprietor points out that:

“So one must assume that the average consumer is told that the mark will get absolute protection (“the umbra”) for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods (“the penumbra”).”

41. The registered proprietor’s submissions place emphasis on the fact that a number of the specified goods are either the same as napkins or share similar purposes and characteristics to napkins. There is some force to this argument in so far as the specification includes serviettes. Ms Goodchild’s evidence exhibits at JEGd the following extract from Collins English Dictionary (Fourth Edition):

“**napkin** (naepkin) *n* **1** Also called: **table napkin** a usually square piece of cloth or paper used while eating to protect the clothes, wipe the mouth, etc.;

serviette. **2** *Rare*. A small piece of cloth. **3** a more formal name for **nappy**¹. **4** a less common term for **sanitary towel** [C15: from OF, from *nape* tablecloth, from L *mappa* cloth]”

42. The first definition clearly indicates that serviette is, in effect, a synonym. The terms would, in my view, be interchangeable.

43. It is also the case that certain other goods (I would say catering rolls, tissues, wipes and tablecloths) have in common with napkins that they exist to protect against, inter alia, food spillage or to wipe up after food spillage. However, the mere fact that they may have certain characteristics in common, as regards say composition and/or purpose, does not mean that consumers (in this case principally the trade) would regard them as falling within the same sub-category of goods. The goods I have identified above are distinct sub-sets. It is not credible to suppose that consumers would describe catering rolls, tissues, wipes and tablecloths as napkins or consider them to be commercially indistinguishable.

44. The point can be tested by reference to the proprietor’s own brochures which consistently describe the MATE products as napkins and use other words to describe other products that might be said to fall within the registered specification eg table covers and banquet (catering) rolls. Nor is it an answer to say that certain of these items share the fact that they may be used to dress a table. That may raise issues as to whether such goods are similar. But I do not read the authorities as suggesting that a fair specification should be based on a consideration of similar goods. Fairness to the registered proprietor does not require this and it is contrary to the approach adopted in the passages from the *WISI* and *Animal* cases referred to above bearing in mind also the proprietor’s infringements rights. Adopting such an approach would not achieve the balance referred to in point (4) of the *Nirvana* summary criteria.

45. As to the remainder of the specification, coasters, place mats and doyleys are for table settings. Handkerchiefs, towels and bibs are more generally associated with personal use rather than protection against food spillage or table settings. But, I accept that these divisions are not clear cut. A bib, for instance, is both a personal item and serves to protect against food spillage. However, this does not in my view disturb the general conclusion that napkins would be recognised and understood to be a distinct sub-category of goods. The items falling within the balance of the specification constitute separate sub-categories of goods. The proprietor has not pressed the case for toilet paper though paragraph 15 of its written submissions includes toilet paper in a category of goods that is said to be “not, in essence different..” from napkins. That is not a sustainable position. Toilet paper is clearly an entirely different commercial product.

46. I conclude that table napkins is a fair specification based on the use shown (the Collins Dictionary extract quoted above indicates that napkins are also called table napkins. It is the latter term that appears in the specification). There is a suggestion in the applicant’s written submission that there should be a further restriction to either disposable paper napkins or even white disposable paper table napkins. That would be going too far and would result in precisely the sort of overly prescriptive specification that arose in the *Aladin* case.

47. On the other hand to avoid an impermissible broadening of the specification the existing qualifications as to composition (all made wholly or principally of paper) and sales outlets (for sale to the vending machine, food, catering and hotel trades) must be retained. Furthermore, for the reason given above, I do not think it serves any purpose to deny the proprietor serviettes in circumstances where this is an accepted alternative name for the goods.

48. Accordingly, the registration will be revoked under Section 46(5) in respect of all goods except:

“Table napkins, serviettes, all made wholly or principally of paper; all included in Class 16 and being for sale to the vending machine, food, catering and hotel trades.”

49. Pursuant to Section 46(6)(a) revocation to the extent indicated will take effect from 18 September 2004 (this being the effective date under Section 46(1)(a)).

COSTS

50. The proprietor has had some limited success but the applicant for revocation has succeeded in large measure. In all the circumstances, I order the registered proprietor to pay the applicant for revocation the sum of **£1200**. 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 18th day of February 2008

**M Reynolds
For the Registrar
The Comptroller-General**