

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION **m** 9330 BY
GREAT ORMOND STREET INTERNATIONAL PROMOTIONS LIMITED
FOR REVOCATION OF TRADE MARK **m** 678189 IN THE NAME OF
J R REID PRINTING GROUP LIMITED

TRADE MARK: **PETER PAN**

TRADE MARKS ACT 1994

IN THE MATTER OF Application **m** 9330
by Great Ormond Street International Promotions Ltd for
revocation of Trade Mark **m** 678189
5 in the name of J R Reid Printing Group Ltd

DECISION

The trade mark **PETER PAN** (**m** 678189) is registered in Class 16 in respect of:

“Invitation cards, gift cards, congratulation cards and writing paper.”

The registration stands in the name of J R Reid Printing Group Ltd.

10 By an application dated 11 December 1996, Great Ormond Street International Promotions Limited applied for revocation of this registration under the provisions of section 46(1)(b) of the Act claiming that there has been no genuine use of the mark in the United Kingdom by the registered proprietor or with its consent in relation to any of the goods for which the mark is registered for at least the preceding five years.

15 The registered proprietor filed a counterstatement denying that there had been no *bona fide* use of the mark in the United Kingdom, and requesting that the application for revocation be refused. As required by rule 31(3), the registered proprietor also filed evidence of use of the mark; I shall review this evidence below.

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

20 In addition to the registered proprietor’s evidence under rule 31(3), both sides also filed evidence under rule 13. At the completion of the evidence stages, and following a request from the applicant for revocation, a hearing was held on 30 June 1998 at which the applicant for revocation was represented by Ms Anne Wong of Carpmaels & Ransford. The registered proprietor was not represented and did not attend.

25 Registered Proprietor’s Evidence - Rule 31(3)

In accordance with rule 31(3), the registered proprietor filed a statutory declaration by John Robertson Reid dated 20 March 1997. Mr Reid is the Managing Director of J R Reid Printing Group Ltd. He says that his company purchased trade mark registration **m** 678189 “PETER PAN” and other registered trade marks from Regent Investment Fund Ltd (the previous
30 registered proprietors) and the Joint Receivers of the registered user, Waverley Stationery Ltd in or around August 1994. In connection with the PETER PAN mark, Mr Reid exhibits a number of packs of greeting cards which he says have been marketed throughout the preceding two years under the mark. Although the greeting cards do not carry the mark PETER PAN, the mark is used on the packaging, together with a declaration that PETER
35 PAN is a trade mark of J R Reid Printers, Blantyre.

Also exhibited to Mr Reid's declaration are two letters addressed to the registered proprietor's solicitors Ness Gallagher & Company. The precise wording of these two letters has been criticised by the applicant for revocation in these proceedings, and I therefore find it appropriate to reproduce the wording of these letters. The first is signed by Mr Gavin Wilson, manager of Burns The Stationers, at 40-42 Union Street, Larkhall. It reads:

Dear Mr Ness

I have been asked by J R REID PRINTERS to confirm to you that we have been supplied with 'Peter Pan' cards and paper on various occasions over the last two years.

We find that as the 'Peter Pan' clearance range basically sells at very low prices the items we receive are usually cleared quickly.

Yours faithfully

Gavin Wilson, Manager

The second letter is signed by Freda Johnstone, Manageress of Wishaw Printing Company, 84 Stewarton Street, Wishaw. Ms Johnstone writes:

Dear Mr Ness

We have been asked to confirm to you that we have been supplied with social stationery for resale bearing the name 'Peter Pan' on several occasions by Rhapsody Stationery of Blairgowrie over the past two years.

It would seem that the 'Peter Pan' brand is used on occasions to sell off slow moving or end of range cards previously sold under the company's main 'Rhapsody' brand name. We have also had 'Peter Pan' writing sets for children containing paper and envelopes, which sell well due to the cheap price level.

Yours sincerely

Freda Johnstone, Manageress

Mr Reid clarifies the reference to Rhapsody Stationery in Ms Johnstone's letter by explaining that Rhapsody Stationery is a subsidiary of the J R Reid Printing Group. (The applicant for revocation has criticised these letters, pointing out that in each case the writer merely repeats that he/she has been asked to confirm - ie they do not go to confirm what they have been asked to confirm.)

Applicant for Revocation's Evidence

The evidence filed on behalf of the applicant for revocation comprises statutory declarations by Ms Dona Selby dated 7 May 1997 and 15 October 1997 (this latter being evidence-in-reply), and Mr Roy Lane dated 6 May 1997.

5 Ms Selby's first declaration primarily concerns the results of research commissioned by her company into the circumstances of the Wishaw Printing Company Ltd. Her evidence establishes a connection between Wishaw Printing Company Ltd and the registered proprietor. In actual fact, it shows that John Robertson Reid is the sole director and the majority shareholder of both companies. The remainder of Ms Selby's first declaration is taken up with
10 submissions rather than evidence, and to the extent that I need to refer to it, I will do so later in this decision.

In her evidence-in-reply, Ms Selby is somewhat critical of the registered proprietor's evidence; indeed this second declaration also contains more submissions than evidence. For example, Ms Selby points to the lack of invoices in the registered proprietor's evidence. She says:

15 "One might expect invoices to be available for sales of products which took place as recently as in the last two years."

Mr Lane's Evidence

Mr Lane is a Research Manager employed by The Carratu International Group Ltd. His evidence concerns enquiries he made on behalf of Carpmaels & Ransford to determine the use
20 or non-use of the trade mark PETER PAN by the registered proprietor. Mr Lane says (in a letter to Carpmaels & Ransford exhibited to his declaration):

25 "We have spoken to the general sales manager, David McCallum, who states he has no knowledge of the mark ever being used and is not part of the company range. Another member of staff who gave her name as Grace McNiere said that there had been company takeovers etc. in the past and Peter Pan may have been used by one of the old companies. However, she further said that J R Reid do not have any details, brochures, printing plates etc., showing the Peter Pan range."

Registered Proprietor's Main Evidence - Rule 13(5)

30 The registered proprietor filed a further statutory declaration by Mr Reid under rule 13(5). In addition to making a number of submissions regarding the applicant's evidence, Mr Reid confirms that the mark PETER PAN has been used on social stationery products that are sold off from time to time at low prices to boost sales of slow moving items and for clearance of old stock — especially items previously sold under his company's main brand name
35 RHAPSODY. He says that it was decided that this new marketing scheme should be tested locally using two outlets, Burns the Stationers in Larkhall and Wishaw Printing Company in Wishaw. He accepts that his company's use of the mark has been limited, but he maintains

that the use has been genuine. Responding to criticism of the wording in Ms Johnstone's letter, Mr Reid says:

5 "... after carefully re-reading the letter there is nevertheless in my view a clear implication that her Company has been supplied with "PETER PAN" branded social stationery for resale over the past two years."

(Emphasis added)

(At this point I will simply note that "a clear implication" falls some way short of evidence. However, for reasons which I shall give below, I am not too concerned with the wording used in these letters.)

10 Mr Reid goes on to say that the information reported by Roy Lane concerning conversations with his company's Sales Manager, David McCallum, and Grace McNiere is "totally misleading". More specifically, he says that Mr McCallum, who is no longer with the company:

15 "... was based at the Blantyre factory and was not directly concerned with marketing of the social stationery products dealt with by the Rhapsody Stationery Division in Blairgowrie. As far as I can ascertain, it seems likely that Mr Lane, when he contacted my Company, indicated initially only that he had a sales query and he would naturally have been directed to Mr McCallum. However, when it became apparent that the enquiry related to social stationery, the only information available to Mr McCallum would have been that in the Rhapsody Stationery brochure and he would have been completely unaware of the limited marketing of the "PETER PAN" social stationery products ..."

(Emphasis added)

Regarding Ms McNiere, Mr Reid says:

25 "... she also is at Blantyre and is concerned mainly with business stationery products such as ledgers. She, like Mr McCallum, would not be in a position to give information about marketing of social stationery products, especially the "PETER PAN" social stationery cards, etc."

That concludes my review of the evidence.

30 These proceedings are brought under Section 46(1)(b) of the Act. This section reads as follows (I have included subsection (a) as well because it explains the reference to "such use"):-

"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;

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

Section 100 of the Act is also relevant, as it explains where the overall burden of proof rests in relation to the question of use. It reads:

5 “**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.”

The registered proprietor does not rely upon proper reasons for non-use as a defence against revocation. Thus there are essentially two parts to the question that must be answered before I can reach a decision in this matter. On the one hand I need to establish from the evidence
10 the **extent** of the use that has been made of the mark PETER PAN in relation to the goods, in the relevant period; in this case the relevant period is the five years immediately preceding 11 December 1996 when the application for revocation was filed. If some use is proven, then I need to go on and consider whether the use has been **genuine**.

15 The only evidence of use provided by the registered proprietor is a declaration of use made by Mr Reid, and supported by two letters exhibited to Mr Reid’s statutory declaration filed under rule 31(3). Rule 31(3) of the Trade Marks Rules 1994 requires that where an application for revocation is based on the ground of non-use, the proprietor shall file evidence of the use by
20 him of the mark within the period allowed for the filing of a counter-statement. This is an extra round of evidence that **only** applies in non-use revocation actions. If nothing else, the evidence filed under rule 31(3) should provide an applicant for revocation with a starting point for his own evidence. In this respect, the evidence required under rule 31(3) overcomes the recognised problem under the old law whereby an applicant for revocation had the difficult and time-consuming task of having to prove a negative; whereas if a trade mark is in fact being
25 used it is a straightforward matter for the proprietor to demonstrate this¹.

Whilst I can accept that the evidence filed under rule 31(3) may have been suitable for the purposes of that rule, I am not persuaded that it satisfies the substantive burden placed on the registered proprietor by section 100. To begin with, the letters exhibited to Mr Reid’s
30 declaration are merely letters signed by their respective authors. They are not sworn statements from those people, and as such they are unsubstantiated. The applicant for revocation has not had an opportunity to challenge the statements made in the letters by cross-examination of the respective authors since the two people concerned have not given evidence on oath in these proceedings. For these reasons I cannot place any significant reliance on the statements made in either of the two letters exhibited to Mr Reid’s declaration, and I therefore
35 disregard them entirely. The only evidence of use which remains, is Mr Reid’s declaration that the mark has been used on a limited scale throughout the two years prior to the date of his first statutory declaration, ie 20 March 1997. The registered proprietor has provided no indication of the quantity, or value, of sales under the mark. Neither, as Ms Selby points out, are there any invoices to support Mr Reid’s declaration.

¹“Reform of Trade Marks Law”; HMSO; September 1990; Cm 1203

A similar situation existed in the NODOZ case². The registered proprietor in that case relied upon evidence of a single sale to establish use. Wilberforce J's comments appear to be relevant to the matter before me. At page 7 lines 34 to 51 he says:

5 “The respondents are relying upon one exclusive act of user, an isolated act, and there is nothing else which is alleged or set up for the whole of the 5 year period. It may well be, of course, that in a suitable case one single act of user of the trade mark may be sufficient; I am not saying for a moment that that is not so; but in a case where one single act is relied on it does seem to me that that single act ought to be established by, if not conclusive proof, at any rate overwhelmingly convincing proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, and it does not seem to me that the evidence which I have heard, which is that an order was received many thousands of miles away in San Francisco or Missouri, and that steps were taken within the company to have the order executed, is sufficient evidence to satisfy the onus which is required.”

(Emphasis added)

15 I can see no reason why the principle enunciated by Wilberforce J in the Nodoz case above should not continue to apply under the Trade Marks Act 1994. In particular I have emphasised the words “...*the fewer the acts relied on the more solidly ought they to be established*”. In relation to the PETER PAN trade mark, the registered proprietor admits that the use has been on a limited scale, but the evidence in these proceedings which is intended to

20 establish such use is almost non-existent.

On the other hand, the applicant for revocation has provided evidence from Mr Lane that the registered proprietor's Sales Manager said he had no knowledge of the mark PETER PAN ever being used. I find Mr Reid's explanation that his company's Sales Manager would have been completely unaware of the limited marketing of the “PETER PAN” products surprising

25 to say the least. The quantity of sales under the mark may have been low, but as this was a new marketing scheme designed to boost sales of slow moving items and for clearance of old stock, and given that it was being piloted locally, I would have expected the company Sales Manager to have had some knowledge of it.

In all the circumstances, I conclude that the registered proprietor has failed to establish that trade mark **m** 678189 - PETER PAN - has been put to genuine use in the relevant period.

30 The application for revocation succeeds accordingly and I therefore order that registration **m** 678189 be revoked. The application having succeeded I order the registered proprietor to pay to the applicant the sum of **£750** as a contribution towards the cost of these proceedings.

Dated this 17th day of July 1998

35 **Mr S J Probert**
Principal Hearing Officer
For the Registrar, the Comptroller-General

² NODOZ Trade Mark 1962 RPC1