

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 10115
BY ANGLIAN WINDOWS LIMITED FOR
REVOCATION OF TRADE MARK No 1366888
IN THE NAME OF WILLIAM KNIGHT**

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trade mark No 1366888 in the name of
William Knight

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DECISION

15 Trade mark No 1366888 is registered in Class 16 for "paper and paper articles; cardboard and
cardboard articles; magazines; brochures; newsletters and news sheets; printed publications".
The mark is ANGLIAN MODE. It is registered in the name of William Knight.

20 By application dated 7 May 1998 Anglian Windows Ltd applied for this registration to be
revoked on the ground that the mark has not been used in this country at any time during a
continuous period of five years up to the date of three months prior to the date of the
application for revocation.

25 The registered proprietor filed a counterstatement denying the above ground and asking that
the Registrar exercise her discretion to maintain the registration.

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

30 Both sides filed evidence. Neither side has requested a hearing. Acting on behalf of the
Registrar and after a careful study of the papers I give this decision.

BACKGROUND

35 The background to this case is that the applicants for revocation have an application of their
own which has the subject mark cited against it. Various attempts were made by the
applicants for revocation to reach an accommodation with the registered proprietor by means
of a letter of consent or possible purchase/assignment of the registration. In the event the
parties were unable to find a mutually acceptable way forward and the applicants for
revocation elected to commence this action. A substantial amount of evidence has been filed
particularly by the applicants for revocation detailing the background which I have referred to
40 briefly above. The story is told from Anglian Windows' perspective by Paul Trevor Kellett,
the Divisional Technical Director of their manufacturing division and from their trade mark
agents' perspective by Keith Wilfrid Nash of Keith W Nash & Co. Mr Knight has acted for
himself throughout and put on record his own position. There is in fact a large measure of
agreement on the background circumstances but different interpretations of the parties'
45 intention and motives.

The background material makes interesting reading but I have to say that I regard the lengthy accounts of the parties' activities prior to the filing of the application for revocation as being of marginal relevance only. Once the application had been filed I can only determine the matter on the basis of those facts that are relevant to the provisions of Section 46 of the Act dealing with revocation of registration. For that reason I do not intend to place on record the usual summary of the evidence but will largely confine myself to Mr Knight's statement of the position insofar as it bears on the revocation action (see below). It seems to me in any case that the applicants do not dispute his version of events but rather draw on it in support of their own case.

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For the record the evidence before me consists of affidavits and statutory declarations as follows:

15	William Knight	-	dated 18 August 1998
	Paul Trevor Kellett	-	dated 2 November 1998
	Keith Wilfrid Nash	-	dated 9 November 1998
	William Knight	-	dated 9 February 1999
	Keith Wilfrid Nash	-	dated 6 May 1999
	Keith Wilfrid Nash	-	dated 14 May 1999
20	William Knight	-	dated 11 May 1999
	Keith Wilfrid Nash	-	dated 17 February 2000

Although I have indicated that I consider a large amount of this evidence to be directed towards issues which do not assist me in dealing with the application for revocation I nevertheless confirm that I have read and given careful consideration to all the evidence filed.

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The applicants base their attack on Section 46(1)(b) which reads:

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

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(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;

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

I have included sub-paragraph (a) because it explains the reference to 'such use' in sub-paragraph (b).

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Section 100 is also relevant and 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."

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The applicants refer to a period of five years up to the date three months prior to the date of the application for revocation. The relevant period is thus 7 February 1993 to 6 February 1998.

5 Mr Knight, the registered proprietor, after setting out his qualifications and background puts his position as follows:-

10 "The business name *Priory Publishing* together with the single regional magazine title *East Anglian Mode* was purchased from a Mrs. Jean Syble Turner of Priory Lane, Toft Monks, Beccles in September 1988 in the total sum of £15,000.

15 Around that time, a firm of Patent Agents in Norwich had mentioned the Registration in the light of the then-recent Copyright Designs & Patents Act 1988. Accordingly, after changing the magazine title to *Anglian Mode*, applications were made in November 1988 via chartered patent agents for the registration of trade names *Anglian Mode* and *Priory Publishing*.

20 After a lengthy correspondence over almost two years, the proposal to register Priory Publishing was unsuccessful. However, the *Anglian Mode* application succeeded and the Registry Certificate dated 23 November 1990 bears the following endorsement:

25 **[The Trade Mark Shown has been registered in part B of the Register under No. 1366888 as of the date 13.12.1988 in Class 16 in respect of: Paper and paper articles; cardboard and cardboard articles, magazines, brochures, news letters and news sheets; printed publications; all included in Class 16 in the name of William Knight. Registration of this mark shall give no right to the exclusive use, separately of the words "Anglian" and "Mode".]**

30 Publication of *Anglian Mode* continued until Issue No. 2, Vol. IV of the magazine was published in July 1991. Preparations for subsequent issues were already well advanced, but disaster struck on 31 July '91 when our elder son was involved in a fall from a high ladder, though most thankfully, after a long period of convalescence he managed to make a complete recovery. Shortly afterwards however, our elder
35 daughter was to leave the family team to be married and work with her husband in France.

40 By this time the effects of the economic recession had seriously affected the publishing industry causing large numbers of magazines and publications - including *Anglian Mode* to be "shelved" until the return of an improved financial climate. In any event it was hoped that by the arrival of my 'official' state retirement date in June 1993, *Anglian Mode* would have been an ideal 'part-retirement' project and by which time publication might have been resumed. However due to client requirements for specialist skills in re-development of former industrial brownfield sites I continue to
45 remain in professional practice.

5 Meanwhile however, still with the express intention of resuming publication of *Anglian Mode*, and at a cost of £250, Registration of Trade Mark No. 1366888 was renewed on 21 December 1995 in Class 16 for a period of 10 years from 13 December 1995 and was advertised as renewed in Trade Mark Journal 6113. Additionally, application was made for the name and address of the undersigned to be the registered address for service and advertised in Journal 61116 (sic) on 13 March 1995.

10 Clearly, the undersigned would not have renewed the registration had it not been the intention to resume publication of *Anglian Mode*, since in the event of the registration being lost, the whole time-consuming and expensive process of obtaining a new trade mark would have had to be re-commenced from stage one.

15 During February '98 Messrs. Keith W. Nash & Co, of Cambridge made an approach as to whether I would consent to their Clients Anglian Windows Application. It was explained however that regional magazines such as *Anglian Mode* often contained advertisements from firms supplying House Improvements, including conservatories and replacement UPV Glazing. It was therefore thought that there could be scope for confusion.

20 In all the circumstances however, it has been made clear to the Applicants that if it would assist in obtaining their objectives, the writer would endeavour to agree a reasonable figure for the sale of the *Anglian Mode* magazine title and trade mark at a figure which would enable acquisition of a suitable replacement magazine title."

25 On the basis of the statement made in his first affidavit (and subsequently confirmed in his later evidence) it is clear that the mark ANGLIAN MODE was at one time used on the title of a regional magazine but that publication ceased after Issue No 2 Vol IV in July 1991. There has been no resumption of use since that date. On that basis if actual use was the only defence available to the registered proprietor I would be forced to conclude from the above statements
30 alone that the application was successful.

Before leaving the matter of use of the mark and considering the further issues that arise there is one further point on which I should comment in relation to use. In his third declaration Mr Knight says that:

35 "Use of the Trade Mark is not confined to publication of a magazine. For example, after registration of the Trade Mark, the "With Compliments" slips in regular use by Priory Publishing have contained a logo which includes the words Anglian Mode."

40 He exhibits an example of such a compliment slip. There is no indication as to the date when such compliment slips were in use or that the reference to Anglian Mode is to some other goods (and if so which) sold under the mark. In my view it can only refer to the magazine but as the magazine was not being published after July 1991 continued reference to it on
45 compliment slips is not evidence of genuine use. I note that the applicants' response to the use of Anglian Mode on compliment slips is to suggest that had they been aware of it before they would have advised that the request for rectification (sic) should be restricted to printed publications, magazines, brochures, newsletters and news sheets. If by that they are

acknowledging a trade in compliment slips (paper articles) then that seems to me to misconstrue the nature of the usage. There is simply no evidence that the registered proprietor has ever traded in goods other than the magazine which was last published in 1991.

5 There are three further aspects of the case to be dealt with - the first is Mr Knight's reference to an intention to resume publication of ANGLIAN MODE; the second is whether proper reasons for non-use can be said to have existed; and thirdly the matter of the Registrar's discretion.

10 Taking these points in order Mr Knight expands on his general claim that he intends to resume publication of the magazine (and hence use of the mark). In his second declaration he exhibits three letters from authors/potential contributors to the magazine. Mr Knight's replies confirm that ANGLIAN MODE is 'on ice' but that it is intended to resume publication. Though I do not doubt the genuineness of Mr Knight's intentions the fact of the matter is that Section 46(1)
15 makes no provision for intention to use as a defence in an action of this kind. It follows also that the mere fact that the registration was renewed in 1995 does not assist.

Section 46(1) does on the other hand provide an exception to the consequences of a non-use finding where proper reasons for non-use are held to exist. It seems that it was not until
20 Mr Knight's third round of evidence that proper reasons for non-use were formally claimed though it is fair to say that the circumstances on which he relies were referred to in his earlier rounds of evidence. I note also that his counterstatement refers to recessionary conditions (one of the circumstances relied on). In any event the applicants have not objected to the point being considered.

25 Although Mr Knight does not expressly list the circumstances he regards as constituting proper reasons for non-use I infer from his evidence that two sets of circumstances arise. Firstly the family circumstances including his son's accident and his daughter's departure to France and secondly the economic recession affecting the publishing industry.

30 I will deal firstly with the family circumstances. It seems that Mr Knight's son's accident took place in July 1991 and that it was followed by a lengthy period of convalescence. Whether this extended to or beyond February 1993 (the commencement of the relevant five year period) is not stated. Nor is the extent of his son's involvement with the magazine made clear.
35 Mr Knight (the registered proprietor) says that he covered his son's professional cases until his return to the office. I assume 'cases' refers to other aspects of the family business which covers commercial property consultancy, corporate acquisitions and disposals and publishing. Mr Knight's son is said to have made a complete recovery so I am unable to reconcile his accident over eighteen months prior to the start of the relevant period with any claim that it
40 could constitute a proper reason for non-use up to February 1998.

I have a similar difficulty in accepting that the departure of Mr Knight's daughter to France (also in 1991 I think) should have represented a long term obstacle to continuation or
45 resumption of publication of the magazine. Mr Nash in his second declaration refers to a telephone conversation with Mr Knight when the latter said that his daughter had been involved in the publishing business. Mr Knight replies to the point in his own evidence by saying that his daughter's work involves electronic artwork and publishing activities and that

"there would be no difficulty in sending her work by electronic means in respect of any of our publications should this be required". It seems therefore that there is a tacit acknowledgement that the move to France was not an insuperable obstacle to the daughter's continued involvement in the business. It follows that I do not accept that any of these family
5 circumstances constitute proper reasons for non-use over such an extended period.

That leaves the issue of recession in the publishing industry. The applicants challenge this claim and say that there is no good and sufficient evidence of any economic recession such as to have affected Mr Knight's ability to publish the magazine during the period at issue. The
10 applicants point by way of example to the continued publication of a number of other local interest magazines in the East Anglian area. This in turn has sparked a response from Mr Knight that the magazines in question are monthly publications in contrast to ANGLIAN MODE which was an occasional (and not subscription based) publication. I do not find it necessary to record this debate in any greater detail as I am not persuaded that it comes close
15 to assisting the registered proprietor.

In INVERMONT Trade Mark, 1997 RPC 135 the hearing officer considered the meaning of the term 'proper reasons for non-use' and contrasted it to the term 'special circumstances in the trade' used in the preceding Act. He commented as follows:
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"Moreover, the word "proper" appears, rather than the slightly more restrictive word "special". The reasons do not have to be 'special', it seems, merely "proper". As can be seen in any English dictionary, 'proper' is a word with many meanings. But bearing in mind the need to judge these things in a business sense, and also bearing in mind the emphasis which is, and has always been placed on the requirement to use a trade mark or lose it, I think the word proper, in the context of section 46 means:- apt, acceptable, reasonable, justifiable in all the circumstances.
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Viewed in this light, I think it is clear enough that the reasons give by Mr. Denholm are not 'proper' in the sense required. He describes difficulties which by his own admission are normal in the industry concerned and in the relevant market place. I do not think the term 'proper' was intended to cover normal situations or routine difficulties. I think it much more likely that it is intended to cover abnormal situations in the industry or the market, or even perhaps some temporary but serious disruption affecting the registered proprietor's business. Normal delays occasioned by some unavoidable regulatory requirement, such as the approval of a medicine, might be acceptable but not, I think, the normal delays found in the marketing function. These are matters within the businessman's own control and I think he should plan accordingly.
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Therefore, I do not find that in this case the registered proprietor had any proper reasons for the non-use, during the relevant period."
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The circumstances in INVERMONT were of course somewhat different but the above extract gives useful general guidance on the principles to be applied.

45 Although it might be said that economic recession is not within a businessman's own control anyone entering business does so in the knowledge that a variety of commercial and economic factors are at various times going to have an effect on trading activity. Thus economic

downturns, the cyclical nature of some industries, exchange rate movements, interest rate variations and the like can impact on a business to a greater or lesser extent. In my view such factors constitute part of the normal range of risks that must be accepted as part and parcel of running a business. Even if such influences are proven to have existed during a given period
5 (and there is no evidence on the recession point here and even Mr Knight talks of it in terms of "the first half of the current decade") they do not constitute a proper reason for non-use of a trade mark over an extended period of time. To put the matter another way if such factors were held to be proper reasons for non-use then most proprietors faced with a revocation action would be able to point to some extenuating economic circumstance during a five year
10 period which has impacted on their business. The eighth recital to the Directive (89/104/EEC) on which the Trade Marks Act 1994 is based makes it clear that a trade mark must be used or be liable to be revoked. I do not think it is in keeping with the principle thus established that a proprietor should be able to defend his registration on the basis of non-use arising from the normal range of economic circumstances which provide a constantly changing backdrop to
15 any commercial activity. I do not, therefore, accept that proper reasons for non-use exist whether Mr Knight's reasons are considered individually or collectively.

Finally I note that Mr Knight's counterstatement asks for the Registrar to exercise her discretion in his favour. I do not know if he was intending thereby to raise or re-open a point
20 of law. The question of whether the Registrar has an overriding or general discretion in revocation cases has been considered in a number of cases with two Registry hearing officers coming to different conclusions on the matter (see *INVERMONT* Trade Mark 1997 RPC 125 and *ZIPPO* 1999 RPC 173). More recently the question has been the subject of a High Court decision by Mr Justice Neuberger in *Premier Brands UK Ltd v Typhoon Europe Ltd* and
25 another (unreported at the time of writing but the judgment is dated 21 January 2000 under reference CH 1998-P-5726). I do not propose to record the full text of the part of the judgment dealing with the point but for the benefit of the parties in this case the following are his concluding remarks:

30 "I do not find it surprising that two members of the Trade Marks Registry come to different conclusions on this difficult point. With diffidence, I have reached the conclusion that the view expressed in *ZIPPO* [1999] RPC 173, namely that there is no discretion, is to be preferred. For reasons I have given, I do not find any of the reasons supporting either view particularly strong. However, it does seem to me
35 somewhat odd if the legislature has specifically provided for no revocation in the event of there being good reason for the non-use, but nonetheless has left the Court with a residual discretion, particularly without giving any indication as to what factors should be taken into account when exercising that discretion. Further, consideration of the combined effect of Section 46(1)(c) and (d) suggest to me that it is more likely that the
40 legislature intended that those two paragraphs were to represent mandatory, rather than discretionary, grounds for revocation. Section 46(5) and Article 13 tend to point in favour of the conclusion I have reached. The words "may" in Section 46(1) and "liable" in Article 12 are perfectly consistent with the concept of revocation being
45 mandatory but only occurring in the event of an application being made. I also bear in mind that it is not only a privilege for a person to be the proprietor of a registered trade mark, but it represents a monopoly: the Court should not be too ready to perpetuate a monopoly in favour of a person who has not done anything to promote or

enjoy it for a period of five years. Decisions of the ECJ to which I have referred show that a major purpose of the trade mark legislation is to protect those who have expended time, effort, ingenuity and money in disseminating a trade mark and building up goodwill in relation to it. It seems to me that the obverse of this approach is that a person who does not use a trade mark for five years or more should lose it."

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I regard myself as being bound by the view that there is no discretion to exercise. In the event, therefore, the revocation is successful. I order that the registration be revoked in its entirety. As no earlier date has been specified the registration will be revoked with effect from 7 February 1998.

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There remains the matter of costs. As the applicants for revocation have been successful they are entitled to an award in their favour. I have given careful consideration to what that award should be particularly as Mr Knight has on several occasions suggested that the applicants' behaviour has been oppressive. On my reading of both sides' evidence I have to say that I do not agree with Mr Knight. On the contrary the applicants and their professional representative seem to me to have behaved perfectly properly and have made reasonable efforts to reach an accommodation with Mr Knight. I see no reason why they should not have an award of costs based on the published scale. I order the registered proprietor to pay the applicants the sum of £635. This sum 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.

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Dated this 19 day of May 2000

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30 M REYNOLDS
For the Registrar
the Comptroller-General