

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 10520  
BY AMERICAN CYANAMID COMPANY  
FOR REVOCATION OF TRADE MARK No B1281083  
STANDING IN THE NAME OF  
LABORATORIES ARKOPHARMA S.A.

## **DECISION**

1) The trade mark A TO ZINC is registered under number B1281083 in class 5 of the register in respect of “Pharmaceutical, veterinary and sanitary substances, infants’ and invalids’ foods; all included in Class 5 and all containing zinc.” The registration of the mark gave no right to the exclusive use, separately, of the letter “A” and the word “Zinc”.

2) The application for registration was made on 3 October 1986 and the mark was placed on the register on 13 October 1989. The registration was originally in the name of Laboratories Arkochim, but was assigned on 24 November 1997 to Laboratories Arkopharma S.A. of Zone Industrielle, 06510 Carros, France.

3) By an application dated 8 January 1999, American Cyanamid Company applied for the revocation of the registration under the provisions of Section 46(1)(b). The grounds stated that the mark has not been put to genuine use in the UK in relation to “vitamin, mineral or dietary supplement products” within the five years and three months prior to the date of the application. Further, they state that there are no proper reasons for such non-use.

4) The applicant also states that the registered proprietor has been aware for some time that an application to revoke the mark might be made, and so any commencement or resumption of use within the three months preceding the application for revocation should be disregarded in accordance with Section 46(3).

5) On 15 April 1999 the registered proprietor filed a counterstatement stating that the mark registered had been used in relation to the goods for which it is registered including “vitamin, mineral or dietary supplement products” within the last five years. The proprietor asked for the refusal of the request for revocation of registration. Both sides seek an award of costs. Only the registered proprietor filed evidence in this case.

6) At the hearing, on 7 June 2001, the registered proprietor was represented by Mr Pritchard of Counsel instructed by Messrs Edward Evans & Co. The applicant for revocation was represented by Ms Carboni of Messrs Linklaters.

## **REGISTERED PROPRIETOR’S EVIDENCE.**

7) The registered proprietor filed a declaration by Michael Domenico Bilewycz, an employee of their Trade Mark Attorneys. Mr Bilewycz states that the UK is an important market for his client and that it has registered a number of other UK trade marks including the mark number 2050845 for “AZINC” in Class 5.

8) At exhibit MDB2 Mr Bilewycz provides “two sample packages relating to the registered proprietor’s multi vitamin and mineral capsules and bearing the trade mark A TO ZINC”. The packaging shows the AZINC trade mark and then a description of the product. Underneath the description are the words “From A to Zinc”. The boxes are not dated but have an address of Coulsdon, Surrey.

9) At exhibit MDB3 Mr Bilewycz provides a series of documents including an invoice and shipping document both dated 3 April 1998 relating to the AZINC product. It is claimed that the mark in suit also appears on this packaging. Both the shipping note and invoice are primarily in French, with no translation provided, and appear to be addressed to the company’s Surrey address.

10) Mr Bilewicz states that exhibit MDB4 is:

“A printout illustrating a sales analysis for the AZINC complex products from 1 January 1994 to 8 April 1999 and the sales figure over that period is encircled. Also found in exhibit MDB4 is a copy of a letter received from our clients which, inter alia, advises us as to the turnover figures related to AZINC complex since 1 January 1994.”

11) The print out is in French with no translation provided. The figure encircled is “3177.24”. The letter attached is dated 12 April 1999 which states that the print out gives a sales figure for the period 1 April 1994 - 8 April 1999 of Frs. 3177,00.

12) That concludes my review of the evidence. I now turn to the decision.

## DECISION

13) The ground of revocation is based on Section 46(1)(b) which 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;*

14) Where the registered proprietor claims that there has been use of the trade mark, the provisions of Section 100 of the Act makes it clear that the onus of showing use rests with him. 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.”*

15) The relevant period has been explicitly specified in this case and is the five years ending three months prior to the date of the application for revocation 7/10/93 - 6/10/98.

16) My attention was drawn to a number of reported cases. In relation to the meaning of the term genuine use and issues to do with substantiality of use Mr Pritchard referred me to headnote 4 of *ZIPPO* Trade Mark [1999] RPC 173:

“(4) The word “genuine” as used in section 46 of the Trade Marks Act 1994 was not intended to have a material effect on previous practice in relation to non-use of a trade mark. Substantiality (or degree) of use continues to be a factor in deciding whether use of a mark was genuine. However, where it was established that a mark had been used, and the genuineness of use was not in question, detailed consideration of substantiality served no purpose....”

17) However, Ms Carboni referred me to *BON MATIN* [1989] RPC 537 at page 543 where Whitford J. commented:

“The main argument on the appeal centred around the question as to the extent to which one must consider the substantiality of the use. Various authorities can be cited, pointing in different directions. I suppose in the interest of Mr Morcom’s clients perhaps one of the earliest and most favourable applications is that which is to be found in Official Ruling 61 RPC which was concerned with the question of a despatch to the United Kingdom of a sample of the product to be sold under the registered trade name which it was held might be regarded as a use of the trade mark in the United Kingdom. I was not taken to the Official Ruling as such but it is to be found referred to in a judgement which was given by Dr R.G. Atkinson, then acting for the Registrar in *VAC-U-FLEX* Trade Mark (1965) FSR 176. There is no doubt that Dr Atkinson did consider a number of earlier authorities. To my mind what plainly emerges from the authorities is this, and Mr Morcom did not attempt to shirk the point, the substantiality of the use is undoubtedly a relevant factor to be considered and at the end of the day one has got to consider every relevant factor. It must always be remembered that what one is directed to by Section 26 of the Act is the question as to whether there has been any bona fide use. Although the extent of the use is a factor which may be of significance, some of those factors may lead to the conclusion that although the use could not in the commercial sense be described as anything other than slight, nonetheless it may be appropriate to reach a conclusion, in the light of the circumstances as a whole, that the use ought to be regarded as bona fide.”

18) I accept that the *Bon Martin* case was concerned with the Trade Marks Act 1938 where the statutory language in Section 26 focussed on whether or not the use had been “bona fide”, whereas under the new law the reference in Section 46 of the 1994 Act is to “genuine use”. However, in my view no substantial change in the law has been brought about by the different use of language and the above remarks are still apt in relation to the new law. Therefore, despite the comments in *ZIPPO*, substantiality is a factor to be considered within the overall test of genuineness and not a separate hurdle that a registered proprietor must overcome. I rely upon the

comments of Jacob J. in *Euromarket Designs Inc. v Peterson & Another* 25 July [2000] ALL ER(D) 1050. The learned judge said that:

“It seems to me that “genuine use” must involve that which a trader or consumer would regard as a real or genuine trade in this country. This involves quantity as well as the nature of use. In part it is a question of degree and there may well be cases on the borderline. If that were not so, and Ms Vittoria were right, a single advertisement intended for local consumption in just one US city in a journal which happened to have a tiny UK distribution would be enough to save a trade mark monopoly in this country. Yet the advertisement would not be a “sham”. This to my mind shows that Ms Vittoria’s gloss on the meaning of “genuine” is not enough. And the only stopping place after that is real trade in this country.”

19) The applicant does not ask for the registration to be revoked in its entirety. They claim only that the mark in suit has not been used on “vitamin, mineral or dietary supplement products” for a period of five years. The only evidence filed is from a UK Trade Mark Attorney who does not claim to have access to the books and records of the registered proprietor. The only evidence of use offered was:

i) At exhibit MDB2 are two samples of packaging which have a UK address on them and which feature the phrase “From A to Zinc” underneath the main trade mark of AZINC. It is not stated that the product was sold in the UK in such packaging, rather it is inferred that this happened.

ii) Two documents purported to be an invoice and a shipping note are provided at exhibit MDB3. The documents are mainly in French although parts are in English. The “invoice” refers to “AZINC CPLX” and is dated 3 /4/98. Mr Pritchard asserted that this refers to the AZINC complex product, the packaging for which was exhibited as referred to above. The invoice appears to be for a total of 1656 GBP which it was claimed referred to Great Britain Pounds. The “shipping document” has a date of 3/4/98 upon it and again a reference to “AZINC CPLX”.

iii) At exhibit MDB4 is another document also in French. It is accompanied by a letter from the proprietor’s Legal Department in London stating that the document relates to sales figures of AZINC complex products for the period 1 January 1994 - 8 April 1999. The sales figure shown is FF3177.24, which at current rates I have calculated this as approximately £300.

20) Commenting on this documentation Mr Pritchard asserted that:

“We say, if you look at those documents and read paragraph 7 it is not a large step, we say, to accept at all, to say that they are good evidence, on the balance of probabilities here, it may be not beyond reasonable doubt, on the balance of probability, here is evidence that this A TO ZINC complex was imported into the UK.”

21) Section 100 of the Act places a clear responsibility on registered proprietors to make out their

case. The balance of probability can only be assessed by reference to the evidence filed, not the evidence that could have been filed.

22) My attention was also drawn to the NODOZ case {1962} RPC 1. In which Mr Justice Wilberforce dealt with the issue of the onus of proof on the registered proprietor. He said:

“ 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 five year period. It may well be, of course, that in a suitable case one single act of user of the trade mark is 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 conclusive proof. It seems to me that the fewer the acts relied on the more solidly ought they to be established, .....

23) The registered proprietor has filed two documents dated 3 April 1998 which it claims are an invoice from the French parent company to the UK subsidiary and also the shipping note. However, these documents are primarily in French with only parts being in English. Without being able to read the whole of the documents I cannot accept that these offer conclusive proof. They have also filed a letter from the proprietor's Legal Department in London. This is written in English and states that the sales of the AZINC complex product amounted to approximately £300 in a five year period. This figure is significantly lower than the amount claimed to be shown on the “invoice”. It is not categorically stated that these sales were in the UK, although this clearly is the inference.

24) The facts contained within the letter from the proprietor's legal department could have been included in a statutory declaration, affidavit or witness statement as per Trade Mark Rule 55. By not doing so the registered proprietor cannot ask for this letter to be given equivalent weight as evidence of the facts therein, particularly as the signatory to the letter does not reveal the source of his data and it is not consistent with the “invoice” at MBD3.

25) On the basis of the above I do not accept that any AZINC products marketed in the UK during the relevant period had the mark “A to Zinc” upon them. Mr Bilewycz makes no such claim as he has no direct knowledge. All that he states is that “A to Zinc” appears on the undated examples in MBD2.

26) If I am wrong in concluding that there is no evidence of use of “A to Zinc” during the relevant period at all, then at best the registered proprietor has shown sales of approximately £300 in the UK in the relevant period of the product AZINC.

27) No details have been given of any promotional activity such as advertising which was undertaken. No details were provided regarding the cost of a packet or bottle of the AZINC Complex tablets. However, from my own experience such items are rarely less than £1 per pack. This would mean that only approximately 300 packs were sold in 5 years and three months.

28) Neither side has commented on the size of the market for such goods but I take judicial note that the market for vitamin tablets and dietary supplements runs into billions of pounds per annum,

although what percentage of this market relates to products containing Zinc is less obvious.

29) The packaging of the product shows that the mark AZINC is the dominant feature. The mark in suit is found in what appears to be a strap line "From A to Zinc" in smaller print lower on the packet. Whilst this is not a common phrase I doubt that the average consumer would see this as a trade mark and certainly would not expect to "pick out" the relevant words to form a trade mark. If it were seen as signifying anything it would probably be seen as a play on the phrase "From A to Z" substituting the letter Z by the word Zinc as the product is a zinc complex tablet. The fact that the word complex appears would denote to the average consumer that the product contains a cocktail of vitamins and minerals to supplement their normal intake so as to ensure that they received their recommended daily allowance.

30) Even if I were to be persuaded that the average consumer would see the words "From A to Zinc" as the trade mark in suit, then the level of sales is so minimal that I could not accept that it constitutes genuine use.

31) Given the very specific nature of the revocation action, the proprietor had no reason not to file clear, unambiguous evidence of use of the mark in relation to the goods under attack. I have come to the view that the registered proprietor has failed to discharge the onus that is placed on them by Section 100 of the Act. Subject to any appeal against this decision, and in accordance with Section 46(5), the specification of the trade mark No B1281083 will be amended to:

"Pharmaceutical, veterinary and sanitary substances, infants' and invalids' foods, but not including vitamin, mineral or dietary supplement products; all included in Class 5 and all containing zinc." The registration of the mark shall give no right to the exclusive use, separately, of the letter "A" and the word "Zinc".

32) The application for revocation succeeds. I order the registered proprietor to pay the applicant the sum of £1235. 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.

Dated this 14<sup>TH</sup> day of August 2001

George W Salthouse  
For the Registrar  
The Comptroller General