

O-381-09

**TRADE MARKS ACT 1994
IN THE MATTER OF REGISTRATION NO. 1083447
IN THE NAME OF BAKER STREET CLOTHING LIMITED
FOR THE TRADE MARK ALLIGATOR
REGISTERED IN CLASS 25**

AND

**IN THE MATTER OF AN APPLICATION FOR REVOCATION
UNDER NO. 82546 IN THE NAME OF
LA CHEMISE LACOSTE (SA)**

Trade Marks Act 1994
IN THE MATTER OF registration No.1083447
in the name of Baker Street Clothing Limited
for the trade mark ALLIGATOR registered in Class 25

And

IN THE MATTER OF an application for revocation
under No. 82546 in the name of La Chemise Lacoste (SA)

BACKGROUND

1. On 9 September 1977, Alligator Clothing Company Limited applied to register the trade mark ALLIGATOR in Class 25. The application was registered on 15 September 1982 for the following specification of goods:

Raincoats and articles of waterproof and showerproof clothing.

2. On 26 April 2004 an assignment of the registration to Baker Street Clothing Limited was recorded.

3. On 5 July 2006, La Chemise Lacoste (SA) filed an application under Sections 46(1)(b) seeking revocation of the registration with effect from 4 July 2006, the basis for the application being that the mark has not been put into genuine use by the proprietor (or with their consent) within the period 4 July 2001 and 4 July 2006.

4. The applicants filed a Counterstatement in which they assert that the mark has been put to genuine use in the relevant period and deny the grounds of the application.

5. Both sides filed evidence which, insofar as it may be relevant I have summarised below. The matter came to be heard on 10 November 2009, when the Applicants were represented by Mr Roger Grimshaw of Mewburn Ellis LLP, their trade mark attorneys. The registered proprietors were represented by Mr Alan Morris of Kuit Steinart Levy LLP. their attorneys.

EVIDENCE

Registered Proprietor's evidence

6. This consists of two Witness Statements. The first is dated 19 October 2006 from Gary William Anthony Johnston of William A Shepherd & Son, the registered proprietor's trade mark attorneys in these proceedings. Mr Johnston says that he is authorised to provide the Witness Statement, the contents of which are either facts within his personal knowledge or have been provided by the registered proprietor.

7. Mr Johnston recounts that on 15 July 2003 he received a telephone call from Mr Joel Brown, a Director of Baker Street Clothing Limited, enquiring about ALLIGATOR which he describes as an old brand "that had been used for many years but which was no longer in use". He says that Mr Brown was looking into the possibility of his company securing the

mark. Mr Johnston gives details of his investigations into Alligator Clothing Company Limited, the proprietor of the ALLIGATOR trade mark registration No 1083447, which revealed that the company had been dissolved on 3 October 2000. He says that the Liquidators for Alligator Clothing Company Limited had relinquished their duties in relation to the dissolution of the company and that for all intents and purposes the trade mark was in the possession of Her Majesty's Treasury. He says that he was instructed to find out if the trade mark was bona vacantia, the Treasury directing him to the Solicitors for the Affairs of the Duchy of Lancaster. The trade mark was acquired from the Duchy of Lancaster by way of a Deed of Assignment dated 19 March 2004. The Assignment to Baker Street Clothing Limited was recorded on the register showing the effective date as stated.

8. Mr Johnston says that during various discussions with Mr Brown during the period 2003 through 2004 it became obvious to him that Baker Street Clothing Limited had a real and firm intention to put the ALLIGATOR brand into use. He cites the acquisition of this trade mark registration and another registered in Class 35 as evidence of this intent. Mr Johnston goes on to refer to Mr Brown and others from Baker Street Clothing Limited making a presentation on ALLIGATOR branded clothing to Debenhams and Cecil Gee in November 2005. Exhibits GWAJ1 and GWAJ2 are provided as photographs of items said to have been presented, the latter exhibit said to show the garments in "mock-up" format. The photographs in the first exhibit depict a range of jackets and overcoats. Although labels can be seen in some, it is not possible to see if they bear the ALLIGATOR name. The second exhibit shows a similar range of coats and jackets but this time with neck labels bearing the name ALLIGATOR.

9. Mr Johnston next refers to Exhibit GWA3 which consists of letters from Seth Harrington of Moss Bros Group PLC, the parent of Cecil Gee, and Adam Creasey, Divisional Trading Director of Debenhams.

10. The letter from Seth Harrington is dated 13 November 2005 and is addressed to Joel Brown of Baker Street Clothing. This thanks Mr Brown for meeting on the 10th, confirms that the concept for the ALLIGATOR brand is "interesting" and the "initial view of the product proposed looks exciting." Mr Harrington says that he has spoken with the relevant buyer within Cecil Gee, recommending that Mr Brown or his team make contact when they are a position to progress further.

11. The Debenhams letter is dated 13 October 2006. It refers to the presentation of the new ALLIGATOR brand of casual jackets, coats and leisurewear and whilst Debenhams cannot at this stage confirm any commitment to this new brand, there is sufficient interest for them to consider it for next season. The letter closes stating that Debenhams look forward to confirmation of the prices and delivery options as soon as possible.

12. Mr Johnston concludes his statement saying that the evidence shows that following the acquisition of the trade mark the registered proprietor has made preparations to bring the brand to the market within the five-year period of non-use claimed.

13. The second Witness Statement is dated 4 March 2009 and comes from Alan Ian Morris, a solicitor and member of Kuit Steinart Levy LLP. Mr Morris confirms that the contents of his Statement come either from his own knowledge or from the records of his firm to which he has full access.

14. Mr Morris states that his firm has been Solicitors for Joel Brown and Baker Street Clothing Limited for many years. He confirms the purchase of the ALLIGATOR trade mark in 2003. Mr Morris says that he was familiar with the ALLIGATOR name from its use on rainwear and casual wear although not how this comes to be. He recounts being informed by Mr Norman Satinoff (part of the family that owned the Alligator Company) that the brand had been used from the first World War until the late 1970s, and that the ALLIGATOR brand had been particularly well known in the 1960s and 1970s when it had concessions in House of Fraser and Debenhams stores, collaborated with Mary Quant and advertised in Vogue magazine.

15. The remainder of Mr Morris's Statement is a repetition of the Statement by Mr Johnston. It does not add anything and I therefore do not propose to include this in my summary of the evidence.

16. That concludes my review of the evidence insofar as it may be relevant to these proceedings.

DECISION

Preliminary issue

17. There is a question over the period of non-use. In a revocation action brought under Section 46(1)(b) asserting non-use for a five year period which does not coincide with the date of the application, revocation can only take place on a day after the expiry of the claimed period of non-use. The application states the period of non-use to be 4 July 2001 to 4 July 2006, which by my reckoning is 5 years and one day. The applicant's request is for revocation to take effect from 4 July 2006, which means that the five year period will run from 4 July 2001 to 3 July 2006.

The Law

18. 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)

(d)

(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).....

(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.”

19. Section 100 of the Act is also relevant and reads:

“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.”

20. The two leading authorities on the guiding principles to be applied in determining whether there has been genuine use of a mark are: *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5, from which I derive the following main points:

genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

the use must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);

the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);

the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);

but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);

an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);

there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

21. Mr Grimshaw argued that there is a strict onus on the proprietor to prove genuine use in the relevant period on the goods for which the mark is registered, his point being that in revocation proceedings the evidence must be analyzed quite closely. He took me to two decisions, firstly *Kabushiki Kaisha Fernandes v OHIM* [2003] ETMR 93, which at paragraph 47 stated:

"In that regard, it must be held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned".

and also to *La Mer* [2002] FSR 51 at paragraph 9, where Jacob J made the same point saying that those concerned with proof of use should read the proposed evidence with a critical eye to ensure that use is actually proved, all the Ts should be crossed and all the I's dotted. Mr Grimshaw questioned whether the evidence filed meets these strict requirements. It must be kept in mind that Jacob J did not suggest, however, that the standard of proof was anything other than the normal standard.

22. It cannot be denied that the evidence is thin and requires a degree of construction to get to what it establishes. However, whilst bearing in mind the cases referred to by Mr Grimshaw, I am also mindful of the guidance given by Mr Richard Arnold QC sitting as the Appointed Person (as he then was) in the *Extreme* trade mark case, [2008] R.P.C. 24. In this he held that it in the absence of positive evidence of non-use it was not correct to impose a standard of

proof requiring the provision of "certainty" and "conclusive evidence". Mr Arnold QC further stated that the standard of proof applied is the ordinary civil standard of proof upon the balance of probabilities. When applying this standard, the less probable the event alleged, the more cogent the evidence had to be to demonstrate that it did indeed occur.

23. Mr Arnold QC also stated that where evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged, nor challenged his evidence in cross-examination, nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then the rule in *Brown v Dunn* applies. It is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence. Making submissions about previously unchallenged evidence amounts to cross-examination of the witness in his absence.

24. Mr Morris confirms that he was informed by Mr Norman Satinoff (part of the family that previously owned the Alligator Clothing Company) that ALLIGATOR had been used from the First World War until the late 1970s and had been particularly well known in the 1960s and 1970s. Whether or not this is the case, and there is no evidence to assist, this is many years prior to the acquisition of the trade mark by the present owners and the relevant period for these proceedings. Consequently, there must be a question of whether any more than a distant recollection of the brand name continued to exist when Baker Street Clothing Limited came on the scene in 2003.

25. Mr Johnston says that it was obvious to him that the registered proprietor had a real and firm intention to put the ALLIGATOR brand into use, in support citing the acquisition of the registration and the filing of further applications to register ALLIGATOR. Notwithstanding the fact that this is no more than a personal opinion, a contrary view could be that having acquired the ALLIGATOR mark the proprietors knew that they were not going to put it into use and filed the applications as a fall back against any attempt to revoke the registration.

26. The evidence of use relates to two presentations that Mr Johnson says were made to Debenhams and Cecil Gee in November 2005. A number of photographs have been exhibited which Mr Johnson says are of jackets/overcoats that were part of these presentations. He describes the first set as "stock garment photographs" although does not explain what this means. I suggested that the photographs were of clothing that the registered proprietor held in stock but that were not necessarily (at least at the time of the photographs) ALLIGATOR branded. Whatever is the case it is not possible to make out the labels bear the ALLIGATOR name and Mr Johnson does say one way or the other.

27. The second set are said to show the jackets/coats in "mock-up" format. These have labels bearing ALLIGATOR that Mr Grimshaw suggested were possibly printed and attached to the garments, either for photographing or for the presentation. He did accept that one label appeared to be sewn in. That they are described as being mock-ups support this contention. That said, I put it to Mr Grimshaw that it did not matter how the labels were attached, the relevant question is whether they were there when the garments were presented.

28. The final exhibit consists of letters from Debenhams and Cecil Gee. These refer to the presentations that Mr Johnston says took place in November 2005. A letter from Seth Harrington of Cecil Gee, dated 13 November 2005, thanks Mr Brown for meeting on the "10th". A letter dated 13 October 2006 from Adam Creasey of Debenhams also refers to a

presentation but does not do so by reference to the date on which this occurred. Mr Grimshaw submitted that the letter from Debenhams was probably obtained following the commencement of these proceedings, and given its date it could well be referring to a presentation that took place outside of the relevant period. It is quite clear from paragraph 4 of Mr Johnson's Statement that the letter is provided as evidence to support that a presentation took place in the November 2005. Both letters mention ALLIGATOR so remove any doubt as to whether the brand had been exposed during the presentations.

29. The applicants primarily focus their argument on the apparent insignificance of the use shown, saying that even if not token it is nonetheless insufficient to be deemed genuine. Mr Grimshaw pointed to the fact that the photographs are not all of different garments but a number of different views of five garments, also questioning whether the goods are actually covered by the specification for which the mark is registered. The photographs provided as Exhibits GWAJ1 and GWAJ2 are of goods that are said to have been part of the presentations so any use revolves around these. They depict what I would describe as jackets, overcoats and/or raincoats, all of which are perfectly capable of being waterproof and/or shower-proof. However, these goods do not reflect the full extent of the specification of the registration which covers waterproof and shower-proof clothing at large. Accordingly, accepting that this is the extent to which genuine use has been shown the registration should be revoked in respect of all goods other than "raincoats", and "jackets/coats" which to remain within the scope of the specification must be qualified as "waterproof and shower-proof".

30. On the first of these points, use need not be quantitatively significant for it to be deemed genuine, but the fewer the instances of use, the more conclusive the evidence must be. The letters provide a degree of certainty to the registered proprietor's claims to having made presentations of ALLIGATOR branded goods. There is nothing that suggests that the proprietors were aware of a potential attack on the registration and the presentations undertaken in a token attempt to thwart a possible application for revocation. This use may not have come into contact with the end consumer, but was nonetheless 'on the market'.

31. Following the presentations Mr Harrington and Mr Creasey both express interest in the ALLIGATOR products, leaving the ball in the registered proprietor's court, Mr Harrington recommends that contact be made when Baker Street Clothing Limited are a position to progress further. Mr Creasey says that his company would consider the ALLIGATOR brand for the next (2007?) season, and that Debenhams look forward to confirmation of the prices and delivery options as soon as possible. There is no evidence of any activity following the presentations which took place but nine months prior to the relevant date. It obviously takes time to put goods into production but I am unsighted as to whether it would be reasonable to expect evidence of further progress during such a period.

32. My view is that taken on its face and at its best, the evidence collectively establishes that in November 2005 the registered proprietors were making preparations to secure customers and create a market share for their clothing and that this should be considered to satisfy the requirements for there to be genuine use.

33. I therefore find that the registration should be revoked with effect from 4 July 2006 in respect of all goods other than:

"Raincoats; jackets, coats, all being waterproof or showerproof"

34. The application for revocation has therefore been successful in part. The applicants sought revocation of the registration in its entirety. The registered proprietors in turn sought to defend the whole registration which given the circumstances was unrealistic. On this basis I consider it appropriate not to make an award of costs

Dated this 9th day of December 2009

**Mike Foley
for the Registrar
the Comptroller-General**