

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for revocation of the registration of Trade Mark No. 149294 and in the matter of the Registered Proprietor's opposition thereto.

HIGH & MIGHTY LIMITED

Applicant for Revocation

ARNOTTS LIMITED

Registered Proprietor

The registered trade mark

1. Arnotts Limited of 12 Henry Street, Dublin 1 is the registered proprietor of the trade mark HIGH AND MIGHTY, which is registered under No. 149294 in Class 25 in respect of articles of clothing, headgear and footwear. The application for registration of the mark was filed on 19 May, 1992 under the Trade Marks Act, 1963 and, by virtue of Section 27 (1) of that Act, the mark is registered as of that date, which is deemed to be the date of registration. Publication of the registration of the mark appeared in Journal No. 1735 on 1 June, 1994.

Application for revocation

2. On 29 September, 2004, High & Mighty Limited, a British company, of 3 Riverside House, Mill Lane, Newbury, Berkshire RG14 5QS, United Kingdom, applied under Section 51 of the Trade Marks Act, 1996 (the Act) for revocation of the registration of the mark and included with the application a statement of the grounds on which it was made.
3. On 4 April, 2005, the Proprietor filed a Notice of Opposition to the application for revocation together with evidence of the use that had been made of the mark.
4. The matter became the subject of a hearing before me, acting for the Controller on 18 January, 2006. The parties were notified on 7 February, 2006 that I had decided to uphold the application and to revoke the registration of the mark. I now state the grounds of my decision and the materials used in arriving thereat.

Grounds of the application

5. In its Statement of Grounds in support of the application for revocation, the Applicant asserts that,
 - (i) within a period of five years following the date of publication of the registration, the trade mark was not put to genuine use in the State, by or with the consent of the Proprietor, in relation to the goods for which it is registered, and there are no proper reasons for such non-use, and
 - (ii) use has been suspended for an uninterrupted period of five years and there are no proper reasons for such non-use.
6. It therefore seeks revocation of the registration of the mark from the date being five years following the completion of the registration procedure or, in the alternative, from the date of the application for revocation.

Notice of Opposition and evidence of use

7. In its Notice of Opposition to the application for revocation the Proprietor states that the trade mark has been put to genuine use in the State in relation to the goods for which it is registered and provides, by way of evidence, a Statutory Declaration (and Exhibits A-D) dated 1 April, 2005 of Barbara Manning, Company Registrar of the Proprietor.
8. In her Declaration, Ms. Manning states that the Proprietor sells a range of goods for larger sized customers under the trade mark HIGH AND MIGHTY, that it has sold and extensively promoted products under the mark in its department store during the preceding five years and that its principal supplier of goods sold under the mark is a company called Saville Heaton. She exhibits 4 photographs demonstrating the manner of use of the mark, a statement of sales figures for products sold under the mark in the years 2003 and 2004, lists of products obtained from Saville Heaton in the period 1999-2004 and some internal memos bearing dates between January, 2001 and November, 2004 and relating to “special offer” type promotions of clothing sold under the mark.

The hearing

9. At the hearing the Applicant for revocation was represented by Mr. Shane Smyth, Trade Mark Agent of F. R. Kelly & Co. and the Proprietor by Mr. Paul Coughlan, BL instructed by Tomkins & Co., Trade Mark Agents.

10. Mr. Smyth asserted that the onus was on the Proprietor to show that it had made genuine use of the mark within the relevant period and that it was for the Proprietor to adduce unambiguous evidence of actual use of the mark on the relevant goods. In his submission, Ms. Manning's Statutory Declaration and accompanying exhibits fell well short of what is required. In particular, he argued that the Declaration was worded in such a way as to avoid any claim that the mark was ever actually affixed to any items of clothing, footwear or headgear sold by the Proprietor and nor did the exhibits show any such use. The only exhibit that showed actual use of the mark was the photographs, which are dated after the application for revocation was filed and should, therefore, be deemed inadmissible. In any event, he said, the photographs show the use only of a sign bearing the words HIGH & MIGHTY and apparently designating an area within the Proprietor's department store and do not show the use of the mark on the relevant goods. As to the other exhibits, Mr. Smyth asserted that the trade mark appears on none of these other than the internal memos and that its use on same was internal to the Proprietor and did not constitute use in trade in the sense intended by the Act.

11. In response, Mr. Coughlan asserted that Ms. Manning's Declaration, when looked at in its totality and given its ordinary meaning, is to the effect that the Proprietor has sold "extra large" size clothing under the registered trade mark within the relevant period. That claim is supported by photographic and documentary evidence that is more than sufficient to discharge the onus of proving, on the balance of probabilities, that there has been genuine use of the mark. It is bizarre to suggest that any use of the mark has been merely internal to the Proprietor in circumstances where the mark is prominently displayed in the Proprietor's department store. The mark has been used in relation to the relevant goods in the sense that those goods have been offered for sale under the mark. The Act does not define what is meant in Section 51 by the words "*use in relation to goods*" but guidance may be taken from Section 14(4)(b),

which states that use of a sign includes “*offering or exposing goods for sale, putting them on the market or stocking them for those purposes under the sign*”. The rights given by registration include the right of the Proprietor to prevent another undertaking making such use of its mark and it would be unreasonable to say that a Proprietor that had, itself, made such use of its mark had not made genuine use of it for the purposes of the Act.

The law

12. The relevant parts of Section 51 of the Act, insofar as the present application is concerned, read as follows:

“(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 publication of the registration, the trade mark has not been put to genuine use in the State, by or with the consent of the proprietor, 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;*

.....

(2) For the purposes 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 State includes affixing the trade mark to goods or to the packaging of goods in the State solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in paragraph (a) or (b) of subsection (1) 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; but, for this purpose, any such commencement or resumption of use occurring after the expiry of the five year period and 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.

.....

(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 Controller is satisfied that the grounds for revocation existed at an earlier date, that date. ”

The issue to be decided

13. The publication of the registration of this trade mark occurred on 1 June, 1994. The application for revocation was made on 29 September, 2004. Those dates define the start and finish, respectively, of the “the relevant period” for the purposes of the present application. The question to be decided is whether there was genuine use of the mark in relation to the goods of the registration within that period and, if so, whether that use was suspended for an uninterrupted period of five years and not recommenced within the relevant period. That is a question both of fact and of law: the factual aspect - *what use, if any, was made of the mark?* the legal aspect – *does that amount to genuine use in relation to the goods?*

The factual aspect

14. As regards the facts of the matter, I think the picture that emerges from Ms. Manning’s Statutory Declaration, and exhibits, is fairly clear. During the relevant period, the Proprietor maintained an area within its department store, which it designated “HIGH & MIGHTY” by means of a sign or signs prominently displayed and bearing that title. Within that area, the Proprietor displayed for sale articles of clothing for larger sized customers (“XL” sizes). The clothing articles in question were not of the Proprietor’s manufacture and did not carry the trade mark HIGH AND MIGHTY attached to them on swing tickets or sewn-in labels. They included a number of different brands including Saville Heaton, Bruhl, Prestige, Douglas, Oakman, Bugatti, etc.. The Proprietor’s employees identified the “HIGH & MIGHTY” area of the store as a separate and discrete collection of clothing articles

and referred to the range of clothing in question by that name in memoranda relating to targeted sales promotions.

The legal question

15. The Act does not specify what is meant by the words “*genuine use in relation to the goods*” in Section 51. Subsection (2) of the Section states, *inter alia*, that use of a trade mark includes use in a form that does not alter its distinctive character and, so, the fact that the mark appears to have been used as “HIGH & MIGHTY” as opposed to “HIGH *AND* MIGHTY” is not significant. The matter that is really in dispute is whether the use of the mark in the manner described constitutes use *in relation to the goods* of the registration. In this regard, the decision of the European Court of Justice (ECJ) in Case No. C-40/01, *Ansul BV and Ajax Brandbeveiliging BV*, is relevant, notwithstanding that, in that case, the ECJ was concerned specifically with the question of what constitutes *genuine* use of a mark. It stated that,

“.... there is 'genuine use' of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.”

16. In this case, the question does not turn on whether the use made of the mark was “genuine”, in the sense that the evidence does not suggest that the use was negligible in volume or extent, that it was token or contrived or that it was purely internal to the Proprietor. Nevertheless, the words of the ECJ are relevant insofar as they confirm that, for a trade mark to have been used in relation to goods, that use must be in accordance with the essential function of a trade mark, namely, to identify the origin

of the goods in question. Use in that manner may be expected to have the effect of creating and preserving for the proprietor of the trade mark a share in the market in the relevant goods.

17. When considered in that light, I think it is obvious that the Proprietor has not used this trade mark in relation to the goods for which it is registered, viz., articles of clothing, footwear and headgear. The clothing items sold within the HIGH & MIGHTY area of the Proprietor's store are identified and distinguished, one from the next, by their respective brand names and the use of those brand names as trade marks for the relevant items serves to create and preserve for their respective proprietors a share in the clothing market. So, for example, the average customer who purchases from the Proprietor a Douglas shirt in an extra large size, which he has seen displayed in the HIGH & MIGHTY section of the Proprietor's store will, on a subsequent occasion, rely on the trade mark DOUGLAS to identify items of the same manufacture and, depending on whether or not he was pleased with the shirt he purchased previously, he may or may not choose to buy another of that make. He would not, however, rely on the trade mark HIGH AND MIGHTY to identify a garment of the same origin as that which he previously purchased. To the extent that that mark may have penetrated his consciousness at all, his experience of it will have informed him that it is the name by which the Proprietor designates a variety of brands of clothing in extra large sizes that it displays together for the convenience of its larger sized customers.

18. The bringing together, in this manner, of a variety of goods enabling customers to conveniently view and purchase them may be described as a form of retail service and the use that the Proprietor has shown in relation to the trade mark HIGH AND MIGHTY could be said to be use of it in relation to such a service. Indeed, it may be assumed that the use of the mark has resulted in the Proprietor securing a share of the market in the retailing of clothing, specifically extra large clothing. The mark may be expected to have become known to certain of the Proprietor's customers as designating the area of the Proprietor's store where they may find clothing to suit their needs. It is an attractive and effective mark in that it alludes to the fact that the clothes sold within the particular area of the store are for larger sized customers but it does so in a positive way – FAT & FLABBY might not be expected to work quite so

well! But it has not been used as a trade mark for the actual articles of clothing themselves. Although it has been displayed in physical proximity to clothing items sold by the Proprietor, it has not functioned to identify the commercial origin of those items and to distinguish them from goods having a different commercial origin. The goods themselves have been identified by their respective brand names and there is no evidence to suggest that the collection of them together under the HIGH & MIGHTY sign has in any way diluted the effect of those brand names or diminished their capacity to distinguish the goods of their proprietors. Indeed, the very way in which the trade mark HIGH AND MIGHTY has been used is such as to inform the Proprietor's customers that it is *not* a mark that identifies a specific brand of clothing, because a range of different brands are sold under it. That does not constitute use of the mark *in relation to* articles of clothing any more than the name over the door of a public house functions as a trade mark for beer.

19. I must refer briefly to the argument, mentioned at paragraph 11 above, advanced on behalf of the Proprietor and based on Section 14(2)(b) of the Act. That argument was to the effect that the Proprietor, having used the mark in a manner that would constitute infringement if done by a third party, must be regarded as having made genuine use of the mark. In my view, that argument must fail for two reasons. Firstly, subsection (4) of Section 14 provides that, *for the purposes of that Section*, use of a sign includes the uses specified in the subsection. As a matter of construction, therefore, the statement of what constitutes use of a sign is limited in effect to Section 14 only and does not affect the question of what constitutes use of a trade mark for the purposes of Section 51. Secondly, to suggest that a Proprietor of a registered trade mark makes genuine use of the mark if he exercises one of the exclusive rights given to him by that registration is to confuse the rights accruing to a Proprietor upon registration of his mark with the responsibilities that he must discharge in order to maintain that registration as valid. These proceedings are concerned with the latter consideration and the plain statement of Section 51 is that a registered trade mark must be used in relation to the goods for which it is registered, failing which the registration is liable to be revoked. Determination of an application for revocation requires consideration, therefore, of the use that the Proprietor has made of the registered mark and such an application cannot be decided by reference to the provisions governing infringement.

Conclusion

20. For the reasons that I have stated, I find that the Proprietor has not shown any use of the registered trade mark in relation to the goods for which it is registered. The registration must be revoked accordingly and all that remains to be decided is the effective date of the revocation. In its application for revocation, the Applicant sought revocation of the registration from the date being five years following the completion of the registration or, in the alternative, from the date of the application for revocation. At the hearing, Mr. Smyth suggested that, if I were to find that there had been no use of the mark in relation to the goods of the registration, the registration might be revoked with effect from the date of completion of the registration process, i.e., the date of publication of the registration. That would not be in order for two reasons. Firstly, it was not pleaded in the application for revocation and there was no request to amend same. Secondly, and more importantly, the registration of a trade mark may only be revoked if grounds for revocation exist and the earliest effective date of a revocation is the first day on which such grounds existed. Grounds for revocation of a registration cannot exist until five years have elapsed since the publication of the registration and there has been no use of the trade mark in relation to the goods or services for which it is registered. In the present case, therefore, the earliest date on which grounds for revocation could have existed was 1 June, 1999 and, in the absence of any evidence of use of the trade mark in relation to the goods of the registration, I am satisfied that such grounds did exist on that date and that the registration must be revoked with effect from that date.

Tim Cleary

Acting for the Controller

7 March, 2006