

TRADE MARKS ACT, 1996

Decision in Hearing

IN THE MATTER OF an application for revocation of the registration of Trade Mark No. 206175 and in the matter of the Registered Proprietor's opposition thereto.

CAMPINA NEDERLAND HOLDING B.V. - Applicant for Revocation

JOSEPH STEWART & CO. - Registered Proprietor

The registered trade mark

1. Joseph Stewart & Co., an unlimited company of Corn Mills, Boyle, Co. Roscommon, is the registered proprietor of the series of trade marks NUTRIFEED/NUTRI-FEED, which is registered under No. 206175 in Class 31 in respect of the following specification of goods:

Agricultural, horticultural and forestry products and grains included in Class 31; fresh fruits and vegetables; foodstuffs for animals.

2. The application for registration of the mark was filed on 27 June, 1997 under Section 37 of the Trade Marks Act, 1996 (the Act) and, by virtue of Section 45(3) of the 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. 1874 on 6 October, 1999.

Application for revocation

3. On 22 February, 2006, Campina Nederland Holding B.V., of Hogeweg 9, 5301 LB, Zaltbommel, The Netherlands, applied under Section 51 of the Act for revocation of the registration of the mark. It stated that investigations conducted on its behalf had failed to establish any use of the mark and it alleged, accordingly, that the mark had not been used or that any use of it had been suspended for a continuous period of five years.

4. On 26 May, 2006, the Proprietor filed a Notice of Opposition to the application and, on 10 August, 2006, it filed evidence of its use of the mark in the form of a Statutory Declaration (and Exhibits NS1 and NS2) dated 4 August, 2006 of Neil Stewart, a Director of the Proprietor. He says that the Proprietor supplies a comprehensive range of high performance animal feeds and that it has used, and continues to use, the trade mark in relation to all of the goods covered by the registration. In support of these assertions, he exhibits (a) photographs of two lorries bearing the name JOSEPH STEWART together with the trade mark, which is depicted interwoven with a device above the words “Premium ANIMAL FEEDS” and, (b) a 10-page product information leaflet also bearing the trade mark and device.

5. The application for revocation became the subject of a hearing before me, acting for the Controller, on 29 March, 2007 at which the Applicant for revocation was represented by Mr. Cliff Kennedy, Trade Mark Agent of MacLachlan and Donaldson and the Proprietor by Ms. Roseanne Mannion, Trade Mark Agent of Cruickshank and Co.. The parties were notified on 4 April, 2007 that I had decided to grant 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 in response to a request in that regard filed on 25 April, 2007 by the Applicant for revocation.

The law and the issue to be decided

6. Section 51 of the Act provides for the revocation of the registration of a trade mark in certain circumstances, including if it has not been put to genuine use in the State, by or with the consent of its proprietor, in relation to the goods for which it is registered within five years following the publication of the registration or, alternatively, if any such use has been suspended for an uninterrupted period of five years. In the present case, the relevant period is from 6 October, 1999 (date of publication of the registration) to 22 February, 2006 (date of application for revocation) and the first question to be decided is whether there was genuine use of the mark in the State within that period. If it is found that there was, then the question of whether such use was suspended for an uninterrupted period of five years must be considered. By virtue of Section 99 of the Act, the onus of proving that there was use of the mark within the relevant period lies with the Proprietor.

7. The Act does not define what is meant by “genuine use” but the question was considered by the European Court of Justice (ECJ) in Case No. C-40/01, Ansul BV and Ajax Brandbeveiliging BV. In that case, the ECJ stated,

“.... 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.”

8. I agree with the submission made at the hearing on behalf of the Applicant for revocation to the effect that, in order to determine, in a given case, whether any claimed use of a trade mark constitutes “genuine use” of it within the meaning of that term as expressed by the ECJ, it is necessary to have information concerning the place, time, extent and nature of that use. Furthermore, the information in question must have sufficient evidential value in order to discharge the onus on the proprietor of proving, on the balance of probabilities, that the claimed use actually took place. Subjective statements or claims on the part of a proprietor may not be taken at face value, even when made as part of a statutory declaration and must, if they are to be accepted, be supported by relevant corroborative materials.

Whether genuine use shown by Proprietor’s evidence

9. In my opinion, the evidence filed on behalf of the Proprietor in this case does not come close to discharging the onus of proving that the trade mark in question was used in relation to any goods within the relevant period. No evidence has been given

showing that any goods were sold, offered for sale or advertised under the mark to customers within the State during that period. The simple application of the trade mark to lorries operated by the Proprietor does not, of itself, prove that the mark was used in relation to the goods covered by the registration. There is nothing in the evidence to show that those lorries came to the notice of consumers of those goods within the relevant period in such a way as to create a link in the minds of those consumers between the goods and the trade mark. Nor is there any evidence that the product information leaflet exhibited by Mr. Stewart was ever published or circulated to consumers within the State. Even if given the most generous of interpretations, the materials exhibited by Mr. Stewart do not prove that the Proprietor has ever used the registered trade mark in a manner that might have secured a share in the market for any goods covered by the registration, let alone for all such goods.

10. I have decided, therefore, that the Proprietor has failed to meet the onus of proving that the registered trade mark was used within the relevant period in relation to any of the goods covered by Registration No. 206175 and that the application for revocation must be granted and the registration revoked in its entirety.

Effective date of revocation

11. Subsection (6) of Section 51 provides that, 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 the date of the application for revocation or, if the Controller is satisfied that the grounds for revocation existed at an earlier date, from that date. In the present case, the earliest date on which grounds for revocation could have existed was 7 October, 2004, i.e., upon the expiry of the period of five years following publication of the registration. It follows from my finding that the Proprietor has failed to show that there was ever any genuine use of the mark in respect of any of the goods covered by the registration that the grounds for revocation did, in fact, exist on that date and that the revocation must take effect from that date.

Tim Cleary

Acting for the Controller

1 May, 2007