

O-353-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 83188  
BY THE BIG BAR COMPANY LIMITED FOR REVOCATION  
OF REGISTRATION NO. 2302610 STANDING IN THE NAME OF  
WHOLEBAKE LTD**

## **BACKGROUND**

1. Registration No. 2302610 is for a series of two trade marks, namely: **BAR 9** and **BAR NINE**. It stands registered in the name of Wholebake Ltd Limited (Wholebake). The trade mark was applied for on 12 June 2002 and the registration procedure was completed on 14 March 2003. The trade mark is registered for the following goods in class 30.

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; cereal bars, energy bars, flapjack, breakfast bars, snack bars, cereal breakfast foods; cereals and preparations made wholly or principally of cereals, all for human consumption; prepared meals; prepared snack foods; constituents for such meals and snack foods, bread, biscuits (other than biscuits for animals), cakes.

2. On 19 March 2008, The Big Bar Company Limited (TBBC) applied for revocation of the registration. Their application is made under sections 46(1)(a) and (b) of the Trade Marks Act 1994 (the Act) and is in respect of all the goods of the registration. In their application TBBC say:

“[The registration] has not been put to genuine use in the UK in the form in which it was registered, in connection with the goods in respect of which it was registered.”

They add that their initial investigations indicate that there has been no genuine use of the trade mark since it was registered. Revocation is sought from 15 March 2008 (under section 46(1)(a)) and 19 March 2008 (under section 46(1)(b)).

3. On 10 September 2008 Wholebake filed a counterstatement in which the grounds of the application are denied.

4. Only Wholebake filed evidence in these proceedings which to the extent that I consider it necessary I have summarised below. Both parties seek an award of costs. While neither party asked to be heard, Wholebake’s professional representatives, Bison Rivers, filed written submissions in lieu of a hearing; I will refer to these as appropriate later in this decision. After a careful consideration of all the material before me, I give this decision.

## **EVIDENCE**

### **Wholebake’s evidence**

5. This consists of a witness statement, dated 10 September 2008, from Stephen Jones who has been a director of Wholebake since it was incorporated in December 1996. Mr Jones explains that in 1984 he was the co-founder of a business that was to become Wholebake. While the original business was to produce and sell vegetarian natural foods, in 1987 the business relocated to its current address and shortly after the focus of production switched to sweet baked bars.

6. Mr Jones states that over the years Wholebake has used:

“.. various forms of the word BAR in combination with the number 9 upon its snack products – the word and number being used in juxtaposition above and to the side of each other.”

7. To support this contention he refers to a range of exhibits. These are as follows:

(4) – consists of a Google search dated 9 September 2008 for “bar 9”. Of the 11 hits retrieved only 3 appear to relate to Wholebake. These are as follows: “Wholebake Hemp Seed Bar – 9 Bar - £28.44 – Auravita”, “Wholebake – Great Taste...Naturally – 9 Bar Original...” and “Hemp Seed bars – Wholebake – Great Taste...Naturally 9 Bar Original..” I note that the second and third references are from [www.wholebake.co.uk](http://www.wholebake.co.uk)

(7) – consists of a page showing the history of the website [www.wholebake.co.uk](http://www.wholebake.co.uk) for the period 1996 to 2007 obtained using the Internet Archive tool waybackmachine. It appears that the site first became active in 2000 and was last updated in 2006. This exhibit also contains a range of pages one of which contains, inter alia, the handwritten text: “Aug 23.2000. On this page there are references to: “Hemp Seed Bar, Wholebake Original 9 bar, Nutty 9bar, Fruity 9bars and Organic 9bars”. Mr Jones states that the pages show results dating from 23 August 2001.

(45) – consists of a page taken from the website [www.wholebake.co.uk](http://www.wholebake.co.uk) on 27 February 2008. It refers to a range of hemp seed bars referred to, for example, as “Flax 9bar”.

(46) – consists of an undated leaflet entitled “A Uniquely Nutritious Range of Mixed Seed & Nut Bars with Hemp”. I note that the leaflet contains the numeral and word “9 Bar” presented in a stylised script.

(47), (48) and (49) consist of photographs of packaging of hemp seed bars bearing the numeral and word “9Bar” in the same format mentioned above. Although the pages are undated the words “Best Before: 13/SEP/2007” can be made out on the packaging shown at exhibit (47).

(55) – consists of an advertisement for “9Bar” which is said to have appeared in “You are What You Eat” in February 2006.

(58) – consists of a page taken from “xenos news Issue 5 Winter 2002” which by reference to Wholebake explains: “A North Wales food company that produces over five million cereal bars each year has unveiled ambitious growth plans thanks to an investment through Finance Wales’ xenos Business Angels Network”. The article contains photographs of and makes reference to “9-bar”.

(76) – consists of an extract taken from the website [www.tesco.com](http://www.tesco.com) on 12 May 2008. The extract contains a photograph of the packaging in the same form shown in exhibit (49).

(77) – consists of a further copy of the packaging shown in exhibit (49) and bearing a best

before date of 16 March 2008.

(87) – consists of an extract taken from the website [ocado.com](http://ocado.com) on 8 May 2008. The extract contains a photograph of the packaging in the same form shown in exhibit (49).

(88) - consists of a Google search dated 12 May 2008 for “9 bar”. Of the 10 hits retrieved only 3 appear to relate to Wholebake. These are much the same as those mentioned in exhibit (4) above.

8. Mr Jones says:

“As a consequence of this use, Wholebake is the proprietor of substantial rights in both BAR 9, 9 BAR and variations thereof, which have been continually used throughout the United Kingdom in relation to snack bars since at least as early as 1998. BAR 9, 9 BAR and the variations thereof are very closely similar indeed..”

9. Mr Jones provides details of the on-going dispute between Wholebake and TBBC. While I have noted these background facts, for the purposes of this decision it is not necessary for me to record these details here.

10. Mr Jones then goes on to provide information under the heading “The use, promotion and reputation of the trade mark” by reference to a range of exhibits. The main points arising from which are:

- Wholebake sell snack bars to retailers and advertise these snack bars on their website [www.wholebake.co.uk](http://www.wholebake.co.uk);
- Exhibits (8) and (9) are said to consist of extracts “from our current website showing that the trade mark remains in use for the products.” I note that the extracts provided were downloaded from the website [www.wholebake.co.uk](http://www.wholebake.co.uk) on 8 May 2008. Exhibit 8 refers, inter alia, to “Latest News – 9bar is now available in most major multiples.” Exhibit 9 consists of a range of press releases from the same website with release dates in 2006. I note that the combination “9BAR” features in all of these press releases;
- Exhibit (89) consists of a Google search conducted on 8 May 2008 for “wholebake”. I note that the combination “9Bar” appears in a number of the results;
- Exhibits (70)-(74), (84) and (85) consist of a range of internet searches conducted on either 8 or 12 May 2008 which Mr Jones explains are to show that: “customers are able to purchase our snack products branded with the trade mark from third party websites”. I note that the websites concerned i.e. [www.wholefoodcoop.co.uk](http://www.wholefoodcoop.co.uk), [www.goodnessdirect.co.uk](http://www.goodnessdirect.co.uk), [www.hollandandbarrett.com](http://www.hollandandbarrett.com), [www.responseresource.com](http://www.responseresource.com), and [www.auravita.com](http://www.auravita.com) all mention Wholebake’s “9BAR” snack bar.

11. Mr Jones states:

“In addition to independent retailers, our snack products are sold under the trade mark through retail chains including Tesco, Waitrose, Sainsbury, Morrisons, Asda and Holland and Barrett.”

He provides the following evidence in support:

Exhibits (86) and (87) are extracts from the website [www.waitrose.com](http://www.waitrose.com) and [www.ocado.com](http://www.ocado.com) obtained on 8 and 13 May 2008. The first exhibit confirms that Ocado.com is part of the Waitrose business and the second exhibit contains a photograph of the packaging of Wholebake’s “9Bar” snack bar. Exhibits 15, 19 and 28 consist of invoices from Wholebake to Waitrose dated 30 June 2004, 25 May 2005 and 14 January 2008. I note that all of the invoices contain references to “9bar”.

Exhibits (75) and (79) consist of extracts taken from the websites [www.tescocorporate.com](http://www.tescocorporate.com) and [www.healthandfitnesswebsite.co.uk](http://www.healthandfitnesswebsite.co.uk) on 8 and 12 May 2008. I note that exhibit (79) contains the following text:

“A healthy snack bar made from hemp seed and other natural ingredients has been snapped up by Tesco. 9 Bar, which is produced by Wholebake, will be stocked in 350 Tesco stores nationwide from July 19, 2006.”

Exhibit (32) contains an invoice from Wholebake to Tesco Stores dated 15 February 2008 in relation to the “9bar” product. In addition, Mr Jones explains that the “9bar” product can be bought from Tesco online, and exhibit (76) which consists of an extract from the website [www.tesco.com/superstore](http://www.tesco.com/superstore) downloaded on 12 May 2008 is provided in support. Exhibit (78) consists of a till receipt dated 28 August 2007 obtained from Tesco’s Royston branch which Mr Jones says shows that the snack product bearing the trade mark was purchased from this branch. Having reviewed the till receipt, I note that it contains a reference to Wholebake but not to “9bar”.

12. Mr Jones states:

“Wholebake has sold its products branded with the trade mark to Sainsbury since 2001.”

In support he provides exhibit (80) which consists of an overview of the business of J Sainsbury plc obtained from [www.jsainsbury.co.uk](http://www.jsainsbury.co.uk) on 12 May 2008 together with exhibits (12), (13), (14), (16), (17), (18), (20), (21), (22), (23), (27), (30), (33) and (34) which consist of a range of invoices from Wholebake to Sainsbury dated: 10 April 2003, 7 April 2004, 28 June 2004, 23 December 2004, 7 April 2005, 19 May 2005, 2 December 2005, 31 May 2006, 7 December 2006, 9 May 2007, 28 December 2007, 12 February 2008, 18 February 2008 and 21 February 2008. I note that all of the invoices contain references to “9bar” (or similar).

13. Mr Jones states:

“Morrison sells Wholebake’s products that bear the trade mark”

In support he refers to exhibit (81) which consists of an overview of the business of M Morrisons obtained from [www.morrisons.co.uk](http://www.morrisons.co.uk) on 12 May 2008 and exhibits (24), (26) and (31) which consist of a range of invoices from Wholebake to Morrisons plc dated: 30 May 2007, 20 December 2007 and 14 February 2008. I note that all of the invoices contain references to “9bar”.

14. Mr Jones states:

“Wholebake has sold its products under the trade mark to Asda for a number of years...Additionally, these branded products are sold online by Asda.”

In support he provides exhibit (82) which consists of an extract from the “Frequently asked questions” section of the website [www.about-asda.com](http://www.about-asda.com) downloaded on 12 May 2008 together with exhibits (29) and (35) which consist of a range of invoices from Wholebake to Asda dated: 5 and 22 February 2008; I note that all of the invoices contain references to “9bar”. Also included as exhibit (83) is an extract from the website mentioned above also downloaded on 12 May 2008 in which the “9bar” products are sold by Asda online.

15. Mr Jones states:

“The products bearing the trade marks are sold in each of Holland and Barrett stores are also available online.”

In support he refers again to exhibits (72) and (73) mentioned above together with exhibits (25) and (36) which consist of a range of invoices from Wholebake to Holland & Barrett dated: 26 May 2004, 25 May 2005, 30 November 2005, 30 June 2006, 23 August 2007, 11 December 2007 and 22 January 2008. I note that all of the invoices contain references to “9bar”.

16. Exhibits (37)-(44) consist of invoices to other outlets. These are as follows:

(37) - invoice to Rainbow Wholefoods of Norwich dated 12 December 2003;

(38) – invoices to Essential Trading Coop Ltd of Bristol dated 13 May 2003 and 19 June 2006;

(39) – invoices to Health Food Stores Ltd of Nottingham dated 28 January 2003, 21 May 2003 and 22 May 2007;

(40) – invoices to Community Foods Ltd of London dated 27 April 2000, 16 December 2004, 23 June 2006, 4 December 2006, 6 December 2007, 16 January 2008 and 29 January 2008.

(41) – invoices to Suma Wholefoods of Elland dated 3 July 2002 and 29 January 2008;

(42) – invoices to the Health Store of Nottingham dated 17 March 2003 and 12 May 2003;

(43) – invoices to Brewhurst Health Foods of Byfleet dated 27 April 2000 and 21 December 2001;

(44) – an invoice to Tree of Life of Newcastle under Lyme dated 29 May 2001.

I note that all of the invoices contain references to “9bar” or similar.

17. Exhibits (50)-(60) are said to consist of examples of press coverage. These are as follows:

(50) – a page taken from “hfb” dated June 2004 – mentions “Wholebake’s original 9bar..”;

(51) – a page taken from an unknown publication which carries a handwritten date of June 2004 and which mentions “New from the manufacturers of the 9bar comes the...”;

(52) – appears to be the same as exhibit (51) but in which the date of June 2004 is printed;

(53) – a page taken from [www.thegrocer.co.uk](http://www.thegrocer.co.uk) dated 29 January 2005 and which mentions the “9 Bar hemp seed bar.”

(54) – a page which bears the handwritten phrase “The Home Magazine Oct 2005” and which mentions “9bar – Mixed Seed Bar with Hemp”;

(55) – as described above;

(56)- a page from the May 2006 edition of “You are what you eat” which mentions “Hemp seed 9 Bars from Wholebake..”;

(57) – a page dated 16 May 2007 from a publication the first word of which is “Daily” but in which the second word cannot be seen. The page contains a photograph of a man holding a seed bar with hemp upon which the numeral and letter “9Bar” appears;

(58) – as described above;

(59) – a page dated April 2007 taken from Food and Beverage International which mentions “In the UK, Wholebake has introduced the Wholebake Hemp 9 Bars...”.

(60) - this consists of an article from the Daily Post which bears the handwritten date 2003. The photograph is substantially the same as that which appears in exhibit (57) above.

18. Exhibits (10) and (11) consist of a Certificate of Analysis dated 14 September 2004 provided to Wholebake Ltd by Law Laboratories Ltd of Birmingham and a nutritional Information leaflet which is undated. They contain references to “9 BAR” and “9 Bar” respectively.

19. Mr Jones explains that over the years Wholebake have promoted their products at trade fairs including: Natural Products Olympia, Natural Trade Harrogate, Pharmacy Show NEC, IFE (2007), BBC Good Food Show and Food & Drink Expo.

20. Mr Jones states that turnover figures (exclusive of VAT) for sales by or under the trade mark in the UK from 2000 for the year ending 31 March are as follows:

<b>Year</b>	<b>Turnover (£)</b>
00/01	78,008
01/02	103,099
02/03	108,563
03/04	186,655
04/05	344,792
05/06	502,092
06/07	734,829
07/08	809,875

21. Mr Jones states that the following sums (exclusive of VAT) for the year ending 31 March have been spent promoting the trade mark:

<b>Year</b>	<b>Expenditure (£)</b>
2003	48,434
2004	11,054
2005	22,806

22. Mr Jones concluded his statement in the following terms:

“I believe that I have demonstrated beyond doubt that Wholebake has used its registration since 1998 in relation to snack bars, which have sold for a continuous period of at least 9 years throughout the United Kingdom. 9 BAR, BAR 9 and the various juxtapositions and representations of the word BAR and 9 are all very closely similar and for the purposes of determining the revocation launched by TBBC constitute use of the same trade mark.”

23. That concludes my summary of the evidence filed to the extent that I consider it necessary.

## **DECISION**

### **The Law**

24. 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.”

25. 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.”

### **The relevant five year periods**

26. The application for revocation is based on sections 46(1)(a) and (b) of the Act; the registration procedure for the trade mark in suit was completed on 14 March 2003. The relevant periods are therefore, under 46(1)(a): 15 March 2003 to 14 March 2008 (with revocation to take effect from 15 March 2008), and under 46(1)(b): 19 March 2003 to 18 March 2008 (with revocation to take effect from 19 March 2008).

### **The authorities on genuine use**

27. 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 these cases 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);
- it 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).

28. I must also keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

29. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

30. And finally the comments of the Court of First Instance in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark

to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

### What trade mark has been used?

31. It is at this point I remind myself that Wholebake's registration is for a series of two trade marks i.e. BAR 9 and BAR NINE. At paragraph 22 I reproduced Mr Jones' comments on the variations in the trade marks used. It is not clear whether Wholebake accept that the trade marks they have used differ from those that they have registered and that they are, as a result, relying on the provisions of section 46(2) of the Act i.e. use in a form differing in elements which does not alter the distinctive character of the trade marks in the form in which they are registered. I noted above that that in their application TBBC specifically refer to use of the registration not being "in the form in which it was registered". While Wholebake have not specifically relied on use in a variant form (if this was indeed their intention), this does not, in my view, close the door to such a defence. Rather, it is (if necessary) for me to go on and make that assessment if I reach the conclusion that the trade marks that have been used differ from those for which registration has been granted.

32. In their written submissions Wholebake say:

"In summary, we believe that the use Wholebake has made of variations of BAR and 9 should be sufficient to retain registration of BAR 9 number 2302610.."

I take this to be a concession on Wholebake's part that they have not used the trade mark BAR NINE and no longer resist the request to revoke the registration at least insofar as it relates to this particular form of the trade mark. This appears to me to be a sensible concession; I will as a result only give further consideration in this decision to the trade mark which remains i.e. BAR 9.

33. A careful review of the evidence provided by Mr Jones shows the numeral "9" and word "bar" being used in a range of different formats, for example, "9 BAR", "9 Bar", "9 bar" and as shown in the examples below:





34. In addition, I note that while on occasion the numeral and word are also accompanied by the word Wholebake, they are more often accompanied by a word or words which describe a characteristic of the product concerned such as: fruity, nutty, flax, pumpkin, organic and original. However, the one consistent feature of the trade mark's presentation is that the numeral 9 always precedes the word BAR regardless of the format in which they are presented; I can find no examples in the evidence provided of the trade mark being used in the only remaining form I am now considering i.e. BAR 9. That being the case, I must now go on to determine if the varying forms in which Wholebake have used their trade made fall within the provisions of section 46(2) of the Act.

35. In *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2003] RPC 25 the Court of Appeal dealt with issues relating to use of a trade mark in a form which does not alter the distinctive character of the mark in the form in which it was registered. In that case Lord Walker stated:

"40 These points are uncontroversial, not to say pedestrian, but they do to my mind help to show what is the right approach to the language of s.46(2) of the Act, which is at the heart of the first appeal: "... 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." (This language is word for word the same as the English language version of Art.10.2(a) of the Directive.)

41 The word "elements" can be used, and often is used, to refer to the basics or essentials of a matter. However it can hardly have that meaning in s.46(2), since a basic

or essential difference in the form in which a trade mark is used would be very likely to alter its distinctive character. In s.46(2) "elements" must have a weaker sense (of "features" or even, as Mr Bloch came close to submitting, "details").

42 The deputy judge touched on this and some related points in paras [18- 22] of his judgment. He stated that the elements of a mark must be assessed separately. He also stated (or at least implied) that only some of the elements might contribute to the distinctive character of the mark. He pointed out that the inquiry was as to whether the mark's distinctive character was altered (not substantially altered).

43 I have no wish to be overcritical of the way in which the deputy judge expressed himself, especially since I think he was a little overcritical of the way in which the hearing officer had expressed himself. But I am inclined to think that the deputy judge made the issue rather more complicated than it is. The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?

44 The distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis. The same is true of any striking and memorable line of poetry:

"Bare ruin'd choirs, where late the sweet birds sang"

is effective whether or not the reader is familiar with Empson's commentary pointing out its rich associations (including early music, vault like trees in winter, and the dissolution of the monasteries).

45 Because distinctive character is seldom analysed by the average consumer but is capable of analysis, I do not think that the issue of "whose eyes?-- registrar or ordinary consumer?" is a direct conflict. It is for the registrar, through the hearing officer's specialised experience and judgment, to analyse the "visual, aural and conceptual" qualities of a mark and make a "global appreciation" of its likely impact on the average consumer, who:

"normally perceives a mark as a whole and does not proceed to analyse its various details."

The quotations are from para.[26] of the judgment of the Court of Justice in Case C-342/97 Lloyd Schuhfabrik Meyer GmbH v Klijsen Handel BV [1999] E.C.R. I-3819; the passage is dealing with the likelihood of confusion (rather than use of a variant mark) but both sides accepted its relevance."

36. In *Boura v Nirvana Spa & Leisure Ltd* BL O/262/06 Mr Richard Arnold QC, sitting as the appointed person, stated:

“15. It is clear from BUD and BUDWEISER BUDBRÄU and the four Court of First Instance cases that the normal approach to the assessment of distinctive character applies in this context. As the European Court of Justice has reiterated in numerous cases, the distinctive character of a trade mark must be assessed (i) in relation to the goods or services in question and (ii) according to the perception of the average consumer of those goods or services, who is deemed to be reasonably well-informed and reasonably observant and circumspect.”

37. As Lord Walker pointed out, the first part of the inquiry is for me to identify what are the points of difference between the trade marks as used and the trade mark as registered. The trade mark as registered consists of the word BAR presented in upper case followed by the numeral 9 separated by a space. As I mentioned above, all of the marks used by Wholebake feature, inter alia, these elements albeit with the word BAR (and to a lesser extent the numeral 9) presented in a range of different formats. However, in the evidence the numeral 9 never appears after the word BAR. In addition, the numeral and word are often accompanied by a word or word which describes the characteristics of the goods concerned such as fruity, nutty, original etc.

38. Having identified the differences between the trade marks used and the trade mark registered, the second part of the inquiry requires me to determine by reference to the visual, aural and conceptual aspects of the respective trade marks whether the distinctive character of the registered trade mark as a whole has been altered by the way in which it has been used. This assessment must be made in the context of the goods for which the trade mark has been used, and according to the perception of the average consumer for such goods who is considered to be reasonably well informed and reasonably observant and circumspect, but who normally perceives trade marks as a whole and does not proceed to analyse their various details. The goods at issue are (as described by Mr Jones in his statement) snack bars, the average consumer for which would be any member of the general public.

39. The visual and aural differences between the respective trade marks are obvious. In the registered trade mark the word BAR is the first word the average consumer will see and articulate with the numeral 9 relegated to a secondary position. The reverse is true of the trade mark used where the numeral 9 has the dominant role. Insofar as the word BAR is concerned, I have no doubt that it will be seen by the average consumer as a reference to the goods on which the trade marks have been used i.e. goods sold in bar form. However, it is not clear how the average consumer will perceive the numeral 9. Wholebake's evidence indicates that their use of the numeral is intended as a reference to the 9 essential amino acids the bars will contain; while this reference may be clear to some in the average consumer group it may not be clear to all. From a conceptual standpoint the trade mark as registered is likely, in my view, to convey the image of, for example, the ninth bar in a series (perhaps where the goods are sold in packs of 10 or more), whereas the trade mark as used is more likely, in my view, and as Wholebake intend, to convey the image of a bar containing 9 of something (in this case amino acids). When considered as wholes the trade mark registered and those used differ, in my view, visually, aurally and conceptually. Taken together these differences are, in my view, more than sufficient for me to conclude that the trade marks used differ in elements which alter the distinctive character of the trade mark in the form in which it was registered.

**40. In summary, I have concluded that within the relevant period Wholebake have used a range of trade marks all of which consist of the numeral 9 and the word BAR presented in that order. I have also concluded that the visual, aural and conceptual differences between these trade marks and the trade mark registered i.e. BAR 9, do alter the distinctive character of the registered trade mark and as such do not fall within the provisions of section 46(2) of the Act.**

41. That conclusion is sufficient to dispose of these proceedings. However, in the event that an appellate body disagrees with the above assessment, I shall now go on to determine on what goods the 9 BAR trade mark (and variants thereof) have been used and what constitutes a fair specification.

**On what goods has use been made?**

42. In their written submissions, Wholebake say:

“We are instructed to submit a limited specification in respect of this matter for your consideration. The goods that are retained are those upon which the trade mark has been used, or are very closely similar thereto. For example, snack bars are identical or very closely similar to confectionery, cereal bars, energy bars, flapjacks, breakfast bars, cereal breakfast foods and preparations made wholly or principally of cereals and we ask that these are retained in the specification in the event that you see fit to remove any goods from it.”

43. The revised specification would read:

“Confectionery, cereal bars, energy bars, flapjack, breakfast bars, snack bars, cereal breakfast foods; preparations made wholly or principally of cereals, all for human consumption; prepared snack foods.”

44. It is clear from the case law mentioned above, that for use to be considered genuine it must be neither token nor internal. While it must be use with a view to creating or preserving a share in the market concerned, it need not be quantitatively significant nor is it necessary to show that a significant market share has been achieved. Although the relevant periods vary slightly in these proceedings, for present purposes they are in effect March 2003 to March 2008.

45. While some of the evidence provided by Mr Jones falls outside of the relevant period, the totality of the evidence clearly demonstrates that in the relevant period Wholebake have made use of a trade mark consisting of the numeral 9 and the word BAR presented in various formats. Turnover and amounts spent on promotion in the relevant period amounted to some £2.6m and £80k respectively. The goods were sold through large multiples such as Waitrose, Tesco, Sainsbury, Morrisons, Asda and Holland and Barrett as well as through a range of independent outlets. In addition, the trade marks were promoted at various trade shows such as IFE 2007 and featured in a range of publications such as “The Grocer”, “The Home Magazine”, “You are what you eat” and “Food and Beverage International.”

46. Insofar as the goods are concerned, the first part of the enquiry is for me to decide as a matter of fact on what goods the trade marks have been used. While the evidence refers to the goods as seed bars and snack bars, I note that Mr Jones describes the goods in his statement as snack bars.

47. Having identified the goods on which the trade mark has been used, I must now go on and determine what constitutes a fair specification. In this respect, it is clear from the comments in the *Thompson Holidays* and *Animal* trade mark cases that to answer this question I must put myself in the shoes of the average consumer and ask how they would describe the goods. Having done so, I think the average consumer faced with this question are likely to describe Wholebake's goods in a number of ways, for example, snack bars, cereal bars, energy bars and breakfast bars. However, as the words snack bars would, in my view, encompass all of these other possibilities, it is these words that would, in my view, represent a fair specification.

**48. In summary, I have concluded that Wholebake have not used their 9 BAR trade mark (and variations thereof) on all of the goods contained in their registration nor on all of the goods contained in the revised specification offered by them in their written submissions. However, I have concluded that they have made genuine use of their trade marks on a range of bars and that "snack bars" represents a fair specification.**

## **Conclusion**

49. The application has succeeded in totality. In the event that on appeal I am found to be wrong in my conclusion on the form of trade marks used and whether these constitute acceptable variations, the specification of the only surviving trade mark i.e. BAR 9 should be limited to snack bars.

## **Costs**

50. As the application for revocation has succeeded, TBBC are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide I award costs to them on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
<b>Total:</b>	<b>£400</b>

51. I order Wholebake Limited to pay to The Big Bar Company Limited the sum of £400. This sum is 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 12<sup>th</sup> day of November 2009**

**C J BOWEN  
For the Registrar  
the Comptroller-General**