

**O-532-16**

**TRADE MARKS ACT 1994  
CONSOLIDATED PROCEEDINGS**

**APPLICATION NO 500951 BY GT GLOBAL TRADEMARKS AG  
FOR THE REVOCATION OF TRADE MARK REGISTRATION NO 2362508**

**LOVE WHERE YOU LIVE**

**OWNED BY VARNISH BIDCO LIMITED**

**AND**

**TRADE MARK APPLICATION NO 3119186**

**HARVEYS LOVE WHERE YOU LIVE**

**IN THE NAME OF GT GLOBAL TRADEMARKS AG**

**AND THE OPPOSITION THERETO UNDER NO. 405888**

**BY**

**VARNISH BIDCO LIMITED**

## **Background and pleadings**

1. LOVE WHERE YOU LIVE is a registered trade mark in classes 20 and 35, owned by Varnish Bidco Limited (“the proprietor”). It was filed on 5 May 2004 and completed its registration procedure on 17 June 2005. On 31 July 2015, GT Global Trademarks AG (“the applicant”) applied to revoke the registration under section 46(1)(b) of the Trade Marks Act 1994 (“the Act”) on the grounds that it had not been put to genuine use between 24 July 2010 and 23 July 2015. The effective date of revocation claimed is 24 July 2015. The TM26(N) (the statutory application form) states that the applicant notified the proprietor on 23 July 2015 that the application to revoke the mark would be made.

2. The proprietor filed a defence and counterstatement in which it states that the mark is and was, at all material times, being used by the proprietor or with its consent, “such use having commenced or resumed before the date on which an application for revocation was made and preparations for the said commencement or resumption of use having begun before the Proprietor became aware that an application might be made for the purposes of Section 46(3) of the Act.”

3. The applicant had also filed a trade mark application for the mark HARVEYS LOVE WHERE YOU LIVE on 23 July 2015, in classes 20, 24, 27 and 35, published on 23 October 2015. The proprietor opposes the application under section 5(2)(b) of the Act, claiming a likelihood of confusion with its earlier mark 2362508 LOVE WHERE YOU LIVE (the subject of the application for revocation). The applicant denies the grounds, referring to its request for proof of use and its application for revocation of the earlier mark.

4. The proceedings were consolidated, with both sides filing evidence. Neither opted to be heard, but both filed written submissions in lieu of a hearing. Both sides are professionally represented.

## Relevant dates

5. The relevant dates for the application for revocation are 24 July 2010 to 23 July 2015, with a claim to the effective date of revocation as being 24 July 2015. The relevant dates for proof of use are 24 October 2010 to 23 October 2015, under section 6A of the Act. The relevant date for consideration of the section 5(2)(b) ground is the date of application of 3119186, which is 23 July 2015.

6. The interplay between the claimed revocation date for 2362508 and the date of application for 3119186 has a bearing on the effect of potential revocation and whether it will mean that the earlier mark, should it be revoked, can still be relied upon in the opposition. The short answer is that it can. This is because, even if the earlier mark is revoked in full, the claimed effective date of revocation was the day after 3119186 was applied for. This is therefore the earliest date that rights in the earlier mark would have ceased to exist. Therefore, on the application date for 3119186, 23 July 2015, the earlier mark would still have been in force and revocation would not have affected its validity as at the application date for 3119186<sup>1</sup>. I will look firstly at the revocation application but, for these reasons, it will still be necessary to look at the proof of use request and the opposition, even if the revocation application is wholly successful.

## Evidence

7. The proprietor is required to demonstrate genuine use in respect of the following goods and services for which the earlier mark is registered:

*Class 20: Furniture; pillows, bolsters, mattresses; beds, sofa beds; mirrors; picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.*

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<sup>1</sup> See the decision of Professor Ruth Annand, sitting as the Appointed Person in *Tax Assist*, BL O/220/12.

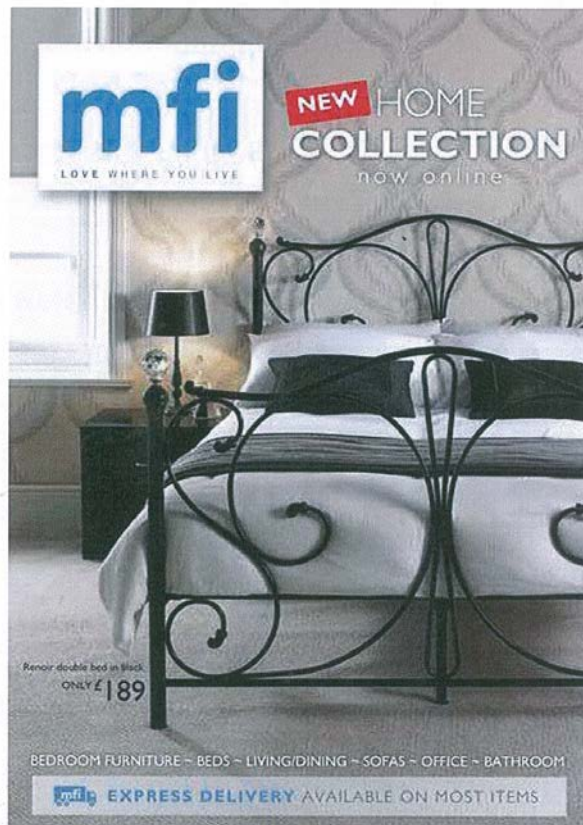
*Class 35: The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a general store specialising in household furniture (including home office furniture), appliances, apparatus, textiles and security.*

8. Evidence has been filed by Dominic Appleton, who is the proprietor's Chief Financial Officer. He states that the proprietor is a holding company within a larger group of companies trading predominantly in online bathroom and bedroom retail. The proprietor owns the controlling interest in Victoria Plum Limited ("Victoria") which operates the group's main retail website, victoriaplum.com. The proprietor also owns the controlling interest in M.F.I. Direct Limited ("MFI") which, from 30 November 2011 until July 2015 operated another of the group's websites, at mfi.co.uk. The proprietor acquired the rights to these businesses from the Walker family, in April 2014, along with the earlier trade mark registration. Mr Appleton states that the mark is currently being used by Victoria with the proprietor's consent, and was used prior to its acquisition by the Walker family's group of companies.

9. Mr Appleton states that, to the best of his knowledge and belief, the mark was in use by Victoria, MFI and/or the Walker group for "at least a two month period between July and August 2013". Mr Appleton states that there may have been other instances of use, but in the time available this is the only specific example which the in-house marketing team at Victoria have managed to locate by searching the Victoria archives. Mr Appleton refers to the fact that every shipment of goods to a customer of Victoria's website during the two month period July to August 2013 included a hard copy flyer, shown in Exhibit DA1. The flyer was sent out by Victoria with its goods as a form of cross-marketing to promote the MFI website. Mr Appleton explains that, at this time, the MFI website traded in a wide range of own-brand household furniture and accessories, including furniture, mattresses, beds, sofa beds, mirrors, various goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and/or substitutes for all these materials, and/or of plastics, own-brand domestic and home office furniture, appliances, apparatus (this is not specified), textiles and 'security'.

10. Mr Appleton states that the MFI website was an online-only continuation (from 30 November 2011) of the bricks and mortar MFI business (which ceased trading in December 2008). When the MFI website launched, it received press coverage. Some examples are shown in pages 14 to 18 of Exhibit DA1. The registered trade mark is not featured in the articles.

11. Exhibit DA1 contains twelve illustrative printouts from the MFI website showing the goods which were available on the website during or around the two month use period. These are taken from the Internet Archive. They are headed “mfi” and show a variety of goods, including bedroom furniture, mirrors, mattresses, sofa beds, TV units and other living room furniture, home office desks and office chairs. The registered mark does not appear in the printouts. The flyer, shown below, refers generally to the MFI ‘home collection’, being the sort of goods for which the MFI brand was previously known before it was an exclusively online retail operation. Mr Appleton states that it would have been clear, given the reputation of MFI, that the flyer referred to the goods and services available on the MFI website during the two month use period.



12. Mr Appleton states that, during the two month period, it is his belief, based on information given to him by employees of Victoria's marketing department, that around 25,000 individual goods shipments (at a value of £8 million) were sent to customers throughout the UK with the flyer included in the package. In July 2015, the proprietor decided to cease operating the MFI website owing to the re-branding and expansion of Victoria into home furnishings from 21 July 2015. Mr Appleton states that the trade mark is an important strategic brand:

“Before the Proprietor became aware of any intention on the part of the Applicant to apply to revoke the Trade Mark on the alleged basis that it has not been used, Victoria had been actively discussing plans to recommence use of the Trade Mark with the consent of the Proprietor. These discussions took place in early 2015 as part of the significant more general rebranding exercise undertaken by the VPL business [Victoria] which was announced and took effect on 21 July 2015 along with the expansion of VPL into home furnishings following months of planning...”.

13. Mr Appleton states that the rebrand and announcement of the expansion into home furnishings cost more than £100,000, receiving substantial media coverage (pages 20 to 23 of Exhibit DA1 show three examples of what appear to be online DIY/trade sites), including a national TV advertising campaign. The registered mark is not mentioned. According to Mr Appleton, the registered mark was identified during the rebranding process as a brand which Victoria would like to “reintroduce” as a marketing device and plans were made to do so. He states that no company within the proprietor's group was aware that the applicant might apply to revoke the trade mark, when the rebranding decisions were taken before July 2015.

14. Mr Appleton states that the proprietor's solicitors first informed the proprietor of the potential application on 31 July 2015, after receiving a fax notification from the applicant's representatives at 6.05pm on 30 July 2015. The fax referred to an earlier email (without stating any email address that was used) which was allegedly sent to the proprietor's solicitors dated 23 July 2015. Mr Appleton states that the proprietor's solicitors have informed him that no trace of the 23 July 2015 email has

been found, and he was, therefore, not told about it. He states that the rebranding decisions were taken prior to 23 July 2015, and he also refers to the two month use period in 2013, detailed above, as long pre-dating the applicant's revocation application.

15. Mr Appleton states that, on 4 August 2015, following the conclusion of the rebranding process and the decision to reintroduce the registered mark, Victoria's website displayed the mark until 16 October 2015 on all its pages. He states that the range of own branded furniture and accessories offered for sale on the website included furniture, mirrors and various goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and/or substitutes for all these materials, and/or plastics. Illustrative pages from the website are included at pages 24 to 37 of Exhibit DA1: Mr Appleton states that these show the range of own-brand goods available on Victoria's website at or around 4 August. Some of the prints are from the Internet Archive and are dated 11 August 2015, 30 August 2015 and 2 October 2015. These relate solely to bathrooms. An example of one of the website pages is shown here, from 11 August 2015 (split across two pictures):

VictoriaPlum.com

Trade Site Account Need help?

FREE DELIVERY IF YOU SPEND OVER £500



Shop all products Search Ideas Advice

Summer sale up to 60% off. Hurry offers of the week ends midnight Monday

BATHROOM BEDROOM Bedrooms coming soon!



Baths



Showers



Basins



Furniture



Heating



Suites



Taps



Toilets



Tiles



Accessories



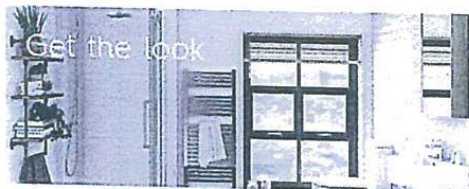
Offers

About VictoriaPlum.com  
 Request a free brochure  
 Help Centre  
 Finance Options  
 Product guarantees  
 Trade account



or browse a category

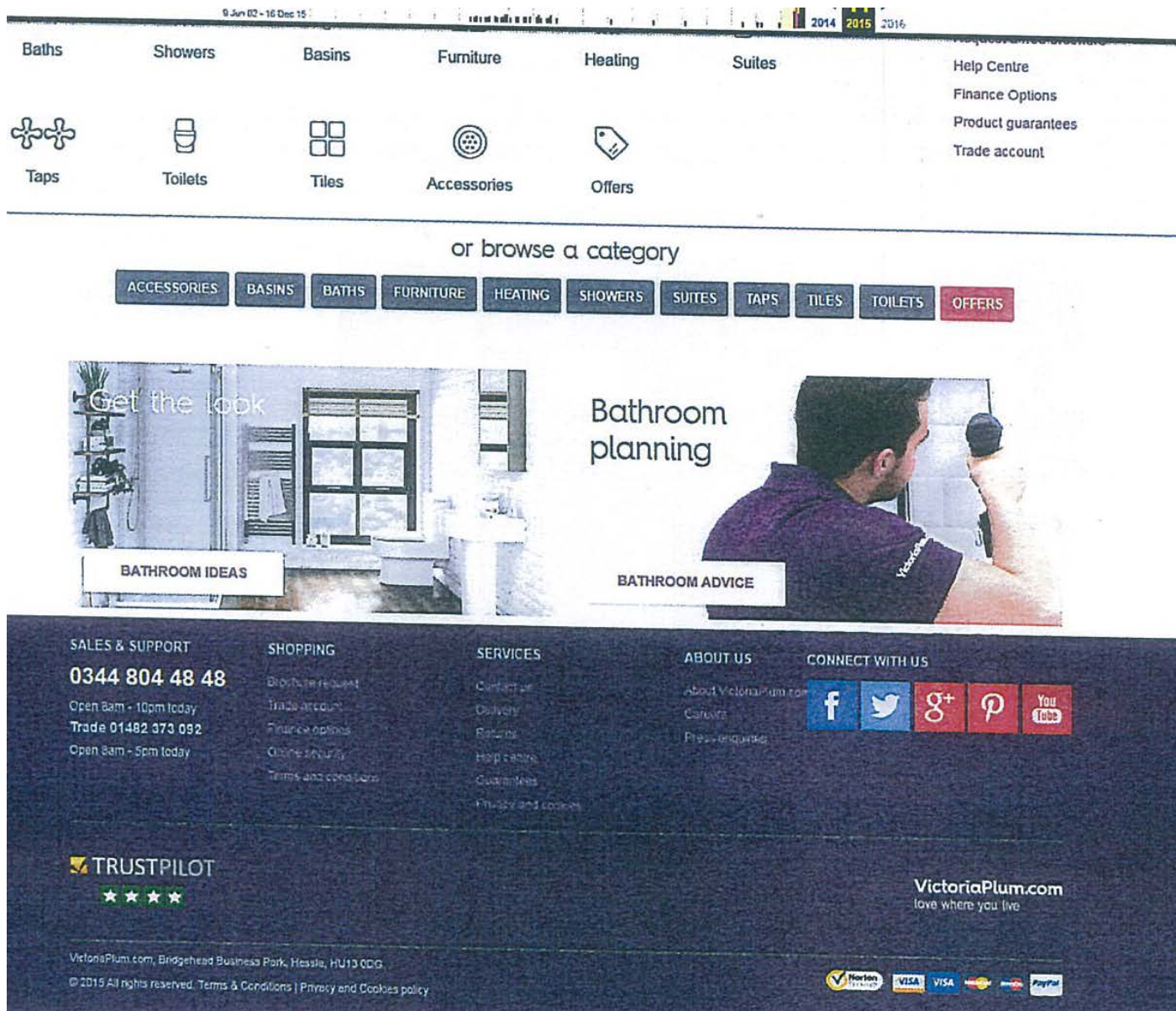
- ACCESSORIES
- BASINS
- BATHS
- FURNITURE
- HEATING
- SHOWERS
- SUITES
- TAPS
- TILES
- TOILETS
- OFFERS



Bathroom planning







16. The registered mark appears at the bottom of the page, underneath 'VictoriaPlum.com'. It does not appear anywhere else. The undated prints show bedroom furniture and mattresses.

17. Mr Appleton states that on or around 16 October 2015, the mark was mistakenly temporarily removed from Victoria's website following a technical update. The mistake was rectified on or around 8 December 2015.

18. Mr Appleton gives advertising and turnover figures for Victoria from 2010 onwards. Although most of these are not relevant because the mark did not appear

on its website until 4 August 2015, they do show the scale of the online business as it existed in August 2015. Turnover between March and November 2015 reached £53 million. The website received 9.5 million visits between March 2015 and the end of November 2015.

19. Mr Appleton states that the final page of Exhibit DA1 consists of the last page of Victoria's 2015/2016 brochure. He states that the brochure went to print on 15 October 2015, and would have been in its design and production phase for some 6 to 8 weeks prior to this date. At the time of Mr Appleton's witness statement, 17 December 2015, 20,000 copies had been, or would be, printed for distribution to customers and potential customers in the UK. The final page of the brochure is shown below:

# Terms and conditions

## CUSTOMER INFORMATION

Here at VictoriaPlum.com we're committed to providing you with the very best service. Our friendly and knowledgeable Customer Care Team are on hand to answer any queries you may have about your order, our products or our services.

You can contact us in the following ways: Call 0344 804 48 48. Use the live chat function at VictoriaPlum.com. Email us at [Info@VictoriaPlum.com](mailto:Info@VictoriaPlum.com). Tweet us at @VictoriaPlumUK. Send us a message via Facebook. All products in this brochure are sold subject to the terms and conditions listed on our website at VictoriaPlum.com.

## YOUR BATHROOM ORDER

When ordering your products, we can confirm if the goods are in stock and give you details of when they'll be delivered. We strongly advise that you do not confirm a start date with your installer until your goods have been delivered and have been checked.

## PRODUCTS AND PRICING

Every care has been taken to ensure that the descriptions, specifications and prices are correct at the time of going to print. All specifications are approximate and intended as a guide only. Whilst we make every effort to reproduce the colours of the products correctly, slight variations may occur during the print and photography process.

All prices shown include VAT at the standard rate and exclude delivery charges. The price information is correct at time of going to print. All prices and specifications are subject to change without prior notice due to an inadvertent error or events beyond our control, such as a change in VAT. The duration of this brochure is up to, and including, 31st December 2015. Prices may change after that date.

We reserve the right to amend our prices without prior notice. Please check item price on VictoriaPlum.com or with the Customer Care Team, as the current price will be shown when you place your order.



## LOWEST PRICE GUARANTEE

By designing and sourcing all our products directly, and with no expensive showrooms, we're able to offer you fantastic products at the lowest prices possible. We constantly check our prices against the likes of B&Q, Bathstore, Wickes and many more...

In fact, we are so confident that our prices are the best around, we offer a lowest price guarantee. If you're able to find an identical product elsewhere for less, we'll happily match it.

## BATHROOM IDEAS AND ADVICE

At VictoriaPlum.com, you'll find the latest trends, style guides and image galleries, along with practical advice in the form of how to guides, buying guides and videos. For further inspiration and great giveaways, you can also follow us on Twitter, Pinterest, Google+ and Instagram, or like our Facebook page.

## PRODUCT GUARANTEES

We take personal pride in the quality of our products. Every single item we sell is manufactured and supplied to the very highest standards. They undergo rigorous testing by our own quality control team and are only released for sale when we're 100% satisfied. In fact, we're so confident in the quality of our bathroom products, we'll happily guarantee each and every one you buy from us.

This extra cover is free of charge. Once you've completed your order, all you have to do to activate your guarantee is complete a quick and easy registration form. This will be sent to you by email 14 days after your products have been delivered. Tiles have a standard 1 year guarantee - this cannot be extended.

To find out more, please visit [VictoriaPlum.com/About/Our-Guarantees](http://VictoriaPlum.com/About/Our-Guarantees)

**VictoriaPlum.com**  
love where you live



Visit us at [VictoriaPlum.com](http://VictoriaPlum.com)

194 Order before 2pm for next day delivery

## STANDARD AND NEXT DAY DELIVERY INFORMATION

Small and medium items are delivered by a parcel courier, whilst large or fragile items are delivered by our specialist 2 person delivery service. We recommend that you check your delivery is complete and undamaged immediately upon arrival. Please open each box and check that everything is as ordered and appears in good condition. There is a single delivery charge per order depending on the quantity and size of the items on your order and your delivery address.

We deliver to all UK addresses, including Northern Ireland, Isle of Man and the Channel Islands. We can even deliver to the Republic of Ireland and other European countries. Here's a guide to our standard delivery charges to the majority of mainland UK addresses:

Postal items (Royal Mail) Standard - £3.99, Next day - £4.99  
Small items (parcel delivery) Standard - from £7.99, Next day - from £9.99  
Medium orders (parcel delivery) Standard - £16.99, Next day - £49.99  
Large/fragile orders (specialist) Standard - £34.99, Next day - £49.99

Standard deliveries are normally delivered within 5 working days. Next day deliveries apply to the next working day, but we are unable to deliver on Sundays, Mondays and Bank Holidays.

Reluctantly, due to the additional distance from our distribution centre and extra transportation costs involved, we have to charge an additional fee (on top of the standard delivery fee) when delivering to the following areas: Channel Islands, Isle of Wight, Isles of Scilly, Isle of Man, Northern Ireland, Republic of Ireland, Scottish Highlands and Islands.

Please contact our Customer Care Team on 0344 804 48 48 for further details or visit [VictoriaPlum.com](http://VictoriaPlum.com).

## RETURNS AND EXCHANGES

If you're not happy with your purchase, for any reason, we offer a 30 day no quibble returns policy. Return your product to us and we'll refund you.

After 30 days, you can exchange your product for another one up to 365 days after receiving it. Simply call us on 0344 804 48 48 and we'll arrange for either a prepaid returns label to be sent to you, or for a courier to collect the returned item(s). We'll also be happy to arrange any alternative items to be sent to you. Before returning your items, please complete the returns section of your delivery note.

\*Collection & redelivery fees apply. Please see "Charges" section below. Applies to Retail customers only. Trade customers please see the Trade website.

## DAMAGED GOODS

Whilst all our products pass strict quality standards, on very rare occasions you may find an item arrives damaged.

Please make sure you inspect your goods as soon as you receive them and let us know within 30 days of receipt if an item is damaged, by calling us on 0344 804 48 48. Once the damage has been confirmed, we'll ensure it's replaced free of charge, and with the minimum of fuss.

In the case of tiles, it is not unusual to have a small proportion of the tile broken to some degree (e.g. chipped edges). These damaged tiles can be used for the cuts you will need to make. If you find an unacceptable proportion of your tiles are damaged please contact us on 0344 804 48 48.

## CHARGES

- We won't charge you a restocking fee for returning your products, but you will be required to pay the transportation costs associated with the return. This will depend on the size, weight and type of item(s) being returned.
- If the items being returned can be sent by parcel service, we can arrange for a collection or send you a prepaid postage label if you wish. The charge for this will be £7.99. Alternatively you may return your items by Royal Mail parcel service to our returns address and pay the cost of the return directly to Royal Mail.
- If your items aren't suitable for the parcel service, we'll arrange for our courier service to collect the products from you. The charge for this will be £39.99.
- If there was a surcharge on your original delivery (due to additional transport costs), we'll have to apply a similar charge to your collection. This will be charged at the applicable rate at the time of collection.
- If you are exchanging an unwanted item, you will also be required to pay the delivery cost of your new item.
- Your statutory rights are not affected.

VictoriaPlum.com (Victoria Plum Ltd) - Registered No 4177694 (VAT registered No 190030626)

VictoriaPlum.com, Bridgehead Business Park, Heesle HU13 6DG.

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For more details call 0344 804 48 48. Our Customer Care Team are available 7 days a week.

20. The applicant's evidence comes from David Lutkin, who is a consultant to the applicant's professional representatives. Mr Lutkin states that he contacted the proprietor's representatives on 23 July 2015, requesting voluntary cancellation of the registration, or assignment to the applicant. Mr Lutkin states that he indicated that the application for revocation would be filed if no substantive reply was received by

close of business on 31 July 2015. No reply was received, and so Mr Lutkin prepared and filed the application for revocation.

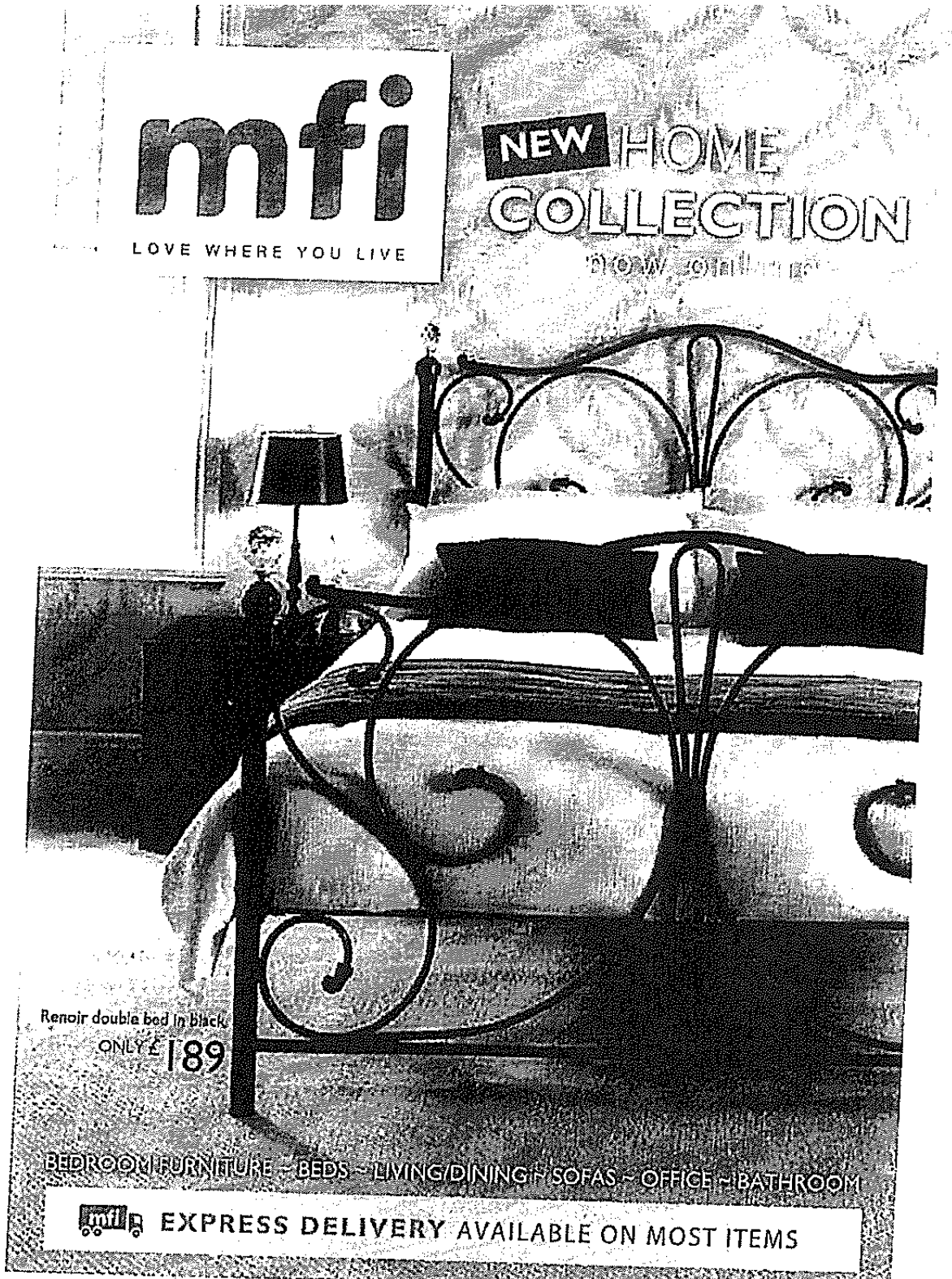
21. Mr Lutkin criticises the proprietor's evidence relating to the flyer, noting that the flyer does not provide MFI's website address. Mr Lutkin therefore doubts its veracity as having promoted the website, considering it to be a draft. He exhibits, at DBL1, a print from the MFI website (from the Internet Archive), dated 17 June 2013 which shows the same bed as depicted on the flyer. Mr Lutkin points out that the print shows the use of the MFI brand, but without the registered mark.

22. The proprietor's reply evidence includes its response to the applicant's challenge to the probity of the flyer. Mr Appleton states, in his second witness statement, that the information he gave in his first statement about the flyer was given to him by Chris Johnson, Head of Design at Victoria. Mr Johnson has also provided a witness statement to confirm that information. Mr Appleton states that the details he gave were not at all fabricated. He also states that Victoria's accounts show that 27,799 separate shipments were dispatched during the two month use period in 2013, and these included the flyer.

23. Mr Johnson states that:

- As Head of Design, he worked within Victoria's in-house marketing team during the Spring and Summer of 2013 and was directly responsible for the design and marketing of the flyer.
- Initial design concepts and drafts were deleted, as is standard practice, to save space on Victoria's server.
- The electronically time-stamped artwork file showing the date the artwork was finalised has been lost due to an encryption attack on Victoria's servers.
- The flyer exhibited to Mr Appleton's first statement consisted of the first page of the final version of the flyer which was sent to customers in hard copy between July and August 2013. It was not a draft. The flyer is, in fact a two-page document, but Mr Appleton only produced the first page in his exhibit.

The entire flyer (Exhibit CJ1) is shown here, showing the MFI website address:



The advertisement features a black and white photograph of a double bed with a decorative metal frame. The bed is set up with a white duvet and pillows. To the left of the bed is a bedside table with a lamp. The background is a textured, light-colored wall.

**mfi**  
LOVE WHERE YOU LIVE

**NEW HOME COLLECTION**

Renoir double bed in black  
ONLY £189


BEDROOM FURNITURE - BEDS - LIVING/DINING SOFAS - OFFICE - BATHROOM

**mfi** EXPRESS DELIVERY AVAILABLE ON MOST ITEMS

# mfi

**DISCOVER THE NEW COLLECTION**  
EXCLUSIVE AND ONLINE AT [MFI.CO.UK](http://MFI.CO.UK)

If you like victoria plumb, you'll love **mfi**. Discover stylish sofas, chic chairs, classic cabinets and so much more online today. All with same quality, attention to detail and value for money you expect from **mfi**



**PESARO BEDROOM FURNITURE RANGE**  
FROM ONLY **£99**

The Pesaro collection is a modern twist on the old Shaker style of furniture. As a result, we have created a truly beautiful bedroom range in a white painted finish with a feminine look and feel.

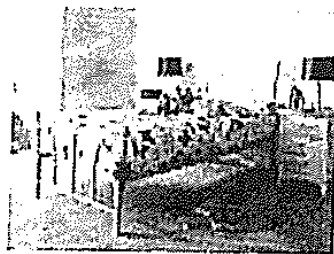
1. 4x2 drawer chest - £219	4. 7 drawer narrow chest - £219
2. 2 draw wardrobe - £299	5. 3x2 drawer chest - £199
3. 3 drawer bedside - £99	6. Twin pedestal dressing table - £279



**EXPRESS DELIVERY AVAILABLE ON MOST ITEMS**



**STYLISH DINING**  
FROM ONLY **£59**



**KIDS**  
FROM ONLY **£19**



**HOME OFFICE**  
FROM ONLY **£39**

**SPREAD THE COST WITH EASY FINANCE OFFERS**

INTEREST FREE CREDIT  BUY NOW PAY LATER

[mfi.co.uk](http://mfi.co.uk)   0845 122 4500

- The Managing Director of Victoria, Ged Lees, instructed Victoria's warehouse team to send the flyer out with every single order.

## **Revocation decision**

24. Section 46 of the Act states:

“(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) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

(d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(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 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) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(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. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks:

“217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

26. The onus is on the proprietor to show use because Section 100 of the Act states:

“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.”

27. The relevant period for proving genuine use is 24 July 2010 to 23 July 2015.

28. In *Plymouth Life Centre*, O/236/13 Mr Daniel Alexander QC, sitting as the appointed person, observed that:

“20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time to review the material that it has to prove use of it.

...

The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

29. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other

factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

30. Genuine use can include a launch phase (*MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* Case T-334/01, General Court) and goods which have not yet been sold, but the marketing of which has already happened or is imminent and for which preparations to secure customers are underway, particularly in the form of advertising campaigns.

31. The evidence which the proprietor has provided essentially comes down to:

(i) the flyer, sent out in about 27,799 packages to customers in July and August 2013; and

(ii) preparations during 2015 for resumption of use of the mark.

Mr Appleton states that this is all the use which the proprietor has been able to provide in the time allowed. This is not a great deal of evidence.

32. There is no continuous use of the mark over the course of the relevant period. The circumstances of the case include the fact that the proprietor's companies were undergoing a time of change, including the acquisition of the companies from the Walker family, and the re-emergence and subsequent ceasing of trading under the MFI name.

33. The flyer was sent out in 27,799 packages during the two month period July and to August 2013. There is no explanation as to what happened after this time until 2015, when the proprietor's company, Victoria, shows a renewed interest in using the mark. Use had, therefore, presumably ceased at some point. It is irrelevant how many visits were made to the MFI website because there is no evidence that the mark was displayed on the MFI website; in fact, the applicant has provided evidence that it was not, which has not been countered by the proprietor. The mark only appears on the flyer, as a sub-brand of MFI, sent out with packages under the Victoria Plumb mark. At best, given no evidence of sales in relation to the mark, these marketing efforts could be viewed as the creation of an outlet for goods and services in relation to which the mark is used.

34. The applicant criticises the probity of the flyer. I consider that the proprietor has satisfactorily answered the challenge in its evidence in reply. However, it is not the case that every proven commercial use of a mark may automatically be deemed to constitute genuine use (*Reber*). In my view, the 'flyer use' of the mark, as a sub-brand beneath "MFI", did not qualify as real commercial use for the purposes of creating an outlet for goods and services in relation to which the mark is registered for two reasons: a) the flyer was used very briefly and b) any customers who followed up the flyer by visiting the MFI website would not then have encountered the registered mark on the website. These two factors combined mean that the use is inconsistent with the essential function of a trade mark, whereby the mark enables

the consumer to distinguish the goods and services from those of another origin. The flyer was not used consistently over time and did not form a frequent part of the proprietor's (and its predecessor's) marketing. A speculative flyer sent with goods is a relatively weak method of bringing a trade mark to the attention to consumers (who have bought the goods from a different outlet). All these factors point to the flyer as not showing genuine use of the registered mark.

35. There is little supporting evidence about the proprietor's/Victoria's plans in 2015 to reintroduce the trade mark. What there is consists of the pages from Victoria's website, which is dated after the relevant period and also after the section 46(3) period. Section 46(3) relates to "...use as is referred to in [section 46(1)(b)]" which, in itself, is a reference to genuine use; it follows, therefore, that the use that is commenced in the period section 46(3) period must qualify as genuine use. The mark is featured right at the bottom of the webpages, underneath VictoriaPlum.com, and the final page of the draft brochure, where it appears at the bottom of the small print, underneath the website name. The positioning of the mark on both the website and on the final page of the brochure, underneath the small print, again raises the question of how visible the mark would have been to the consumer. For instance, the top of the website pages show "Victoria.Plum.com", but the registered mark does not appear underneath. There are no other pages of the draft brochure shown, such as the front page, where one would expect to see trade marks. The only way that a consumer would encounter the mark is if, for some reason, they scrolled to the very bottom of the web page, underneath the Facebook, Twitter, Google, Pinterest and YouTube icons, or if they read the small print in the brochure. The mark, as it appears in this evidence, is proportionately quite small. Again, the evidence does not strike me as showing real commercial use for the purposes of creating an outlet for goods and services in relation to which the mark is registered.

36. I find that the mark was not put to genuine use during the relevant period and that the proprietor cannot avail itself of the proviso to section 46(3) of the Act.

## **Revocation outcome**

37. The outcome is that registration number 2362508 is revoked from 24 July 2015.

## **The opposition**

38. Section 6A of the Act provides:

“(1) This section applies where—

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has 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, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

- (a) 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



(b) 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.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects—

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4)(relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

39. The proof of use dates differ in that the relevant period is 24 October 2010 to 23 October 2015. In my decision on the application for revocation, I considered the proprietor’s evidence after the relevant dates. This evidence fell within the period for proof of use in the opposition. My findings also apply here; there was no genuine use of the mark within the relevant period. The proprietor may not, therefore, rely upon its mark as an earlier mark for the purposes of its opposition.

### **Overall outcome**

40. Registration number 2362508 is revoked from 24 July 2015. The opposition fails. Subject to appeal, the application may proceed to registration.

## Costs

41. The applicant has been successful. Bearing in mind the consolidation, which would have reduced costs<sup>2</sup>, I order Varnish Bidco Limited to pay GT Global Trademarks AG the sum of £1700 which, in the absence of an appeal, should be paid within fourteen days of the expiry of the appeal period. This sum is calculated as follows:

Official fee for form TM26(N)	£200
Filing the revocation application and considering the counterstatement	£300
Considering the opposition and filing a counterstatement	£200
Filing and considering evidence	£700
Filing written submissions	£300
Total	£1700

**Dated this 16th day of November 2016**

**Judi Pike**  
**For the Registrar,**  
**the Comptroller-General**

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<sup>2</sup> As per the scale set out in Tribunal Practice Notice 4/2007.  
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